Chapter 700 Examination of Applications

701 Statutory Authority for Examination
702 Requisites of the Application
702.01 Obviously Informal Cases
703 "General Information Concerning Patents"
704 Search and Requirements for Information
704.01 Search
704.10 Requirements for Information
704.11 What Information May Be Required
704.11(a) Examples of Information Reasonably Required
704.11(b) When May a Requirement for Information Be Made
704.12 Replies to a Requirement for Information
704.12(a) Relationship of Requirement for Information to Duty of Disclosure
704.12(b) What Constitutes a Complete Reply
704.12(c) Treatment of an Incomplete Reply
704.13 Time Periods for Reply
704.14 Making a Requirement for Information
704.14(a) Format of the Requirement
704.14(b) Examiner's Obligation Following Applicant's Reply
704.14(c) Petitions to Requirements Under 37 CFR 1.105
704.14(d) Relationship to Information Disclosure Statements
705 Patentability Reports
705.01 Instructions re Patentability Reports
705.01(a) Nature of P.R., Its Use and Disposal
705.01(b) Sequence of Examination
705.01(c) Counting and Recording P.R.s
705.01(d) Duplicate Prints of Drawings
705.01(e) Limitation as to Use
705.01(f) Interviews With Applicants
706 Rejection of Claims
706.01 Contrasted With Objections
706.02 Rejection on Prior Art
706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent
706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent
706.02(c) Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale
706.02(d) Rejections Under 35 U.S.C. 102(c)
706.02(e) Rejections Under 35 U.S.C. 102(d)
706.02(f) Rejections Under 35 U.S.C. 102(e)
706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e)
706.02(f)(2) Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application
706.02(g) Rejections Under 35 U.S.C. 102(f)
706.02(h) Rejections Under 35 U.S.C. 102(g)
706.02(i) Form Paragraphs for Use in Rejections Under 35 U.S.C. 102
706.02(j) Contents of a 35 U.S.C. 103 Rejection
706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103
706.02(l) Rejections Under 35 U.S.C. **>103(a) Using Prior Art Under Only 35 U.S.C. 102(e), (f), or (g)<
706.02(l)(1) Rejections Under 35 U.S.C. **>103(a) Using Prior Art Under 35 U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under 35 U.S.C. 103(c)<
706.02(l)(2) Establishing Common Ownership >or Joint Research Agreement<
706.02(l)(3) Examination Procedure with Respect to 35 U.S.C. 103(c)
706.02(m) Form Paragraphs for Use in Rejections Under 35 U.S.C. 103
706.02(n) Biotechnology Process Applications; 35 U.S.C. 103(b)
706.03 Rejections Not Based on Prior Art
706.03(a) Rejections Under 35 U.S.C. 101
706.03(b) Barred by Atomic Energy Act
706.03(c) Rejections Under 35 U.S.C. 112, First Paragraph
706.03(d) Rejections Under 35 U.S.C. 112, Second Paragraph
706.03(k) Duplicate Claims
706.03(m) Nonelected Inventions
706.03(o) New Matter
706.03(s) Foreign Filing Without License
706.03(u) Disclaimer
706.03(v) After Interference or Public Use Proceeding
706.03(w) *Res Judicata*
706.03(x) Reissue
706.04 Rejection of Previously Allowed Claims
706.05 Rejection After Allowance of Application
706.06 Rejection of Claims Copied From Patent
706.07 Final Rejection
706.07(a) Final Rejection, When Proper on Second Action
706.07(b) Final Rejection, When Proper on First Action
706.07(c) Final Rejection, Premature
706.07(d) Final Rejection, Withdrawal of, Premature
706.07(e) Withdrawal of Final Rejection, General
706.07(f) Time for Reply to Final Rejection
706.07(g) Transitional After-Final Practice
706.07(h) Request for Continued Examination (RCE) Practice
707 Examiner's Letter or Action

INFINEON 1039
Infineon v. Mosaid
IPR2025-01171

707.01 Primary Examiner Indicates Action for New Assistant
707.02 Applications Up for Third Action and 5-Year Applications
707.05 Citation of References
707.05(a) Copies of Cited References
707.05(b) Citation of Related Art and Information by Applicants
707.05(c) Order of Listing
707.05(d) Reference Cited in Subsequent Actions
707.05(e) Data Used in Citing References
707.05(f) Effective Dates of Declassified Printed Matter
707.05(g) Incorrect Citation of References
707.06 Citation of Decisions, Orders Memorandums, and Notices
707.07 Completeness and Clarity of Examiner's Action
707.07(a) Complete Action on Formal Matters
707.07(b) Requiring New Oath
707.07(c) Draftsperson's Requirement
707.07(d) Language To Be Used In Rejecting Claims
707.07(e) Note All Outstanding Requirements
707.07(f) Answer All Material Traversed
707.07(g) Piecemeal Examination
707.07(h) Notify of Inaccuracies in Amendment
707.07(i) Each Claim To Be Mentioned in Each Office Action
707.07(j) State When Claims Are Allowable
707.07(k) Numbering Paragraphs
707.07(l) Comment on Examples
707.08 Reviewing and Initialing by Assistant Examiner
707.09 Signing by Primary or Other Authorized Examiner
707.10 Entry
707.11 Date
707.12 Mailing
707.13 Returned Office Action

708 Order of Examination

708.01 List of Special Cases
708.02 Petition To Make Special
708.03 Examiner Tenders Resignation

709 Suspension of Action

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee

710 Period for Reply

710.01 Statutory Period
710.01(a) Statutory Period, How Computed
710.02 Shortened Statutory Period and Time Limit Actions Computed
710.02(b) Shortened Statutory Period: Situations in Which Used
710.02(c) Specified Time Limits: Situations In Which Used
710.02(d) Difference Between Shortened Statutory Periods for Reply and Specified Time Limits
710.02(e) Extension of Time
710.04 Two Periods Running
710.04(a) Copying Patent Claims
710.05 Period Ending on Saturday, Sunday, or a Federal Holiday
710.06 Situations When Reply Period Is Reset or Restarted

711 Abandonment of Patent Application

711.01 Express or Formal Abandonment
711.02 Failure To Take Required Action During Statutory Period
711.02(a) Insufficiency of Reply
711.02(b) Special Situations Involving Abandonment
711.02(c) Termination of Proceedings
711.03 Reconsideration of Holding of Abandonment; Revival
711.03(a) Holding Based on Insufficiency of Reply
711.03(b) Holding Based on Failure To Reply Within Period
711.03(c) Petitions Relating to Abandonment
711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding
711.04 Public Access to Abandoned Applications
711.04(a) Pulling and Forwarding Abandoned Applications
711.04(b) Ordering of Patented and Abandoned Files
711.04(c) Notifying Applicants of Abandonment
711.05 Letter of Abandonment Received After Application is Allowed
711.06 Abstracts, Abbreviatures, and Defensive Publications
711.06(a) Citation and Use of Abstracts, Abbreviatures, and Defensive Publications as References

713 Interviews

713.01 General Policy, How Conducted
713.02 Interviews Prior to First Official Action
713.03 Interview for "Sounding Out" Examiner Not Permitted
713.04 Substance of Interview Must Be Made of Record
713.05 Interviews Prohibited or Granted, Special Situations
713.06 No Inter Partes Questions Discussed Ex Parte
713.07 Exposure of Other Cases
713.08 Demonstration, Exhibits, Models
713.09 Finally Rejected Application

713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312

714 Amendments, Applicant's Action

714.01 Signatures to Amendments
714.01(a) Unsigned or Improperly Signed Amendment
714.01(c) Signed by Attorney or Agent Not of Record
714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record
714.01(e) Amendments Before First Office Action
714.02 Must Be Fully Responsive
714.03 Amendments Not Fully Responsive, Action To Be Taken
714.03(a) >Supplemental< Amendment **
714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty
714.05 Examiner Should Immediately Inspect
714.06 Amendments Sent to Wrong Technology Center
714.07 Amendments Not in Permanent Ink
**
714.10 Claims Added in Excess of **>Claims Previously Paid For<
714.11 Amendment Filed During Interference Proceedings
714.12 Amendments >and other Replies< After Final Rejection or Action
714.13 Amendments >and other Replies< After Final Rejection or Action, Procedure Followed
714.14 Amendments After Allowance of All Claims
714.15 Amendment Received in Technology Center After Mailing of Notice of Allowance
714.16 Amendment After Notice of Allowance, 37 CFR 1.312
714.16(a) Amendments Under 37 CFR 1.312, Copied Patent Claims
714.16(b) Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR *>41.208<
714.16(c) Amendments Under 37 CFR 1.312, Additional Claims
714.16(d) Amendments Under 37 CFR 1.312, Handling
714.16(e) Amendments Under 37 CFR 1.312, Entry in Part
714.17 Amendment Filed After the Period for Reply Has Expired
714.18 Entry of Amendments
714.19 List of Amendments, Entry Denied
714.20 List of Amendments Entered in Part
714.21 Amendments Inadvertently Entered, No Legal Effect
**
714.25 Discourtesy of Applicant or Attorney

715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131

715.01 37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits
715.01(a) Reference Is a Joint Patent or Published Application to Applicant and Another
715.01(b) Reference and Application Have Common Assignee
715.01(c) Reference Is Publication of Applicant's Own Invention
715.01(d) Activities Applied Against the Claims
715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims
715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question
715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations
715.05 U.S. Patent or Application Publication Claiming Same Invention
715.07 Facts and Documentary Evidence
715.07(a) Diligence
715.07(b) Interference Testimony Sometimes Used
715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country
715.07(d) Disposition of Exhibits
715.08 Passed Upon by Primary Examiner
715.09 Seasonable Presentation
715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode

716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

716.01 Generally Applicable Criteria
716.01(a) Objective Evidence of Nonobviousness
716.01(b) Nexus Requirement and Evidence of Nonobviousness
716.01(c) Probative Value of Objective Evidence
716.01(d) Weighing Objective Evidence
716.02 Allegations of Unexpected Results
716.02(a) Evidence Must Show Unexpected Results
716.02(b) Burden on Applicant
716.02(c) Weighing Evidence of Expected and Unexpected Results
716.02(d) Unexpected Results Commensurate in Scope With Claimed Invention
716.02(e) Comparison With Closest Prior Art
716.02(f) Advantages Disclosed or Inherent
716.02(g) Declaration or Affidavit Form
716.03 Commercial Success

716.03(a) Commercial Success Commensurate in Scope With Claimed Invention
716.03(b) Commercial Success Derived From Claimed Invention
716.04 Long-Felt Need and Failure of Others
716.05 Skepticism of Experts
716.06 Copying
716.07 Inoperability of References
716.08 Utility and Operability of Applicant's Disclosure
716.09 Sufficiency of Disclosure
716.10 Attribution
718 Affidavit or Declaration to Disqualify Commonly Owned Patent or Published Application as Prior Art, 37 CFR 1.130
719 File Wrapper
719.01 Papers in File Wrapper
719.01(a) Arrangement of Papers in File Wrapper
719.01(b) Prints
719.02 Data Entered on File Wrapper
719.02(b) Name or Residence of Inventor or Title Changed
719.03 Classification During Examination
719.04 Index of Claims
719.05 Field of Search
719.06 Foreign Filing Dates
719.07 Related Applications
720 Public Use Proceedings
720.01 Preliminary Handling
720.02 Examiner Determination of *Prima Facie* Showing
720.03 Preliminary Hearing
720.04 Public Use Proceeding Testimony
720.05 Final Decision
724 Trade Secret, Proprietary, and Protective Order Materials
724.01 Completeness of the Patent File Wrapper
724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials
724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02
724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02
724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122
724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)
724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)
724.05 Petition To Expunge Information or Copy of Papers in Application File
724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File

701 Statutory Authority for Examination

35 U.S.C. 131. Examination of application.

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102 and 103.

35 U.S.C. 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Form paragraph 7.04 copies 35 U.S.C. 101. See MPEP § 706.03(a).

35 U.S.C. 100. Definitions.

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or *inter partes* reexamination under section 311 who is not the patent owner.

702 Requisites of the Application [R-3]

When a new application is assigned in the Technology Center, the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111(a). Any matters affecting the filing date or abandonment of the application, such as lack of an oath or declaration, filing fee, or claims should be checked **. For Image File Wrapper (IFW) processing, see IFW Manual sections 3.1 and 3.3.

The examiner should be careful to see that the application meets all the requisites set forth in MPEP Chapter 600 both as to formal matters and as to the

completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

702.01 Obviously Informal Cases [R-2]

When an application is reached for its first Office action and it is then discovered to be impractical to give a complete action on the merits because of an informal or insufficient disclosure, the following procedure may be followed:

(A) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention and claims and any apparently pertinent art cited. In the rare case in which the disclosure is so incomprehensible as to preclude a reasonable search, the Office action should clearly inform applicant that no search was made;

(B) Informalities noted by the Office of Initial Patent Examination (OIPE) and deficiencies in the drawing should be pointed out by means of attachments to the Office action (see MPEP § 707.07(a));

(C) A requirement should be made that the specification be revised to conform to idiomatic English and United States >patent< practice;

(D) The claims should be rejected as failing to define the invention in the manner required by 35 U.S.C. 112 if they are informal. A blanket rejection is usually sufficient.

The examiner should attempt to point out the points of informality in the specification and claims. The burden is on the applicant to revise the application to render it in proper form for a complete examination.

If a number of obviously informal claims are filed in an application, such claims should be treated as being a single claim for fee and examination purposes.

It is obviously to applicant's advantage to *file* the application with an adequate disclosure and with claims which conform to the U.S. Patent and Trademark Office usages and requirements. This should be done whenever possible. If, however, due to the pressure of a Convention deadline or other reasons, this is not possible, applicants are urged to submit *promptly, preferably within 3 months after filing*, a preliminary amendment which corrects the obvious informalities. The informalities should be corrected to the extent that the disclosure is readily understood and the claims to be initially examined are in proper form, particularly as to dependency, and otherwise clearly define the invention. "New matter" must be excluded from these amendments since preliminary amendments >filed after the filing date of the application< do not enjoy original disclosure status. See MPEP § 608.04(b).

Whenever, upon examination, it is found that the terms or phrases or modes of characterization used to describe the invention are not sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected, to enable the examiner to make the examination specified in 37 CFR 1.104, the examiner should make a reasonable search of the invention so far as it can be understood from the disclosure. The action of the examiner may be limited to a citation of what appears to be the most pertinent prior art found and a request that applicant correlate the terminology of the specification with art-accepted terminology before further action is made.

Use form paragraph 7.01 where the terminology is such that a proper search cannot be made.

>

¶ *7.01 Use of Unconventional Terminology, Cannot Be Examined*

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that a proper search of the prior art cannot be made. For example: **[1]**

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. Use this or form paragraph 7.02 when a proper search cannot be made. However, see MPEP § 702.01 which requires a reasonable search.

2. In bracket 1, fill in an appropriate indication of the terminology, properties, units of data, etc. that are the problem as well as the pages of the specification involved.

3. For the procedure to be followed when only the drawing is informal, see MPEP §§ 608.02(a) and 608.02(b).

<

Use form paragraph 7.02 where the application is so incomprehensible that a reasonable search cannot be made.

¶ *7.02 Disclosure Is Incomprehensible*

The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: **[1]**

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (*i.e.*, matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. Use this form paragraph when a search cannot be made.
2. In bracket 1, indicate the page numbers and features which are not understood.
3. See form paragraphs 6.28 and 6.30 for improper idiomatic English.
4. Use form paragraphs 7.31.01 – 7.31.04, as appropriate, for a rejection of claims (when necessary) based on the deficiencies set forth in this form paragraph.

For the procedure to be followed when only the drawing is informal, see MPEP § 608.02(a) and § 608.02(b).

703 "General Information Concerning Patents"

The booklet "General Information Concerning Patents" for use by applicants contemplating the filing or prosecution of their own applications, may be purchased from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. The booklet is also available from the USPTO Web page at: http://www.uspto.gov.

704 Search and Requirements for Information

704.01 Search

After reading the specification and claims, the examiner searches the prior art. The subject of searching is more fully treated in MPEP Chapter 900. See especially MPEP § 904 through § 904.03. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution.

PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See MPEP § 719.05.

704.10 Requirements for Information [R-3]

37 CFR 1.105. Requirements for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii)*In Use:* Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

>

(viii) *Technical information known to applicant.* Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information per-

tinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items.<

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

**>

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.<

>

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

<

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

An examiner or other Office employee may require from individuals identified under 37 CFR 1.56(c), or any assignee, the submission of such information as may be reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111, in a pending or abandoned application that has entered the national stage under 35 U.S.C. 371, in a patent, or in a reexamination proceeding. The scope of 37 CFR 1.105 is extended to any assignee because the information required may be known to some members of the assignee even if not known by the inventors.

The authority for the Office to make such requirements arises from the statutory requirements of examination pursuant to 35 U.S.C. 131 and 132. An examiner or other Office employee may make a requirement for information reasonably necessary to the examination or treatment of a matter in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports. See *Star Fruits S.N.C. v. United States*, **>393 F.3d 1277, 1283, 73 USPQ2d 1409, 1414 (Fed. Cir. 2005) ("Star Fruits' argument fails to come to grips with the real issue in this case, which is whether the Office can use section 1.105 to compel disclosure of information that the examiner deems pertinent to patentability when the applicant has a contrary view of the applicable law. We answer this question in the affirmative.")<

704.11 What Information May Be Required [R-3]

Information which may be required under 37 CFR 1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111 (including a reissue application), in a pending or abandoned application that has entered the national stage under 35 U.S.C. 371, in a patent, or in a reexamination proceeding.

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

>The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.<

INFORMATION REASONABLY NECESSARY FOR FINDING PRIOR ART

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP § 704.01 and §§ 904 – 904.03.

The criteria of reasonable necessity is generally met, e.g., where:

(A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or

(B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination.

The first instance generally occurs where the invention as a whole is in a new area of technology which has no patent classification or has a class with few pieces of art that diverge substantially from the nature of the claimed subject matter. In this situation, the applicant is likely to be among the most knowledgeable in the art, as evidenced by the scarcity of art, and requiring the applicant's information of areas of search is justified by the need for the applicant's expertise.

The second instance generally occurs where the application file, or other related applications or publications authored by the applicant, suggests the applicant likely has access to information necessary to a more complete understanding of the invention and its context. In this situation, the record suggests that the details of such information may be relevant to the issue of patentability, and thus shows the need for information in addition to that already submitted by the applicant.

704.11(a) Examples of Information Reasonably Required [R-3]

37 CFR 1.105(a)(1)(i)-*>(viii)< lists specific examples of information that may be reasonably required. Other examples, not meant to be exhaustive, of information that may be reasonably required for examination of an application include:

(A) The name and citation of any particularly relevant indexed journal, or treatise.

(B) The trade name of any goods or services the claimed subject matter is embodied in.

(C) The citation for, the dates initially published and copies of any advertising and promotional literature prepared for any goods or services the claimed subject matter has been embodied in.

(D) The citation for and copies of any journal articles describing any goods or services the claimed subject matter has been embodied in.

(E) The trade names and providers of any goods or services in competition with the goods or services the claimed subject matter has been embodied in.

(F) Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or services the claimed subject matter has been embodied in.

(G) Identification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application.

(H) A reply to a matter raised in a protest under 37 CFR 1.291.

(I) An explanation of technical material in a publication, such as one of the inventor's publications.

(J) The identification of changes made in a reformatted continuing application filed under 37 CFR 1.53(b).

(K) A mark-up for a continuation-in-part application showing the subject matter added where there is an intervening reference.

(L) Comments on a new decision by the Federal Circuit that appears on point.

(M) The publication date of an undated document mentioned by applicant that may qualify as printed publication prior art (35 U.S.C. 102(a) or (b)).

(N) Comments on information of record which raises a question of whether applicant derived the invention from another under 35 U.S.C. 102(f).

>

(O) Art related to applicant's invention, applicant's disclosure, or the claimed subject matter.

(P) Other factual information pertinent to patentability.

(Q) The accuracy of the examiner's stated analysis of such items.

(R) Clarification of the correlation and identification of what structure, material, or acts set forth in the specification would be capable of carrying out a function recited in a means or steps plus function claim limitation. If it is not apparent to the examiner where in the specification and drawings there is support for a particular claim limitation reciting a means to accomplish a function, and if an inquiry by the examiner for such support is met by a stated lack of knowledge thereof by the applicant, the examiner could very well conclude that there is no such support and make appropriate rejections under, for example, 35 U.S.C. 112, first paragraph (written description) and 35 U.S.C. 112, second paragraph.

(S) Interrogatories or Stipulations.

(1) Of the common technical features shared among all claims, or admission that certain groups of claims do not share any common technical features,

(2) About the support found in the disclosure for means or steps plus function claims (35 U.S.C. 112, paragraph 6),

(3) Of precisely which portion(s) of the disclosure provide the written description and enablement support for specific claim element(s),

(4) Of the meaning of claim limitations or terms used in the claims, such as what teachings in the prior art would be covered by particular limitations or terms in a claim and which dictionary definitions would define a particular claim term, particularly where those terms are not used *per se* in the specification,

(5) Of which portions of each claim correspond to any admitted prior art in the specification,

(6) Of the specific utility provided by the claimed subject matter on a claim-by-claim basis,

(7) As to whether a dependent claim element is known in the prior art based on the examiner having a reasonable basis for believing so,

(8) Of support for added limitations in an amended claim,

(9) Of facts related to public use or sale situations.<

704.11(b) When May a Requirement for Information Be Made [R-2]

A requirement for information under 37 CFR 1.105 is discretionary. A requirement may be made at any time once the necessity for it is recognized and should be made at the earliest opportunity after the necessity is recognized. The optimum time for making a requirement is prior to or with a first action on the merits because the examiner has the maximum opportunity to consider and apply the response. Ordinarily, a request for information should not be made with or after a final rejection.

>

I. < PRIOR TO THE FIRST ACTION ON THE MERITS

It may be appropriate to make a requirement for information prior to the first action on the merits, such as with a restriction requirement, when the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents or in areas of emerging technology where the Office has minimal prior art.

Factors to be considered for the appropriateness of a separate requirement for information prior to the first action on the merits include:

(A) Whether the claimed subject matter is in a newly established art area without a well-developed prior art resource pool;

(B) Whether the applicant submitted an Information Disclosure Statement;

(C) Whether the specification's background description adequately describes the background of the disclosed subject matter;

(D) Whether related documents, written by an inventor or an employee of the assignee, which were not submitted, are found during the search or described in the application file;

(E) Whether non-patent literature is referred to in the disclosure, but a copy has not been supplied; and

(F) Whether the specification's background of the invention describes information as being known or conventional, which may be considered as an admission of prior art, but such information is unfamiliar to examiner and cannot be found within the application file or from the examiner's search, and further details of the information would be relevant to the question of patentability.

>

II. < WITH THE FIRST ACTION ON THE MERITS

A requirement for information may be combined with a first action on the merits that includes at least one rejection, if, for example, either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination.

It is not appropriate to make a requirement for information based on a lack of relevant prior art with a first action on the merits allowance or *Ex parte Quayle* action.

>

III. < AFTER THE FIRST ACTION ON THE MERITS

A requirement for information made after the first action on the merits may be appropriate when the application file justifies asking the applicant if he or she has information that would be relevant to the patentability determination. It is rarely appropriate to require information because of a lack of relevant prior art after the first action on the merits.

A requirement for information is not proper when no further action would be taken by the examiner. The reasonable necessity criteria for a requirement for information implies further action by the examiner. This means that actions in which requirements for information necessary for examination are made should generally be a non-final action because the applicant's reply must be considered and applied as appropriate.

Under limited circumstances, requirements under 37 CFR 1.105 may be made in an application that is issued or abandoned. Such a requirement would normally be made only during part of some ongoing proceeding involving the issued patent or abandoned application. Examples of proceedings when an examiner or other Office employee would issue such a request in an abandoned application include proceedings to revive the abandoned application. Examples of proceedings when an examiner or other Office employee would issue such a request in a patent include proceedings to change inventorship and reexamination proceedings.

704.12 Replies to a Requirement for Information

Replies to requirements for information must be complete and filed within the time period set including any extensions. Failure to reply within the time period set will result in the abandonment of the application. All replies for a request for information should be checked for completeness. Any incomplete reply can be completed within the original time period set including any extensions. Supplemental replies filed after the expiration of the original period for reply including any extensions of time must comply with all other rules for submissions of information.

704.12(a) Relationship of Requirement for Information to Duty of Disclosure [R-2]

The duty of candor and good faith under 37 CFR 1.56 applies to the applicant's reply to a requirement for information under 37 CFR 1.105, and requires that the applicant reply to a requirement under 37 CFR 1.105 with information reasonably and readily available.

37 CFR 1.56 requires parties identified in 37 CFR 1.56(c) to disclose to the Office information material to the patentability of the claimed subject matter. This threshold is substantially higher than that for requiring information under 37 CFR 1.105, which is reasonable necessity to the examination of the application. >See, e.g., *Star Fruits S.N.C. v. United States*, 280 F.Supp.2d 512, 515-16 (E.D. Va 2003)("Beyond that which a patent applicant is duty-bound to disclose pursuant to 37 CFR 1.56, an examiner may require the production of 'such information as may be reasonably necessary to properly examine or treat the matter.'")<

In contrast with the applicant's duty to disclose on his or her own initiative information material to pat-

entability under 37 CFR 1.56, the Office has the authority to require information reasonably necessary to the examination or treatment of a matter in an application. Such information may not be considered material to patentability by applicant, hence applicant would not be required to provide the information under 37 CFR 1.56. The information is instead reasonably necessary to determine the state of the art, the context in which the invention is practiced, the directions in which the relevant art are advancing, the similarity between the claimed subject matter and other art worked on by the applicants and their assignees or to otherwise proceed in the examination and treatment of matters in an application.

Similar to 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information already known, but there is no requirement to search for information that is unknown. Unlike 37 CFR 1.56, applicant is required by 37 CFR 1.105 to submit information that may not be material to patentability in itself, but that is necessary to obtain a complete record from which a determination of patentability may be determined.

704.12(b) What Constitutes a Complete Reply [R-3]

A complete reply to a 37 CFR 1.105 requirement is a reply to each enumerated requirement for information giving either the information required or a statement that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested. There is no requirement for the applicant to show that the required information was not, in fact, readily attainable, but applicant is required to make a good faith attempt to obtain the information and to make a reasonable inquiry once the information is requested.

>There is no need for applicants to distinguish between whether the required information is unknown or is not readily available. Thus, if information remains unknown after a reasonable inquiry is made, applicant may simply reply that the requested information is either unknown or is not readily available rather than be required to make a categorical position either that the information is unknown to the applicant, or that the information is not readily available to the applicant.<

A reply stating that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will generally be sufficient unless, for example, it is clear the applicant did not understand the requirement, or the reply was ambiguous and a more specific answer is possible.

>Depending on the facts surrounding the requirement and the reply, a follow up requirement may be made where both reasonable and warranted.<

704.12(c) Treatment of an Incomplete Reply [R-2]

An incomplete reply to a 37 CFR 1.105 requirement in a pending application or reexamination proceeding is handled in the same manner as an amendment not fully responsive to a non-final *>Office< action. See 37 CFR 1.135(c) and MPEP § 714.03. Where the reply is a *bona fide* reply, form paragraph 7.95 may be used. Note that a 37 CFR 1.105 requirement, even absent an action on the merits, is an Office action.

¶ *7.95 Bona Fide, Non-Responsive Amendments*

The reply filed on **[1]** is not fully responsive to the prior Office action because of the following omission(s) or matter(s): **[2]**. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

704.13 Time Periods for Reply [R-2]

A reply, or a failure to reply, to a requirement for information under 37 CFR 1.105 will be governed by 37 CFR 1.135 and 1.136. See MPEP § 710 *et seq.*

Requirements for information under 37 CFR 1.105 made without an action on the merits should set a shortened statutory period of two months for reply. Applicant may extend the time period for reply up to six months in accordance with 37 CFR 1.136(a).

Requirements sent with an *>Office< action on the merits, and not as a separate Office action, will be

given the same period for reply as the action on the merits.

A requirement for information under 37 CFR 1.105 is an Office action under 35 U.S.C. 132 for patent term adjustment purposes. See MPEP § 2730 for information pertaining to patent term adjustment.

704.14 Making a Requirement for Information

A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope. It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

704.14(a) Format of the Requirement [R-3]

The requirement must clearly indicate that a requirement under 37 CFR 1.105 is being made, the basis for the requirement, and what information is being required. Requirements should specify the particular art area involved, and the particular claimed subject matter within such art area, in which the information is required in order to avoid overly burdening the applicant and to avoid inviting large volumes of information that are not relevant to the need for the information. The requirement should also clearly indicate the form the required information is expected to take. That is, whether the requirement is for citations and copies of individual art references, for the identification of whole collections of art, for answers to questions, or for another specified form.

A requirement for information under 37 CFR 1.105 is generally prepared as a separate document that may be attached to an Office action on the merits or mailed as a stand alone action. The rule permits a requirement to be included within an Office action, but creating a separate document is preferable because the existence of the requirement is immediately brought to the attention of the recipient and it is more readily routed by the applicant to the parties best able to respond.

The requirement should state why the requirement has been made and how the information is necessary to the examination.

>Interrogatories may be used to ask specific questions seeking applicant's factual knowledge. Such a requirement for information may include an inquiry as to the existence of a particular document or other piece of information and a requirement that such information be supplied if it is known to exist and is readily available. A stipulation may be used as to facts with which applicant may agree or disagree in order to clarify the record about uncontroverted matters.<

FORM PARAGRAPHS

The following form paragraphs should be used when preparing a requirement for information:

¶ *7.105 Requirement for Information, Heading*

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Examiner Note:

1. This form paragraph should appear at the beginning of any requirement for information under 37 CFR 1.105, and should be followed by an explanation of why the required information is necessary for examination. Form paragraphs 7.106 – 7.121 may be used as appropriate.

2. The requirement for information should conclude with form paragraphs 7.122 – 7.126 as appropriate.

>The following form paragraphs should be used as appropriate where the information required pertains to stipulations of facts or interrogatories of facts known to the applicant:<

>

¶ *7.105.01 Stipulations of Facts Known to Applicant*

In response to this requirement, please agree or disagree to the stipulation of each of the following assertions of facts:

[1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 –7.126 as appropriate.

2. In bracket 1, specify each factual assertion, in the form of a separate, numbered sentence, that the applicant is to either agree or disagree to so stipulate. It is suggested that at the end of each assertion, the parenthetic phrase, "(agree/disagree)" be appended to facilitate a reply by way of applicant marking up a copy of the requested stipulations.

¶ *7.105.02 Interrogatories of Facts Known to Applicant*

In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

[1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 –7.126 as appropriate.
2. In bracket 1, specify each interrogatory question, in the form of a separate, numbered sentence, that the applicant is to answer. The scope of each query must be clearly set forth and the content of the expected reply is to be characterized as factual information.

<

The following form paragraphs should be used as appropriate where the information required pertains to a search for prior art, or to citations and/or copies of publications:

¶ *7.106 Domain of Search*

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class **[1]** and subclasses **[2]**, which describe **[3]**. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of **[4]**.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 4, insert a description of the art claimed but not found in the classification system.

¶ *7.107 Level of Skill and Knowledge in the Art*

The information is required to document the level of skill and knowledge in the art of **[1]**.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.108 Background Description*

The information is required to complete the background description in the disclosure by documenting **[1]**.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.109 Products and Services Embodying Invention*

The information is required to identify products and services embodying the disclosed subject matter of **[1]** and identify the properties of similar products and services found in the prior art.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.110 Art Suggested as Relevant*

The information is required to enter in the record the art suggested by the applicant as relevant to this examination in **[1]**.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, describe where in the application file applicant suggests that the art is relevant, e.g., the specification and the relevant page thereof, or a paper received in the Office on a specified date and the relevant page thereof.

¶ *7.111 List of Keywords*

In response to this requirement, please provide a list of keywords that are particularly helpful in locating publications related to the disclosed art of **[1]**.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.112 Citations for Electronically Searchable Databases or Other Indexed Collections*

In response to this requirement, please provide a list of citations to electronically searchable databases or other indexed collections containing publications that document the knowledge within the disclosed art of **[1].**

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.113 Copy of Art Referred to in the Disclosure, But Not Submitted*

In response to this requirement, please provide a copy of each of the following items of art referred to in the **[1]**.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, describe where in the application file applicant refers to art that has not been previously submitted, e.g., the specification and the relevant page thereof, or a paper received in the Office on a specified date and the relevant page thereof.

¶ *7.114 Copies of Publications Authored by Inventor(s)*

In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of **[1]**.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.115 Art Relied Upon for Description of Prior Art*

In response to this requirement, please provide the title, citation and copy of each publication that is a source used for the description of the prior art in the disclosure. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.

¶ *7.116 Art Relied Upon for Development of Invention*

In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing **[1]**. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.
3. In bracket 1, insert a description of the most important inventive elements.

¶ *7.117 Art Relied Upon for Drafting Claimed Subject Matter*

In response to this requirement, please provide the title, citation and copy of each publication that was relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.

¶ *7.118 Results of Applicant's Prior Art Search*

In response to this requirement, please state whether any search of prior art was performed. If a search was performed, please state the citation for each prior art collection searched. If any art retrieved from the search was considered material to demonstrating the knowledge of a person having ordinary skill in the art to the disclosed **[1]**, please provide the citation for each piece of art considered and a copy of the art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, describe the subject matter for which art is required.

¶ *7.119 Names of Products or Services Incorporating Claimed Invention*

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ *7.120 Names of Products or Services Incorporating Disclosed Prior Art*

In response to this requirement, please provide the names of any products or services that have incorporated the disclosed prior art **[1].**

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, specify the attributes of the prior art that most closely approximate the claimed subject matter to narrow the focus of the reply.

¶ *7.121 Details of Improvement Over the Prior Art*

In response to this requirement, please state the specific improvements of the subject matter in claims **[1]** over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

The following form paragraphs should appear at the end of the requirement for information, as appropriate:

¶ *7.122 Submission of Only Pertinent Pages Where Document is Large*

In responding to those requirements that require copies of documents, where the document is a bound text or a single article

over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure**.**

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. Use this form paragraph where the scope of the requirement for information specifically includes copies of publications.

¶ *7.123 Waiver of Fee and Statement Requirements for Certain Information Disclosures*

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of the requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97 where appropriate.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraph 7.124 and either form paragraph 7.125 or 7.126 as appropriate.
2. Use this form paragraph where the scope of the requirement for information specifically includes citations to and/or copies of publications.

¶ *7.124 Contents of Good Faith Reply*

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraph 7.125 or 7.126 as appropriate.
2. This form paragraph should appear in the conclusion of any requirement for information.

¶ *7.125 Conclusion of Requirement That Accompanies Office Action*

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should appear at the conclusion of any requirement for information that accompanies an Office action. If the requirement for information is mailed without any other Office action, use form paragraph 7.126 instead.
2. Form paragraph 7.127 should appear at the end of any Office action that includes an attached requirement for information.

¶ *7.126 Conclusion Of Requirement Mailed Without Any Other Office Action*

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of **[1]** months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should appear at the conclusion of any requirement for information mailed without any other Office action. If the requirement for information is mailed an Office action, use form paragraph 7.125 instead .
2. The period for reply is ordinarily set for 2 months.

¶ *7.127 Conclusion of Office Action That Includes Requirement*

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Examiner Note:

This form paragraph should appear at the end of any Office action that includes an attached requirement for information.

704.14(b) Examiner's Obligation Following Applicant's Reply [R-2]

The examiner must consider the information submitted with the applicant's reply and apply the information as the examiner deems appropriate. This obligation arises from the examiner's assertion that the information is necessary to the examination in making the requirement.

Information constituting identification of areas of search must be considered and the examiner must indicate which areas were used and which areas were not used in performing a search. This indication may be placed in the file wrapper search notes, or may be made by notations on the applicant's reply, with the examiner's initials and date, and with a notation in the file wrapper search notes that searching based on the 37 CFR 1.105 requirement was made according to the notes on the applicant's reply. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.<

Information constituting answers to queries posed by the examiner or another Office employee must be

considered, and the record must indicate that the answers were considered. This indication may be made minimally by indicating "Considered" with the initials and date of the person making such consideration on the reply. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.<

Art that is submitted in response to a 37 CFR 1.105 requirement must be considered, at least to the extent that art submitted with an Information Disclosure Statement under 37 CFR 1.97 and 1.98 is considered. See MPEP § 609. If the applicant provides a written list of citations for the art submitted with a reply to a 37 CFR 1.105 requirement, an examiner must indicate on that list which art has been considered and which art has not been considered, in the same manner as with an Information Disclosure Statement under 37 CFR 1.97 and 1.98. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.< If the applicant provides no such list, there is no requirement for the examiner to prepare such a list or otherwise make the submitted art of record unless the examiner relies on such art in a rejection.

It is never appropriate to deny considering information that is submitted in reply to, and is within the scope of, a requirement under 37 CFR 1.105. However, information that is beyond the scope of a 37 CFR 1.105 requirement, submitted along with information responding to a requirement under 37 CFR 1.105, need not be considered unless the submission of such art conforms to the provisions of 37 CFR 1.97 and 1.98, and MPEP § 609. The criteria for measuring the scope of a 37 CFR 1.105 requirement is the plain meaning of the text of the requirement. For this reason, it is essential that the scope of information required be carefully specified. If art which is beyond the scope of a 37 CFR 1.105 requirement is submitted in accordance with the provisions of 37 CFR 1.97 and 1.98, and MPEP § 609, such art must be considered according to the provisions of 37 CFR 1.97 and 37 CFR 1.98.

704.14(c) Petitions to Requirements Under 37 CFR 1.105

Applicants who seek to have a requirement under 37 CFR 1.105 withdrawn or modified, or who seek to have information submitted under 37 CFR 1.105 considered, may submit a petition under 37 CFR 1.181 to the Director of the Technology Center in which the requirement was issued. However, a petition is not a reply to a 37 CFR 1.105 requirement. The time period for the applicant to reply to the 37 CFR 1.105 requirement continues to run, even where a petition has been submitted.

704.14(d) Relationship to Information Disclosure Statements [R-3]

The initial reply, if responsive to the requirement for information under 37 CFR 1.105 and submitted within the original time period for reply including any extensions of time, does not have to satisfy the fee and/or certification requirements of 37 CFR 1.97 and 1.98. Applicant should list the references on a copy of Form PTO-1449 or PTO/SB/08 to have the citations entered in the record. Any replies made subsequent to the initial reply must meet the provisions of 37 CFR 1.97 and 1.98 as appropriate.

Any submission of art beyond the scope of a requirement for information under 37 CFR 1.105 is a submission of art under 37 CFR 1.97 and 1.98 and MPEP § 609, and must meet the provisions of 37 CFR 1.97 and 1.98 for the art to be considered.

Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment. This section explicitly distinguishes the practice following a reply under 37 CFR 1.105 from the practice in MPEP § **>609.04(b)< and MPEP § 706.07(a) following a submission of an Information Disclosure Statement under 37 CFR 1.97 and 1.98.

705 Patentability Reports [R-3]

Where an application, properly assigned to one Technology Center (TC), is found to contain one or more claims, *per se*, classifiable in one or more other TCs, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first TC, the application may be referred to the other TC(s) concerned for a report as to the patentability of certain designated claims. This report is known as a Patentability Report (P.R.) and is signed by the primary examiner in the reporting TC.

**

Note that the Patentability Report practice is only to be used in extraordinary circumstances. See MPEP § 705.01(e).

705.01 Instructions re Patentability Reports [R-2]

When an application comes up for any action and the primary examiners involved (i.e., from both the requesting and the requested Technology Center (TC)) agree that a Patentability Report is necessary, and if the TC Director of the requesting TC approves, the application is forwarded to the proper TC with a memorandum attached, for instance, "For Patentability Report from TC -- as to claims --." >For Image File Wrapper (IFW) processing, see IFW Manual.<

705.01(a) Nature of P.R., Its Use and Disposal [R-3]

The primary examiner in the Technology Center (TC) from which the Patentability Report is requested, if he or she approves the request, will direct the preparation of the Patentability Report. This Patentability Report is **>in< memorandum form and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. For Image File Wrapper (IFW) processing, see IFW Manual. When an examiner to whom an application has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he or she should so state. The Patentability Report when signed by the primary examiner in the reporting TC will be returned to the TC to which the application is regularly assigned and placed in the file wrapper.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the examiner to whom the case is assigned to avoid duplication of work.

If the primary examiner in a reporting TC is of the opinion that a Patentability Report is not in order, he or she should so advise the primary examiner in the forwarding TC.

I. DISAGREEMENT AS TO CLASSIFICATION

Conflict of opinion as to classification may be referred to a **>classification dispute TC representative panel< for decision.

If the primary examiner in the TC having jurisdiction of the application agrees with the Patentability Report, he or she should incorporate the substance thereof in his or her action, which action will be complete as to *all* claims. The Patentability Report in such a case is *not* given a paper number but is allowed to remain in the file until the application is finally disposed of by allowance or abandonment, at which time it should be removed. For Image File Wrapper (IFW) processing, see IFW Manual.

II. DISAGREEMENT ON PATENTABILITY REPORT

If the primary examiner does not agree with the Patentability Report or any portion thereof, he or she may consult with the primary examiner responsible for the report. If agreement as to the resulting action cannot be reached, the primary examiner having jurisdiction of the application need not rely on the Patentability Report but may make his or her own action on the referred claims, in which case the Patentability Report should be removed from the file.

III. APPEAL TAKEN

When an appeal is taken from the rejection of claims, all of which are examinable in the TC preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the application to said TC should be made for the purpose of appeal only. For Image File Wrapper (IFW) processing, see IFW Manual section 3.1. The receiving TC will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said TC with its classification determined by the controlling claims remaining in the application.

705.01(b) Sequence of Examination

In the event that the supervisory patent examiners concerned in a P.R. case cannot agree as to the order of examination by their Technology Centers (TCs), the supervisory patent examiner having jurisdiction of

the application will direct that a complete search be made of the art relevant to his or her claims prior to referring the application to another TC for report. The TC to which the application is referred will be advised of the results of this search.

If the supervisory patent examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

705.01(c) Counting and Recording P.R.s

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding Technology Center (TC). When the P.R. is completed and the application is ready for return to the forwarding TC, it is not counted either as a receipt or action by transfer. Credit, however, is given for the time spent.

The date status of the application in the reporting TC will be determined on the basis of the dates in the TC of original jurisdiction. To ensure orderly progress in the reported dates, a timely reminder should be furnished to the TC making the P.R.

705.01(d) Duplicate Prints of Drawings [R-2]

In Patentability Report applications having drawings, the examiner to whom the case is assigned will furnish to the Technology Center (TC) to which the application is referred, prints of such sheets of the drawings as are applicable, for interference search purposes. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.1.< That this has been done may be indicated by a pencil notation on the file wrapper. >For Image File Wrapper (IFW) processing, see IFW Manual.<

When an application that has had Patentability Report prosecution is passed for issue or becomes abandoned, NOTIFICATION of this fact will AT ONCE be given by the TC having jurisdiction of the application to each TC that submitted a Patentability Report. The examiner of each such reporting TC will note the date of allowance or abandonment on the duplicate set of prints. At such time as these prints become of no value to the reporting TC, they may be destroyed.

705.01(e) Limitation as to Use [R-2]

The above outlined Patentability Report practice is not obligatory and should be resorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of the claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ in scope only, prosecution by Patentability Report is never proper.

Exemplary situation where Patentability Reports are ordinarily not proper are as follows:

(A) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(B) Where the claims are related as product and a process which involves merely the fact that a product having certain characteristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(C) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination, *per se*. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.

Where it can be shown that a Patentability Report will save total examiner time, one is permitted with the approval of the Director of the Technology Center to which the application is assigned. The “Approved” stamp should be impressed on the memorandum requesting the Patentability Report. >For Image File Wrapper (IFW) processing, see IFW Manual.<

705.01(f) Interviews With Applicants

In situations where an interview is held on an application in which a Patentability Report has been adopted, the reporting Technology Center may be called on for assistance at the interview when it concerns claims treated by them. See MPEP § 713 to § 713.10 regarding interviews in general.

706 Rejection of Claims [R-3]

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection, before issuing the next Office action. Where the examiner determines that information reasonably necessary for the examination should be required from the applicant under 37 CFR 1.105, such a requirement should generally be made either prior to or with the first Office action on the merits and should follow the procedures in MPEP § 704.10 *et seq.*

Although this part of the Manual explains the procedure in rejecting claims, the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.

37 CFR 1.104. Nature of examination.

*****

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

**>

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(i) Subject matter developed by another person and a claimed invention shall be deemed to have been commonly owned by the same person or organization, or subject to an obligation of assignment to the same person or organization in any application and in any patent granted on or after December 10, 2004, if:

(A) The claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) The claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(ii) For purposes of paragraph (c)(4)(i) of this section, the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

*****

I. UNIFORM APPLICATION OF THE PATENTABILITY STANDARD

The standards of patentability applied in the examination of claims must be the same throughout the

Office. In every art, whether it be considered "complex," "newly developed," "crowded," or "competitive," all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and 103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture" claim) is never, in itself, justification for the allowance of such a claim.

An application should not be allowed, unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it "strictly adhere" to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The standard to be applied in all cases is the "preponderance of the evidence" test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.

II. DEFECTS IN FORM OR OMISSION OF A LIMITATION; CLAIMS OTHERWISE ALLOWABLE

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

III. PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

IV. RECONSIDERATION OF CLAIMS AFTER REPLY BY APPLICANT

37 CFR 1.112. Reconsideration before final action.

**>

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

**

37 CFR 1.112 provides for the reconsideration and continued examination of an application **>after reply by the applicant, and for the reconsideration and continued examination of a reexamination proceeding after a response by< the patent owner. If claims are rejected, or objections or requirements >are< made, >the< applicant or patent owner will be notified in the same manner as >notification was provided< after the first examination. Applicant or patent owner may reply to such Office action >(with or without amendment)< in the same manner provided in 37 CFR 1.111>,< or 37 CFR 1.945 **>for an *inter partes* reexamination<, unless such Office action indicates that it is made final (37 CFR 1.113), or an appeal under 37 CFR >41.31< has been taken (37 CFR 1.116), or >such Office action indicates< in an *inter partes* reexamination* that it is an action closing prosecution (37 CFR 1.949) or a right of appeal notice (37 CFR 1.953). Once an appeal has been taken in an application>or in an *ex parte* reexamination proceeding<, any amendment >(filed prior to an appeal brief)< is subject to the provisions of 37 CFR 1.116(b) and (c), even if the appeal is in reply to a non-final Office action.>See 37 CFR 41.33(b) for amendments filed with or after the filing of an appeal brief.<

V. REJECTIONS IN STATUTORY INVENTION REGISTRATIONS

See MPEP Chapter 1100 for rejection of claims in an application for a Statutory Invention Registration.

706.01 Contrasted With Objections [R-2]

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § 608.01(n). The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the *>Director of the USPTO<.

Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

706.02 Rejection on Prior Art [R-3]

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1)during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b)(1)Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

**>

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

<

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed subject matter is either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See MPEP § 707.07(d).

I. CHOICE OF PRIOR ART; BEST AVAILABLE

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;

(B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or

(C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

See also MPEP § 707.05.

II. RELIANCE UPON ABSTRACTS AND FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The record must also be clear as to whether the examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patent-

ability, thereby improving quality and reducing pendency.

When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection. In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action. Whether the next Office action may be made final is governed by MPEP § 706.07(a).

III. REEXAMINATION

For scope of rejections in *ex parte* reexamination proceedings, see MPEP § 2258 and in *inter partes* reexamination, see MPEP § 2658.

IV. DISTINCTION BETWEEN 35 U.S.C. 102 AND 103

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP § 2131 - § 2146 for guidance on patentability determinations under 35 U.S.C. 102 and 103.

V. DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION

The effective filing date of a U.S. application may be determined as follows:

(A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of 35 U.S.C. 120 and 365(c), respectively, have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications.

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.

(C) If the application claims foreign priority under 35 U.S.C. 119(a)-(d) or 365(a)>or (b)<, the effective filing date is the filing date of the U.S. application, unless situation (A) or (B) as set forth above applies. The filing date of the foreign priority document is not the effective filing date, although the filing date of the foreign priority document may be used to overcome certain references. See MPEP § 706.02(b) and § 2136.05.

(D) If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application.

See MPEP § 1893.03(b) for determining the effective filing date of an application under 35 U.S.C. 371. See MPEP § 201.11(a) and § 1895 for additional information on determining the effective filing date of a continuation, divisional, or continuation-in-part of a PCT application designating the U.S. See also MPEP § 1895.01 and § 1896 which discuss differences between applications filed under 35 U.S.C. 111(a) and international applications that enter national stage under 35 U.S.C. 371.

706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent [R-3]

Once the examiner conducts a search and finds a printed publication or patent which discloses the claimed invention, the examiner should determine whether the rejection should be made under 35 U.S.C. 102(a), (b), or (e).

In order to determine which section of 35 U.S.C. 102 applies, the effective filing date of the application

must be determined and compared with the date of the reference. See MPEP § 706.02 regarding determination of effective filing date of the application.

I. DETERMINING THE REFERENCE ISSUE OR PUBLICATION DATE

The examiner must determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made. A magazine is effective as a printed publication under 35 U.S.C. 102(b) as of the date it reached the addressee and not the date it was placed in the mail. *Protein Foundation Inc. v. Brenner,* 260 F. Supp. 519, 151 USPQ 561 (D.D.C. 1966). See MPEP § 707.05(f). For foreign patents see MPEP § 901.05. See MPEP § 2124, § 2126, and § 2128 - § 2128.02 for case law relevant to reference date determination.

II. DETERMINING WHETHER TO APPLY 35 U.S.C. 102(a), (b), or (e)

A. 35 U.S.C. 102(b)

First, the examiner should consider whether the reference qualifies as prior art under 35 U.S.C. 102(b) because this section results in a statutory bar to obtaining a patent. If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b).

Where the last day of the year dated from the date of publication falls on a Saturday, Sunday or Federal holiday, the publication is not a statutory bar under 35 U.S.C. 102(b) if the application was filed on the next succeeding business day. *Ex parte Olah,* 131 USPQ 41 (Bd. App. 1960) (The Board in *Olah* held that 35 U.S.C. 21(b) is applicable to the filing of an original application for patent and that applicant's own activity will not bar a patent if the 1-year grace period expires on a Saturday, Sunday, or Federal holiday and the application's U.S. filing date is the next succeeding business day.) Despite changes to 37 CFR 1.6(a)(2) and 1.10 which permit the USPTO to accord a filing date to an application as of the date of deposit as "Express Mail" with the U.S. Postal Service in accordance with 37 CFR 1.10 (e.g., a Saturday filing date), the rule changes do not affect applicant's concurrent right to defer the filing of an application until the next business day when the last day for "taking any action" falls on a Saturday, Sunday, or Federal holiday (e.g., the last day of the 1-year grace period falls on a Saturday).

B. 35 U.S.C. 102(e)

If the publication or issue date of the reference is too recent for 35 U.S.C. 102(b) to apply, then the examiner should consider 35 U.S.C. 102(e).

In order to apply a reference under 35 U.S.C. 102(e), the inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor *>needs to< be different for the inventive entities to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some inventors in common between the application and the reference.

Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. The filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions supersede all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000 (discussed further below). Furthermore, the provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). See MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

*****

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

*****

As mentioned above, references based on international applications that were filed prior to November 29, 2000 are subject to the former (pre-AIPA) version of 35 U.S.C. 102(e) as set forth below.

Former 35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless-

*****

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

*****

Revised 35 U.S.C. 102(e) has two separate clauses, namely, 35 U.S.C. 102(e)(1) for **publications** of patent applications and 35 U.S.C. 102(e)(2) for U.S. patents. 35 U.S.C. 102(e)(1), in combination with amended 35 U.S.C. 374, created a new category of prior art by providing prior art effect for certain **publications** of patent applications, including certain international applications, as of their effective United States filing dates (which will include certain international filing dates). Under revised 35 U.S.C. 102(e), an international filing date which is on or after November 29, 2000 is a United States filing date if the international application designated the United States and was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. Therefore, the prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date (if all three conditions noted above are met) or an earlier U.S. filing date for which priority or benefit is properly claimed. Publication under PCT Article 21(2) may result from a request for early publication by an applicant of an international application or after the expiration of 18-months after the earliest claimed filing date in an international application. An applicant of an international application that has designated only the U.S. would continue to be required to request publication from WIPO as the reservation under PCT Article 64(*>3<) continues to be in effect for such applicants. International applications, which: (1) were filed prior to November 29, 2000, or (2) did not designate the U.S., or (3) were not published in English under PCT Article 21(2) by WIPO, may not be used to reach back (bridge) to an earlier filing date through a priority or benefit claim for prior art purposes under 35 U.S.C. 102(e).

Revised 35 U.S.C. 102(e) eliminated the reference to fulfillment of the 35 U.S.C. 371(c)(1), (2) and (4) requirements. As a result, United States **patents** issued directly from international applications filed on or after November 29, 2000 will no longer be available as prior art under 35 U.S.C. 102(e) as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) have been satisfied. Under 35 U.S.C. 102(e)(2), as amended by the AIPA and Pub. L. 107-273, an international filing date which is on or after November 29, 2000 is a United States filing date for purposes of determining the earliest effective prior art date of a patent if the international application designated the United States and was published in the English language under PCT Article 21(2) by WIPO.

No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e) in accordance with the last sentence of the effective date provisions of Pub. L. 107-273. **Patents** issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. **Publications** of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the national stage (35 U.S.C. 371)) do not have a 35 U.S.C. 102(e) date at all (however, such publications are available as prior art under 35 U.S.C. 102(a) or (b) as of the publication date). Specifically, under revised 35 U.S.C. 374, the international application must be filed on or after November 29, 2000 for its WIPO publication to be "deemed a publication under section 122(b)" and

thus available as a possible prior art reference under 35 U.S.C. 102(e) as amended by the AIPA.

C. 35 U.S.C. 102(a)

Even if the reference is prior art under 35 U.S.C. 102(e), the examiner should still consider 35 U.S.C. 102(a) for two reasons. First, if the reference is a U.S. patent or patent application publication of, or claims benefit of, an international application, the publication of the international application under PCT Article 21(2) may be the earliest prior art date under 35 U.S.C. 102(a) for the disclosure. Second, references that are only prior art under 35 U.S.C. 102(e), (f), or (g) and applied in a rejection under 35 U.S.C. 103(a) are subject to being disqualified under 35 U.S.C. 103(c) if the reference and the application were commonly owned, or subject to an obligation of common assignment, at the time the invention was made. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work.

706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-3]

A rejection based on 35 U.S.C. 102(b) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Perfecting priority under 35 U.S.C. 120, within the time period set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. See MPEP § 201.11 and § 706.02; or

(D) Perfecting priority claim under 35 U.S.C. 119(e) by complying with the requirements of 37 CFR 1.78(a) (see item (C) above). Since a provisional application could not have been filed more than one year prior to the filing of a nonprovisional application that claims benefit to the provisional application, in order to overcome a rejection under 35 U.S.C. 102(b), there must be at least one intermediate application between the provisional application and the nonprovisional application under examination, e.g., chain of prior applications. In order to overcome the rejection under 35 U.S.C. 102(b), priority must be perfected for the chain of prior applications (35 U.S.C. 119(e) and 120 must be perfected). See MPEP § 201.11.

A rejection based on 35 U.S.C. 102(e) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR *>41.203(a)<. See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c). See MPEP § 201.13. The foreign priority filing date must antedate the reference and be perfected.

The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph; or

(F) Perfecting priority under 35 U.S.C. 119(e) or 120, within the time periods set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. See MPEP § 201.11 and § 706.02.

A rejection based on 35 U.S.C. 102(a) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR *>41.203(a)<. See MPEP § 715 for information on the requirements of 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not appropriate to overcome the rejection.

(D) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) as explained in reference to 35 U.S.C. 102(e) above;

(F) Perfecting priority under 35 U.S.C. 119(e) or 120 as explained in reference to 35 U.S.C. 102(e) above.

706.02(c) Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale

An applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was sold by applicant or known by others in this country. The language "in this country" means in the United States only and does not include other WTO or NAFTA member countries. In these cases the examiner must determine if 35 U.S.C. 102(a) or 102(b) applies. See MPEP § 2133.03 for a discussion of case law treating the "public use" and "on sale" statutory bars.

If the activity is by an entity other than the inventors or assignee, such as sale by another, manufacture by another or disclosure of the invention by applicant to another then both 35 U.S.C. 102(a) and (b) may be applicable. If the evidence only points to knowledge within the year prior to the effective filing date then 35 U.S.C. 102(a) applies. However, no rejection under 35 U.S.C. 102(a) should be made if there is evidence that applicant made the invention and only disclosed it to others within the year prior to the effective filing date.

35 U.S.C. 102(b) is applicable if the activity occurred more than 1 year prior to the effective filing date of the application. See MPEP § 2133.03 for a discussion of "on sale" and "public use" bars under 35 U.S.C. 102(b).

Note that as an aid to resolving public use or on sale issues, as well as to other related matters of 35 U.S.C. 102(b) activity, an applicant may be required to answer specific questions posed by the examiner and to explain or supplement any evidence of record. See 35 U.S.C. 132, 37 CFR 1.104(a)(2). Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability. The examiner may consider making a requirement for information under 37 CFR 1.105 where the evidence of record indicates reasonable necessity. See MPEP § 704.10 *et seq.*

A 1- or 2-month time period should be set by the examiner for any reply to the requirement, unless the

requirement is part of an Office action having a shortened statutory period, in which case the period for reply to the Office action will also apply to the requirement. If applicant fails to reply in a timely fashion to a requirement for information, the application will be regarded as abandoned. 35 U.S.C. 133. See MPEP § 2133.03.

If there is not enough information on which to base a public use or on sale rejection, the examiner should make a requirement for more information. Form paragraph 7.104 can be used.

¶ *7.104 Requirement for Information, Public Use or Sale*

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: **[1]**

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Examiner Note:

1. Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability. See MPEP § 2133.03.

2. A one or two month time period should be set by the examiner for reply to the requirement unless it is part of an Office action having an SSP, in which case the period for reply will apply also to the requirement.

3. If sufficient evidence already exists to establish a *prima facie* case of public use or on sale, use form paragraph 7.16 to make a rejection under 35 U.S.C. 102(b). See MPEP § 2133.03.

706.02(d) Rejections Under 35 U.S.C. 102(c)

Under 35 U.S.C. 102(c), abandonment of the "invention" (as distinguished from abandonment of an application) results in loss of right to a patent. See MPEP § 2134 for case law which sets forth the criteria for abandonment under 35 U.S.C. 102(c).

706.02(e) Rejections Under 35 U.S.C. 102(d) [R-2]

35 U.S.C. 102(d) establishes four conditions which, if all are present, establish a statutory bar against the granting of a patent in this country:

(A) The foreign application must be filed more than 12 months before the effective filing date of the United States application. See MPEP § 706.02 regarding determination of the effective filing date of the application.

(B) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.

(C) The foreign application must have actually issued as a patent or inventor's certificate (e.g., granted by sealing of the papers in Great Britain) before the filing in the United States. It need not be published but the patent rights granted must be enforceable.

(D) The same invention must be involved.

If such a foreign patent or inventor's certificate is discovered by the examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of statutory bar.

See MPEP § 2135.01 for case law which further clarifies each of the four requirements of 35 U.S.C. 102(d).

SEARCHING FOR 35 U.S.C. 102(d) PRIOR ART

The examiner should only undertake a search for an issued foreign patent for use as 35 U.S.C. 102(d) prior art if there is a reasonable possibility that a foreign patent covering the same subject matter as the U.S. application has been granted to the same inventive entity before the U.S. effective filing date, i.e., the time period between foreign and U.S. filings is greater than the usual time it takes for a patent to issue in the foreign country. Normally, the probability of the inventor's foreign patent issuing before the U.S. filing date is so slight as to make such a search unproductive. However, it should be kept in mind that the average pendency varies greatly between foreign countries. In Belgium, for instance, a patent may be granted in just a month after its filing, while in Japan the patent may not issue for **>several years<.

The search for a granted patent can be accomplished on an electronic database either by the examiner or by the staff of the Scientific and Technical Information Center. See MPEP § 901.06(a), paragraph IV.B., for more information on online searching. The document must be a patent or inventor's certificate and not merely a published or laid open application.

706.02(f) Rejection Under 35 U.S.C. 102(e) [R-3]

35 U.S.C. 102(e), in part, allows for certain prior art (i.e., U.S. patents, U.S. patent application publica-

tions and WIPO publications of international applications) to be applied against the claims as of its effective U.S. filing date. This provision of 35 U.S.C. 102 is mostly utilized when the publication or issue date is too recent for the reference to be applied under 35 U.S.C. 102(a) or (b). In order to apply a reference under 35 U.S.C. 102(e), the inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor *>needs to< be different for the inventive entities to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some inventors in common between the application and the reference.

706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e) [R-3]

I. DETERMINE THE APPROPRIATE 35 U.S.C. 102(e) DATE FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES, EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

(A)The potential reference must be a U.S. patent, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e).

(B) Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below. The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 2136.02.

(C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(1) If the international application meets the following three conditions:

(a) an international filing date on or after November 29, 2000;

(b) designated the United States; and

(c) published under PCT Article 21(2) in English,

then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). If such an international application properly claims benefit to an earlier-filed U.S. or international application, or to an earlier-filed U.S. provisional application, apply the reference under 35 U.S.C. 102(e) as of the earlier filing date, assuming all the conditions of 35 U.S.C. 102(e), 119(e), 120, or 365(c) are met. The subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e). Note, where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under PCT Article 21(2)) for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

(2) If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do **not** apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

(3) If the international application has an international filing date prior to November 29, 2000, apply the reference under the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments:

(a) For U.S. patents, apply the reference under 35 U.S.C. 102(e) as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application;

(b) For U.S. application publications and WIPO publications directly resulting from international applications under PCT Article 21(2), never apply these references under 35 U.S.C. 102(e). These references may be applied as of their publication dates under 35 U.S.C. 102(a) or (b);

(c) For U.S. application publications of applications that claim the benefit under 35 U.S.C. 120 or 365(c) of an international application filed prior to November 29, 2000, apply the reference under 35 U.S.C. 102(e) as of the actual filing date of the later-filed U.S. application that claimed the benefit of the international application.

(4) Examiners should be aware that although a publication of, or a U.S. Patent issued from, an international application may not have a 35 U.S.C. 102(e) date at all, or may have a 35 U.S.C. 102(e) date that is after the effective filing date of the application being examined (so it is not "prior art"), the corresponding WIPO publication of an international application may have an earlier 35 U.S.C. 102(a) or (b) date.

(D) Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a)-(d), (f), or 365(a) >or (b)<) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may **not** be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a) >or (b)<.

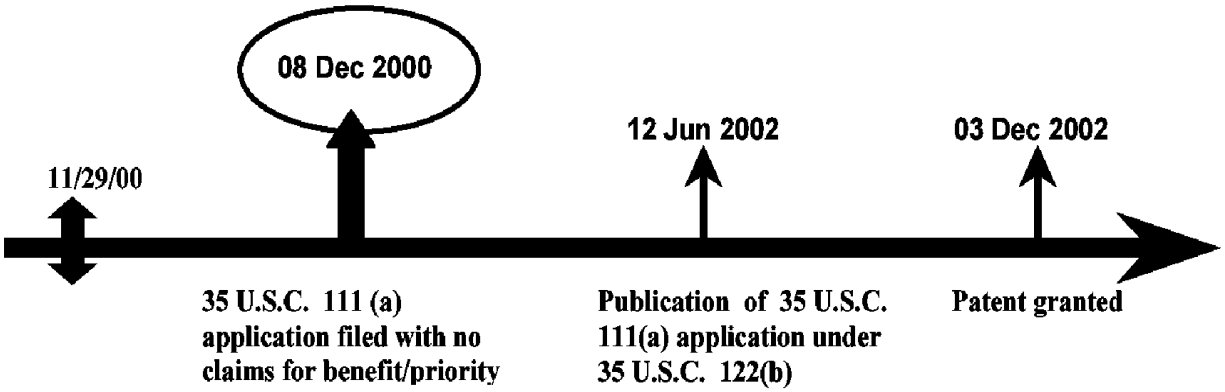
II. EXAMPLES

In order to illustrate the prior art dates of U.S. and WIPO **publications** of patent applications and U.S. **patents** under 35 U.S.C. 102(e), nine examples are presented below. The examples only cover the most common factual situations that might be encountered when determining the 35 U.S.C. 102(e) date of a reference. Examples 1 and 2 involve only U.S. application publications and U.S. patents. Example 3 involves a priority claim to a foreign patent application. Examples 4-9 involve international applications. The **time lines** in the examples below show the history of the prior art **references** that could be applied against the claims of the application under examination, or the patent under reexamination.

The examples only show the information necessary to determine a prior art date under 35 U.S.C. 102(e). Also, the dates in the examples below are arbitrarily used and are presented for illustrative purposes only. Therefore, correlation of patent grant dates with Tuesdays or application publication dates with Thursdays may not be portrayed in the examples.

Example 1: Reference Publication and Patent of 35 U.S.C. 111(a) Application with no Priority/Benefit Claims.

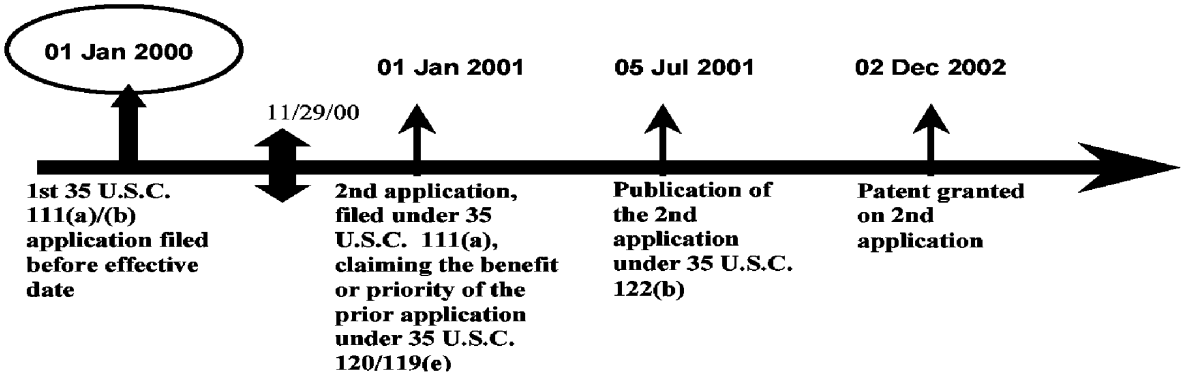
For reference publications and patents of patent applications filed under 35 U.S.C. 111(a) with no claim for the benefit of, or priority to, a prior application, the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which does not claim any benefit under either 35 U.S.C. 119(e), 120 or 365(c), would be accorded the application's actual filing date as its prior art date under 35 U.S.C. 102(e).



The 35 U.S.C. 102(e)(1) date for the Publication is 08 Dec. 2000.
The 35 U.S.C. 102(e)(2) date for the Patent is: 08 Dec. 2000.

Example 2: Reference Publication and Patent of 35 U.S.C. 111(a) Application with Priority/Benefit Claim to a Prior U.S. Provisional or Nonprovisional Application.

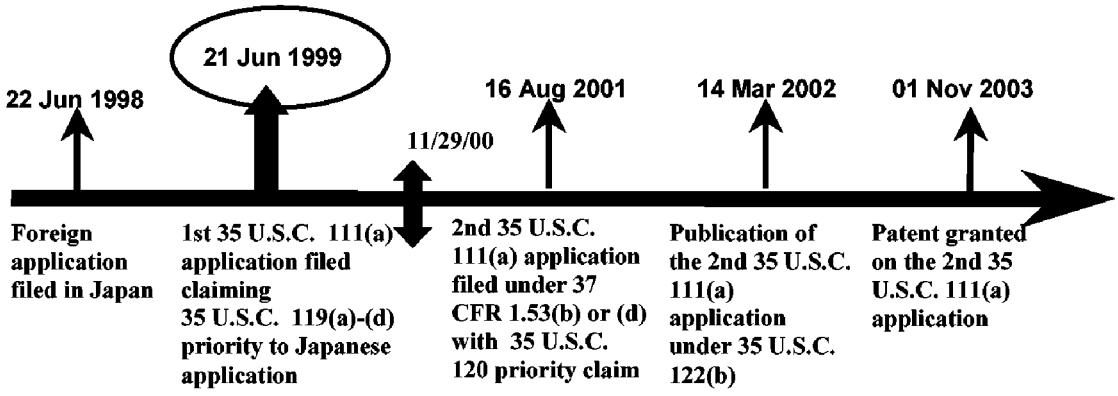
For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims priority under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C. 119(e) or 120.



The 35 U.S.C. 102(e)(1) date for the Publication is: 01 Jan. 2000.
The 35 U.S.C. 102(e)(2) date for the Patent is: 01 Jan. 2000.

Example 3: Reference Publication and Patent of 35 U.S.C. 111(a) Application with 35 U.S.C. 119(a)-(d) Benefit Claim to a Prior Foreign Application.

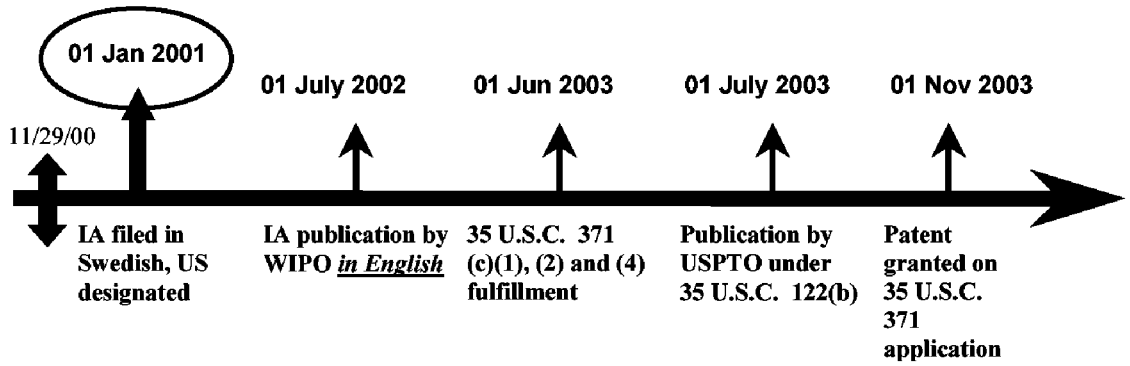
For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. No benefit of the filing date of the foreign application is given under 35 U.S.C. 102(e) for prior art purposes (*In re Hilmer*, 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims benefit under 35 U.S.C. 119(a)-(d) to a prior foreign-filed application (or under 35 U.S.C. 365(a) to an international application), would be accorded its U.S. filing date as its prior art date under 35 U.S.C. 102(e). In the example below, it is assumed that the earlier-filed U.S. application has proper support for the subject matter of the later-filed U.S. application as required by 35 U.S.C. 120.



The 35 U.S.C. 102(e)(1) date for the Publication is: 21 June 1999.
The 35 U.S.C. 102(e)(2) date for the Patent is: 21 June 1999.

Example 4: References based on the **national stage (35 U.S.C. 371)** of an **International Application filed on or after November 29, 2000** and which was published in **English** under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000, designated the U.S., and was published in English under PCT Article 21(2) by WIPO have the 35 U.S.C. 102(e) prior art date of the international filing date or earlier effective U.S. filing date. No benefit of the international filing date (nor any U.S. filing dates prior to the IA), however, is given for 35 U.S.C. 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English.



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: 01 Jan. 2001.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Jan. 2001.
The 35 U.S.C. 102(e)(2) date for the Patent is: 01 Jan. 2001.

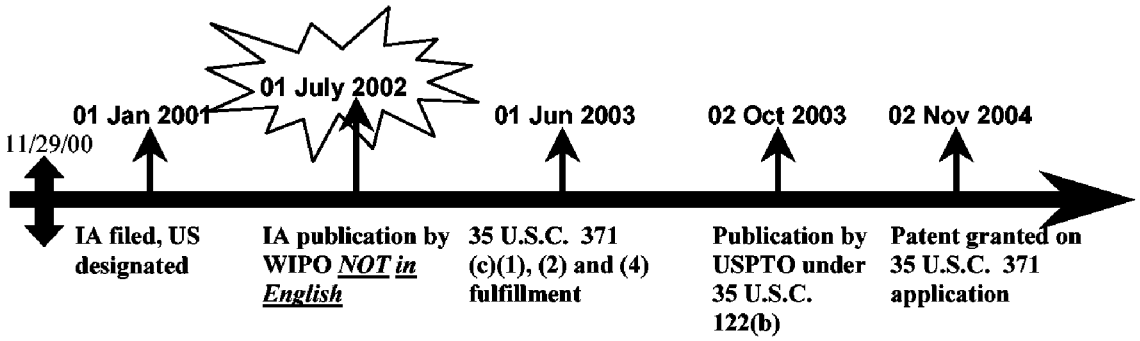
Additional Priority/Benefit Claims:

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the later-filed U.S. application would be the international filing date, assuming the earlier-filed IA has proper support for the subject matter relied upon as required by 35 U.S.C. 120.

If the IA properly claimed priority to an earlier-filed U.S. provisional (35 U.S.C. 111(b)) application or the benefit of an earlier-filed U.S. nonprovisional (35 U.S.C. 111(a)) application, the 35 U.S.C. 102(e) date for all the references would be the filing date of the earlier-filed U.S. application, assuming the earlier-filed application has proper support for the subject matter relied upon as required by 35 U.S.C. 119(e) or 120.

Example 5: References based on the **national stage (35 U.S.C. 371)** of an **International Application filed on or after November 29, 2000** and which was **not** published in **English** under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent, of an international application (IA) that was filed on or after November 29, 2000 but was **not** published in **English** under PCT Article 21(2) have no 35 U.S.C. 102(e) prior art date at all. According to 35 U.S.C. 102(e), no benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102(e) prior art purposes if the IA was published under PCT Article 21(2) in a language other than English, regardless of whether the international application entered the national stage. Such references may be applied under 35 U.S.C. 102(a) or (b) as of their publication dates, but never under 35 U.S.C. 102(e).



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None.
The 35 U.S.C. 102(e)(2) date for the Patent is: None.

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 July 2002).

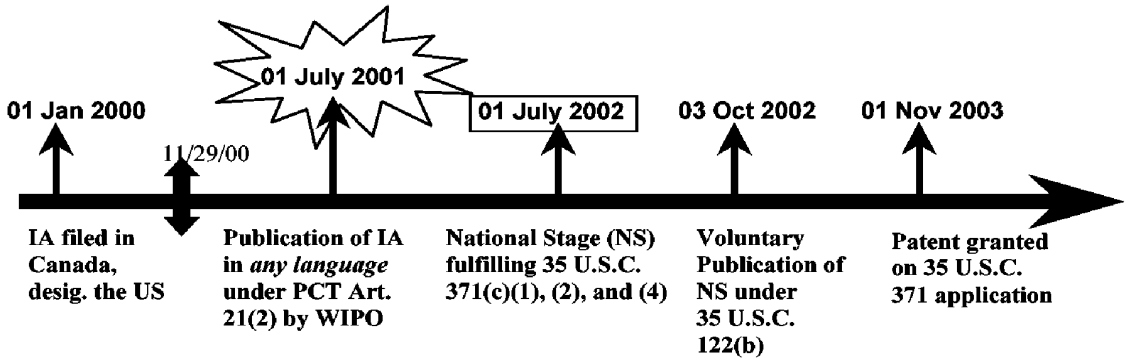
Additional Priority/Benefit Claims:

If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e) date for all the references.

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application.

Example 6: References based on the national stage (**35 U.S.C. 371**) of an **International Application filed prior to November 29, 2000** (language of the publication under PCT Article 21(2) is not relevant).

The reference U.S. patent issued from an international application (IA) that was filed prior to November 29, 2000 has a 35 U.S.C. 102(e) prior art date of the date of fulfillment of the requirements of 35 U.S.C. 371(c)(1), (2) and (4). This is the pre-AIPA 35 U.S.C. 102(e). The application publications, both the WIPO publication and the U.S. publication, published from an international application that was filed prior to November 29, 2000, do not have any 35 U.S.C. 102(e) prior art date. According to the effective date provisions as amended by Pub. L. 107-273, the amendments to 35 U.S.C. 102(e) and 374 are not applicable to international applications having international filing dates prior to November 29, 2000. The application publications can be applied under 35 U.S.C. 102(a) or (b) as of their publication dates.



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: None.
The 35 U.S.C. 102(e)* date for the Patent is: 01 July 2002.

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 July 2001).

Additional Priority/Benefit Claims:

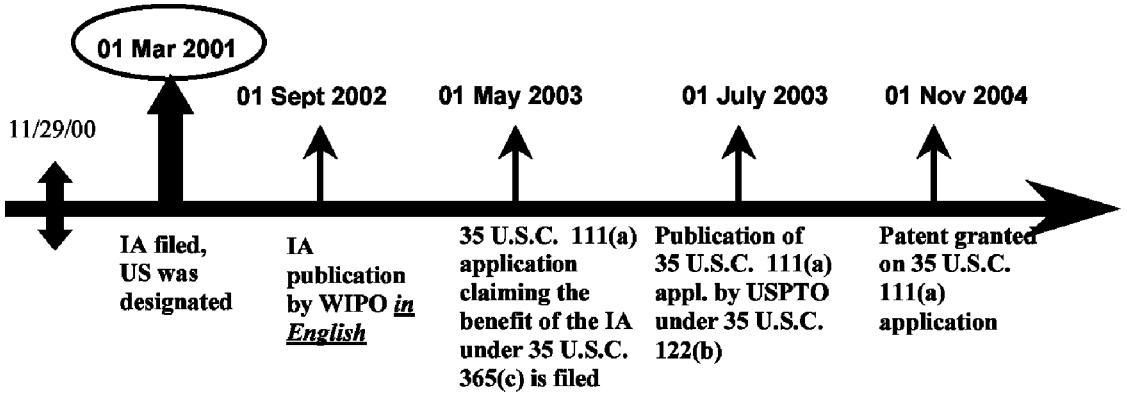
If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the U.S. and WIPO application publications, and the 35 U.S.C. 102(e) date for the patent will still be 01 July 2002 (the date of fulfillment of the requirements under 35 U.S.C. 371(c)(1), (2) and (4)).

If a later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the IA in the example above, the 35 U.S.C. 102(e)(1) date of the application publication of the later-filed U.S. application would be the actual filing date of the later-filed U.S. application, and the 35 U.S.C. 102(e) date of the patent of the later-filed U.S. application would be 01 July 2002 (the date that the earlier-filed IA fulfilled the requirements of 35 U.S.C. 371(c)(1), (2) and (4)).

If the patent was based on a later-filed U.S. application that claimed the benefit of the international application and the later filed U.S. application's filing date is before the date the requirements of 35 U.S.C. 371(c)(1),(2) and (4) were fulfilled (if fulfilled at all), the 35 U.S.C. 102(e) date of the patent would be the filing date of the later-filed U.S. application that claimed the benefit of the international application.

Example 7: References based on a 35 U.S.C. 111(a) Application which is a **Continuation of an International Application**, which was filed on or after **November 29, 2000, designated the U.S.** and was **published in English** under PCT Article 21(2).

All references, whether the WIPO publication, the U.S. patent application publication or the U.S. patent of, or claiming the benefit of, an international application (IA) that was filed on or after November 29, 2000, designated the U.S., and was published in English under PCT Article 21(2) have the 35 U.S.C. 102(e) prior art date of the international filing date or earlier effective U.S. filing date. No benefit of the international filing date (nor any U.S. filing dates prior to the IA), however, is given for 35 U.S.C. 102(e) purposes if the IA was published under PCT Article 21(2) by WIPO in a language other than English. In the example below, it is assumed that the earlier-filed IA has proper support for the subject matter of the later-filed U.S. application as required by 35 U.S.C. 120 and 365(c).



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: 01 Mar. 2001.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Mar. 2001.
The 35 U.S.C. 102(e)(2) date for the Patent is: 01 Mar. 2001.

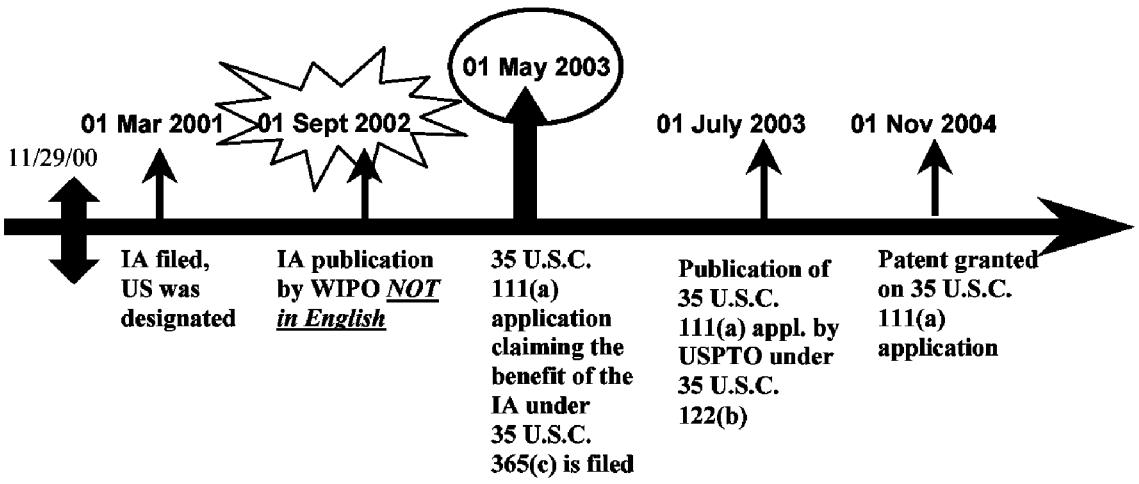
Additional Priority/Benefit Claims:

If the IA properly claimed priority to an earlier-filed U.S. provisional (35 U.S.C. 111(b)) application or the benefit of an earlier-filed U.S. nonprovisional (35 U.S.C. 111(a)) application, the 35 U.S.C. 102(e) date for all the references would be the filing date of the earlier-filed U.S. application, assuming the earlier-filed application has proper support for the subject matter relied upon as required by 35 U.S.C. 119(e) or 120.

If a second, later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the 35 U.S.C. 111(a) application in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the international filing date of the IA, assuming the earlier-filed IA has proper support for the subject matter relied upon as required by 35 U.S.C. 120 and 365(c).

Example 8: References based on a 35 U.S.C. 111(a) Application which is a **Continuation of an International Application**, which was **filed on or after November 29, 2000** and was **not published in English** under PCT Article 21(2).

Both the U.S. publication and the U.S. patent of the 35 U.S.C. 111(a) continuation of an international application (IA) that was filed on or after November 29, 2000 but **not** published in English under PCT Article 21(2) have the 35 U.S.C. 102(e) prior art date of the actual U.S. filing date of the 35 U.S.C. 111(a) application. No benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102(e) purposes since the IA was published under PCT Article 21(2) in a language other than English. The IA publication under PCT Article 21(2) does not have a prior art date under 35 U.S.C. 102(e)(1) because the IA was not published in English under PCT Article 21(2). The IA publication under PCT Article 21(2) can be applied under 35 U.S.C. 102(a) or (b) as of its publication date.



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 May 2003.
The 35 U.S.C. 102(e)(2) date for the Patent is: 01 May 2003

The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 Sept 2002).

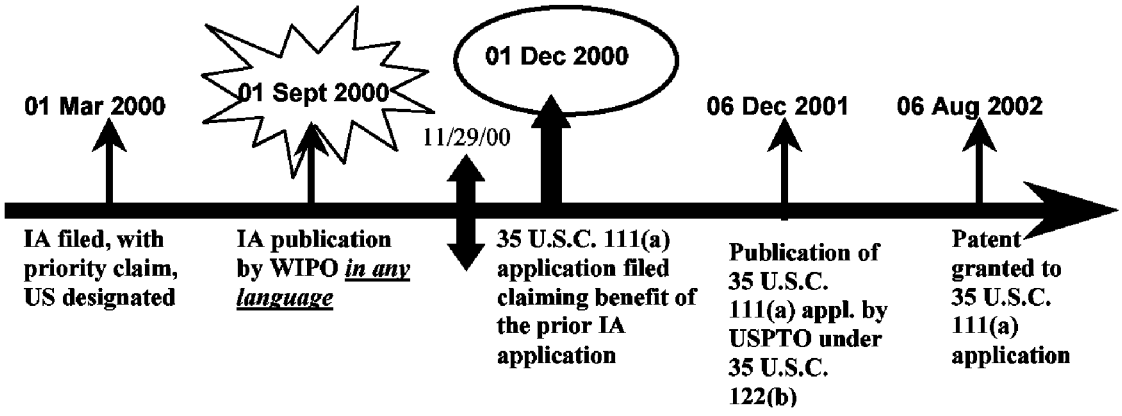
Additional Priority/Benefit Claims:

If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the IA publication by WIPO, and the U.S. patent application publication and patent would still have a 35 U.S.C. 102(e) date of the actual filing date of the later-filed 35 U.S.C. 111(a) application in the example above (01 May 2003).

If a second, later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of the 35 U.S.C. 111(a) application in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the 35 U.S.C. 111(a) application in the example above (01 May 2003).

Example 9: References based on a 35 U.S.C. 111(a) Application which is a **Continuation** (filed prior to any entry of the national stage) **of an International Application**, which was **filed prior to November 29, 2000** (language of the publication under PCT Article 21(2) is not relevant).

Both the U.S. publication and the U.S. patent of the 35 U.S.C. 111(a) continuation (filed prior to any entry of the national stage) of an international application (IA) that was filed prior to November 29, 2000 have the 35 U.S.C. 102(e) prior art date of their actual U.S. filing date under 35 U.S.C. 111(a). No benefit of the international filing date (nor any U.S. filing dates prior to the IA) is given for 35 U.S.C. 102(e) prior art purposes since the IA was filed prior to November 29, 2000. The IA publication under PCT Article 21(2) does not have a prior art date under 35 U.S.C. 102(e)(1) because the IA was filed prior to November 29, 2000. The IA publication under PCT Article 21(2) can be applied under 35 U.S.C. 102(a) or (b) as of its publication date.



The 35 U.S.C. 102(e)(1) date for the IA Publication by WIPO is: None.
The 35 U.S.C. 102(e)(1) date for the Publication by USPTO is: 01 Dec. 2000.
The 35 U.S.C. 102(e)(2) date for the Patent is: 01 Dec. 2000.

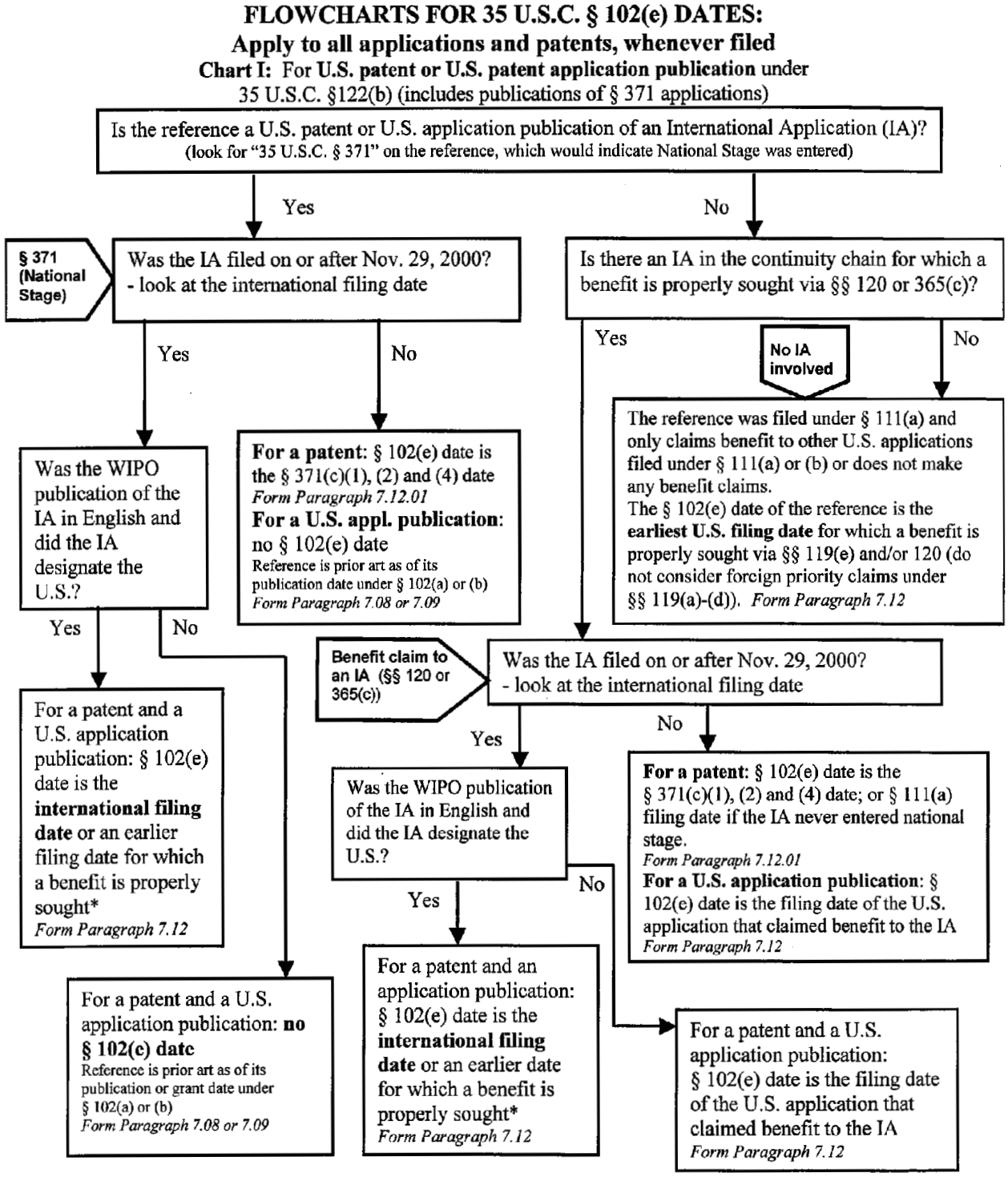
The IA publication by WIPO can be applied under 35 U.S.C. 102(a) or (b) as of its publication date (01 Sept 2000).

Additional Priority/Benefit Claims:

If the IA properly claimed priority/benefit to any earlier-filed U.S. application (whether provisional or nonprovisional), there would still be no 35 U.S.C. 102(e)(1) date for the IA publication by WIPO, and the U.S. application publication and patent would still have a 35 U.S.C. 102(e) date of the actual filing date of later-filed 35 U.S.C. 111(a) application in the example above (01 Dec 2000).

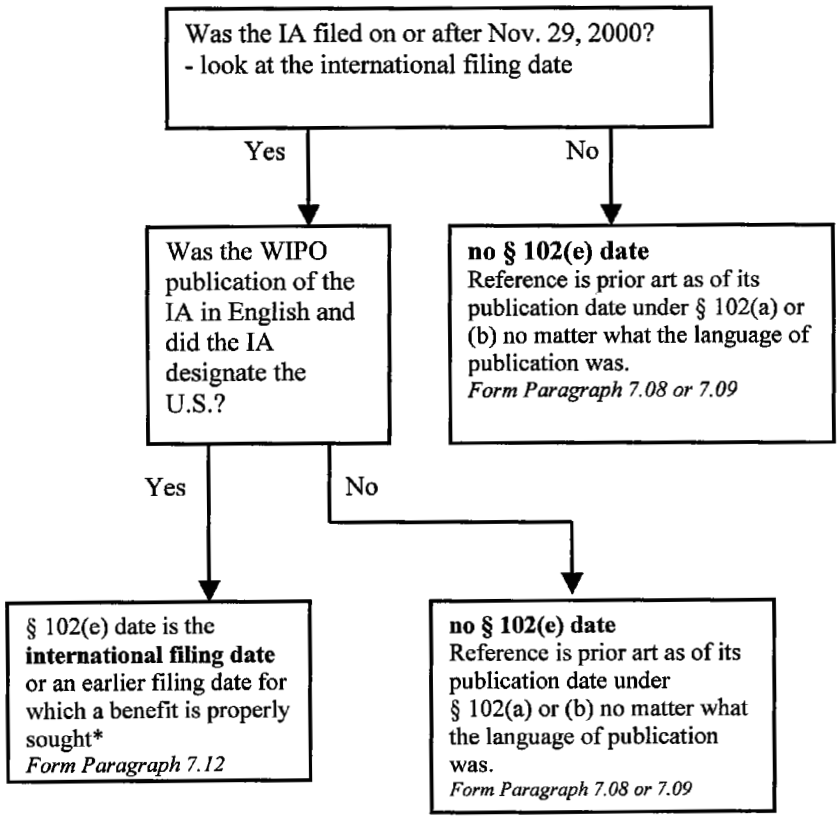
If a second, later-filed U.S. nonprovisional (35 U.S.C. 111(a)) application claimed the benefit of 35 U.S.C. 111(a) application in the example above, the 35 U.S.C. 102(e) date of the patent or publication of the second, later-filed U.S. application would still be the actual filing date of the 35 U.S.C. 111(a) application in the example above (01 Dec 2000).

III. FLOWCHARTS



* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

FLOWCHARTS FOR 35 U.S.C. § 102(e) DATES:
Apply to all applications and patents, whenever filed
Chart II: For **WIPO publication of International Applications** (IAs)



* Consider benefit claims properly made under § 119(e) to U.S. provisional applications, § 120 to U.S. nonprovisional applications, and § 365(c) involving IAs. Do NOT consider foreign priority claims.

Glossary of Terms:

U.S. patent application publication = pre-grant publication by the USPTO under 35 U.S.C. § 122(b)
International application (IA) = an application filed under the Patent Cooperation Treaty (PCT)
§ 371 application = an IA that has entered the national stage in the U.S. (35 U.S.C. § 371(c)(1), (2) and (4))
November 29, 2000 = the effective date for the amendments to §§ 102(e) and 374
WIPO = World Intellectual Property Organization
WIPO Publication = a publication of an IA under PCT Article 21(2) (e.g., Publication No. WO 99/12345)
§ 111(a) = provision of the patent code that states the **filing** requirements for **nonprovisional applications**
§ 111(b) = provision of the patent code that states the **filing** requirements for **provisional applications**
§ 119(e) = provision of the patent code that allows for **priority claims to provisional applications**
§ 119(a)-(d) = provision of the patent code that allows for **priority claims to foreign applications**
§ 120 = provision of the patent code that allows for **benefit claims to nonprovisional applications**
§ 365(c) = provision of the patent code that allows for **benefit claims to international applications**

706.02(f)(2) Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application [R-3]

If an earlier filed, copending, and unpublished U.S. patent application discloses subject matter which would anticipate the claims in a later filed pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional 35 U.S.C. 102(e) rejection of the later filed application can be made. In addition, a provisional 35 U.S.C. 102(e) rejection may be made, in the circumstances described below, if the earlier filed, pending application has been published as redacted (37 CFR 1.217) and the subject matter relied upon in the rejection is not supported in the redacted publication of the patent application.

I. COPENDING U.S. APPLICATIONS HAVING AT LEAST ONE COMMON INVENTOR OR ARE COMMONLY ASSIGNED

If (1) at least one common inventor exists between the applications or the applications are commonly assigned and (2) the effective filing dates are different, then a provisional rejection of the later filed application should be made. The provisional rejection is appropriate in circumstances where if the earlier filed application is published or becomes a patent it would constitute actual prior art under 35 U.S.C. 102. Since the earlier-filed application is not published at the time of the rejection, the rejection must be provisionally made under 35 U.S.C. 102(e).

A provisional rejection under 35 U.S.C. 102(e) can be overcome in the same manner that a 35 U.S.C. 102(e) rejection can be overcome. See MPEP § 706.02(b). The provisional rejection can also be overcome by abandoning the applications and filing a new application containing the subject matter of both.

Form paragraph 7.15.01 should be used when making a provisional rejection under 35 U.S.C. 102(e).
**>

¶ *7.15.01 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor*

Claim **[1]** provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. **[2]** which has a common **[3]** with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. **[4]**.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention which has not been published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01). See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.

3. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.

4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.

6. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using form paragraphs 8.30 and 8.32.

7. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using form paragraphs 7.13 and/or 7.14 should also be made.

<

II. COPENDING APPLICATIONS HAVING NO COMMON INVENTOR OR ASSIGNEE

If there is no common assignee or common inventor and the application was not published pursuant to 35 U.S.C. 122(b), the confidential status of applications under 35 U.S.C. 122(a) must be maintained and no rejection can be made relying on the earlier filed, unpublished application, or subject matter not supported in a redacted application publication, as prior art under 35 U.S.C. 102(e). If the filing dates of the applications are within 6 months of each other (3 months for simple subject matter) then interference may be proper. See MPEP Chapter 2300. If the application with the earliest effective U.S. filing date will not be published pursuant to 35 U.S.C. 122(b), it must be allowed to issue once all the statutory requirements are met. After the patent is published, it may be used as a reference in a rejection under 35 U.S.C. 102(e) in the still pending application as appropriate. See MPEP § 706.02(a) and § 2136 *et seq*.

706.02(g) Rejections Under 35 U.S.C. 102(f)

35 U.S.C. 102(f) bars the issuance of a patent where an applicant did not invent the subject matter being claimed and sought to be patented. See also 35 U.S.C. 101, which requires that whoever invents or discovers is the party who may obtain a patent for the particular invention or discovery. The examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor.

See MPEP § 2137 - § 2137.02 for more information on the substantive requirements of rejections under 35 U.S.C. 102(f).

706.02(h) Rejections Under 35 U.S.C. 102(g)

35 U.S.C. 102(g) bars the issuance of a patent where another made the invention in the United States before applicant and had not abandoned, suppressed, or concealed it. This section of 35 U.S.C. 102 forms a basis for interference practice. See MPEP Chapter 2300 for more information on interference procedure. See MPEP § 2138 - § 2138.06 for more information on the requirements of 35 U.S.C. 102(g).

706.02(i) Form Paragraphs for Use in Rejections Under 35 U.S.C. 102 [R-3]

The following form paragraphs should be used in making the appropriate rejections.

Note that the particular part of the reference relied upon to support the rejection should be identified.

¶ *7.07 Statement of Statutory Basis, 35 U.S.C. 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use form paragraph 7.103.
2. Form paragraphs 7.07 to 7.14 are to be used ONLY ONCE in a given Office action.

¶ *7.08 102(a), Activity by Another Before Invention by Applicant*

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07.

¶ *7.09 102(b), Activity More Than One Year Prior to Filing*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Examiner Note:

This form paragraph must be preceded by paragraph form 7.07, and may be preceded by form paragraph 7.08.

¶ *7.10 102(c), Invention Abandoned*

(c) he has abandoned the invention.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 and 7.09.

¶ *7.11 102(d), Foreign Patenting*

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application

for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.10.

¶ *7.12 Rejection under 35 U.S.C 102(e), Patent Application Publication or Patent to Another with Earlier Filing Date, in view of the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002*

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Examiner Note:

1. This form paragraph should only be used if the reference is one of the following:

(a) a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

(b) a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has an **international filing date on or after November 29, 2000**.

2. In determining the 35 U.S.C. 102(e) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), U.S. nonprovisional applications under 35 U.S.C. 120 or 121, and international applications under 35 U.S.C. 120, 121 or 365(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). Do NOT consider foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a).

3. In order to rely on an international filing date for prior art purposes under 35 U.S.C. 102(e), the international application must have been filed on or after November 29, 2000, it must have designated the U.S., and the international publication under PCT Article 21(2) by WIPO must have been in English. If any one of the conditions is not met, the international filing date is not a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

4. If an international application was published by WIPO in a language other than English, or did not designate the U.S., the International Application's publication by WIPO, the U.S. publication of the national stage application (35 U.S.C. 371) of the international application and a U.S. patent issued from the national stage of the international application may not be applied as a reference under 35 U.S.C. 102(e). The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

5. If an international application was published by WIPO in a language other than English, or did not designate the U.S., the U.S. publication of, or a U.S. patent issued from, a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to such an international application, has a 35 U.S.C. 102(e) date as of the earliest U.S. filing date after the international filing date.

6. If the reference is a U.S. patent issued directly, or indirectly, from an international application that has an international filing date prior to November 29, 2000, use form paragraph 7.12.01. In that situation, pre-AIPA 35 U.S.C. 102(e) is applicable in the determination of the prior art date of the patent issued from such an international application.

7. If the reference is a publication of an international application (including the U.S. publication of a national stage (35 U.S.C. 371)) that has an international filing date prior to November 29, 2000, do not use this form paragraph. Such a reference may not be applied as a prior art reference under 35 U.S.C. 102(e). The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

8. This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.11.

¶ *7.12.01 Rejection under 35 U.S.C. 102(e), Patent to Another with Earlier Filing Date, Reference is a U.S. Patent Issued Directly or Indirectly From a National Stage of, or a Continuing Application Claiming Benefit under 35 U.S.C. 365(c) to, an International Application Having an International Filing Date Prior to November 29, 2000*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Examiner Note:

1. This form paragraph should only be used if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 365(c) to an international application having an international filing date prior to November 29, 2000.

2. If the reference is a U.S. patent issued directly from a national stage of such an international application, the reference's 35 U.S.C. 102(e) date is the date that the requirements of 35

U.S.C. 371(c)(1), (2) and (4) were fulfilled. The language of WIPO publication (PCT) is not relevant in this situation. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under 35 U.S.C. 102(a) or 102(b).

3. If the reference is a U.S. patent issued directly from a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to such an international application (which had not entered the national stage prior to the continuing application's filing date, otherwise see note 4), the prior art reference's 35 U.S.C. 102(e) date is the actual U.S. filing date of the continuing application. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under 35 U.S.C. 102(a) or 102(b).

4. In determining the 35 U.S.C. 102(e) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), U.S. nonprovisional applications under 35 U.S.C. 120 or 121, and international applications under 35 U.S.C. 120, 121 or 365(c) only if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application. Do NOT consider foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a).

5. This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.11.

¶ *7.13 102(f), Applicant Not the Inventor*

(f) he did not himself invent the subject matter sought to be patented.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.12.

¶ *7.14 102(g), Priority of Invention*

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.13.

¶ *7.15 Rejection, 35 U.S.C. 102(a), (b) Patent or Publication, and (g)*

Claim **[1]** rejected under 35 U.S.C. 102**[2]** as being **[3]** by **[4]**.

Examiner Note:

1. In bracket 2, insert the appropriate paragraph letter or letters of 35 U.S.C. 102 in parentheses. If paragraph (e) of 35 U.S.C. 102 is applicable, use form paragraph 7.15.02 or 7.15.03.

2. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

3. In bracket 4, insert the prior art relied upon.

4. This rejection must be preceded either by form paragraph 7.07 and form paragraphs 7.08, 7.09, and 7.14 as appropriate, or by form paragraph 7.103.

5. If 35 U.S.C. 102(e) is also being applied, this form paragraph must be followed by either form paragraph 7.15.02 or 7.15.03.

**>

¶ *7.15.01 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor*

Claim **[1]** provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. **[2]** which has a common **[3]** with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. **[4]**.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention which has not been published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international

application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01). See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.

3. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.

4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.

6. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using form paragraphs 8.30 and 8.32.

7. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using form paragraphs 7.13 and/or 7.14 should also be made.

<

¶ *7.15.02 Rejection, 35 U.S.C. 102(e), Common Assignee or Inventor(s)*

Claim **[1]** rejected under 35 U.S.C. 102(e) as being anticipated by **[2]**.

The applied reference has a common **[3]** with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date that discloses but does not claim the same invention. The patent or patent application publication must have either a common assignee or a common inventor.

2. 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) must be applied if the reference is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**.

See the Examiner Notes for form paragraph 7.12 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C 102(e) (form paragraph 7.12.01) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

4. In determining the 35 U.S.C. 102(e) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), U.S. nonprovisional applications under 35 U.S.C. 120 or 121, and international applications under 35 U.S.C. 120, 121 or 365(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a).

5. If the reference is a publication of an international application (including voluntary U.S. publication under 35 U.S.C. 122 of the national stage or a WIPO publication) that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under 35 U.S.C. 102(e). The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

6. In bracket 3, insert either --assignee-- or --inventor--.

7. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.

8. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.

¶ *7.15.03 Rejection, 35 U.S.C. 102(e), No Common Assignee or Inventor(s)*

Claim **[1]** rejected under 35 U.S.C. 102(e) as being **[2]** by **[3]**.

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date that discloses but does not claim the same invention. The patent or patent application publication is not required to have a common assignee nor a common inventor.

2. 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) must be applied if the reference is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**.

See the Examiner Notes for form paragraph 7.12 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C 102(e) (form paragraph 7.12.01) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

4. In determining the 35 U.S.C. 102(e) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under 35 U.S.C. 119(e), U.S. nonprovisional applications under 35 U.S.C. 120 or 121, and international applications under 35 U.S.C. 120, 121 or 365(c) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November29, 2000, may only result in an effective U.S. filing date as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under 35 U.S.C. 119(a)-(d) and 365(a).

5. If the reference is a publication of an international application (including voluntary U.S. publication under 35 U.S.C. 122 of the national stage or a WIPO publication) that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under 35 U.S.C. 102(e). The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

6. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

7. In bracket 3, insert the prior art relied upon.

8. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.

9. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.

¶ *7.16 Rejection, 35 U.S.C. 102(b), Public Use or on Sale*

Claim **[1]** rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. **[2]**

Examiner Note:

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.09 or by form paragraph 7.103.

2. A full explanation of the evidence establishing a public use or sale must be provided in bracket 2.

¶ *7.17 Rejection, 35 U.S.C. 102(c), Abandonment of Invention*

Claim **[1]** rejected under 35 U.S.C. 102(c) because the invention has been abandoned. **[2]**

Examiner Note:

1. This form paragraph must be preceded either by form paragraph 7.07 and 7.10 or by form paragraph 7.103.

2. In bracket 2, insert a full explanation of the evidence establishing abandonment of the invention. See MPEP § 2134.

¶ *7.18 Rejection, 35 U.S.C. 102(d), Foreign Patenting*

Claim **[1]** rejected under 35 U.S.C. 102(d) as being barred by applicants **[2]**.

[3]

Examiner Note:

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.11 or by form paragraph 7.103.

2. In bracket 3, insert an explanation of this rejection which must include appropriate dates and how they make the foreign patent available under 35 U.S.C. 102(d).

3. Refer to MPEP § 2135 for applicable 35 U.S.C. 102(d) prior art.

¶ *7.19 Rejection, 35 U.S.C. 102(f), Applicant Not the Inventor*

Claim **[1]** rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. **[2]**

Examiner Note:

1. This paragraph must be preceded either by paragraphs 7.07 and 7.13 or by paragraph 7.103.

2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See MPEP § 2137.

706.02(j) Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the refer-

ences themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp,* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch,* 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) - § 706.02(l)(3) for a discussion of prior art disqualified under 35 U.S.C. 103(c).

706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103 [R-3]

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) **>was< disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." **>This amendment to 35 U.S.C. 103(c) was made pursuant to section 4807 of the American Inventors Protection Act of 1999 (AIPA); see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999). The changes to 35 U.S.C. 102(e) in the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)) did not affect the exclusion under 35 U.S.C. 103(c) as amended on November 29, 1999. Subsequently, the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act) (Pub. L. 108-453, 118 Stat. 3596 (2004)) further amended 35 U.S.C. 103(c) to provide that subject matter developed by another person shall be treated as owned by the same person or subject to an obligation of assignment to the same person for purposes of determining obviousness if three conditions are met:

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement (hereinafter "joint research agreement disqualification").

These changes to 35 U.S.C. 103(c) apply to all patents (including reissue patents) granted on or after December 10, 2004. The amendment to 35 U.S.C. 103(c) made by the AIPA to change "subsection (f) or (g)" to "one of more of subsections (e), (f), or (g)" applies to applications filed on or after November 29, 1999. It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant. In a reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004 to determine whether 35 U.S.C. 103(c), as amended by the CREATE Act, applies. For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed on or after November 29, 1999, it is the 1999 changes to 35 U.S.C. 103(c) that are applicable to the disqualifying commonly assigned/owned prior art provisions of 35 U.S.C. 103(c). See MPEP § 706.02(l)(1) for additional information regarding disqualified prior art under 35 U.S.C. 102(e)/103. For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to 35 U.S.C. 103(c) are applicable. Therefore, only prior art under 35 U.S.C. 102(f) or (g) used in a rejection under 35 U.S.C. 103(a) may be disqualified under the commonly assigned/owned prior art provision of 35 U.S.C. 103(c).<

Where two applications of different inventive entities are copending, not published under 35 U.S.C. 122(b), and the filing dates differ, a provisional rejection under 35 U.S.C. 102(e)/103 should be made in the later filed application **>unless the application has been excluded under 35 U.S.C. 103(c), including the new provisions added by the CREATE Act.< See MPEP § 706.02(l)(3) for examination procedure with respect to 35 U.S.C. 103(c). See also MPEP § 706.02(f) for examination procedure in determining when provisional rejections are appropriate. Otherwise the confidential status of unpublished application, or any part thereof, under 35 U.S.C. 122 must be maintained. Such a rejection alerts the applicant that he or she can expect an actual rejection on the same ground if one of the applications issues and also lets applicant know that action must be taken to avoid the rejection.

This gives applicant the opportunity to analyze the propriety of the rejection and possibly avoid the loss of rights to desired subject matter. Provisional rejections of the obviousness type under 35 U.S.C. 102(e)/103 are rejections applied to copending applications having different effective filing dates wherein each application has a common assignee or a common inventor. The earlier filed application, if patented or published, would constitute prior art under 35 U.S.C. 102(e). The rejection can be overcome by:

(A) Arguing patentability over the earlier filed application;

(B) Combining the subject matter of the copending applications into a single application claiming benefit under 35 U.S.C. 120 of the prior applications and abandoning the copending applications (Note that a claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997).);

(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that any unclaimed invention disclosed in the copending application was derived from the inventor of the other application and is thus not invention "by another" (see MPEP § 715.01(a), § 715.01(c), and § 716.10);

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing a date of invention prior to the effective U.S. filing date of the copending application. See MPEP § 715; or

(E) For an application >that is pending on or after December 10, 2004, a showing that (1)< the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person>, or (2) the subject matter is disqualified under the amendment to 35 U.S.C. 103(c) made by the CREATE Act (i.e., joint research agreement disqualification).<

Where the applications are claiming the same patentable invention, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103 in a common ownership situation if the earlier filed application has been published or matured into a patent. See MPEP § 718.

If a provisional rejection is made and the copending applications are combined into a single application and the resulting single application is subject to a restriction requirement, the divisional application would not be subject to a provisional or actual rejection under 35 U.S.C. 102(e)/103 since the provisions of 35 U.S.C. 121 preclude the use of a patent issuing therefrom as a reference against the other application. Additionally, the resulting continuation-in-part is entitled to 35 U.S.C. 120 benefit of each of the prior applications. This is illustrated in Example 2, below.

The following examples are instructive as to the application of 35 U.S.C. 102(e)/103 in applications filed prior to November 29, 1999 >for which a patent was granted prior to December 10, 2004<:

Example 1. Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1. A invents X and later files application.	This is permissible.
2. B modifies X to XY. B files application before A's filing.	No 35 U.S.C. 102(f)/103 or 102(g)/103 rejection; provisional 35 U.S.C. 102(e)/103 rejection applies. Provisional double patenting rejection made.
3. B's patent issues.	A's claims rejected under 35 U.S.C. 102(e)/103 and double patenting.
4. A files 37 CFR 1.130 affidavit to disqualify B's patent as prior art where the same patentable invention is being claimed. Terminal disclaimer filed under 37 CFR 1.321(c).	Rejection under 35 U.S.C. 102(e)/103 may be overcome and double patenting rejection may be overcome if inventions X and XY are commonly owned and all requirements of 37 CFR 1.130 and 1.321 are met.

In situation (2.) above, the result is a provisional rejection by the examiner under 35 U.S.C. 102(e)/103. The rejection is provisional since the subject matter and the prior art are pending applications.

Example 2. Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files application establishing that A and B were both under obligation to assign inventions to C at the time the inventions were made.	Provisional 35 U.S.C. 102(e)/103 rejection made; provisional double patenting rejection made; no 35 U.S.C. 102(f)/103 or 102(g)/103 rejection made.

SITUATIONS	RESULTS
3. A and B file continuing application claiming priority to >both< their earlier applications and abandon the earlier applications.	Assume it is proper that restriction be required between X and XY.
4. X is elected and patent issues on X with divisional application being timely filed on XY.	No rejection of divisional application under 35 U.S.C. 102(e)/103 in view of 35 U.S.C. 121.

The following examples are instructive as to rejections under 35 U.S.C. 102(e)/103 in applications **>that are pending on or after December 10, 2004<:

Example 3. Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed. Employee A's application, **>which is pending on or after December 10, 2004<, is being examined.

SITUATIONS	RESULTS
1. A invents X and later files application.	This is permissible.
2. B modifies X to XY. B files application before A's filing. A files an application on invention X.	Provisional 35 U.S.C. 102(e)/103 rejection and a provisional double patenting rejection >are< made.
3. B's patent issues.	A's claims >are< rejected under 35 U.S.C. 102(e)/103 and double patenting.
4. A files evidence of common ownership of inventions X and XY at the time invention XY was made to disqualify B's patent as prior art. In addition, A files a terminal disclaimer under 37 CFR 1.321(c).	Rejection under 35 U.S.C. 102(e)/103 will be withdrawn and double patenting rejection will be obviated if inventions X and XY are commonly owned at the time invention XY was made and all requirements of 37 CFR 1.321 are met.

In situation (2.) above, the result is a provisional rejection by the examiner under 35 U.S.C. 102(e)/103. The rejection is provisional since the subject matter and the prior art are pending applications.

Example 4. Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed. Employee B's application, **>which is pending on or after December 10, 2004<, is being examined.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files evidence establishing that A and B were both under obligation to assign inventions to C at the time the invention XY was made.	Provisional 35 U.S.C. 102(e)/103 rejection cannot be made; provisional double patenting rejection >is< made; no 35 U.S.C. 102(*>f<)/103 or 102(g)/103 rejection made.
3. B files a terminal disclaimer under 37 CFR 1.321(c).	The provisional double patenting rejection made in B's application would be obviated if all requirements of 37 CFR 1.321 are met.

>***Example 5***. Assumption: Employee A works for assignee I and Employee B works for assignee J. There is a joint research agreement, pursuant to 35 U.S.C. 103(c), between assignees I and J. Employees A and B each filed an application as set forth below. Employee B's invention claimed in his application was made after the joint research agreement was entered into, and it was made as a result of activities undertaken within the scope of the joint agreement. Employee B's application discloses assignees I and J as the parties to the joint research agreement. Employee B's application, which is pending on or after December 10, 2004, is being examined.

SITUATIONS	RESULTS
1. A invents X and files application.	This is permissible.
2. B modifies X to XY after A's application is filed. B files evidence establishing a joint research agreement in compliance with 35 U.S.C. 103(c).	Provisional 35 U.S.C. 102(e)/103 rejection cannot be made; provisional double patenting rejection is made; no 35 U.S.C. 102(f)/103 or 102(g)/103 rejection made.
3. B files a terminal disclaimer under 37 CFR 1.321.	The provisional double patenting rejection made in B's application would be obviated if all requirements of 37 CFR 1.321 are met.

<

EXAMINATION OF CONTINUING APPLICATION COMMONLY OWNED WITH ABANDONED PARENT APPLICATION TO WHICH BENEFIT IS CLAIMED UNDER 35 U.S.C. 120

An application claiming the benefit of a prior filed copending national or international application under 35 U.S.C. 120 must name as an inventor at least one inventor named in the prior filed application. The prior filed application must also 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. This practice contrasts with the practice in effect prior to November 8, 1984 (the date of enactment of Public Law 98-622) where the inventorship entity in each of the applica-

tions was required to be the same for benefit under 35 U.S.C. 120.

So long as the applications have at least one inventor in common and the other requirements are met, the Office will permit a claim for 35 U.S.C. 120 benefit without any additional submissions or notifications from applicants regarding inventorship differences.

In addition to the normal examination conducted by the examiner, he or she must examine the earlier filed application to determine if the earlier and later applications have at least one inventor in common and that the other 35 U.S.C. 120 requirements are met. The claim for 35 U.S.C. 120 benefit will be permitted without examination of the earlier application for disclosure and support of at least one claim of the later filed application under 35 U.S.C. 112, first paragraph unless it becomes necessary to do so, for example, because of an intervening reference.

706.02(l) Rejections Under 35 U.S.C. **>103(a) Using Prior Art Under Only 35 U.S.C. 102 (e), (f), or (g)< [R-3]

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

*****

**>

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

<

>

It is important to recognize that 35 U.S.C. 103(c) applies only to consideration of prior art for purposes of obviousness under 35 U.S.C. 103. It does not apply to or affect subject matter which is applied in a rejection under 35 U.S.C. 102 or a double patenting rejection. In addition, if the subject matter qualifies as prior art under any other subsection of 35 U.S.C. 102 (e.g., 35 U.S.C. 102(a) or (b)) it will not be disqualified as prior art under 35 U.S.C. 103(c).

A patent applicant or patentee urging that subject matter is disqualified has the burden of establishing that the prior art is disqualified under 35 U.S.C. 103(c). Absent proper evidence of disqualification, the appropriate rejection under 35 U.S.C. 103(a) with applying prior art under 35 U.S.C. 102(e), (f), or (g) should be made. See MPEP § 706.02(l)(2) for information pertaining to establishing prior art exclusions due to common ownership or joint research agreements.

The term "subject matter" will be construed broadly, in the same manner the term is construed in the remainder of 35 U.S.C. 103. The term "another" as used in 35 U.S.C. 103 means any inventive entity other than the inventor and would include the inventor and any other persons. The term "developed" is to be read broadly and is not limited by the manner in which the development occurred. The term "commonly owned" means wholly owned by the same person(s) or organization(s) at the time the invention was made. The term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. See MPEP § 706.02(l)(2).

FOR APPLICATIONS FILED PRIOR TO NOVEMBER 29, 1999 AND GRANTED AS PATENTS PRIOR TO DECEMBER 10, 2004<

Prior to November 29, 1999, 35 U.S.C. 103(c) provided that subject matter developed by another which qualifies as "prior art" only under subsections 35 U.S.C. 102(f) or 35 U.S.C. 102(g) is not to be considered when determining whether an invention

sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 706.02(l)(1) for information regarding when prior art under 35 U.S.C. 102(e)/103 is disqualified under 35 U.S.C. 103(c).

For applications filed prior to November 29, 1999 >and granted as patents prior to December 10, 2004<, the subject matter that is disqualified as prior art under 35 U.S.C. 103(c) is strictly limited to subject matter that A) qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under 35 U.S.C. 103(c). See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997) ("We therefore hold that subject matter derived from another not only is itself unpatentable to the party who derived it under § 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of §§ 102(f) and 103.") **>Therefore, in these applications, information learned from or transmitted to persons outside the organization is not disqualified as prior art.<

**

Inventors of subject matter not commonly owned at the time of the invention, but currently commonly owned, may file as joint inventors in a single application. However, the claims in such an application are not protected from a 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 rejection. Applicants in such cases have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made to enable the examiner to consider the applicability of a 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 rejection. The examiner will assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure.

Foreign applicants will sometimes combine the subject matter of two or more related applications with different inventors into a single U.S. application naming joint inventors. The examiner will make the assumption, absent contrary evidence, that the applicants are complying with their duty of disclosure if no information is provided relative to invention dates and common ownership at the time the later invention was made. Such a claim for 35 U.S.C. 119(a)-(d) *>priority< based upon the foreign filed applications is appropriate and 35 U.S.C. 119(a)-(d) *>priority< can be accorded based upon each of the foreign filed applications.

>For rejections under 35 U.S.C. 103(a) using prior art under 35 U.S.C. 102(f) or (g) in applications pending on or after December 10, 2004, see MPEP § 706.02(l)(1).<

706.02(l)(1) Rejections Under 35 U.S.C. **>103(a) Using Prior Art Under 35 U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under 35 U.S.C. 103(c)< [R-3]

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

*****

**>

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

>

I. COMMON OWNERSHIP OR ASSIGNEE PRIOR ART EXCLUSION UNDER 35 U.S.C. 103(c)<

*>Enacted on< November 29, 1999, >the American Inventors Protection Act (AIPA) added< subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) **>as< disqualified * prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." *>The 1999< change to 35 U.S.C. 103(c) *>only applied< to all utility, design and plant patent applications filed on or after November 29, 1999**>. The Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), in part, redesignated the former 35 U.S.C. 103(c) to 35 U.S.C. 103(c)(1) and made this provision effective to all applications in which the patent is granted on or after December 10, 2004. Therefore, the provision of 35 U.S.C. 103(c)(1) is effective for all applications pending on or after December 10, 2004, including applications filed prior to November 29, 1999. In addition, this provision applies to all patent applications, including utility, design, plant and reissue applications. The amendment to 35 U.S.C. 103(c)(1) does not affect any application filed before November 29, 1999 and issued as a patent prior to December 10, 2004.

In a reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004 to determine whether 35 U.S.C. 103(c), as amended by the CREATE Act, applies. For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed on or after November 29, 1999, it is the 1999 changes to 35 U.S.C. 103(c) that are applicable to the disqualifying commonly assigned/owned prior art provisions of 35 U.S.C. 103(c). For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to 35 U.S.C. 103(c) are applicable. Therefore, only prior art under 35 U.S.C. 102(f) or (g) used in a rejection under 35 U.S.C. 103(a) may be disqualified under the commonly assigned/owned prior art provisions of 35 U.S.C. 103(c).<

** For reissue applications, the doctrine of recapture may prevent the presentation of claims in the reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was **>not able to be excluded under 35 U.S.C. 103(c) in the application that issued as a patent.< If an examiner determines that this situation applies in the reissue application under examination, a consultation with the Office of Patent Legal Administration should be initiated via the Technology Center Special Program Examiner.

35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. 102 ** is not affected, and may still be used to reject claims as being anticipated. >In addition, double patenting rejections, based on subject matter now disqualified as prior art in amended 35 U.S.C. 103(c), should still be made as appropriate. See 37 CFR 1.78(c) and MPEP § 804.<

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter. *>For example, the< fact that the reference and the application have the same assignee is not, by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that the common ownership was "at the time the invention was made."

See MPEP § 706.02(l)(2) for information regarding establishing common ownership. See MPEP § 706.02(l)(3) for examination procedure with respect to 35 U.S.C. 103(c).**

>

II. JOINT RESEARCH AGREEMENT DISQUALIFICATION UNDER 35 U.S.C. 103(c) BY THE CREATE ACT

The CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)) was enacted on December 10, 2004 and is effective for applications for which the patent is granted on or after December 10, 2004. Specifically, the CREATE Act amended 35 U.S.C. 103(c) to provide that:

- subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person;

- for purposes of 35 U.S.C. 103, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if

  - the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made,

  - the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and

  - the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement;

- for purposes of 35 U.S.C. 103(c), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, development, or research work in the field of the claimed invention.

The effective date provision of the CREATE Act provided that its amendments shall apply to any patent (including any reissue patent) granted on or after December 10, 2004. The CREATE Act also provided that its amendment shall not affect any final decision of a court or the Office rendered before December 10, 2004, and shall not affect the right of any party in any action pending before the Office or a court on December 10, 2004, to have that party's rights determined on the basis of the provisions of title 35, United States Code, in effect on December 9, 2004. Since the CREATE Act also includes the amendment to 35 U.S.C. 103(c) made by section 4807 of the AIPA (see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)), the change of "subsection (f) or (g)" to "one or more of subsections (e), (f), or (g)" in 35 U.S.C. 103(c) is now also applicable to applications filed prior to November 29, 1999, that were pending on December 10, 2004.

35 U.S.C. 103(c), as amended by the CREATE Act, continues to apply only to subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g), and which is being relied upon in a rejection under 35 U.S.C. 103. If the rejection is anticipation under 35 U.S.C. 102(e), (f), or (g), 35 U.S.C. 103(c) cannot be relied upon to disqualify the subject matter in order to overcome or prevent the anticipation rejection. Likewise, 35 U.S.C. 103(c) cannot be relied upon to overcome or prevent a double patenting rejection. See 37 CFR 1.78(c) and MPEP § 804.

Because the CREATE Act applies only to patents granted on or after December 10, 2004, the recapture doctrine may prevent the presentation of claims in the reissue applications that had been amended or cancelled (e.g., to avoid a rejection under 35 U.S.C. 103(a) based on subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent being reissued.<

706.02(l)(2) Establishing Common Ownership >or Joint Research Agreement< [R-3]

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned >, or subject to an obligation of assignment to a same person,< at the time the claimed invention was made or **>be subject to a joint research agreement at the time the invention was made<. See MPEP § 706.02(l) for 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 prior art disqualified under 35 U.S.C. 103(c)>in applications granted as patents prior to December 10, 2004<. See MPEP § 706.02(l)(1) for 35 U.S.C. 102(e)>, (f), or (g)</103 prior art disqualified under 35 U.S.C. 103(c).

I. DEFINITION OF COMMON OWNERSHIP

The term "commonly owned" is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)/business entity(ies) at the time the claimed invention was made. If the person(s) or organization(s) owned less than 100 percent of the subject matter which would otherwise be prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist. Common ownership requires that the person(s) or organization(s)/business entity(ies) own 100 percent of the subject matter and 100 percent of the claimed invention.

Specifically, if an invention claimed in an application is owned by more than one entity and those entities seek to exclude the use of a reference under 35 U.S.C. 103, then the reference must be owned by, or subject to an obligation of assignment to, the same entities that owned the application, at the time the later invention was made. For example, assume Company A owns twenty percent of patent Application X and Company B owns eighty percent of patent Application X at the time the invention of Application X was made. In addition, assume that Companies A and B seek to exclude the use of Reference Z under 35 U.S.C. 103. Reference Z must have been co-owned, or have been under an obligation of assignment to both companies, on the date the invention was made in order for the exclusion to be properly requested. A statement such as "Application X and Patent Z were, at the time the invention of Application X was made, jointly owned by Companies A and B" would be sufficient evidence of common ownership.

For applications owned by a joint venture of two or more entities, both the application and the reference must have been owned by, or subject to an obligation of assignment to, the joint venture at the time the invention was made. For example, if Company A and Company B formed a joint venture, Company C, both Application X and Reference Z must have been owned by, or subject to an obligation of assignment to, Company C at the time the invention was made in order for Reference Z to be properly excluded as prior art under 35 U.S.C. 103(c). If Company A by itself owned Reference Z at the time the invention of Application X was made and Application X was owned by Company C on the date the invention was made, then a request for the exclusion of Reference Z as prior art under 35 U.S.C. 103(c) would not be proper.

As long as principal ownership rights to either the subject matter or the claimed invention reside in different persons or organizations common ownership does not exist. A license of the claimed invention to another by the owner where basic ownership rights are retained would not defeat ownership.

The requirement for common ownership at the time the claimed invention was made is intended to preclude obtaining ownership of subject matter after the claimed invention was made in order to disqualify that subject matter as prior art against the claimed invention.

The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual(s) or organization(s) or a legal obligation to assign both the subject matter and the claimed invention to the same individual(s) or organization(s)/business entity(ies) must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art. A moral or unenforceable obligation would not evidence common ownership.

Under 35 U.S.C. 103(c), an applicant's admission that subject matter was developed prior to applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art only under sections 35 U.S.C. **>102(e), (f), or (g)<, and if the subject matter and the claimed invention were commonly owned at the time the invention was made. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982), for a decision involving an applicant's admission which was used as prior art against their application. If the subject matter and invention were not commonly owned, an admission that the subject matter is prior art would be usable under 35 U.S.C. 103.

The burden of establishing that subject matter is disqualified as prior art under 35 U.S.C. 103(c) is intended to be placed and reside upon the person or persons urging that the subject matter is disqualified. For example, a patent applicant urging that subject matter is disqualified as prior art under 35 U.S.C.

103(c), would have the burden of establishing that it was commonly owned at the time the claimed invention was made. The patentee in litigation would likewise properly bear the same burden placed upon the applicant before the U.S. Patent and Trademark Office. To place the burden upon the patent examiner or the defendant in litigation would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee.

In view of 35 U.S.C. 103(c), the Director has reinstituted in appropriate circumstances the practice of rejecting claims in commonly owned applications of different inventive entities on the grounds of double patenting. Such rejections can be overcome in appropriate circumstances by the filing of terminal disclaimers. This practice has been judicially authorized. See *In re Bowers*, 359 F.2d 886, 149 USPQ 57 (CCPA 1966). The use of double patenting rejections which then could be overcome by terminal disclaimers preclude patent protection from being improperly extended while still permitting inventors and their assignees to obtain the legitimate benefits from their contributions. See also MPEP § 804.

The following examples are provided for illustration only:

Example 1

Parent Company owns 100% of Subsidiaries A and B

- inventions of A and B are commonly owned by the Parent Company.

Example 2

Parent Company owns 100% of Subsidiary A and 90% of Subsidiary B

- inventions of A and B are not commonly owned by the Parent Company.

Example 3

If same person owns subject matter and invention at time invention was made, license to another may be made without the subject matter becoming prior art.

Example 4

Different Government inventors retaining certain rights (e.g. foreign filing rights) in separate inventions owned by Government precludes common ownership of inventions.

Example 5

Company A and Company B form joint venture Company C. Employees of A, while working for C with an obligation to assign inventions to C, invent invention #1; employees of B while working for C with an obligation to assign inventions to C, invent invention #2, with knowledge of #1.

Question: Are #1 and #2 commonly owned at the time the later invention was made so as to preclude a rejection under 35 U.S.C. 102(e), (f) or (g) in view of 35 U.S.C. 103?

Answer: Yes- If the required evidence of common ownership is made of record in the patent application file. If invention #1 was invented by employees of Company A **not** working for Company C and Company A maintained sole ownership of invention #1 at the time invention #2 was made, inventions #1 and #2 would not be commonly owned as required by 35 U.S.C. 103(c).

Example 6

Company A owns 40% of invention #1 and 60% of invention #2, and Company B owns 60% of invention #1 and 40% of invention #2 at the time invention #2 was made.

-inventions #1 and #2 are commonly owned.

Example 7

Company B has a joint research project with University A. Under the terms of the joint research project, University A has agreed that all of its patents will be jointly owned by Company B and University A. Professor X, who works for University A, has an employee agreement with University A assigning all his patents only to University A. After the joint research project agreement is executed, University A files patent application #1 for the invention of Professor X, before Company B files patent application #2 on a similar invention.

- inventions #1 and #2 are commonly owned because Professor X's obligation to assign patents to University A who has an obligation to assign patents to the A-B joint venture legally establishes Professor X's obligation to assign patents to the A-B joint venture.

Example 8

Inventor X working at Company A invents and files patent application #1 on technology T, owned by Company A. After application #1 is filed, Company A spins off a 100% owned Subsidiary B for technology T including the transfer of the ownership of patent application #1 to Subsidiary B. After Subsidiary B is formed, inventor Y (formerly a Company A employee, but now an employee of Subsidiary B obligated to assign to Subsidiary B) jointly files application #2 with inventor X (now also an employee of Subsidiary B with an obligation to assign to Subsidiary B), which is directed to a possibly unobvious improvement to technology T.

- the inventions of applications #1 and #2 are commonly owned since Subsidiary B is a wholly owned subsidiary of Company A.

The examiner must examine the application as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103 only if the application file(s) establishes common ownership at the time the later invention was made. Thus, it is necessary to look to the time at which common ownership exists. If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103. An invention is "made" when conception is complete as defined in *Mergenthaler v. Scudder*, 11 App. D.C. 264, 81 O.G. 1417, 1897 C.D. 724 (D.C. Cir. 1897); *In re Tansel*, 253 F.2d 241, 117 USPQ 188 (CCPA 1958). See *Pfaff v. Wells Elecs.*, 525 U.S. 55, 119 S. Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) ("the invention must be ready for patenting . . . . by proof that prior to the critical date the inventor had prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.") Common ownership at the time the invention was made for purposes of obviating a 35 U.S.C. 102(e)/35 U.S.C. 103, 35 U.S.C. 102(f)/35 U.S.C. 103 or 35 U.S.C. 102(g)/35 U.S.C. 103 rejection may be established irrespective of whether the invention was made in the United States or abroad. The provisions of 35 U.S.C. 104, however, will continue to apply to other proceedings in the U.S. Patent and Trademark Office, e.g. in an interference proceeding, with regard to establishing a date of invention by knowledge or use thereof, or other activity with respect thereto, in a foreign country. The foreign filing date will continue to be used for interference purposes under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 365.

II. EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP

It is important to recognize just what constitutes sufficient evidence to establish common ownership at the time the invention was made. The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

> Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

See "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (December 26, 2000). The applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO.

The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.

For example, an attorney or agent of record receives an Office action for Application X in which

all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

> "Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

In rare instances, the examiner may have independent evidence that raises a material doubt as to the accuracy of applicant's representation of either (1) the common ownership of, or (2) the existence of an obligation to commonly assign, the application being examined and the applied U.S. patent or U.S. patent application publication reference. In such cases, the examiner may explain why the accuracy of the representation is doubted, and require objective evidence of common ownership of, or the existence of an obligation to assign, the application being examined and the applied reference as of the date of invention of the application being examined. As mentioned above, applicant(s) may submit, *in addition to* the above-mentioned statement regarding common ownership, the following objective evidence:

(A) Reference to assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3 which convey the entire rights in the applications to the same person(s) or organization(s);

(B) Copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) are filed in each of the applications;

(C) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; and

(D) Other evidence is submitted which establishes common ownership of the applications.

>

III. EVIDENCE REQUIRED TO ESTABLISH A JOINT RESEARCH AGREEMENT

Once an examiner has established a *prima facie* case of obviousness under 35 U.S.C. 103(a), the burden of overcoming the rejection by invoking the joint research agreement provisions of 35 U.S.C. 103(c) as amended by the CREATE Act is on the applicant or the patentee. 35 U.S.C. 103(c)(3) defines a "joint research agreement" as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention, that was in effect on or before the date the claimed invention (under examination or reexamination) was made.

Like the common ownership or assignment provision, the joint research agreement must be shown to be in effect on or before the time the later invention was made. The joint research agreement may be in effect prior to the effective date (December 10, 2004) of the CREATE Act. In addition, the joint research agreement is NOT required to be in effect on or before the prior art date of the reference that is sought to be disqualified.

To overcome a rejection under 35 U.S.C. 103(a) based upon subject matter (whether a patent document, publication, or other evidence) which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f), or (g) via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect.

If the applicant disqualifies the subject matter relied upon by the examiner in accordance with 35 U.S.C. 103(c) as amended by the CREATE Act and the procedures set forth in the rules, the examiner will treat the application under examination and the 35 U.S.C. 102(e), (f), or (g) prior art as if they are commonly owned for purposes of 35 U.S.C. 103(a).

The following examples are provided for illustration only:

Example 1

Company A and University B have a joint research agreement (JRA) in place prior to the date invention X' was made. Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent

application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. Invention X' was made as a result of the activities undertaken within the scope of the JRA. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could invoke the joint research agreement provisions of 35 U.S.C. 103(c) to disqualify University B's application as prior art in a rejection under 35 U.S.C. 103(a).

Example 2

Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. Company A and University B have a joint research agreement (JRA), which goes into effect on December 20, 2004. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could **not** invoke the joint research agreement provisions of 35 U.S.C. 103(c) to disqualify University B's application as prior art in a rejection under 35 U.S.C. 103(a) because the JRA was not in effect until after the later invention was made.

Example 3

Company A and University B have a joint research agreement (JRA) in place prior to the date invention X' was made but the JRA is limited to activities for invention Y, which is distinct from invention X. Professor BB from University B communicates invention X to Company A. On November 12, 2004, University B filed a patent application on invention X. On December 13, 2004, Company A filed a patent application disclosing and claiming invention X', which is an obvious variant of invention X. University B retains ownership of invention X and Company A retains ownership of invention X', without any obligation to assign the inventions to a common owner. Company A could **not** invoke the joint research agreement provisions of 35 U.S.C. 103(c) to disqualify University B's application as prior art in a rejection under 35 U.S.C. 103(a) because the claimed invention was not made as a result of the activities undertaken within the scope of the JRA.<

706.02(l)(3) Examination Procedure With Respect to 35 U.S.C. 103(c) [R-3]

Examiners are reminded that a reference used in an anticipatory rejection under 35 U.S.C. 102(e), (f), or (g) is not disqualified as prior art if evidence is provided to show **>that the reference is disqualified under 35 U.S.C. 103(c). Generally, such a< reference is only disqualified when

(A) proper evidence is filed,

(B) the reference *only* qualifies as prior art under 35 U.S.C. 102>(e),< (f) or (g) ** (e.g.>,< not 35 U.S.C. 102(a) or (b))>,< and

(C) the reference was used in an obviousness rejection under 35 U.S.C. 103(a).

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s). >In order to overcome a rejection under 35 U.S.C. 103(a) based upon a reference which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f), or (g), via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect.<

See MPEP § 706.02(l)(2) for additional information pertaining to establishing common ownership.

I. EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES WHERE COMMON OWNERSHIP >OR A JOINT RESEARCH AGREEMENT< HAS NOT BEEN ESTABLISHED

If the application file being examined **>has not established that the reference is disqualified as prior art under 35 U.S.C. 103(c)<, the examiner will:

(A) assume the **>reference is not disqualified under 35 U.S.C. 103(c)<;

(B) examine the application on all grounds other than any conflict between the reference patent(s) or application(s) arising from a possible 35 U.S.C. 103 rejection based on 35 U.S.C. 102(e), (f) and/or (g);

(C) consider the applicability of any references under 35 U.S.C. 103 based on 35 U.S.C. 102(e), (f) and/or (g), including provisional rejections under 35 U.S.C. 102(e)/103; and

(D) apply the best references against the claimed invention by rejections under 35 U.S.C. 102 and 103, including any rejections under 35 U.S.C. 103 based on 35 U.S.C. 102(e), (f) and/or (g), until such time that **>the reference is disqualified under 35 U.S.C. 103(c)<. When applying any 35 U.S.C. 102(e)/103 references against the claims**, the examiner should anticipate that **>the reference may be disqualified under 35 U.S.C. 103(c).< See MPEP § 706.02(l)(1). If * a statement >of common ownership or assignment< is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP § 706.07(a). >If the reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c) and a new subsequent double patenting rejection based upon the disqualified reference is applied, the next Office action, which contains the new double patenting rejection, may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). The Office action is properly made final because the new double patenting rejection was necessitated by amendment of the application by applicant.<

II. EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES ** WHERE COMMON OWNERSHIP >OR A JOINT RESEARCH AGREEMENT< HAS BEEN ESTABLISHED

If the application being examined **>has established that the reference is disqualified as prior art under 35 U.S.C. 103(c)< the examiner will:

(A) examine the applications as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103, including provisional rejections under 35 U.S.C. 102(e)/103;

(B) examine the applications for double patenting, including statutory and nonstatutory double patenting, and make a provisional rejection, if appropriate; and

(C) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate >(see 37 CFR 1.321)<.

**>

III. < DOUBLE PATENTING REJECTIONS

Commonly owned applications of different inventive entities may be rejected on the ground of double patenting, even if the later filed application claims 35 U.S.C. 120 benefit to the earlier application. >In addition, double patenting rejection may arise as a result of the amendment to 35 U.S.C. 103(c) by the CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)). Congress recognized that this amendment to 35 U.S.C. 103(c) would result in situations in which there would be double patenting rejections between applications not owned by the same party (see H.R. Rep. No. 108-425, at 5-6 (2003). For purposes of double patenting analysis, the application or patent and the subject matter disqualified under 35 U.S.C. 103(c) as amended by the CREATE Act will be treated as if commonly owned.<

A rejection based on a pending application would be a provisional rejection. The practice of rejecting claims on the ground of double patenting in commonly owned applications of different inventive entities is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See MPEP § 804 for guid-

ance on double patenting issues. In accordance with established patent law doctrines, double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the existing provisions of 37 CFR 1.321, the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life. >For a double patenting rejection based on a non-commonly owned patent (treated as if commonly owned pursuant to the CREATE Act), the double patenting rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(d).< See MPEP § 804 and § 804.02.

706.02(m) Form Paragraphs for Use in Rejections Under 35 U.S.C. 103 [R-3]

The following form paragraphs should be used in making the appropriate rejections under 35 U.S.C. 103.

¶ *7.20 Statement of Statutory Basis, 35 U.S.C. 103(a)*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Examiner Note:

1. The statute is not to be cited in all Office actions. It is only required in first actions on the merits employing 35 U.S.C. 103(a) and final rejections. Where the statute is being applied, but is not cited in an action on the merits, use paragraph 7.103.

2. This form paragraph should only be used ONCE in a given Office action.

3. This form paragraph must precede form paragraphs 7.20.01 - 7.22 when this form paragraph is used to cite the statute in first actions and final rejections.

**>

¶ *7.20.01 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Not Disqualified Under 35 U.S.C. 103(c) Because Reference Is Prior Art Under Another Subsection of 35 U.S.C. 102*

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as **[1]** at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference **[2]** additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Examiner Note:

1. This form paragraph must be included following form paragraph 7.20 in all actions containing rejections under 35 U.S.C. 103(a) using art that is disqualified under 103(c) using 102(e), (f), or (g), but which qualifies under another section of 35 U.S.C. 102.
2. In brackets 1 and 2, identify the reference which is sought to be disqualified.

<

**

¶ *7.20.02 Joint Inventors, Common Ownership Presumed*

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Examiner Note:

This paragraph must be used in all applications with joint inventors (unless the claims are clearly restricted to only one claimed invention, e.g., only a single claim is presented in the application).

>

¶ *7.20.04 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Attempted To Be Disqualified Under 35 U.S.C. 103(c) Using the Common Ownership or Assignment Provision*

Applicant has attempted to disqualify reference **[1]** under 35 U.S.C. 103(c) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as **[2]** at the time this invention was made. However, applicant has failed to

provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(l).

In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Examiner Note:

1. This form paragraph must be included in all actions containing rejections under 35 U.S.C. 103(a) where an attempt has been made to disqualify the reference under 35 U.S.C. 103(c), but where the applicant has not provided a proper statement indicating common ownership or assignment **at the time the invention was made**.

2. In brackets 1 and 2, identify the commonly owned applied art (e.g., patent or co-pending application).

¶ *7.20.05 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Attempted To Be Disqualified Under 35 U.S.C. 103(c) Using the Joint Research Agreement Provisions*

Applicant has attempted to disqualify reference **[1]** under 35 U.S.C. 103(c) by showing that the invention was subject to a joint research agreement at the time this invention was made. However, applicant has failed to **[2]**. Applicant must file the missing requirements in order to properly disqualify the reference under 35 U.S.C. 103(c). See 37 CFR 1.71(g) and 1.104(c) and MPEP § 706.02(l).

In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Examiner Note:

1. This form paragraph must be included in all actions containing rejections under 35 U.S.C. 103(a) where an attempt has been made to disqualify the reference under 35 U.S.C. 103(c) using the joint research agreement provisions but the disqualification attempt is ineffective.

2. In bracket 1, identify the reference which is sought to be disqualified under 35 U.S.C. 103(c).

3. In bracket 2, identify the reason(s) why the disqualification attempt is ineffective. The reason(s) could be noncompliance with the statutory requirements of 35 U.S.C. 103(c) or rule requirements relating to the CREATE Act.

<

**>

¶ *7.21 Rejection, 35 U.S.C. 103(a)*

Claim **[1]** rejected under 35 U.S.C. 103(a) as being unpatentable over **[2].**

Examiner Note:

1. This paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.

2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.

3. If the rejection relies upon prior art under 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

4. If the applicability of this rejection (e.g., the availability of the prior art as a reference under 35 U.S.C. 102(a) or 35 U.S.C. 102(b)) prevents the reference from being disqualified under 35 U.S.C. 103(c), form paragraph 7.20.01 must follow this form paragraph.

5. If this rejection is a provisional 35 U.S.C. 103(a) rejection based upon a copending application that would comprise prior art under 35 U.S.C. 102(e) if patented or published, use form paragraph 7.21.01 instead of this paragraph.

<

**>

¶ *7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim **[1]** provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. **[2]** which has a common **[3]** with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. **[4]**

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under

35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Examiner Note:

1. This paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications pending on or after December 10, 2004 when the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(l)(3).
2. Use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act (AIPA) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA 35 U.S.C. 102(e) to determine the copending application reference's prior art date. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date.
3. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.
4. In bracket 3, insert either --assignee-- or --inventor--.
5. In bracket 4, insert explanation of obviousness.
6. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using paragraph 8.33 and 8.37.
7. If evidence indicates that the copending application is also prior art under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 35 U.S.C. 103(a) rejection pursuant to 35 U.S.C. 103(c), a rejection should additionally be made under 35 U.S.C. 103(a) using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

<
**>

¶ *7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim **[1]** rejected under 35 U.S.C. 103(a) as being obvious over **[2]**.

The applied reference has a common **[3]** with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). **[4]**

Examiner Note:

1. This paragraph is used to reject over a reference (patent or published application) with an earlier filing date that discloses the claimed invention, and that only qualifies as prior art under 35 U.S.C. 102(e). If the reference qualifies as prior art under 35 U.S.C. 102(a) or (b), then this form paragraph should not be used (form paragraph 7.21 should be used instead). The reference must have either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications when the reference is disqualified under 35 U.S.C. 103(c) as prior art in a 35 U.S.C. 103(a) rejection. See MPEP § 706.02(l)(3).
2. 35 U.S.C. 102(e) as amended by the American Inventors Protection Act of 1999 (AIPA) must be applied if the reference is one of the following:

a. a U.S. patent or a publication of a U.S. application for patent filed under 35 U.S.C. 111(a);

b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**.

See the Examiner Notes for form paragraph 7.12 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.

3. Pre-AIPA 35 U.S.C 102(e) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the 35 U.S.C. 102(e) date of the reference.
4. In bracket 3, insert either --assignee-- or --inventor--.
5. In bracket 4, insert explanation of obviousness.

<

¶ *7.22 Rejection, 35 U.S.C. 103(a), Further in View Of*

Claim **[1]** rejected under 35 U.S.C. 103(a) as being unpatentable over **[2]** as applied to claim **[3]** above, and further in view of **[4]**.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.21.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.
3. If the rejection relies upon prior art under 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date

prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

¶ *7.23 Graham v. Deere, Test for Obviousness*

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.Determining the scope and contents of the prior art.

2.Ascertaining the differences between the prior art and the claims at issue.

3.Resolving the level of ordinary skill in the pertinent art.

4.Considering objective evidence present in the application indicating obviousness or nonobviousness.

Examiner Note:

This form paragraph may be used, if appropriate, in response to an argument of the use of Graham v. Deere.

¶ *7.27 Rejection, 35 U.S.C. 102 or 103(a)*

Claim **[1]** rejected under 35 U.S.C. 102**([2])** as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **[3]**.

Examiner Note:

1. This form paragraph is NOT intended to be commonly used as a substitute for a rejection under 35 U.S.C. 102. In other words, a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103(a) should be made whenever possible using appropriate form paragraphs 7.15 to 7.19, 7.21 and 7.22. Examples of circumstances where this paragraph may be used are as follows:

a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP §§ 2111- 2116.01 for guidelines on claim interpretation.

b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112-2112.02.

c. When the reference teaches a small genus which places a claimed species in the possession of the public as in In re Schaumann, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. 102. See MPEP §§ 2131.02 and 2144.08 for more information on anticipation and obviousness of species by a disclosure of a genus.

d. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

e. When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent to the claimed element and therefore anticipatory, or whether the prior art element is an obvious variant of the claimed element. See MPEP §§ 2183- 2184.

f. When the ranges disclosed in the reference and claimed by applicant overlap in scope but the reference does not contain a specific example within the claimed range. See the concurring opinion in Ex parte Lee, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). See MPEP § 2131.03.

2. If the interpretation of the claim(s) renders the claim(s) indefinite, a rejection under 35 U.S.C. 112, 2nd paragraph, may be appropriate.

3. In bracket 2, insert the appropriate paragraph letter(s) in parenthesis.

4. A full explanation should follow this form paragraph.

5. If the rejection relies upon prior art under 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

6. This form paragraph must be preceded by 7.07, one or more of form paragraphs 7.08 to 7.14 as appropriate, and form paragraph 7.20 or form paragraph 7.103.

706.02(n) Biotechnology Process Applications; 35 U.S.C. 103(b) [R-1]

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

*****

(b)(1)Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

*****

35 U.S.C. 103(b) is applicable to biotechnological processes only. 35 U.S.C. 103(b) precludes a rejection of process claims which involve the use or making of certain nonobvious biotechnological compositions of matter under 35 U.S.C. 103(a).

35 U.S.C. 103(b) requires that:

(A) the biotechnological process and composition of matter be contained in either the same application or in separate applications having the same effective filing date;

(B) both the biotechnological process and composition of matter be owned or subject to an assignment to the same person at the time the process was invented;

(C) a patent issued on the process also contain the claims to the composition of matter used in or made by the process, or, if the process and composition of matter are in different patents, the patents expire on the same date;

(D) the biotechnological process falls within the definition set forth in 35 U.S.C. 103(b); and

(E) a timely election be made to proceed under the provisions of 35 U.S.C. 103(b).

An election to proceed under 35 U.S.C. 103(b) shall be made by way of petition under 37 CFR 1.182. The petition must establish that all the requirements set forth in 35 U.S.C. 103(b) have been satisfied.

An election will normally be considered timely if it is made no later than the earlier of either the payment of the issue fee or the filing of an appeal brief in an application which contains a composition of matter claim which has not been rejected under 35 U.S.C. 102 or 103.

In an application where at least one composition of matter claim has not been rejected under 35 U.S.C. 102 or 103, a 35 U.S.C. 103(b) election may be made by submitting the petition and an amendment requesting entry of process claims which correspond to the composition of matter claim.

For applications pending on or after November 1, 1995, in which the issue fee has been paid prior to March 26, 1996, the timeliness requirement for an election under 35 U.S.C. 103(b) will be considered satisfied if the conditions of 37 CFR 1.312(b) are met. However, if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b) without an election having been made as a result of error without deceptive intent, patentees may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment.

See MPEP § 2116.01 for a discussion of the Federal Circuit's decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) which address the general issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In view of the Federal Circuit's decisions in *Ochiai* and *Brouwer*, an applicant's need to rely upon 35 U.S.C. 103(b) should be rare. See also 1184 O.G. 86 (Comm'r Pat. 1996). See 35 U.S.C. 282 for the effect of a determination of nonobviousness under 35 U.S.C. 103(b)(1) on the presumption of validity.

706.03 Rejections Not Based on Prior Art

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating

effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Rejections based on nonstatutory subject matter are explained in MPEP § 706.03(a), § 2105, § 2106 - § 2106.02, and § 2107 - § 2107.02. Rejections based on subject matter barred by the Atomic Energy Act are explained in MPEP § 706.03(b). Rejections based on duplicate claims are addressed in MPEP § 706.03(k), and double patenting rejections are addressed in MPEP § 804. See MPEP § 706.03(o) for rejections based on new matter. Foreign filing without a license is discussed in MPEP § 706.03(s). Disclaimer, after interference or public use proceeding, *res judicata*, and reissue are explained in MPEP § 706.03(u) to § 706.03(x). Rejections based on 35 U.S.C. 112 are discussed in MPEP § 2161 - § 2174. IF THE LANGUAGE IN THE FORM PARAGRAPHS IS INCORPORATED IN THE OFFICE ACTION TO STATE THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

706.03(a) Rejections Under 35 U.S.C. 101 [R-3]

I. SUBJECT MATTER ELIGIBILITY

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

The term "process" as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

See MPEP § 2105 for patentability of microorganisms and MPEP § 2106 - § 2106.02 for patentability of mathematical algorithms or computer programs.

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the statute follow:

A. Printed Matter

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

B. Naturally Occurring Article

Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture." A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).

C. Scientific Principle

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854).

This subject matter is further limited by the Atomic Energy Act explained in MPEP § 706.03(b).

II. UTILITY

A rejection on the ground of lack of utility includes the more specific grounds of inoperativeness, involving perpetual motion**>. A rejection under 35 U.S.C. 101 for lack of utility should not be based on grounds that the invention is frivolous, fraudulent or against public policy. See *Juicy Whip Inc. v. Orange Bang Inc*., 185 F.3d 1364, 1367-68, 51 USPQ2d 1700, 1702-03 (Fed. Cir. 1999) ("[Y]ears ago courts invalidated patents on gambling devices on the ground that they were immoral…, but that is no longer the law…Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace and general welfare of the community are promoted…we find no basis in section 101 to hold that inventions can be ruled unpatentable for lack of utility simply because they have the capacity to fool some members of the public.")<. The statutory basis for this rejection is 35 U.S.C. 101. See MPEP § 2107 for guidelines governing rejections for lack of utility. See MPEP § 2107.01 - § 2107.03 for legal precedent governing the utility requirement.

Use Form Paragraphs 7.04 through 7.05.03 to reject under 35 U.S.C. 101.

¶ *7.04 Statement of Statutory Basis, 35 U.S.C. 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Examiner Note:

This paragraph must precede the first use of 35 U.S.C. 101 in all first actions on the merits and final rejections.

¶ *7.05 Rejection, 35 U.S.C. 101, -Heading Only- (Utility, Non-Statutory, Inoperative)*

Claim **[1]** rejected under 35 U.S.C. 101 because

Examiner Note:

1. This form paragraph must be followed by any one of form paragraphs 7.05.01- 7.05.03 or another appropriate reason.
2. Explain the rejection following the recitation of the statute and the use of form paragraphs 7.05.01-7.05.03 or other reason.
3. See MPEP §§ 706.03(a) and 2105- 2107.03 for other situations.
4. This form paragraph must be preceded by form paragraph 7.04 in first actions and final rejections.

¶ *7.05.01 Rejection, 35 U.S.C. 101, Non-Statutory*

the claimed invention is directed to non-statutory subject matter. **[1]**

Examiner Note:

In bracket 1, insert identification of non-statutory subject matter.

¶ *7.05.02 Rejection, 35 U.S.C. 101, Utility Lacking*

the claimed invention lacks patentable utility. **[1]**

Examiner Note:

In bracket 1, provide explanation of lack of utility, such as, for example, that which is frivolous, fraudulent, against public policy. See MPEP §§ 706.03 (a) and 2105- 2107.03.

¶ *7.05.03 Rejection, 35 U.S.C. 101, Inoperative*

the disclosed invention is inoperative and therefore lacks utility. **[1]**

Examiner Note:

In bracket 1, explain why invention is inoperative.

¶ *7.05.04 Utility Rejections Under 35 U.S.C. 101 and 35 U.S.C. 112, First Paragraph*

Claim **[1]** rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a **[2]** asserted utility or a well established utility.

[3]

Claim **[4]** also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a **[5]** asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Examiner Note:

1. Where the specification would not enable one skilled in the art to make the claimed invention, or where alternative reasons support the enablement rejection, a separate rejection under 35 U.S.C. 112, first paragraph, enablement should be made using the factors set forth in In re Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) and an undue experimentation analysis. See MPEP §§ 2164- 2164.08(c).
2. Use Format A, B, or C below as appropriate.

Format A:

(a) Insert the same claim numbers in brackets 1 and 4.

(b) Insert --specific and substantial-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

(d) Format A is to be used when there is no asserted utility and when there is an asserted utility but that utility is not specific and substantial.

Format B:

(a) Insert the same claim numbers in brackets 1 and 4.

(b) Insert --credible-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a credible asserted utility or a well established utility.

Format C:

For claims that have multiple utilities, some of which are not specific and substantial, some of which are not credible, but none of which are specific, substantial and credible:

(a) Insert the same claim numbers in brackets 1 and 4.

(b) Insert --specific and substantial asserted utility, a credible-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility, a credible asserted utility or a well established utility. Each utility should be addressed.

706.03(b) Barred by Atomic Energy Act [R-2]

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181(a)>)< thereof reads in part as follows:

No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms "atomic energy" and "special nuclear material" are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181(c) and (d)) set up categories of pending applications relating to atomic energy that must be brought to the attention of the Department of Energy. Under 37 CFR >*1.14(d)<, applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy and the Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by the Atomic Energy Act.

All applications received in the U.S. Patent and Trademark Office are screened by Technology Center (TC) work group 3640 personnel, under 37 CFR *>1.14(d)<, in order for the *>Director< to fulfill his or her responsibilities under section 151(d) (42 U.S.C. 2181(d)>)< of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review in TC work group 3640.

All rejections based upon sections 151(a)(42 U.S.C. 2181(a)>)<, 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by TC work group 3640 personnel.

706.03(c) Rejections Under 35 U.S.C. 112, First Paragraph [R-2]

Rejections based on the first paragraph of 35 U.S.C. 112 are discussed in MPEP § 2161 - § 2165.04. For a discussion of the utility requirements of 35 U.S.C. 112, first paragraph, and 35 U.S.C. 101, see MPEP § 2107 - § 2107.03. The appropriate form paragraphs 7.30.01 and 7.31.01 through 7.33.01 should be used in making rejections under 35 U.S.C. 112, first paragraph.

¶ *7.30.01 Statement of Statutory Basis, 35 U.S.C. 112, First Paragraph*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Form paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

**>

¶ *7.31.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Description Requirement, Including New Matter Situations*

Claim **[1]** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **[2]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, identify (by suitable reference to page and line numbers and/or drawing figures) the subject matter not properly described in the application as filed, and provide an explanation of your position. The explanation should include any questions the examiner asked which were not satisfactorily resolved and consequently raise doubt as to possession of the claimed invention at the time of filing.

<

Form paragraph 7.31.02 should be used when it is the examiner's position that nothing within the scope of the claims is enabled. In such a rejection, the examiner should explain all the reasons why nothing within the scope of the claim is enabled. To make sure all relevant issues are raised, this should include any issues regarding the breadth of the claims relative to the guidance in the disclosure.

**>

¶ *7.31.02 Rejection, 35 U.S.C. 112, 1st Paragraph, Enablement*

Claim **[1]** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. **[2]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. If the problem is one of scope, form paragraph 7.31.03 should be used.

3. In bracket 2, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § 2164.01(a) and § 2164.04. The explanation should include any questions the examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.

4. Where an essential component or step of the invention is not recited in the claims, use form paragraph 7.33.01.

<

Form paragraph 7.31.03 should be used when it is the examiner's position that something within the scope of the claims is enabled but the claims are not limited to that scope.

¶ *7.31.03 Rejection, 35 U.S.C. 112, 1st Paragraph: Scope of Enablement*

Claim **[1]** rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for **[2]**, does not reasonably provide enablement for **[3]**. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to **[4]** the invention commensurate in scope with these claims. **[5]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. This form paragraph is to be used when the scope of the claims is not commensurate with the scope of the enabling disclosure.

3. In bracket 2, identify the claimed subject matter for which the specification is enabling. This may be by reference to specific portions of the specification.

4. In bracket 3, identify aspect(s) of the claim(s) for which the specification is not enabling.

5. In bracket 4, fill in only the appropriate portion of the statute, i.e., one of the following: --make--, --use--, or --make and use--.

6. In bracket 5, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § 2164.01(a) and § 2164.04. The explanation should include any questions posed by the examiner which were not satisfactorily resolved and consequently raise doubt as to enablement.

¶ *7.31.04 Rejection, 35 U.S.C. 112, 1st Paragraph: Best Mode Requirement*

Claim **[1]** rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon **[2]**.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. In bracket 2, insert the basis for holding that the best mode has been concealed, e.g., the quality of applicant's disclosure is so poor as to effectively result in concealment.

3. Use of this form paragraph should be rare. See MPEP §§ 2165- 2165.04.

Form paragraph 7.33.01 should be used when it is the examiner's position that a feature considered critical or essential by applicant to the practice of the claimed invention is missing from the claim.

¶ *7.33.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Essential Subject Matter Missing From Claims (Enablement)*

Claim **[1]** rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. **[2]** critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). **[3]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.

2. In bracket 2, recite the subject matter omitted from the claims.

3. In bracket 3, give the rationale for considering the omitted subject matter critical or essential.

4. The examiner shall cite the statement, argument, date, drawing, or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims which are rejected.

706.03(d) Rejections Under 35 U.S.C. 112, Second Paragraph [R-3]

Rejections under 35 U.S.C. 112, second paragraph, are discussed in MPEP § 2171 - § 2174. Form paragraphs 7.30.02 and 7.34 through 7.35.01 should be used to reject under 35 U.S.C. 112, second paragraph.

¶ *7.30.02 Statement of Statutory Basis, 35 U.S.C. 112, Second Paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

¶ *7.34 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Claim Applicant's Invention*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim **[2]** fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed **[3]**. In that paper, applicant has stated **[4]**, and this statement indicates that the invention is different from what is defined in the claim(s) because **[5]**.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. This paragraph is to be used only where applicant has stated, somewhere other than in the application, as filed, that the invention is something different from what is defined in the claim(s).
3. In bracket 3, identify the submission by applicant (which is not the application, as filed, but may be in the remarks by applicant, in the brief, in an affidavit, etc.) by the date the paper was filed in the USPTO.
4. In bracket 4, set forth what applicant has stated in the submission to indicate a different invention.
5. In bracket 5, explain how the statement indicates an invention other than what is being claimed.

**>

¶ *7.34.01 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.11, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See MPEP §§ 2171 - 2174 for guidance. See also form paragraph 7.34.15 for *pro se* applicants.

<

¶ *7.34.02 Terminology Used Inconsistent with Accepted Meaning*

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "**[1]**" in claim **[2]** is used by the claim to mean "**[3]**", while the accepted meaning is "**[4]**." The term is indefinite because the specification does not clearly redefine the term.

Examiner Note:

1. In bracket 3, point out the meaning that is assigned to the term by applicant's claims, taking into account the entire disclosure.
2. In bracket 4, point out the accepted meaning of the term. Support for the examiner's stated accepted meaning should be provided through the citation of an appropriate reference source, e.g., textbook or dictionary. See MPEP § 2173.05(a).
3. This paragraph must be preceded by form paragraph 7.34.01.
4. This paragraph should only be used where the specification does not clearly redefine the claim term at issue.

¶ *7.34.03 Relative Term - Term of Degree Rendering Claim Indefinite*

The term "**[1]"** in claim **[2]** is a relative term which renders the claim indefinite. The term "**[1]**" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. **[3]**

Examiner Note:

1. In bracket 3, explain which parameter, quantity, or other limitation in the claim has been rendered indefinite by the use of the term appearing in bracket 1.
2. This form paragraph must be preceded by form paragraph 7.34.01.

**>

¶ *7.34.04 Broader Range/Limitation And Narrow Range/ Limitation in Same Claim*

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature

introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd.App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim **[1]** recites the broad recitation **[2]**, and the claim also recites **[3]** which is the narrower statement of the range/limitation.

Examiner Note:

1. In bracket 2, insert the broader range/limitation and where it appears in the claim; in bracket 3, insert the narrow range/limitation and where it appears. This form paragraph may be modified to fit other instances of indefiniteness in the claims.

2. This form paragraph must be preceded by form paragraph 7.34.01.

<

¶ *7.34.05 Lack of Antecedent Basis in the Claims*

Claim **[1]** recites the limitation **[2]** in **[3]**. There is insufficient antecedent basis for this limitation in the claim.

Examiner Note:

1. In bracket 2, insert the limitation which lacks antecedent basis, for example --said lever-- or --the lever--.

2. In bracket 3, identify where in the claim(s) the limitation appears, for example, --line 3--, --the 3rd paragraph of the claim--, --the last 2 lines of the claim--, etc.

3. This form paragraph should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate. It must be preceded by form paragraph 7.34.01.

¶ *7.34.06 Use Claims*

Claim **[1]** provides for the use of **[2]**, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim **[3]** is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Examiner Note:

1. In bracket 2, insert what is being used. For example, insert --the monoclonal antibodies of claim 4--, where the claim recites "a method for using monoclonal antibodies of claim 4 to purify interferon."

2. See MPEP § 2173.05(q).

3. This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.07 Claims Are a Literal Translation*

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.08 Indefinite Claim Language: "For Example"*

Regarding claim **[1]**, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.09 Indefinite Claim Language: "Or The Like"*

Regarding claim **[1]**, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.10 Indefinite Claim Language: "Such As"*

Regarding claim **[1]**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.11 Modifier of "Means" Lacks Function*

Regarding claim **[1]**, the word "means" is preceded by the word(s) "**[2]**" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Examiner Note:

1. It is necessary for the words which precede "means" to convey a function to be performed. For example, the phrase "latch means" is definite because the word "latch" conveys the function "latching." In general, if the phrase can be restated as "means for _____," and it still makes sense, it is definite. In the above example, "latch means" can be restated as "means for latching." This is clearly definite. However, if "conduit means" is restated as "means for conduiting," the phrase makes no sense because

the word "conduit" has no functional connotation, and the phrase is indefinite.

2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ *7.34.12 Essential Steps Omitted*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: **[2]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. In bracket 2, recite the steps omitted from the claims.

3. Give the rationale for considering the omitted steps critical or essential.

¶ *7.34.13 Essential Elements Omitted*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: **[2]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. In bracket 2, recite the elements omitted from the claims.

3. Give the rationale for considering the omitted elements critical or essential.

¶ *7.34.14 Essential Cooperative Relationships Omitted*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: **[2]**

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. In bracket 2, recite the structural cooperative relationships of elements omitted from the claims.

3. Give the rationale for considering the omitted structural cooperative relationships of elements being critical or essential.

¶ *7.34.15 Rejection Under 35 U.S.C. 112, Pro Se*

Claim **[1]** rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

¶ *7.35 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point Out And Distinctly Claim - Omnibus Claim*

Claim **[1]** rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.

2. Use this paragraph to reject an "omnibus" type claim. No further explanation is necessary.

3. See MPEP § 1302.04(b) for cancellation of such a claim by examiner's amendment upon allowance.

4. An example of an omnibus claim is: "A device substantially as shown and described."

¶ *7.35.01 Trademark or Trade Name as a Limitation in the Claim*

Claim **[1]** contains the trademark/trade name **[2]**. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe **[3]** and, accordingly, the identification/description is indefinite.

Examiner Note:

1. In bracket 2, insert the trademark/trade name and where it is used in the claim.

2. In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.

706.03(k) Duplicate Claims

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference

in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.

Form paragraphs 7.05.05 and 7.05.06 may be used where duplicate claims are present in an application.

¶ *7.05.05 Duplicate Claims, Warning*

Applicant is advised that should claim **[1]** be found allowable, claim **[2]** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Examiner Note:

1. Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.
2. If the claims are allowable, use form paragraph 7.05.06.

¶ *7.05.06 Duplicate Claims, Objection*

Claim **[1]** objected under 37 CFR 1.75 as being a substantial duplicate of claim **[2]**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Examiner Note:

If the duplicate claims are not allowable, use form paragraph 7.05.05.

See MPEP § 804 for double patenting rejections of inventions not patentable over each other.

706.03(m) Nonelected Inventions

See MPEP § 821 to § 821.03 for treatment of claims held to be drawn to nonelected inventions.

706.03(o) New Matter [R-3]

35 U.S.C. 132. Notice of rejection; reexamination.

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

*****

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen,* 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See MPEP § 2163.06 - § 2163.07(b) for a discussion of the relationship of new matter to 35 U.S.C. 112, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c). See *In re Wertheim,* 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and MPEP § 2163.05 for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter.

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. 35 U.S.C. 132 >(a)< should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting to add new disclosure to that originally disclosed on filing.

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(l).

If new matter is added to the specification, it should be objected to by using Form Paragraph 7.28.

**>

¶ *7.28 Objection to New Matter Added to Specification*

The amendment filed **[1]** is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: **[2]**.

Applicant is required to cancel the new matter in the reply to this Office action.

Examiner Note:

1. This form paragraph is <u>not</u> to be used in reissue applications; use form paragraph 14.22.01 instead.
2. In bracket 2, identify the new matter by page and the line numbers and/or drawing figures and provide an appropriate explanation of your position. This explanation should address any state-

ment by applicant to support the position that the subject matter is described in the specification as filed. It should further include any unresolved questions which raise a doubt as to the possession of the claimed invention at the time of filing.

3. If new matter is added to the claims, or affects the claims, a rejection under 35 U.S.C. 112, first paragraph, using form paragraph 7.31.01 should also be made. If new matter is added only to a claim, an objection using this paragraph should not be made, but the claim should be rejected using form paragraph 7.31.01. As to any other appropriate prior art or 35 U.S.C. 112 rejection, the new matter must be considered as part of the claimed subject matter and cannot be ignored.

<

706.03(s) Foreign Filing Without License

35 U.S.C. 182. Abandonment of invention for unauthorized disclosure.

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner of Patents that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner of Patents. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner of Patents shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

35 U.S.C. 184. Filing of application in foreign country.

Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner of Patents pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not, required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.

35 U.S.C. 185. Patent barred for filing without license.

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.

If, upon examining an application, the examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for 6 months, and if the invention apparently was made in this country, he or she shall refer the application to Licensing and Review Section of Technology Center (TC) working group 3640, calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the TC for prosecution on the merits. When it is otherwise in condition for allowance, the application will be again submitted to Licensing and Review Section of TC work group 3640 unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under 35 U.S.C. 185, Licensing and Review Section of TC work group 3640 will request transfer of the application to it.

706.03(u) Disclaimer [R-3]

Claims may be rejected on the ground that applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant's failure to:

(A) make claims suggested for interference with another application under 37 CFR*> 41.202(c)< (See MPEP *>Chapter 2300<),

(B) copy a claim from a patent when suggested by the examiner (MPEP *>Chapter 2300<), or

(C) respond or appeal, within the time limit fixed, to the examiner's rejection of claims copied from a patent (see MPEP *>Chapter 2300<).

The rejection on disclaimer applies to all claims not patentably distinct from the disclaimed subject matter as well as to the claims directly involved.

Rejections based on disclaimer should be made by using one of Form Paragraphs 7.48 and 7.49.

**>

¶ *7.48 Failure To Present Claims for Interference*

Claim **[1]** rejected under 35 U.S.C. **[2]** based upon claim **[3]** of Patent No. **[4]**.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Examiner Note:

1. This form paragraph should be used only after applicant has been notified that interference proceedings must be instituted before the claims can be allowed and applicant has refused to copy the claims.
2. In bracket 2, insert --102(g)-- or --102(g)/103(a)--.
3. In bracket 4, insert the patent number, and --in view of _____-- if another reference is also relied upon. When the rejection is under 35 U.S.C. 103(a), the examiner's basis for a finding of obviousness should be included. Note that interferences may include obvious variants, see MPEP Chapter 2300.

¶ *7.49 Rejection, Disclaimer, Failure To Appeal*

An adverse judgment against claim **[1]** has been entered by the Board. Claim **[2]** stand(s) finally disposed of for failure to reply to or appeal from the examiner's rejection of such claim(s) presented for interference within the time for appeal or civil action specified in 37 CFR 1.304. Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently. See 37 CFR 41.127(a)(2).

<

706.03(v) After Interference or Public Use Proceeding

For rejections following an interference, see MPEP *>Chapter 2300<.

The outcome of public use proceedings may also be the basis of a rejection. See 37 CFR 1.292 and *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Upon termination of a public use proceeding including a case also involved in an interference, in order for a prompt resumption of the interference proceedings, a notice should be sent to the Board of Patent Appeals and Interferences notifying them of the disposition of the public use proceeding.

706.03(w) *Res Judicata*

Res judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of *res judicata* rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision.

The timely filing of a second application copending with an earlier application does not preclude the use of *res judicata* as a ground of rejection for the second application claims.

When making a rejection on *res judicata*, action should ordinarily be made also on the basis of prior art, especially in continuing applications. In most situations the same prior art which was relied upon in the earlier decision would again be applicable.

In the following cases a rejection of a claim on the ground of *res judicata* was sustained where it was based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

In re Freeman, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994).

Edgerton v. Kingland, 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947).

In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963).

In re Katz, 467 F.2d 939, 167 USPQ 487 (CCPA 1970) (prior decision by District Court).

In the following cases for various reasons, *res judicata* rejections were reversed.

In re Fried, 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (differences in claims).

In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963) (differences in claim).

In re Hellbaum, 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (differences in claims).

In re Herr, 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (same claims, new evidence, prior decision by CCPA).

In re Kaghan, 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner "to simplify the issue," differences in claims; holding of waiver based on language in MPEP at the time).

In re Craig, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (Board of Appeals held second set of claims patentable over prior art).

In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (difference in claims).

In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (new evidence, rejection on prior art reversed by court).

In re Ackermann, 444 F.2d 1172, 170 USPQ 340 (CCPA 1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court).

Plastic Contact Lens Co. v. Gottschalk, 484 F.2d 837, 179 USPQ 262 (D.C. Cir. 1973) (follows *In re Kaghan*).

706.03(x) Reissue [R-3]

The examination of reissue applications is covered in MPEP Chapter 1400.

35 U.S.C. 251 forbids the granting of a reissue "enlarging the scope of the claims of the original patent" unless the reissue is applied for within 2 years from the grant of the original patent. This is an absolute bar and cannot be excused. This prohibition has been interpreted to apply to any claim which is broader in any respect than the claims of the original patent. Such claims may be rejected as being barred by 35 U.S.C. 251. However, when the reissue is applied for within 2 years >or properly claims the benefit of a broadening reissue application filed within 2 years of the patent grant<, the examiner does not go into the question of undue delay.

The same section permits the filing of a reissue application by the assignee of the entire interest only in cases where it does not "enlarge the scope of the claims of the original patent." Such claims which do enlarge the scope may also be rejected as barred by the statute. In *In re Bennett*, 766 F.2d 524, 226 USPQ 413 (Fed. Cir. 1985), however, the court permitted the erroneous filing by the assignee in such a case to be corrected.

A defective reissue oath affords a ground for rejecting all the claims in the reissue application. See MPEP § 1444.

Note that a reissue application is "special" and remains so even if applicant does not make a prompt reply.

706.04 Rejection of Previously Allowed Claims [R-1]

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. >*Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).<

Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

¶ *7.50 Claims Previously Allowed, Now Rejected, New Art*

The indicated allowability of claim **[1]** is withdrawn in view of the newly discovered reference(s) to **[2]**. Rejection(s) based on the newly cited reference(s) follow.

Examiner Note:

1. In bracket 2, insert the name(s) of the newly discovered reference.
2. Any action including this form paragraph requires the signature of a Primary Examiner. MPEP § 1004.

706.05 Rejection After Allowance of Application

See MPEP § 1308.01 for a rejection based on a reference after allowance.

706.06 Rejection of Claims Copied From Patent [R-3]

See MPEP *>Chapter 2300<.

706.07 Final Rejection [R-3]

37 CFR 1.113. Final rejection or action.

**>

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.<

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; *Ex parte Hoogendam*, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments

raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

¶ *7.39 Action Is Final*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

Form paragraph 7.39.01 may be used to notify applicant of options available after final rejection.

¶ *7.39.01 Final Rejection, Options for Applicant, Pro Se*

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of $**[1]**.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Examiner Note:

The form paragraph must be preceded by any one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.42.03, or 7.42.09.

The Office Action Summary Form PTOL-326 should be used in all Office actions up to and including final rejections.

For amendments filed after final rejection, see MPEP § 714.12 and § 714.13.

For final rejection practice in reexamination proceedings see MPEP § 2271.

706.07(a) Final Rejection, When Proper on Second Action [R-3]

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § >609.04(b)<. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement

under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), unless the new ground of rejection was necessitated by an amendment to the claims or as a result of information submitted in an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

When applying any 35 U.S.C. 102(e)/103 references against the claims of an application ** the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP § 706.02(l)(3).>If a reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c) and a new subsequent double patenting rejection based upon the disqualified reference is applied, the next Office action, which contains the new double patenting rejection, may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). The Office action is properly made final because the new double patenting rejection was necessitated by amendment of the application by applicant.<

See MPEP § 809.02(a) for actions which indicate generic claims as not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

Form paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment.

¶ *7.40 Action Is Final, Necessitated by Amendment*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

**>

¶ *7.40.01 Action Is Final, Necessitated by IDS With Fee*

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on **[1]** prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant

to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.
2. In bracket 1, insert the filing date of the information disclosure statement containing the identification of the item of information used in the new ground of rejection.

<

¶ *7.40.02 Action Is Final, Necessitated by Invoking the Joint Research Agreement Prior Art Exclusion Under 35 U.S.C. 103(c)*

Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on **[1]** prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.02(l)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).
2. In bracket 1, insert the filing date of the submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c).

<

706.07(b) Final Rejection, When Proper on First Action [R-1]

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

>A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).<

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A first action final rejection should be made by using Form Paragraphs 7.41 or 7.41.03, as appropriate.

¶ *7.41 Action Is Final, First Action*

This is a **[1]** of applicant's earlier Application No. **[2]**. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. In bracket 1, insert either --continuation-- or --substitute--, as appropriate.
2. If an amendment was refused entry in the parent case on the grounds that it raised new issues or new matter, this form paragraph cannot be used. See MPEP § 706.07(b).
3. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP-1 or 2 months).
4. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

¶ *7.41.03 Action Is Final, First Action Following Submission Under 37 CFR 1.53(d), Continued Prosecution Application (CPA)*

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph is for a first action final rejection in a Continued Prosecution Application filed under 37 CFR 1.53(d).
2. This form paragraph must be preceded by one of form paragraphs 2.30 or 2.35, as appropriate.

¶ *7.42.09 Action Is Final, First Action Following Request for Continued Examination under 37 CFR 1.114*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

This form paragraph is for a first action final rejection following a Request for Continued Examination filed under 37 CFR 1.114.

706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

706.07(d) Final Rejection, Withdrawal of, Premature

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. The finality of the Office action must be withdrawn while the application is still pending. The examiner cannot vacate the final rejection once the application is abandoned.

Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

¶ *7.42 Withdrawal of Finality of Last Office Action*

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

706.07(e) Withdrawal of Final Rejection, General

See MPEP § 714.12 and § 714.13 for amendments after final rejection.

Once a final rejection that is not premature has been entered in an application/reexamination proceeding, it should not be withdrawn at the applicant's or patent owner's request except on a showing under 37 CFR 1.116(b). Further amendment or argument will be

considered in certain instances. An amendment that will place the application either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

New grounds of rejection made in an Office action reopening prosecution after the filing of an appeal brief require the approval of the supervisory patent examiner. See MPEP § 1002.02(d).

706.07(f) Time for Reply to Final Rejection [R-3]

The time for reply to a final rejection is as follows:

(A) *All* final rejections setting a 3-month shortened statutory period (SSP) for reply should contain one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.41.03, or 7.42.09 advising applicant that if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established. If the last day of "2 months of the date of the final Office action" falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, and a reply is filed on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday, pursuant to 37 CFR 1.7(a), the reply is deemed to have been filed within the 2 months period and the shortened statutory period will expire at 3 months from the date of the final rejection or on the mailing date of the advisory action, whichever is later (see MPEP §710.05). In no event can the statutory period for reply expire later than 6 months from the mailing date of the final rejection.

**>

(B) < This procedure of setting a variable reply period in the final rejection dependent on when applicant files a first reply to a final Office action does not apply to situations where a SSP less than 3 months is set, e.g., reissue litigation applications (1-month SSP) or any reexamination proceeding.

I. ADVISORY ACTIONS

*>

(C) < Where the final Office action sets a variable reply period as set forth in paragraph (A) above AND applicant files a complete first reply to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the reply:

(1) places the application in condition for allowance — then the application should be processed as an allowance and no extension fees are due;

(2) places the application in condition for allowance except for matters of form which the examiner can change without authorization from applicant, MPEP § 1302.04 — then the application should be amended as required and processed as an allowance and no extension fees are due; or

(3) does not place the application in condition for allowance — then the advisory action should inform applicant that the SSP for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking ** box >1.b)< at the top portion of the Advisory Action form, PTOL-303.

**

*>

(D) < Where the final Office action sets a variable reply period as set forth in paragraph (A) above, and applicant does NOT file a complete first reply to the final Office action within 2 months, examiners should

**>check box 1.a) at the top portion of the Advisory Action form, PTOL-303<.

**

*>

(E) < When **>box 1.b) at the top portion of the Advisory Action form, PTOL-303 is checked<, the time for applicant to take further action (including the calculation of extension fees under 37 CFR 1.136(a)) begins to run 3 months from the date of the final rejection, or from the date of the advisory action, whichever is later. Extension fees cannot be prorated for portions of a month. In no event can the statutory period for reply expire later than 6 months from the date of the final rejection. For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such case, if a petition for extension of time is granted, the due date for a reply is computed from the date stamped or printed on the Office action with the final rejection. See MPEP § 710.01(a). If the examiner, however, does not mail an advisory action until after the end of the 3-month period, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension of time fee would be calculated from the mailing date of the advisory action.

>

Advisory Action Before the Filing of an Appeal Brief	**Application No.**	**Applicant(s)**	
	Examiner	**Art Unit**	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-303 (Rev. 7-05) **Advisory Action Before the Filing of an Appeal Brief** Part of Paper No.

<

II. EXAMINER'S AMENDMENTS

*>

(F) < Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action. Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.

*>

(G) < Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner.

*>

(H) < An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g., when an examiner's amendment is necessary after the shortened statutory period for reply has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process ** fee (as opposed to information product or service fees) to a credit card. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be given before the extended period expires. The authorization must be made of record in an examiner's amendment by indicating the name of the person making the authorization, when the authorization was given, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged to the deposit account. Form Paragraph 13.02.02 should be used.

**>

¶ *13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone*

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on **[1]**, **[2]** requested an extension of time for **[3]** MONTH(S) and authorized the Director to charge Deposit Account No. **[4]** the required fee of $ **[5]** for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See MPEP § 706.07(f) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

<

III. PRACTICE AFTER FINAL

*>

(I) < Replies after final should be processed and considered promptly by all Office personnel.

*>

(J) < Replies after final should not be considered by the examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 37 CFR 1.136(a)). See also MPEP § 710.02(e). This requirement also applies to supplemental replies filed after the first reply.

*>

(K) < Interviews may be conducted after the expiration of the shortened statutory period for reply to a final Office action but within the 6-month statutory period for reply without the payment of an extension fee.

*>

(L) < Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an *Ex parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters — the correction of which had not yet been required by the examiner.

*>

(M)< If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action should be withdrawn to avoid the issue of abandonment and the payment of extension fees. For example, if a new reference comes to the attention of the examiner which renders unpatentable a claim indicated to be allowable, the Office action should begin with a statement to the effect: "The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below." Form paragraph 7.42 could be used in addition to this statement. See MPEP § 706.07(d).

706.07(g) Transitional After-Final Practice [R-3]

37 CFR 1.129. Transitional procedures for limited examination after final rejection and restriction practice.

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

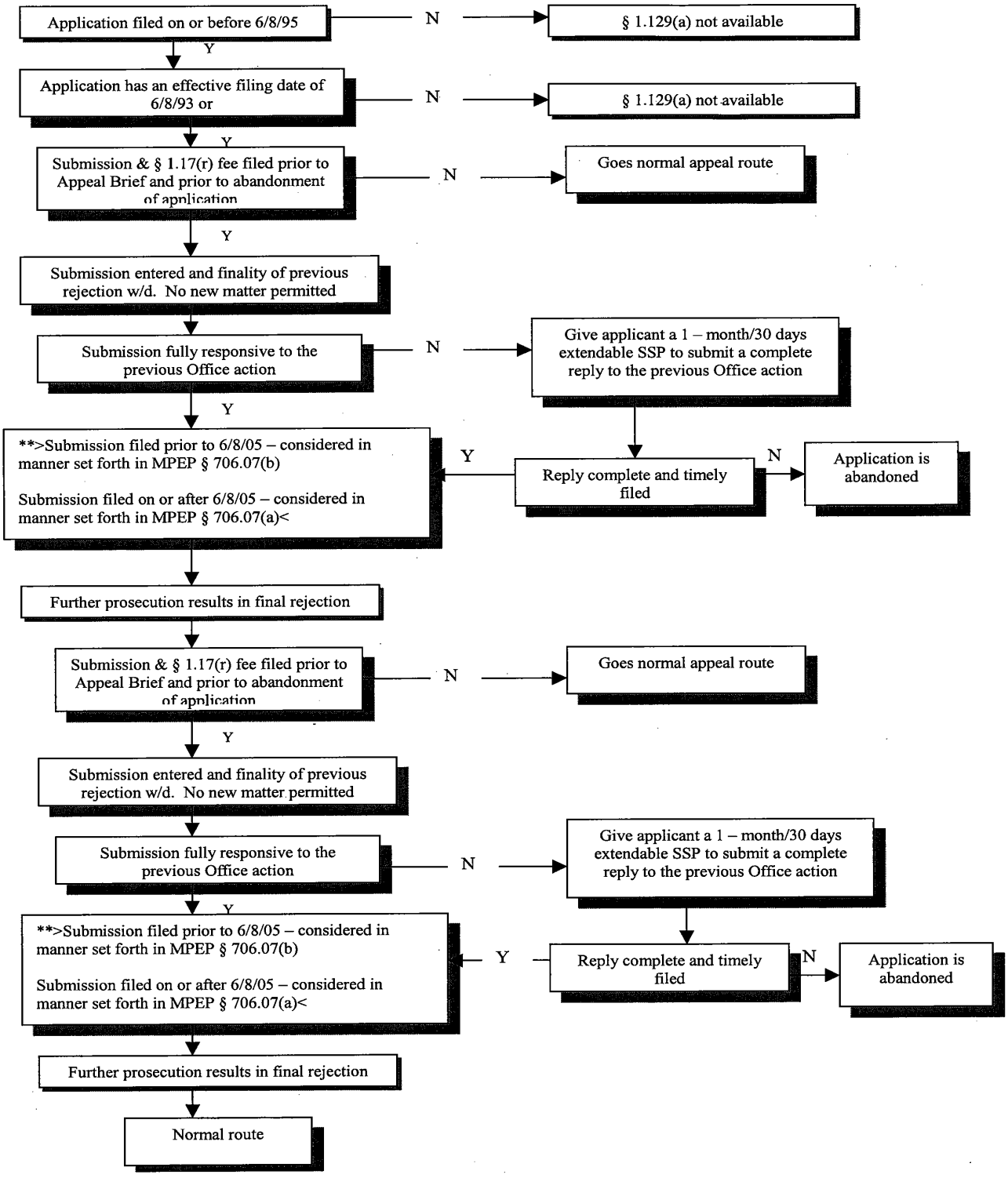
*****

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

In order to facilitate the completion of prosecution of applications pending in the USPTO as of June 8, 1995 and to ease the transition between a 17-year patent term and a 20-year patent term, Public Law 103-465 provided for the further limited reexamination of an application pending for 2 years or longer as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, or 365(c). The further limited reexamination permits applicants to present for consideration, as a matter of right upon payment of a fee, a submission after a final rejection has been issued on an application. An applicant will be able to take advantage of this provision on two separate occasions provided the submission and fee are presented prior to the filing of the Appeal Brief and prior to abandonment of the application. This will have the effect of enabling an applicant to essentially **>remove the finality of the prior Office action in< the pending application on two separate occasions by paying a fee for each occasion, and avoid the impact of refiling the application to obtain consideration of additional claims and/or information relative to the claimed subject matter. The transitional after-final practice is only available to applications filed on or before June 8, 1995 and it is not available for reissue or design applications or reexamination proceedings.

The following flowchart illustrates the transitional after-final procedures set forth in 37 CFR 1.129(a).

Transitional After-Final Provision – 37 CFR 1.129(a)
Starting June 8, 1995



Effective June 8, 1995, in any pending application having an actual or effective filing date of June 8, 1993 or earlier, applicant is entitled, under 37 CFR 1.129(a), to have a first submission after final rejection entered and considered on the merits, if the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an Appeal Brief under 37 CFR *>41.37< and prior to abandonment. For an application entering national stage under 35 U.S.C. 371 or an application filed under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 of a PCT application designating the U.S., the PCT international filing date will be used to determine whether the application has been pending for at least 2 years as of June 8, 1995.

Form paragraph 7.41.01 may be used to notify applicant that the application qualifies under 37 CFR 1.129(a).

**>

¶ *7.41.01 Transitional After Final Practice, First Submission (37 CFR 1.129(a))*

This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or 365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 41.37. Upon the timely filing of a first submission and the appropriate fee of $**[1]** for a **[2]** entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 41.20(b) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

Examiner Note:

1. This form paragraph may follow any of form paragraphs 7.39-7.41, 7.67-7.67.02, 7.72-7.78 or 7.80 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under 35 U.S.C. 120, 121 or 365(c) to a previously filed application and no previous fee has been paid under 37 CFR 1.17(r).

2. This form paragraph should NOT be used in a design or reissue application, or in a reexamination proceeding.

3. In bracket 1, insert the current fee for a large or small entity, as appropriate.

4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.

<

The submission under 37 CFR 1.129(a) may comprise, but is not limited to, an information disclosure statement >(IDS)<, an amendment to the written description, claims or drawings, a new substantive argument and/or new evidence. No amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application 35 U.S.C. 132. In view of the fee set forth in 37 CFR 1.17(r), any **>(IDS)< previously refused consideration in the application because of applicant's failure to comply with 37 CFR 1.97(c) or (d) will be treated as though it has been filed within one of the time periods set forth in 37 CFR 1.97(b) and will be considered without the petition and petition fee required in 37 CFR 1.97(d), if it complies with the requirements of 37 CFR 1.98.>Any IDS submitted under 37 CFR 1.129(a) on or after June 8, 2005 without a statement specified in 37 CFR 1.97(e) will be treated as though it had been filed within the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). The examiner may introduce a new ground of rejection based on the information submitted in the IDS and make the next Office action final provided that the examiner introduces no other new ground of rejection, which has not been necessitated by amendment to the claims. See MPEP § 706.07(a).<

If the application qualifies under 37 CFR 1.129(a), that is, it was filed on or before June 8, 1995 and the application has an effective U.S. filing date of June 8, 1993 or earlier, the examiner must check to see if the submission and 37 CFR 1.17(r) fee were filed prior to the filing of the Appeal Brief and prior to abandonment of the application. If an amendment was timely filed in reply to the final rejection but the fee set forth in 37 CFR 1.17(r) did not accompany the amendment, examiners will continue to consider these amendments in an expedited manner as set forth in MPEP § 714.13 and issue an advisory action notifying applicant whether the amendment has been entered. If the examiner indicated in an advisory action that the amendment has not been entered, applicant may then

pay the fee set forth in 37 CFR 1.17(r) and any necessary fee to avoid abandonment of the application and obtain entry and consideration of the amendment as a submission under 37 CFR 1.129(a). If the submission and the fee set forth in 37 CFR 1.17(r) were timely filed in reply to the final rejection and no advisory action has been issued prior to the payment of the fee set forth in 37 CFR 1.17(r), no advisory action will be necessary. The examiner will notify applicant that the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.129(a). It is noted that if the submission is accompanied by a "conditional" payment of the fee set forth in 37 CFR 1.17(r), i.e., an authorization to charge the fee set forth in 37 CFR 1.17(r) to a deposit account or to a credit card in the event that the submission would not otherwise be entered, the *>Office< will treat the conditional payment as an unconditional payment of the 37 CFR 1.17(r) fee.

The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in 37 CFR 1.17(r). Upon the timely payment of the fee set forth in 37 CFR 1.17(r), all previously unentered submissions, >and< submissions filed with the 37 CFR 1.17(r) fee ** will be entered >in the order in which they were filed absent specific instructions for entry<. Any conflicting amendments should be clarified for entry by the applicant upon payment of the 37 CFR 1.17(r) fee. ** Form paragraph 7.42.01 should be used to notify applicant that the finality of the previous Office action has been withdrawn.

¶ *7.42.01 Withdrawal of Finality of Last Office Action - Transitional Application Under 37 CFR 1.129(a)*

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.129(a). Applicant's **[1]** submission after final filed on **[2]** has been entered.

Examiner Note:

Insert --first-- or --second-- in bracket 1.

If a Notice of Appeal and the appeal fee set forth in 37 CFR 1.17(b) were filed prior to or with the payment of the fee set forth 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a).

Upon the timely payment of the fee set forth in 37 CFR 1.17(r), if the examiner determines that the submission is not fully responsive to the previous Office action, e.g., if the submission only includes an information disclosure statement, applicant will be given a new shortened statutory period of 1 month or 30 days, whichever is longer, to submit a complete reply. Form paragraph 7.42.02 should be used.
**>

¶ *7.42.02 Nonresponsive Submission Filed Under 37 CFR 1.129(a)*

The timely submission under 37 CFR 1.129(a) filed on **[1]** is not fully responsive to the prior Office action because **[2]**. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the appeal fee set forth in 37 CFR 41.20(b) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

Examiner Note:

The reasons why the examiner considers the submission not to be fully responsive must be set forth in bracket 2.

<
>

I. SUBMISSIONS UNDER 37 CFR 1.129(a) FILED PRIOR TO JUNE 8, 2005 <

After submission and payment of the fee set forth in 37 CFR 1.17(r), the next Office action on the merits may be made final only under the conditions for making a first action in a continuing application final set forth in MPEP § 706.07(b).

Form paragraph 7.42.03 may be used if it is appropriate to make the first action final following a submission under 37 CFR 1.129(a) >filed prior to June 8, 2005<.
**>

¶ *7.42.03 Action Is Final, First Action Following Submission Under 37 CFR 1.129(a) Filed Prior to June 8, 2005*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in

the application prior to entry under 37 CFR 1.129(a). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under 37 CFR 1.129(a). See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

Also use form paragraph 7.41.02 if this is a final rejection following a first submission under 37 CFR 1.129(a).

<

If a subsequent final rejection is made in the application, applicant would be entitled to have a second submission entered and considered on the merits under the same conditions set forth for consideration of the first submission. Form paragraph 7.41.02 should be used.

**>

¶ *7.41.02 Transitional After Final Practice, Second Submission (37 CFR 1.129(a))*

Since the fee set forth in 37 CFR 1.17(r) for a first submission subsequent to a final rejection has been previously paid, applicant, under 37 CFR 1.129(a), is entitled to have a second submission entered and considered on the merits if, prior to abandonment, the second submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 41.37. Upon the timely filing of a second submission and the appropriate fee of $**[1]** for a **[2]** entity under 37CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 41.20(b) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

Examiner Note:

1. This form paragraph is to follow any of form paragraphs 7.39-7.41 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under 35 U.S.C. 120, 121 or 365(c) to a previously filed application and a first submission fee has been previously paid under 37 CFR 1.17(r).
2. This form paragraph should NOT be used in a design or reissue application or in a reexamination proceeding.
3. In bracket 1, insert the current fee for a large or small entity, as appropriate.
4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.
5. If the fee set forth in 37 CFR 1.17(r) has been twice paid, the provisions of 37 CFR 1.129(a) are no longer available.

<

Any submission filed after a final rejection made in the application subsequent to the fee set forth in 37 CFR 1.17(r) having been twice paid will be treated in accordance with the current after-final practice set forth in 37 CFR 1.116.

>

II. SUBMISSIONS UNDER 37 CFR 1.129(a) FILED ON OR AFTER JUNE 8, 2005

For timely submission and payment of the fee set forth in 37 CFR 1.17(r) on or after June 8, 2005, the next Office action on the merits will be equivalent to the next Office action following a reply to a non-final Office action. Under existing second Office action final practice, such an Office action on the merits will be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant' s amendment of the claims nor based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

Form paragraph 7.42.031 may be used to make the next Office action final following a submission under 37 CFR 1.129(a) filed on or after June 8, 2005.

¶ *7.42.031 Action Is Final, Action Following Submission Under 37 CFR 1.129(a) Filed On or After June 8, 2005*

Under the final action practice for Office actions following a submission under 37 CFR 1.129(a) filed on or after June 8, 2005, the next Office action following timely filing of a submission under 37 CFR 1.129(a) will be equivalent to the next Office action following a reply to a non-final Office action. Under existing Office second action final practice, such an Office action on the merits will be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

In this Office action, there is no new ground of rejection that was not necessitated by applicant's amendment of the claims or based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the

fee set forth in 37 CFR 1.17(p). Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

Also use form paragraph 7.41.02 if this is a final rejection following a first submission under 37 CFR 1.129(a).

An applicant whose application is eligible for the transitional further limited examination procedure set forth in 37 CFR 1.129(a) is entitled to consideration of two after final submissions. Thus, if such an applicant has filed one submission under 37 CFR 1.129(a) and the application is again under a final rejection, the applicant is entitled to only one additional submission under 37 CFR 1.129(a). If such an applicant has filed two submissions under 37 CFR 1.129(a) and the application is again under a final rejection, applicant is not entitled to have any additional submissions considered under 37 CFR 1.129(a). Applicant may be entitled to consideration of an additional submission if the submission meets the conditions set forth in 37 CFR 1.116.<

706.07(h) Request for Continued Examination (RCE) Practice [R-3]

35 U.S.C. 132. Notice of rejection; reexamination.

*****

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

37 CFR 1.114. Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

**>

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.<

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

35 U.S.C. 132(b) provides for continued examination of an application at the request of the applicant (request for continued examination or RCE) upon payment of a fee, without requiring the applicant to file a continuing application under 37 CFR 1.53(b). To implement the RCE practice, 37 CFR 1.114 provides a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (*e.g.*, the application is under final rejection or a notice of allowance) by filing a submission and paying a specified fee. Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration

and not entered. See subsection VI. below. An RCE is not the filing of a new application. Thus, the Office will not convert an RCE to a new application such as an application filed under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d).

I. CONDITIONS FOR FILING AN RCE

The provisions of 37 CFR 1.114 apply to utility or plant applications filed under 35 U.S.C. 111(a) on or after June 8, 1995, or international applications filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE provisions of 37 CFR 1.114 do not apply to:

(A) a provisional application;

(B) an application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(C) an international application filed under 35 U.S.C. 363 before June 8, 1995;

(D) an application for a design patent; or

(E) a patent under reexamination.

See 37 CFR 1.114(e).

An applicant may obtain continued examination of an application by filing a request for continued examination (see form PTO/SB/30), a submission and the fee set forth in 37 CFR 1.17(e) prior to the earliest of:

(A) payment of the issue fee (unless a petition under 37 CFR 1.313 is granted);

(B) abandonment of the application; or

(C) the filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or the commencement of a civil action (unless the appeal or civil action is terminated).

See 37 CFR 1.114(a). An applicant cannot request continued examination of an application until after prosecution in the application is closed. See 37 CFR 1.114(a). Prosecution in an application is closed if the application is under appeal, or the last Office action is a final action (37 CFR 1.113), a notice of allowance (37 CFR 1.311), or an action that otherwise closes prosecution in the application (*e.g.*, an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935)).

II. SUBMISSION REQUIREMENT

A "submission" as used in 37 CFR 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. See 37 CFR 1.114(c). If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 CFR 1.111. See 37 CFR 1.114(c). Thus, an applicant may file a submission under 37 CFR 1.114 containing only an information disclosure statement (37 CFR 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151, but not in an application where the last Office action is a final rejection or an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or in an application that is under appeal. A request for a suspension of action, an appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR 1.103 and 1.114(d). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In addition, a previously filed amendment after final (whether or not entered) may satisfy this submission requirement.

Arguments submitted after final rejection, which were entered by the examiner but not found persuasive, may satisfy the submission requirement if such arguments are responsive within the meaning of 37 CFR 1.111 to the Office action. Consideration of whether any submission is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action is done without factoring in the "final" status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 CFR 1.113 when the application is under a final rejection may be acceptable as a reply under 37 CFR 1.111.

Status of the Application	The Submission:	For More Information
After Final	Must include a reply under 37 CFR 1.111 to the final rejection (e.g., an amendment filed with the RCE or a previously-filed after final amendment).	See subsections V. and VI.
After *Ex Parte Quayle* action	Must include a reply to the *Ex Parte Quayle* action.	See subsection IX.
After allowance	Includes, but not limited to, an IDS, amendment, new arguments, **or** new evidence.	See subsection IX.
After appeal	Must include a reply under 37 CFR 1.111 to the final rejection (e.g., a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief).	See subsections X., XI., and XII.

III. INITIAL PROCESSING

An RCE will be initially processed by the Technology Center (TC) assigned the application. Technical support personnel in the TC will verify that:

(A) the RCE was filed on or after May 29, 2000;

(B) the application was filed on or after June 8, 1995;

(C) the application is a utility or plant application (*e.g.*, not a design application);

(D) the application was pending (*i.e.*, not patented or abandoned) when the RCE was filed;

(E) prosecution in the application is closed (*e.g.*, the last Office action is a final rejection, notice of allowance, or an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or the application is under appeal);

(F) the RCE was filed before the payment of the issue fee or, if not, a petition under 37 CFR 1.313 to withdraw the application from issue was filed and granted;

(G) the RCE was accompanied by the proper fee(s) including the RCE fee under 37 CFR 1.17(e); and

(H) the RCE included a submission as required by 37 CFR 1.114.

A. Treatment of Improper RCE

If one or more conditions for filing an RCE have **not** been satisfied, applicant will be so notified. Generally, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, will be mailed to applicant. An improper RCE will **not** operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.

If an examiner discovers that an improper RCE has been forwarded to the examiner in error, the application should be immediately returned to a head supervisory legal instruments examiner (HSLIE) within the TC.

1. Prosecution Is Not Closed

If prosecution in the application is not closed, applicant will be notified of the improper RCE and any amendment/reply will be entered. Thereafter, the application will be forwarded to the examiner for consideration of the amendment/reply under 37 CFR 1.111.

2. Application Is Under Appeal

If the application is under appeal and the RCE was not accompanied by the fee set forth in 37 CFR 1.17(e) and/or a submission as required by 37 CFR 1.114, the application will be forwarded to the examiner for appropriate treatment and applicant will be notified of the improper RCE (See subsection X below).

B. Ambiguous Transmittal Paper

If an applicant files a transmittal paper that is ambiguous as to whether it is a continued prosecution application (CPA) under 37 CFR 1.53(d) or a request for continued examination (RCE) under 37 CFR 1.114 (*e.g.*, contains references to both an RCE and a CPA), and the application is a plant or utility application filed on or after June 8, 1995, the Office will treat the transmittal paper as an RCE under 37 CFR 1.114 since effective July 14, 2003, CPA practice has been eliminated as to plant and utility applications. If an applicant files a transmittal paper that is ambiguous as to whether it is a CPA or an RCE, and the application is a design application, the Office will treat the transmittal paper as a request for a CPA under 37 CFR 1.53(d) since RCE practice does not apply to design applications. Other papers filed with the transmittal paper (*e.g.*, a preliminary amendment or information disclosure statement) will not be taken into account in determining whether a transmittal paper is a CPA, or an RCE, or ambiguous as to whether it is a CPA or an RCE. If, however, applicant files an unambiguous transmittal paper that is an RCE in a design application, it will be treated as an improper RCE and a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, will be mailed to the applicant. An RCE is not a type of new application filing. Therefore, the Office cannot convert an RCE (whether proper or improper) to a new application such as a CPA under 37 CFR 1.53(d).

C. Treatment of Conditional RCE

If a submission is accompanied by a "conditional" RCE and payment of the RCE fee under 37 CFR 1.17(e) (*i.e.*, an authorization to charge the 37 CFR 1.17(e) fee to a deposit account in the event that the submission would not otherwise be entered), the Office will treat the "conditional" RCE and payment as if an RCE and payment of the fee set forth in 37 CFR 1.17(e) had been filed.

D. Treatment of Proper RCE

If the conditions for filing an RCE have been satisfied, the technical support personnel will process the proper RCE. Any previously filed unentered amendments, >and< amendments filed with the RCE ** will normally be entered. *>Such< amendments **>will be< entered in the order in which they were filed in the absence of any specific instructions for entry. For example, if applicant files an amendment after final rejection which is denied entry by the examiner and applicant subsequently files an RCE with an amendment but the RCE is silent as to whether or not the previously filed after-final amendment should be entered, then the Office will enter both amendments in the order in which they were filed. If, however, applicant files an amendment after final rejection which is denied entry by the examiner and applicant subsequently files an RCE with an amendment including specific instructions that the previously filed after-final amendment is not to be entered, then the Office will enter the amendment filed with the RCE but will not enter the after-final amendment. If conflicting amendments have been previously filed, applicant should clarify which amendments should be entered upon filing the RCE (and fee). Applicants are encouraged to file all amendments no later than the filing of the RCE to avoid disapproval of entry under 37 CFR 1.111(b). See MPEP § 714.03(a). If additional time is needed to prepare and file a supplement (*e.g.*, affidavit or declaration containing test data) to the previously filed submission, applicant should consider filing a suspension of action by the Office under 37 CFR 1.103(c) with the RCE. For more details on suspension of action, see MPEP § 709.

After entry of any amendments and processing of the fee(s), the application will be forwarded to the examiner. Applicant does not need to pay a fee for excess claims previously paid for prior to the filing of the RCE. Of course, new claims in excess of the number previously paid for, which are filed with the RCE or thereafter, will require payment of the appropriate fees(s) under 37 CFR 1.16.

IV. IMPROPER CPA TREATED AS RCE

37 CFR 1.53(d)(1) has been amended to provide that CPA practice under 37 CFR 1.53(d) does **not** apply to utility and plant applications. Effective July 14, 2003, a CPA may only be filed if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b).

In the event that an applicant files a request for a CPA (on or after July 14, 2003) of a utility or plant application that was filed on or after June 8, 1995, the Office will automatically treat the improper CPA as an RCE of the prior application (identified in the request for CPA) under 37 CFR 1.114. If the CPA does not satisfy the requirements of 37 CFR 1.114 to be a proper RCE (e.g., lacks a submission under 37 CFR 1.114(b), or is not accompanied by the fee set forth in 37 CFR 1.17(e)), the improper CPA will be treated as an improper RCE, and the time period set in the last Office action (or notice of allowance) will continue to run. If the time period (considering any available extension under 37 CFR 1.136(a)) has expired, the applicant will need to file a petition under 37 CFR 1.137 (with the lacking submission under 37 CFR 1.114(b) or fee set forth in 37 CFR 1.17(e)) to revive the abandoned application.

Effective July 14, 2003, the Office will not convert an improper CPA into an application under 37 CFR 1.53(b) simply because it is requested by the applicant. The Office will convert an improper CPA into an application under 37 CFR 1.53(b) only if the applicant shows that there are extenuating circumstances that warrant the burdensome process of converting a CPA into an application under 37 CFR 1.53(b) (e.g., restoring the application to pending status and correcting the improper RCE is not possible because the application has issued as a patent).

Form paragraph 7.42.15 should be used by the examiner to inform applicant that a CPA is being treated as a RCE.

¶ *7.42.15 Continued Prosecution Application Treated as Continued Examination under 37 CFR 1.114*

The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on [1] is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that a CPA must be for a design patent and the prior application of the CPA must be a design application that is complete as defined by 37 CFR 1.51(b). *See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, final rule, 68 *Fed. Reg.* 32376 (May 30, 2003), 1271 *Off. Gaz. Pat. Office* 143 (June 24, 2003). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114.

Examiner Note:

1. Use this form paragraph to advise the applicant that a CPA is being treated as an RCE.

2. Also use form paragraph 7.42.04, 7.42.05, 7.42.06, or 7.42.07 as applicable, to acknowledge entry of applicant's submission if the fee set forth in 37 CFR 1.17(e) has been timely paid.

3. If the fee set forth in 37 CFR 1.17(e) and/or a submission as required by 37 CFR 1.114 is/are missing and the application is not under appeal, a Notice of Improper Request for Continued Examination should be mailed. If the application is under appeal and the fee set forth in 37 CFR 1.17(e) and/or submission is/are missing, this form paragraph should be followed with one of form paragraphs 7.42.10 - 7.42.14, as applicable.

V. AFTER FINAL REJECTION

If an applicant timely files an RCE with the fee set forth in 37 CFR 1.17(e) and a submission that meets the reply requirements of 37 CFR 1.111, the Office will withdraw the finality of any Office action to which a reply is outstanding and the submission will be entered and considered. See 37 CFR 1.114(d). The submission meeting the reply requirements of 37 CFR 1.111 must be timely received to continue prosecution of an application. In other words, the mere request for, and payment of the fee for, continued examination will **not** operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application.

Any submission that is an amendment must comply with the manner of making amendments as set forth in 37 CFR 1.121. See MPEP § 714.03. The amendment must include markings showing the changes relative to the last entered amendment. Even though previously filed unentered amendments after final may satisfy the submission requirement under 37 CFR 1.114(c), applicants are encouraged to file an amendment at the time of filing the RCE that incorporates all of the desired changes, including changes presented in any previously filed unentered after final amendments, accompanied by instructions not to enter the unentered after final amendments. See subsection VI for treatment of not fully responsive submissions including noncompliant amendments.

If the RCE is proper, form paragraph 7.42.04 should be used to notify applicant that the finality of the previous Office action has been withdrawn.

¶ *7.42.04 Continued Examination under 37 CFR 1.114 after Final Rejection*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **[1]** has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR 1.17(e) and a submission, was filed after a final rejection.

2. In bracket 1, insert the date(s) of receipt of the submission. The submission may be a previously filed amendment(s) after final rejection and/or an amendment accompanying the RCE. As set forth in 37 CFR 1.114, a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If a reply to the Office action is outstanding the submission must meet the reply requirements of 37 CFR 1.111. Use instead form paragraph 7.42.08 if the submission does not comply with 37 CFR 1.111. Arguments which were previously submitted in a reply after final rejection, which were entered but not found persuasive, may be considered a submission under 37 CFR 1.114 if the arguments are responsive within the meaning of 37 CFR 1.111 to the outstanding Office action. If the last sentence of this form paragraph does not apply (e.g., the submission consists of previously entered arguments), it may be deleted or modified as necessary.

3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

VI. NOT FULLY RESPONSIVE SUBMISSION

If reply to a final Office action is outstanding and the submission is not fully responsive to the final Office action, then it must be a *bona fide* attempt to provide a complete reply to the final Office action in order for the RCE to toll the period for reply.

If the submission is not a *bona fide* attempt to provide a complete reply, the RCE should be treated as an improper RCE. Thus, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, should be prepared by the technical support personnel and mailed to the applicant indicating that the request was not accompanied by a submission complying with the requirements of 37 CFR 1.111 (see 37 CFR 1.114(c)). The RCE will not toll the period for reply and the application will be abandoned after the expiration of the statutory period for reply if no submission complying with 37 CFR 1.111 is filed. For example, if a reply to a final Office action is outstanding and the submission only includes an information disclosure statement (IDS), the submission will not be considered a *bona fide* attempt to provide a complete reply to the final Office action and the period for reply will not be tolled. Similarly, an amendment that would cancel all of the claims in an application and does not present any new or substitute claims is not a *bona fide* attempt to advance the application to final action. The Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001).

If the submission is a *bona fide* attempt to provide a complete reply, applicant should be informed that the submission is not fully responsive to the final Office action, along with the reasons why, and given a new shortened statutory period of one month or thirty days (whichever is longer) to complete the reply. See 37 CFR 1.135(c). Form paragraph 7.42.08 set forth below should be used.

Situations where a submission is not a fully responsive submission, but is a *bona fide* attempt to provide a complete reply are:

(A) Non-compliant amendment - An RCE filed with a submission which is an amendment that is not in compliance with 37 CFR 1.121, but which is a *bona fide* attempt to provide a complete reply to the last Office action, should be treated as a proper RCE and a Notice of Noncompliant Amendment should be mailed to the applicant. Applicant is given a time period of one month or thirty days from the mailing date of the notice, whichever is longer, to provide an amendment complying with 37 CFR 1.121. See MPEP § 714.03 for information on the amendment practice under 37 CFR 1.121.

(B) Presentation of claims for different invention - Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145. If an RCE is filed with an amendment canceling all claims drawn to the elected invention and presenting only claims drawn to a nonelected invention, the RCE should be treated as a proper RCE but the amendment should not be entered. The amendment is not fully responsive and applicant should be given a time

period of one month or thirty days (whichever is longer) to submit a complete reply. See MPEP § 821.03. Form paragraphs 8.04 or 8.26 should be used as appropriate.

¶ *7.42.08 Request For Continued Examination With Submission Filed Under 37 CFR 1.114 Which is Not Fully Responsive*

Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on **[1]**. The submission, however, is not fully responsive to the prior Office action because **[2]**. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period for reply supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a).

Examiner Note:

1. Use this form paragraph to acknowledge an RCE filed with the fee and a submission where the submission is not fully responsive to the prior Office action. This form paragraph may be used for any RCE filed with a submission which is not fully responsive, i.e., an RCE filed after final rejection, after allowance, after an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or after appeal.

2. In bracket 2, identify the reasons why the examiner considers the submission not to be fully responsive.

3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

VII. NEW MATTER

35 U.S.C. 132(a) provides that "[n]o amendment shall introduce new matter into the disclosure of the invention." Any amendment entered pursuant to 37 CFR 1.114 that is determined to contain new matter should be treated in the same manner that a reply under 37 CFR 1.111 determined to contain new matter is currently treated. See MPEP § 706.03(o). In those instances in which an applicant seeks to add new matter to the disclosure of an application, the procedure in 37 CFR 1.114 is not available, and the applicant must file a continuation-in-part application under 37 CFR 1.53(b) containing such new matter.

VIII. FIRST ACTION FINAL AFTER FILING AN RCE

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.

Form paragraph 7.42.09 should be used if it is appropriate to make the first action after the filing of the RCE final.

¶ *7.42.09 Action Is Final, First Action Following Request for Continued Examination under 37 CFR 1.114*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

This form paragraph is for a first action final rejection following a Request for Continued Examination filed under 37 CFR 1.114.

IX. AFTER ALLOWANCE OR QUAYLE ACTION

The phrase "withdraw the finality of any Office action" in 37 CFR 1.114(d) includes the withdrawal of the finality of a final rejection, as well as the closing of prosecution by an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or notice of allowance under 35 U.S.C. 151 (or notice of allowability). Therefore, if an applicant files an RCE with the fee set forth in 37 CFR 1.17(e) and a submission in an application which has been allowed, prosecution will be reopened. If the issue fee

has been paid, however, payment of the fee for an RCE and a submission without a petition under 37 CFR 1.313 to withdraw the application from issue will not avoid issuance of the application as a patent. If an RCE (with the fee and a submission) is filed in an allowed application prior to payment of the issue fee, a petition under 37 CFR 1.313 to withdraw the application from issue is not required.

If an RCE complying with the requirements of 37 CFR 1.114 is filed in an allowed application after the issue fee has been paid and a petition under 37 CFR 1.313 is also filed and granted, prosecution will be reopened. Applicant may **not** obtain a refund of the issue fee. If, however, the application is subsequently allowed, the Notice of Allowance will reflect an issue fee amount that is due that is the difference between the current issue fee amount and the issue fee that was previously paid.

Form paragraph 7.42.05 should be used to notify applicant that prosecution has been reopened.

¶ *7.42.05 Continued Examination Under 37 CFR 1.114 After Allowance or Quayle Action*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on **[1]** has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR 1.17(e) and a submission, was filed after a notice of allowance (or notice of allowability) or Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).

2. In bracket 1 insert the date(s) of receipt of the submission. As set forth in 37 CFR 1.114, a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability.

3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

4. If the RCE was filed after the issue fee was paid, a petition under 37 CFR 1.313 to withdraw the application from issue must have been filed and *granted*.

X. AFTER APPEAL BUT BEFORE DECISION BY THE BOARD

If an applicant files an RCE under 37 CFR 1.114 after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences (Board), but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner, regardless of whether the RCE is proper or improper. See 37 CFR 1.114(d). The Office will withdraw the appeal upon the filing of an RCE. Applicants should advise the Board when an RCE under 37 CFR 1.114 is filed in an application containing an appeal awaiting decision. Otherwise, the Board of Patent Appeals and Interferences may refuse to vacate a decision rendered after the filing (but before the recognition by the Office) of an RCE under 37 CFR 1.114.

A. Proper RCE

If the RCE is accompanied by a fee (37 CFR 1.17(e)) and a submission that includes a reply which is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action, the Office will withdraw the finality of the last Office action and the submission will be entered and considered. If the submission is not fully responsive to the last outstanding Office action but is considered to be a *bona fide* attempt to provide a complete reply, applicant will be notified that the submission is not fully responsive, along with the reasons why, and will be given a new time period to complete the reply (using form paragraph 7.42.08). See 37 CFR 1.135(c) and subsection VI.

If the RCE is proper, form paragraph 7.42.06 should be used to notify applicant that the appeal has been withdrawn and prosecution has been reopened.

¶ *7.42.06 Continued Examination Under 37 CFR 1.114 After Appeal But Before A Board Decision*

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on **[1]** has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR 1.17(e) and a submission, was filed after a Notice of Appeal or an appeal brief, but there has not been a decision on the appeal. Note that it is not necessary for an appeal brief to have been filed.

2. As set forth in 37 CFR 1.114, a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. The submission may consist of arguments in a previously filed appeal brief or reply brief, or an incorporation of such arguments in the transmittal letter or other paper accompanying the RCE.

3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

B. Improper RCE

The appeal will be withdrawn even if the RCE is improper. If an RCE is filed in an application after appeal to the Board but the request does not include the fee required by 37 CFR 1.17(e) or the submission required by 37 CFR 1.114, or both, the examiner should treat the request as an improper RCE and withdraw the appeal pursuant to 37 CFR 1.114(d). If the submission is not considered to be a *bona fide* attempt to provide a complete reply to the last outstanding Office action (e.g., an IDS only), the submission will be treated as an improper submission or no submission at all under 37 CFR 1.114(c) (thus the request is an improper RCE). See subsection VI.

Upon withdrawal of the appeal, the application will be treated in accordance with MPEP § 1215.01 based on whether there are any allowed claims or not. The proceedings as to the rejected claims are considered terminated. Therefore, if no claim is allowed, the application is abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. See MPEP § 1215.01. If there is at least one allowed claim, the application should be passed to issue on the allowed claim(s). If there is at least one allowed claim but formal matters are outstanding, applicant should be given a shortened statutory period of one month or thirty days (whichever is longer) in which to correct the formal matters. Form paragraphs 7.42.10-7.42.14 should be used as appropriate.

¶ *7.42.10 Application On Appeal, Request For Continued Examination Under 37 CFR 1.114 Without Submission/ Fee; No Claims Allowed*

A request for continued examination under 37 CFR 1.114 was filed in this application on **[1]** after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. The request, however, lacks the fee required by 37 CFR 1.17(e) and/or the submission required by 37 CFR 1.114. Since the proceedings as to the rejected claims are considered terminated, and no claim is allowed, the application is abandoned. See MPEP 1215.01.

Examiner Note:

1. If a request for continued examination was filed after a Notice of Appeal or after an appeal brief, but before a decision on the appeal, and the request lacks the fee set forth in 37 CFR 1.17(e) or a submission or both, use this form paragraph to withdraw the appeal and hold the application abandoned if there are no allowed claims.

2. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ *7.42.11 Application On Appeal, Request For Continued Examination Under 37 CFR 1.114 Without Submission; Claim Allowed*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on **[1]** after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. The request, however, lacks the submission required by 37 CFR 1.114. Since the proceedings as to the rejected claims are considered terminated, the application will be passed to issue on allowed claim**[2]** . Claim**[3]** been canceled. See MPEP § 1215.01.

Examiner Note:

1. If a request for continued examination, including the fee, was filed after a Notice of Appeal or after an appeal brief but before a decision on the appeal, and the request lacks the required submission, use this form paragraph to withdraw the appeal and pass the application to issue on the allowed claims.

2. In bracket 3, insert the claim number(s) of the claim(s) which has/have been canceled followed by either --has-- or --have--. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected and therefore are to be canceled along with the rejected claims. See MPEP § 1215.01.

3. This form paragraph should be used with the mailing of a Notice of Allowability.

4. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ *7.42.12 Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Submission; Claim Allowed with Formal Matters Outstanding*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on **[1]** after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. The request, however, lacks the submission required by 37 CFR 1.114. The proceedings as to the rejected claims are considered terminated, and the application will be passed to issue on allowed claim **[2]** provided the following formal matters are promptly corrected: **[3]**. Prosecution is otherwise closed. See MPEP § 1215.01. Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. If a request for continued examination, including the fee, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the required submission, use this form paragraph to withdraw the appeal if there are allowed claims but outstanding formal matters need to be corrected.
2. In bracket 3, explain the formal matters which must be corrected.
3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ *7.42.13 Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Fee; Claim Allowed*

A request for continued examination under 37 CFR 1.114, including a submission, was filed in this application on **[1]** after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. The request, however, lacks the fee required by 37 CFR 1.17(e). Therefore, the submission has not been entered. See 37 CFR 1.116(c). Since the proceedings as to the rejected claims are considered terminated, the application will be passed to issue on allowed claim**[2]**. Claim**[3]** been canceled. See MPEP § 1215.01.

Examiner Note:

1. If a request for continued examination, including the submission, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the required fee, use this form paragraph to withdraw the appeal and pass the application to issue on the allowed claims.
2. In bracket 3, insert the claim number(s) of the claim(s) which has/have been canceled followed by either --has-- or --have--. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected and therefore are to be canceled along with the rejected claims. See MPEP § 1215.01.
3. This form paragraph should be used with the mailing of a Notice of Allowability.
4. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ *7.42.14 Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Fee; Claim Allowed With Formal Matters Outstanding*

A request for continued examination under 37 CFR 1.114, including a submission, was filed in this application on **[1]** after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. The request, however, lacks the fee required by 37 CFR 1.17(e). Therefore, the submission has not been entered. See 37 CFR 1.116(c). The proceedings as to the rejected claims are considered terminated, and the application will be passed to issue on allowed claim**[2]** provided the following formal matters are promptly corrected: **[3]**. Prosecution is otherwise closed. See MPEP § 1215.01.Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. If a request for continued examination, including a submission, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the fee required by 37 CFR 1.17(e), use this form paragraph to withdraw the appeal if there are allowed claims but outstanding formal matters need to be corrected.
2. In bracket 3, explain the formal matters that must be corrected.
3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

XI. AFTER DECISION BY THE BOARD

A. Proper RCE After Board Decision

The filing of an RCE (accompanied by the fee and a submission) after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action in federal district court, will also result in the finality of the rejection or action being withdrawn and the submission being considered. Gen-

erally, the time period for filing a notice of appeal to the Federal Circuit or for commencing a civil action is within two months of the Board's decision. See 37 CFR 1.304 and MPEP § 1216. Thus, an RCE filed within this two month time period and before the filing of a notice of appeal to the Federal Circuit or the commencement of a civil action would be timely filed. In addition to the *res judicata* effect of a Board of Patent Appeals and Interferences decision in an application (see MPEP § 706.03(w)), a Board decision in an application is the "law of the case," and is thus controlling in that application and any subsequent, related application. See MPEP § 1214.01 (where a new ground of rejection is entered by the Board of Patent Appeals and Interferences pursuant to 37 CFR 1.196(b), argument without either amendment of the claims so rejected or the submission of a showing of facts can only result in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board of Patent Appeals and Interferences). As such, a submission containing arguments without either amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection.

Form paragraph 7.42.07 should be used to notify applicant that the appeal has been withdrawn and prosecution has been reopened.

¶ *7.42.07 Continued Examination under 37 CFR 1.114 after Board Decision but Before Further Appeal or Civil Action*

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on **[1]** has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR 1.17(e) and a submission, was timely filed after a decision by the Board of Patent Appeals and Interferences but before further appeal or civil action. Generally, the time for filing a notice of appeal to the Federal Circuit or for commencing a civil action is within two months of the Board's decision. See MPEP § 1216 and 37 CFR 1.304.

2. A Board of Patent Appeals and Interferences decision in an application has *res judicata* effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. See MPEP § 706.03(w) and 1214.01.

3. To be eligible for continued examination under 37 CFR 1.114, the application must be a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

B. Improper RCE After Board Decision

If an RCE is filed after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action in federal district court, and the RCE was **not** accompanied by the fee and/or the submission, the examiner should notify the applicant that the RCE is improper by using form paragraph 7.42.16 set forth below. If the time for seeking court review has passed without such review being sought, the examiner should include the form paragraph with the mailing of a Notice of Allowability or a Notice of Abandonment depending on the status of the claims. See MPEP § 1214.06. If the time for seeking court review remains, the examiner should include the form paragraph on a PTOL-90. No time period should be set. If a submission is filed with the RCE, but the fee is missing, the examiner should also include a statement as to whether or not the submission has been entered. In general, such a submission should not be entered. If, however, the submission is an amendment that obviously places the application in condition for allowance, it should be entered with the approval of the supervisory patent examiner. See MPEP § 1214.07. Form paragraph 7.42.16 should not be used if the application is not a utility or plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. In that situation, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, should be prepared and mailed by the technical support personnel to notify applicant that continued examination does not apply to the application. When the time for seeking court review has passed without such review being sought, the examiner must take up the applica-

tion for consideration. See MPEP § 1214.06 for guidance on the action to be taken.

¶ *7.42.16 After Board Decision But Before Further Appeal Or Civil Action, Request for Continued Examination Under 37 CFR 1.114 Without Submission and/or Fee*

A request for continued examination (RCE) under 37 CFR 1.114 was filed in this application on **[1]** after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. The request, however, lacks the fee required by 37 CFR 1.17(e) and/or the submission required by 37 CFR 1.114. Accordingly, the RCE is improper and any time period running was not tolled by the filing of the improper request.

Examiner Note:

1. This form paragraph should be used with the mailing of a Notice of Allowability or a Notice of Abandonment, as appropriate, if the time for seeking court review has passed without such review being sought, or it should be used on a PTOL-90 if time still remains.
2. This form paragraph should not be used if the application is not a utility application or a plant application filed under 35 U.S.C. 111(a) on or after June 8, 1995, or an international application filed under 35 U.S.C. 363 on or after June 8, 1995. In that situation, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, should be prepared and mailed by the technical support personnel to notify applicant that continued examination does not apply to the application.
3. In general, if a submission was filed with the improper RCE in this situation, it should not be entered. An exception exists for an amendment which obviously places the application in condition for allowance. See MPEP § 1214.07. The examiner should also include a statement as to whether or not any such submission has been entered (e.g., "The submission filed with the improper RCE has not been entered.").

XII. AFTER APPEAL TO THE FEDERAL CIRCUIT OR CIVIL ACTION

The procedure set forth in 37 CFR 1.114 is **not** available in an application after the filing of a Notice of Appeal to the Federal Circuit or the commencement of a civil action in federal district court, unless the appeal or civil action is terminated and the application is still pending. If an RCE is filed in an application that has undergone court review, the examiner should bring the application to the attention of the supervisory patent examiner or special program examiner in the TC to determine whether the RCE is proper. Unless an application contains allowed claims (or the court's mandate clearly indicates that further action is to be taken by the Office), the termination of an unsuccessful appeal or civil action results in abandonment of the application. See MPEP § 1216.01.

XIII. **FORMS

Form PTO/SB/30, "Request for Continued Examination (RCE) Transmittal," may be used by applicant for filing a RCE under 37 CFR 1.114. The form used by the Technology Centers to notify applicant of an improper RCE, "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, is shown below.

**>

PTO/SB/30 (04-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Request for Continued Examination (RCE) Transmittal

Address to:
Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. Submission required under 37 CFR 1.114 Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

   a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

      i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

      Ii. ☐ Other _____

   b. ☐ Enclosed

      I. ☐ Amendment/Reply

      ii. ☐ Affidavit(s)/ Declaration(s)

      iii. ☐ Information Disclosure Statement (IDS)

      iv. ☐ Other _____

2. Miscellaneous

   a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

   b. ☐ Other _____

3. Fees The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

   a. ☐ The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

      i. ☐ RCE fee required under 37 CFR 1.17(e)

      ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)

      iii. ☐ Other _____

   b. ☐ Check in the amount of $ _____enclosed

   c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature		Date	
Name (Print/Type)		Registration No.	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature			
Name (Print/Type)		Date	

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/30 (04-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Instruction Sheet for RCEs

(not to be submitted to the USPTO)

NOTES:

An RCE is not a new application, and filing an RCE will not result in an application being accorded a new filing date.

Filing Qualifications:

The application must be a utility or plant application filed on or after June 8, 1995. The application cannot be a provisional application, a utility or plant application filed before June 8, 1995, a design application, or a patent under reexamination. See 37 CFR 1.114(e).

Filing Requirements:

Prosecution in the application must be closed. Prosecution is closed if the application is under appeal, or the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex parte Quayle*). See 37 CFR 1.114(b).

A submission and a fee are required at the time the RCE is filed. If reply to an Office action under 35 U.S.C. 132 is outstanding (e.g., the application is under final rejection), the submission must meet the reply requirements of 37 CFR 1.111. If there is no outstanding Office action, the submission can be an information disclosure statement, an amendment, new arguments, or new evidence. See 37 CFR 1.114(c). The submission may be a previously filed amendment (e.g., an amendment after final rejection).

WARNINGS:

Request for Suspension of Action:

All RCE filing requirements must be met before suspension of action is granted. A request for a suspension of action under 37 CFR 1.103(c) does not satisfy the submission requirement and does not permit the filing of the required submission to be suspended.

Improper RCE will NOT toll Any Time Period:

Before Appeal - If the RCE is improper (e.g., prosecution in the application is not closed or the submission or fee has not been filed) and the application is not under appeal, the time period set forth in the last Office action will continue to run and the application will be abandoned after the statutory time period has expired if a reply to the Office action is not timely filed. No additional time will be given to correct the improper RCE.

Under Appeal - If the RCE is improper (e.g., the submission or the fee has not been filed) and the application is under appeal, the improper RCE is effective to withdraw the appeal. Withdrawal of the appeal results in the allowance or abandonment of the application depending on the status of the claims. If there are no allowed claims, the application is abandoned. If there is at least one allowed claim, the application will be passed to issue on the allowed claim(s). See MPEP 1215.01.

See MPEP 706.07(h) for further information on the RCE practice.

**>

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

DATE MAILED:

NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on _____ is improper for reason(s) indicated below:

☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.

☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).

☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.

☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).

☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.

☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

☐ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date **on or after June 8, 1995** will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

A copy of this Notice MUST be returned with the reply.

Direct any questions concerning this notice to

_____, Technology Center _____.

(571) _____

Form **PTO-2051** (Rev. 4/05)

<

707 Examiner's Letter or Action [R-3]

37 CFR 1.104. Nature of examination.

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) *Completeness of examiner's action*. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

**>

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(e), (f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(i) Subject matter developed by another person and a claimed invention shall be deemed to have been commonly owned by the same person or organization, or subject to an obligation of assignment to the same person or organization in any application and in any patent granted on or after December 10, 2004, if:

(A) The claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) The claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(ii) For purposes of paragraph (c)(4)(i) of this section, the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

(d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(e) *Reasons for allowance*. If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

For Office actions in reexamination proceedings, see MPEP § 2260.

Under the current first action procedure, the examiner signifies on the Office Action Summary Form PTOL-326 certain information including the period set for reply, any attachments, and a "Summary of Action," which is the position taken on all the claims.

Current procedure also allows the examiner, in the exercise of his or her professional judgment to indicate that a discussion with applicant's or patent owner's representative may result in agreements whereby the application or patent under reexamination may be placed in condition for allowance and that the examiner will telephone the representative within about 2 weeks. Under this practice the applicant's or patent owner's representative can be adequately prepared to conduct such a discussion. Any resulting amendment may be made either by the applicant's or patent owner's attorney or agent or by the examiner in an examiner's amendment. It should be recognized that when extensive amendments are necessary it would be preferable if they were filed by the attorney or agent of record, thereby reducing the professional and clerical workload in the Office and also providing the file wrapper with a better record, including applicant's arguments for allowability as required by 37 CFR 1.111.

The list of references cited appears on a separate form, Notice of References Cited, PTO-892 (copy in MPEP § 707.05) attached to applicant's copies of the action. Where applicable, Notice of Draftsperson's Patent Drawing Revision, PTO-948 and Notice of Informal Patent Application, PTO-152 are attached to the first action.

The attachments have the same paper number and are to be considered as part of the Office action.

Replies to Office actions should include the application number as well as the 4-digit art unit number and the examiner's name to expedite handling within the Office. Further, applicants are encouraged to include the 4-digit confirmation number on every paper filed in the Office. See MPEP § 503 for an explanation of the confirmation number.

In accordance with the patent statute, "Whenever, on examination, any claim for a patent is rejected, or any objection . . . made," notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included. For rejections under 35 U.S.C. 103, the way in which a reference is modified or plural references are combined should be set out.

In exceptional cases, as to satisfy the requirements under 37 CFR 1.104(c)(2), and in *pro se* cases where the inventor is unfamiliar with patent law and practice, a more complete explanation may be needed.

Objections to the disclosure, explanation of references cited but not applied, indication of allowable subject matter, requirements (including requirements for restriction if applicable) and any other pertinent comments may be included. Office Action Summary form PTOL-326, which serves as the first page of the Office action (although a Form PTOL-90 may be used as a coversheet for the correspondence address and the mail date of the Office action), is to be used with all first actions and will identify any allowed claims.

One of form paragraphs 7.100, 7.101, or 7.102 should conclude all actions.

¶ *7.100 Name And Number of Examiner To Be Contacted*

Any inquiry concerning this communication should be directed to **[1]** at telephone number **[2]**.

Examiner Note:

1. This form paragraph, form paragraph 7.101, or form paragraph 7.102 should be used at the conclusion of all actions.

2. In bracket 1, insert the name of the examiner designated to be contacted first regarding inquiries about the Office action. This could be either the non-signatory examiner preparing the action or the signatory examiner.
3. In bracket 2, insert the individual area code and phone number of the examiner to be contacted.

**>

¶ *7.101 Telephone Inquiry Contacts- Non 5/4/9 Schedule*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **[1]** whose telephone number is **[2]**. The examiner can normally be reached on **[3]** from **[4]** to **[5]**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **[6]**, can be reached on **[7]**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off every Friday.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 5:00 PM."
5. In bracket 6, insert your SPE's name.
6. In bracket 7, insert your SPE's area code and phone number.

¶ *7.102 Telephone Inquiry Contacts- 5/4/9 Schedule*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **[1]** whose telephone number is **[2]**. The examiner can normally be reached on **[3]** from **[4]** to **[5]**. The examiner can also be reached on alternate **[6]**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **[7]**, can be reached on **[8]**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off on alternate Fridays.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 4:00 PM."
5. In bracket 6, insert the day in each pay-period that is your compressed day off, e.g. "Fridays" for an examiner on a 5/4/9 work schedule with the first Friday off.
6. In bracket 7, insert your SPE's name.
7. In bracket 8, insert your SPE's area code and phone number.

<

Where the text of sections of Title 35, U.S. Code was previously reproduced in an Office action, form paragraph 7.103 may be used.

¶ *7.103 Statute Cited in Prior Action*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**>

Office Action Summary	**Application No.**	**Applicant(s)**	
	Examiner	**Art Unit**	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 7-05) **Office Action Summary** Part of Paper No./Mail Date

<

707.01 Primary Examiner Indicates Action for New Assistant [R-2]

After the search has been completed, action is taken in the light of the references found. Where the assistant examiner has been in the Office but a short time, it is the duty of the primary examiner to review the application thoroughly. The usual procedure is for the assistant examiner to explain the invention and discuss the references which he or she regards as most pertinent. The primary examiner may indicate the action to be taken, whether restriction or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, the >primary< examiner may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

707.02 Applications Up for Third Action and 5-Year Applications [R-2]

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent *>Office< action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort >should be< made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

707.05 Citation of References [R-3]

37 CFR 1.104. Nature of examination.

*****

(d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

*****

During the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained.

The examiner must consider all the prior art references (alone and in combination) cited in the application or reexamination, including those cited by the applicant in a properly submitted Information Disclosure Statement. See MPEP § 609.

Form paragraph 7.96 may be used as an introductory sentence.

¶ *7.96 Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **[1]**

Examiner Note:

When such prior art is cited, its relevance should be explained in bracket 1 in accordance with MPEP § 707.05.

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121 or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification to delete any references to prior applications. Therefore, examiners should search all applications based on the actual U.S. filing date of the application rather

than on the filing date of any parent U.S. application for which priority is claimed. Examiners should cite of interest all material prior art having an effective filing date after the filing date of the U.S. parent application but before the actual filing date of the application being examined.

Allowed applications should generally contain a citation of pertinent prior art for printing in the patent, even if no claim presented during the prosecution was considered unpatentable over such prior art. Only in those instances where a proper search has not revealed any prior art relevant to the claimed invention is it appropriate to send an application to issue with no art cited. In the case where no prior art is cited, the examiner must write "None" on a form PTO-892 and insert it in the file wrapper. For Image File Wrapper (IFW) processing, see IFW Manual section 3.7. Where references have been cited during the prosecution of parent applications and a continuing application, having no newly cited references, is ready for allowance, the cited references of the parent applications should be listed on a form PTO-892. The form should then be placed in the file of the continuing application. For Image File Wrapper (IFW) processing, see IFW Manual section 3.7. See MPEP § 1302.12. In a continued prosecution application filed under 37 CFR 1.53(d), it is not necessary to prepare a new form PTO-892 since the form from the parent application is in the same file wrapper and will be used by the printer.

In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art.

Applicants and/or applicants' *>attorneys< in PCT related national applications may wish to cite the material citations from the PCT International Search Report by an information disclosure statement under 37 CFR 1.97 and 1.98 in order to ensure consideration by the examiner.

In those instances where no information disclosure statement has been filed by the applicant and where documents are cited in the International Search Report but neither a copy of the documents nor an English translation (or English family member) is provided, the examiner may exercise discretion in deciding whether to take necessary steps to obtain the copy and/or translation.

Copies of documents cited will be provided as set forth in MPEP § 707.05(a). That is, copies of documents cited by the examiner will be provided to applicant *except* where the documents:

(A) are cited by applicant in accordance with MPEP § 609, § 707.05(b), and § 708.02;

(B) have been referred to in applicant's disclosure statement;

(C) are cited and have been provided in a parent application;

(D) are cited by a third party in a submission under 37 CFR 1.99 (MPEP § 1134.01); or

(E) are U.S. Patents or U.S. application publications **.

See MPEP § 707.05(e) regarding data used in citing references.

707.05(a) Copies of Cited References [R-3]

Copies of cited >foreign patent documents and nonpatent literature< references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the examiner during the prosecution.>Copies of U.S. patents and U.S. patent application publications are not provided in paper to applicants and are not placed in the application file.<

Copies of references cited by applicant in accordance with MPEP § 609, § 707.05(b) and § 708.02 are *not* furnished to applicant with the Office action. Additionally, copies of references cited in continuation applications if they had been previously cited in the parent application are not furnished. The examiner should check the left hand column of form PTO-892 if a copy of the reference is not to be furnished to the applicant.

Copies of foreign patent documents and nonpatent literature (NPL) which are cited by the examiner at the time of allowance will be furnished to applicant with the Office action, and copies of the same will also be retained in the file. For Image File Wrapper (IFW) processing, see IFW Manual section 3.7. This will apply to all allowance actions, including first action allowances and *Ex Parte Quayle* actions.

In the rare instance where no art is cited in a continuing application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent.

To assist in providing copies of >, or access to,< references, the examiner should:

(A) *>Type< the citation of the references on form PTO-892, "Notice of References Cited" >using OACS<;

(B) Place the form PTO-892 in the front of the file wrapper;

(C) Include in the application file wrapper all of the references cited by the examiner which are to be furnished to the applicant ** (for Image File Wrapper (IFW) processing, see IFW Manual);

*>

(D) < Turn the application in to the technical support staff for counting. Any application which is handed in without all of the required references will be returned to the examiner. The missing reference(s) should be obtained and the file returned to the technical support staff as quickly as possible. For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.

In the case of design applications, procedures are the same as set forth in MPEP § 707.05 (a)-(g) **.
>

¶ *7.82.03 How To Obtain Copies of U.S. Patents and U.S. Patent Application Publications*

In June 2004, the USPTO ceased mailing paper copies of cited U.S. patents and U.S. patent application publications with all Office actions. See "USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies," 1282 O.G. 109 (May 18, 2004). Foreign patent documents and non-patent literature will continue to be provided to the applicant on paper.

All U.S. patents and U.S. patent application publications are available free of charge from the USPTO web site (www.uspto.gov/patft/index.html), for a fee from the Office of Public Records (http://ebiz1.uspto.gov/oems25p/index.html), and from commercial sources. Copies are also available at the Patent and Trademark Depository Libraries (PTDLs). A list of the PTDLs may be found on the USPTO web site (www.uspto.gov/web/offices/ac/ido/ptdl/ptdlib_1.html). Additionally, a simple new feature in the Office's Private Patent Application Information Retrieval system (PAIR), E-Patent Reference, is available for downloading and printing of U.S. patents and U.S. patent application publications cited in U.S. Office Actions.

STEPS TO USE THE E-PATENT REFERENCE FEATURE

Access to Private PAIR is required to utilize E-Patent Reference. If you do not already have access to Private PAIR, the Office urges practitioners and applicants not represented by a practitioner to: (1) obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate; (2) obtain a USPTO customer number; (3) associate all of their pending and new application filings with their customer number; (4) install free software (supplied by the Office) required to access Private PAIR and the E-Patent Reference; and (5) make appropriate arrangements for Internet access.

Instructions for performing the 5 steps:

Step 1: Full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page (www.uspto.gov/ebc/downloads.html). Note that a notarized signature will be required to obtain a digital certificate.

Step 2: To get a Customer Number, download and complete the Customer Number Request form, PTO-SB/125, from the USPTO web site (www.uspto.gov/web/forms/sb0125.pdf). The completed form can be transmitted by facsimile to the Patent Electronic Business Center at (571) 273-0177, or mailed to the address on the form. If you are a registered attorney or agent, your registration number must be associated with your customer number. This association is accomplished by adding your registration number to the Customer Number Request form.

Step 3: A description of associating a customer number with the correspondence address of an application is described at the EBC Web page (www.uspto.gov/ebc/registration_pair. html).

Step 4: The software for electronic filing is available for downloading at www.uspto.gov/ebc. Users can also contact the EFS Help Desk at (571) 272-4100 and request a copy of the software on compact disc. Users will also need Adobe Acrobat Reader, which is available through a link from the USPTO web site.

Step 5: Internet access will be required which applicants may obtain through a supplier of their own choice. As images of large documents must be downloaded, high-speed Internet access is recommended.

The E-Patent Reference feature is accessed using a button on the Private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents in Portable Document Format (PDF). The downloaded documents can be viewed and printed using commercially available software, such as ADOBE® READER®. ADOBE® READER® is available free of charge from Adobe Systems Incorporated (www.adobe.com/products/acrobat/readermain.html).

Examiner Note:

This form paragraph is recommended for use in Office actions citing U.S. patents or U.S. patent application publications when the applicant is not represented by a registered patent attorney or a registered patent agent.

<

Notice of References Cited	Application/Control No.	Applicant(s)/Patent Under Reexamination	
	Examiner	Art Unit	Page of

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification	
	A	US-				
	B	US-				
	C	US-				
	D	US-				
	E	US-				
	F	US-				
	G	US-				
	H	US-				
	I	US-				
	J	US-				
	K	US-				
	L	US-				
	M	US-				

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification	
	N						
	O						
	P						
	Q						
	R						
	S						
	T						

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-892 (Rev. 01-2001) **Notice of References Cited** Part of Paper No.

707.05(b) Citation of Related Art and Information by Applicants [R-2]

>

I. < CITATION OF RELATED ART BY APPLICANTS

MPEP § 609 sets forth guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the U.S. Patent and Trademark Office.

Submitted citations will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing >other< pertinent prior art of which they may be aware**.

Prior art submitted by applicant in the manner provided in MPEP § 609 will not be supplied with an Office action.

>

II. < CITATION OF RELATED INFORMATION BY APPLICANTS

37 CFR 1.105 and MPEP § 704.10 *et seq*. set forth procedures for examiners to require applicants, their attorneys and agents to submit information reasonably necessary for the Office to examine an application or treat a matter being addressed in an application.

Any such requirement, and any information submitted in reply thereto, will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing >other< pertinent prior art of which they may be aware**.

Information submitted by applicant in the manner provided in MPEP § 704.10 *et seq*. will not be supplied with an Office action.

707.05(c) Order of Listing

In citing references for the first time, the identifying data of the citation should be placed on form PTO-892 "Notice of References Cited," a copy of which will be attached to the Office action. No distinction is to be made between references on which a claim is rejected and those formerly referred to as "pertinent." With the exception of applicant submitted citations, MPEP § 609 and § 708.02, it is recommended that the pertinent features of references which are not used as a basis for rejection be pointed out briefly.

See MPEP § 1302.12.

707.05(d) Reference Cited in Subsequent Actions [R-2]

Where an applicant in an amendatory paper refers to a reference that is subsequently relied upon by the examiner, such reference shall be cited by the examiner in the usual manner using a form PTO-892, "Notice of References Cited," unless applicant has listed the reference on a >form< PTO-1449 or *>PTO/SB/08< that has been initialed by the examiner.

707.05(e) Data Used in Citing References [R-2]

37 CFR 1.104(d) (see also MPEP § 707.05 and § 901.05(a)) requires the examiner to provide certain data when citing references. The examiner should provide the citations on the "Notice of References Cited" form PTO-892 (copy at MPEP § 707.05).

>

I. < U.S. PATENT DOCUMENTS

If a U.S. patent application publication is cited by the examiner, the publication number, publication date, name of the applicant, class, and subclass should be cited under the section "U.S. Patent Documents" on the form PTO-892. For U.S. patents, the patent number, patent date, name of the patentee, class and subclass should also be cited under the same section. In addition, examiners are encouraged to cite the kind codes printed on U.S. patent application publications and patents. See MPEP § 901.04(a) for an explanation of the kind codes. See MPEP § 901.04 for details concerning the various series of U.S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U.S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

Defensive Publications and Statutory Invention Registrations (SIRs) should be cited under the section "U.S. Patent Documents" on the form PTO-892 (see MPEP § 711.06(a) and § 901.06(a)).

>

II. < FOREIGN PATENTS AND FOREIGN PUBLISHED APPLICATIONS

In citing foreign patents, the patent number, kind code, citation date, name of the country, name of the patentee, and U.S. class and subclass, if appropriate, must be given. Foreign patents searched in those Technology Centers (TCs) filing by International Patent Classification (IPC) will be cited using the appropriate IPC subclass/group/subgroup. On the file wrapper "Searched" box and PTO-892, the IPC subclass/group/subgroup shall be cited in the spaces provided for "Classification." >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.<

Where less than the entire disclosure of the reference is relied upon, the sheet and page numbers specifically relied upon and the total number of sheets of drawing and pages of specification must be included (except applicant submitted citations). If the entire disclosure is relied on, the total number of sheets and pages are not required to be included on the PTO-892.

Publications such as German allowed applications and Belgian and Netherlands printed specifications should be similarly handled.

See MPEP § 901.05(a) for a chart in which foreign language terms indicative of foreign patent and publication dates to be cited are listed.

>

III. < PUBLICATIONS

Abstracts, abbreviatures, Alien Property Custodian publications, withdrawn U.S. patents, withdrawn U.S. patent application publications, and other non-patent documents should be cited under the section "Non-Patent Documents" on the form PTO-892). See MPEP § 711.06(a) for citation of abstracts, and abbreviatures. See MPEP § 901.06(c) for citation of Alien Property Custodian publications. In citing a publication, sufficient information should be given to determine the identity and facilitate the location of the publication. For books, the data required by 37 CFR 1.104(d) (MPEP § 707.05) with the specific pages relied on identified together with the Scientific and Technical Information Center (STIC) call number will suffice. The call number appears on the "spine" of the book if the book is thick enough and, in any event, on the back of the title page. Books on interlibrary loan will be marked with the call numbers of the other library, of course. THIS NUMBER SHOULD NOT BE CITED. The same convention should be followed in citing articles from periodicals. The call number should be cited for periodicals owned by the STIC, but not for periodicals borrowed from other libraries. In citing periodicals, information sufficient to identify the article includes the author(s) and title of the article and the title, volume number issue number, date, and pages of the periodical. If the copy relied on is located only in the Technology Center making the action (there may be no call number), the additional information, "Copy in Technology Center — —" should be given.

The following are examples of nonpatent bibliographical citations:

(A) *For books*:
Winslow. C. E. A. *Fresh Air and Ventilation*. N.Y., E. P. Dutton, 1926. p. 97-112. TI17653.W5.

(B) *For parts of books*:
Smith, J. F. "Patent Searching." in: Singer, T.E.R., *Information and Communication Practice in Industry* (New York, Reinhold, 1958), pp. 157-165. T 175.S5.

(C) *For encyclopedia articles*:
Calvert, R. "Patents (Patent Law)." in: *Encyclopedia of Chemical Technology* (1952 ed.), vol. 9, pp. 868-890. Ref. TP9.E68.

(D) *For sections of handbooks*:
Machinery's Handbook, 16th ed. New York, International Press, 1959. pp. 1526-1527. TJ151.M3 1959.

(E) *For periodical articles*:
Noyes, W. A. *A Climate for Basic Chemical Research*
Chemical & Engineering News, Vol. 38, no. 42 (Oct. 17, 1960), pp. 91-95. TP1.I418.

The following are examples of how withdrawn U.S. patents and withdrawn U.S. patent application publications should be cited:

(A) *Withdrawn U.S. patents*:
US 6,999,999, 10/2002, Brown et al., 403/155 (withdrawn).

(B) *Withdrawn U.S. patents application publications*:
US 2002/0009999 A1, 7/2002, Jones et al., 403/155 (withdrawn).

Titles of books and periodicals SHOULD NOT be abbreviated because an abbreviation such as P.S.E.B.M. will not be sufficient to identify the publication. References are to be cited so that anyone reading a patent may identify and retrieve the publications cited. Bibliographic information provided must be at least enough to identify the publication. author, title and date. For books, minimal information includes the author, title, and date. For periodicals, at least the title of the periodical, the volume number, date, and pages should be given. These minimal citations may be made ONLY IF the complete bibliographic details are unknown or unavailable.

Where a nonpatent literature reference with a document identification number is cited, the identification number and the class and subclass should be included on form PTO-892. For example, the citation should be as follows: (S00840001) Winslow, C.E.A. Fresh Air and Ventilation N.Y., E.P. Dutton, 1926, p. 97-112, TH 7653, W5, 315/22.

If the original publication is located outside the Office, the examiner should immediately make or order a photocopy of at least the portion relied upon and indicate the class and subclass in which it will be filed, if any.

>

IV. < ELECTRONIC DOCUMENTS

An electronic document is one that can be retrieved from an online source (e.g., the Internet, online database, etc.) or sources found on electronic storage media (e.g., CD-ROM, magnetic disk or tape, etc.). Many references in paper format may also be retrieved as electronic documents. Other references are retrievable only from electronic sources.

The U.S. Patent and Trademark Office follows the format recommended by World Intellectual Property Organization (WIPO) Standard ST.14, "Recommendation for the Inclusion of References Cited in Patent Documents." The format for the citation of an electronic document is as similar as possible to the format used for paper documents of the same type, but with the addition of the following information in the locations indicated, where appropriate:

(A) the type of electronic medium provided in square brackets [ ] after the title of the publication or the designation of the host document, e.g., [online], [CD-ROM], [disk], [magnetic tape];

(B) the date when the document was retrieved from the electronic media in square brackets following after the date of publication, e.g., [retrieved on March 4, 1998], [retrieved on 1998-03-04]. The four-digit year must always be given.

(C) identification of the source of the document using the words "Retrieved from" and its address where applicable. This item will precede the citation of the relevant passages.

(D) specific passages of the text could be indicated if the format of the document includes pagination or an equivalent internal referencing system, or by the first and last words of the passage cited.

Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

If an electronic document is also available in paper form it does not need to be identified as an electronic document, unless it is considered desirable or useful to do so.

Examples 1-4: Documents retrieved from online databases outside the Internet

Example 1:
SU 1511467 A (BRYAN MECH) 1989-09-30 (abstract) World Patents Index [online]. London, U.K.: Derwent Publications, Ltd. [retrieved on 1998-02-24]. Retrieved from: Questel/Orbit, Paris, France. DW9016, Accession No. 90-121923.

Example 2:
DONG, X. R. 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements', Chung Hua Wai Ko Tsa Chih, May 1993, Vol. 31, No. 5, pages 301-302. (abstract) Medline [online]. Bethesda, MD, USA: United States National Library of Medicine [retrieved on 24 February 1998]. Retrieved from: Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession No. 07736604.

Example 3:
JENSEN, B. P. 'Multilayer printed circuits: production and application II'. Electronik, June-July

1976, No. 6-7, pages 8, 10,12,14,16. (abstract) INSPEC [online]. London, U.K.: Institute of Electrical Engineers [retrieved on 1998-02-24]. Retrieved from: STN International, Columbus, Ohio, USA. Accession No. 76:956632.

Example 4:

JP 3002404 (TAMURA TORU) 1991-03-13 (abstract). [online] [retrieved on 1998-09-02]. Retrieved from: EPO PAJ Database.

Examples 5-11: Documents retrieved from the Internet

Example 5:

(Entire Work – Book or Report)

WALLACE, S., and BAGHERZADEH, N. Multiple Branch and Block Prediction. Third International Symposium on High-Performance Computer Architecture [online], February 1997 [retrieved on 1998-05-20]. Retrieved from the Internet:< URL: http://www.eng.uci.edu/comp.arch/papers-wallace/hpca3-block.ps>.

Example 6:

(Part of Work – chapter or equivalent designation)

National Research Council, Board on Agriculture, Committee on Animal Nutrition, Subcommittee on Beef Cattle Nutrition. Nutrient Requirements of Beef Cattle [online]. 7th revised edition. Washington, DC: National Academy Press, 1996 [retrieved on 1998-06-10]. Retrieved from the Internet:< URL: http://www2.nap.edu/htbin/docpage/title=Nutrient+Requirements+of+Beef+Cattle%3A+Sev-
enth+Revised+Edtion%2C+1996&dload=0&path=/ext5/extra&name=054265%2Erdo&docid=00805F50FE7b%3A840052612&colid=4%7C6%7C41&start=38> Chapter 3, page 24, table 3-1.

Example 7:

(Electronic Serial – articles or other contributions)

Ajtai. Generating Hard Instances of Lattice Problems. Electronic Colloquium on Computational Complexity, Report TR96-007 [online], [retrieved on 1996-01-30]. Retrieved from the Internet <URL: ftp://ftp.eccc.uni-trier.de/pub/eccc/reports/1996/TR96-007/index.html>

Example 8:

(Electronic bulletin boards, message systems, and discussion lists – Entire System)

BIOMET-L (A forum for the Bureau of Biometrics of New York) [online]. Albany (NY): Bureau of Biometrics, New York State Health Department, July, 1990 [retrieved 1998-02-24]. Retrieved from the Internet: <listserv@health.state.ny.us>, message: subscribe BIOMET-L your real name.

Example 9:

(Electronic bulletin boards, message systems, and discussion lists – Contributions)

PARKER, Elliott. 'Re: citing electronic journals'. In PACS-L (Public Access Computer Systems Forum) [online]. Houston (TX): University of Houston Libraries, November 24, 1989; 13:29:35 CST [retrieved on 1998-02-24]. Retrieved from the Internet: <URL:telnet://bruser@a.cni.org>.

Example 10:

(Electronic mail)

'Plumb design of a visual thesaurus'. The Scout Report [online]. 1998, vol. 5 no. 3 [retrieved on 1998-05-18]. Retrieved from Internet electronic mail: <listserv@cs.wisc.edu>, subscribe message: info scout-report. ISSN: 1092-3861\cf15.

Example 11:

Corebuilder 3500 Layer 3 High-function Switch. Datasheet [online]. 3Com Corporation, 1997 [retrieved on 1998-02-24]. Retrieved from the Internet: <URL: www.3com.com/products/dsheets/400347.html>.

(Product Manual/Catalogue or other information obtained from a Web-site)

Example 12:

HU D9900111 Industrial Design Application, (HADJDUTEJ TEJIPARI RT, DEBRECEN) 1999-09-28, [online], [retrieved on 1999-10-26] Retrieved from the Industrial Design Database of the Hungarian Patent Office using Internet <URL: http:/www.hpo.hu/English/db/indigo/>.

Examples 13 and 14: Documents retrieved from CD-ROM products

Examples 13 and 14:

JP 0800085 A (TORAY IND INC), (abstract), 1996-05-31. In: Patent Abstracts of Japan [CD-ROM].

Examples 14:

HAYASHIDA, O. et. al.: Specific molecular recognition by chiral cage-type cyclophanes having leucine, valine, and alanine residues. In: Tetrahedron 1955, Vol. 51 (31), p. 8423-36. In: CA on CD [CD-ROM]. Columbus, OH: CAS.\f5Abstract 124:9350.

707.05(f) Effective Dates of Declassified Printed Matter

In using declassified material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. See *Ex parte Harris*, 79 USPQ 439 (Comm'r Pat. 1948). If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Department of Commerce.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit or declaration under 37 CFR 1.131.

707.05(g) Incorrect Citation of References [R-3]

Where an error in citation of a reference is brought to the attention of the Office by applicant, a letter correcting the error, together with a correct copy of the reference, is sent to applicant. See MPEP § 710.06. Where the error is discovered by the examiner, applicant is also notified and the period for reply restarted. In either case, the examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his or her initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given. See MPEP § 710.06. For Image File Wrapper (IFW) processing, see IFW Manual.

Form paragraphs 7.81-7.83 may be used to correct citations or copies of references cited.

¶ *7.81 Correction Letter Re Last Office Action*

In response to applicant's **[1]** regarding the last Office action, the following corrective action is taken.

The period for reply of **[2]** MONTHS set in said Office action is restarted to begin with the mailing date of this letter.

Examiner Note:

1. In bracket 1, insert --telephone inquiry of _____-- or --communication dated _____--.
2. In bracket 2, insert new period for reply.
3. This form paragraph must be followed by one or more of form paragraphs 7.82, 7.82.01 or 7.83.
4. Before restarting the period, the SPE should be consulted.

¶ *7.82 Correction of Reference Citation*

The reference **[1]** was not correctly cited in the last Office action. The correct citation is shown on the attached PTO-892.

Examiner Note:

1. Every correction MUST be reflected on a corrected or new PTO-892.
2. This form paragraph must follow form paragraph 7.81.
3. If a copy of the PTO-892 is being provided without correction, use form paragraph 7.83 instead of this form paragraph.
4. Also use form paragraph 7.82.01 if reference copies are being supplied.

**>

¶ *7.82.01 Copy of Reference(s) Furnished*

Copies of the following references not previously supplied are enclosed:

Examiner Note:

1. The USPTO ceased mailing paper copies of U.S. patents and U.S. application publications cited in Office Actions in nonprovisional applications beginning in June 2004. See the phase-in schedule of the E-Patent Reference program provided in "USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies," 1282 O.G. 109 (May 18, 2004). Therefore, this form paragraph should only be used for foreign patent documents, non-patent literature, pend-

ing applications that are not stored in the image file wrapper (IFW) system, and other information not previously supplied.

2. The reference copies being supplied must be listed following this form paragraph.

3. This form paragraph must be preceded by form paragraph 7.81 and may also be used with form paragraphs 7.82 or 7.83.

<
**

¶ *7.83 Copy of Office Action Supplied*

[1] of the last Office action is enclosed.

Examiner Note:

1. In bracket 1, explain what is enclosed. For example:

a. "A corrected copy"

b. "A complete copy"

c. A specific page or pages, e.g., "Pages 3-5"

d. "A Notice of References Cited, Form PTO-892"

2. This form paragraph should follow form paragraph 7.81 and may follow form paragraphs 7.82 and 7.82.01.

In any application otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by examiner's amendment accompanying the Notice of Allowability form PTOL-37.

If a FOREIGN patent is incorrectly cited: for example, the wrong country is indicated or the country omitted from the citation, the General Reference Branch of the Scientific and Technical Library may be helpful. The date and number of the patent are often sufficient to determine the correct country which granted the patent.

707.06 Citation of Decisions, Orders Memorandums, and Notices [R-2]

In citing court decisions, the USPQ citation should be given and, when it is convenient to do so, the U.S., CCPA or Federal Reporter citation should also be provided.

The citation of manuscript decisions which are not available to the public should be avoided.

It is important to recognize that a federal district court decision that has been reversed on appeal cannot be cited as authority.

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Patent Appeals and Interferences which has not been published but which is available to the public in the patented file should be cited, as " *Ex parte* — — , decision of the Board of Patent Appeals and Interferences, Patent No. — — — , paper No. — — , — — — pages."

Decisions found only in patented files should be cited only when there is no published decision on the same point.

When a *>Director's< order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such as a specific issue of the *Journal of the Patent and Trademark Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

707.07 Completeness and Clarity of Examiner's Action

37 CFR 1.104. Nature of examination.

*****

(b) *Completeness of examiner's action*. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

*****

707.07(a) Complete Action on Formal Matters [R-3]

Forms are placed in informal applications listing informalities noted by the Draftsperson (form PTO-948) and the Office of Initial Patent Examination (form PTO-152). Each of these forms comprises an original for the file record and a copy to be mailed to applicant as a part of the examiner's first action. For Image File Wrapper (IFW) processing, see IFW Manual. They are specifically referred to as attachments to the action and are marked with its paper number. In every instance where these forms are to be used, they should be mailed with the examiner's *first* action, and any additional formal requirements which the examiner desires to make should be included in the *first* action.

When any formal requirement is made in an examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to 37 CFR 1.111(b) and state that a complete reply must either comply with all formal requirements or specifically traverse each requirement not complied with.

**>

¶ *7.43.03 Allowable Subject Matter, Formal Requirements Outstanding*

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Examiner Note:

This form paragraph would be appropriate when changes (for example, drawing corrections or corrections to the specification) must be made prior to allowance.

<

707.07(b) Requiring New Oath

See MPEP § 602.02.

707.07(c) Draftsperson's Requirement

See MPEP § 707.07(a); also MPEP § 608.02(a), (e), and (s).

707.07(d) Language To Be Used in Rejecting Claims

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as broader than the enabling disclosure, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

See MPEP § 706.02 (i), (j), and (m) for language to be used.

Everything of a personal nature must be avoided. Whatever may be the examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he or she should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he or she express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him or her the claims allowed.

The examiner should, as a part of the first Office action on the merits, identify any claims which he or she judges, as presently recited, to be allowable and/or should suggest any way in which he or she considers that rejected claims may be amended to make them allowable. If the examiner does not do this, then by implication it will be understood by the applicant or his or her attorney or agent that in the examiner's opinion, as presently advised, there appears to be no allowable claim nor anything patentable in the subject matter to which the claims are directed.

IMPROPERLY EXPRESSED REJECTIONS

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

707.07(e) Note All Outstanding Requirements

In taking up an amended application for action the examiner should note in every letter all the requirements outstanding against the application. Every point in the prior action of an examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the *requirement*. Such requirements include requirements for information under 37 CFR 1.105 and MPEP § 704.10; however the examiner should determine whether any such requirement has been satisfied by a negative reply under 37 CFR 1.105(a)(3).

As soon as allowable subject matter is found, correction of all informalities then present should be *required*.

707.07(f) Answer All Material Traversed [R-3]

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If applicant's arguments are persuasive and upon reconsideration of the rejection, the examiner determines that the previous rejection should be withdrawn, the examiner must provide in the next Office communication the reasons why the previous rejection is withdrawn by referring specifically to the page(s) and line(s) of applicant's remarks which form the basis for withdrawing the rejection. It is not acceptable for the examiner to merely indicate that all of applicant's remarks form the basis for withdrawing the previous rejection. Form paragraph 7.38.01 may be used. If the withdrawal of the previous rejection results in the allowance of the claims, the reasons, which form the basis for the withdrawal of the previous rejection, may be included in a reasons for allowance. See MPEP § 1302.14.

If applicant's arguments are persuasive and the examiner determines that the previous rejection should be withdrawn but that, upon further consideration, a new ground of rejection should be made, form paragraph 7.38.02 may be used. See MPEP § 706.07(a) to determine whether the Office action may be made final.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised. See MPEP § 716 *et seq.* for the treatment of affidavits and declarations under 37 CFR 1.132.

The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument).

Form paragraphs 7.37 through 7.37.13 may be used where applicant's arguments are not persuasive.

Form paragraphs 7.38 through 7.38.02 may be used where applicant's arguments are moot or persuasive.

¶ *7.37 Arguments Are Not Persuasive*

Applicant's arguments filed **[1]** have been fully considered but they are not persuasive. **[2]**

Examiner Note:

1. The examiner must address all arguments which have not already been responded to in the statement of the rejection.
2. In bracket 2, provide explanation as to non-persuasiveness.

¶ *7.38 Arguments Are Moot Because of New Ground(s) of Rejection*

Applicant's arguments with respect to claim **[1]** have been considered but are moot in view of the new ground(s) of rejection.

Examiner Note:

The examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied.

¶ *7.38.01 Arguments Persuasive, Previous Rejection/ Objection Withdrawn*

Applicant's arguments, see [**1**], filed [**2**], with respect to [**3**] have been fully considered and are persuasive. The [**4**] of [**5**] has been withdrawn.

Examiner Note:

1. In bracket 1, identify the page(s) and line number(s) from applicant's remarks which form the basis for withdrawing the previous rejection/objection.
2. In bracket 3, insert claim number, figure number, the specification, the abstract, etc.
3. In bracket 4, insert rejection or objection.
4. In bracket 5, insert claim number, figure number, the specification, the abstract, etc.

¶ *7.38.02 Arguments Persuasive, New Ground(s) of Rejection*

Applicant's arguments, see [**1**], filed [**2**], with respect to the rejection(s) of claim(s) [**3**] under [**4**] have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of [**5**].

Examiner Note:

1. In bracket 1, identify the page(s) and line number(s) from applicant's remarks which form the basis for withdrawing the previous rejection.
2. In bracket 3, insert the claim number(s).
3. In bracket 4, insert the statutory basis for the previous rejection.
4. In bracket 5, insert the new ground(s) of rejection, e.g., different interpretation of the previously applied reference, newly found prior art reference(s), and provide an explanation of the rejection.

¶ *7.37.01 Unpersuasive Argument: Age of Reference(s)*

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.02 Unpersuasive Argument: Bodily Incorporation*

In response to applicant's argument that **[1]**, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of bodily incorporation.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.03 Unpersuasive Argument: Hindsight Reasoning*

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.04 Unpersuasive Argument: No Suggestion To Combine*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, **[1]**.

Examiner Note:

1. In bracket 1, explain where the motivation for the rejection is found, either in the references, or in the knowledge generally available to one of ordinary skill in the art.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.05 Unpersuasive Argument: Nonanalogous Art*

In response to applicant's argument that **[1]** is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, **[2]**.

Examiner Note:

1. In bracket 1, enter the name of the reference which applicant alleges is nonanalogous.
2. In bracket 2, explain why the reference is analogous art.
3. This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.06 Unpersuasive Argument: Number of References*

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.07 Unpersuasive Argument: Applicant Obtains Result Not Contemplated by Prior Art*

In response to applicant's argument that **[1]**, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of results not contemplated by the prior art.

2. This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.08 Unpersuasive Argument: Arguing Limitations Which Are Not Claimed*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **[1]**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner Note:

1. In bracket 1, recite the features upon which applicant relies, but which are not recited in the claim(s).

2. This form paragraph must be preceded by form paragraph 7.37.

**>

¶ *7.37.09 Unpersuasive Argument: Intended Use*

In response to applicant's argument that **[1]**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of intended use.

2. This form paragraph must be preceded by form paragraph 7.37.

<

¶ *7.37.10 Unpersuasive Argument: Limitation(s) in Preamble*

In response to applicant's arguments, the recitation **[1]** has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner Note:

1. In bracket 1, briefly restate the recitation about which applicant is arguing.

2. This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.11 Unpersuasive Argument: General Allegation of Patentability*

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.12 Unpersuasive Argument: Novelty Not Clearly Pointed Out*

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ *7.37.13 Unpersuasive Argument: Arguing Against References Individually*

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding,

however, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

(A) Where an application is too informal for a complete action on the merits. See MPEP § 702.01;

(B) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination. See MPEP § 2173.05(n);

(C) Where there is a misjoinder of inventions and there has been no successful telephone request for election. See MPEP § 803, § *>810<, § 812.01;

(D) Where disclosure is directed to perpetual motion. See *Ex parte Payne*, 1904 C.D. 42, 108 O.G. 1049 (Comm'r Pat. 1903). However, in such cases, the best prior art readily available should be cited and its pertinency pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of *res judicata*, no *prima facie* showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accompanied by rejection on all other available grounds.

707.07(h) Notify of Inaccuracies in Amendment

See MPEP § 714.23.

707.07(i) Each Claim To Be Mentioned in Each Office Action [R-3]

In every Office action, each pending claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the application, its history through successive actions is thus easily traceable. Each action should include a summary of the status of all claims presented for examination. Form PTO-326 "Office Action Summary" should be used.

Claims retained under 37 CFR 1.142 and claims retained under 37 CFR 1.146 should be treated as set out in MPEP § 821 to § **>821.04(b)<.

See MPEP *>Chapter 2300< for treatment of claims in the application of losing party in interference.

The Index of Claims should be kept up to date as set forth in MPEP § 719.04. For Image File Wrapper (IFW) processing, see IFW Manual.

707.07(j) State When Claims Are Allowable [R-2]

>

I. < INVENTOR FILED APPLICATIONS

When, during the examination of a *pro se* application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent. Although this practice may be desirable and is permissible in any case deemed appropriate by the examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

>

II. < ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

>

III. < EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

Form paragraphs 7.43, 7.43.01, and 7.43.02 may be used to indicate allowable subject matter.

¶ *7.43 Objection to Claims, Allowable Subject Matter*

Claim **[1]** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**>

¶ *7.43.01 Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Independent Claim/Dependent Claim*

Claim **[1]** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Examiner Note:

This form paragraph is to be used when (1) the noted independent claim(s) or (2) the noted dependent claim(s), which depend from an allowable claim, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended to overcome the rejection.

¶ *7.43.02 Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Dependent Claim*

Claim **[1]** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner Note:

This form paragraph is to be used only when the noted dependent claim(s), which depend from a claim that is rejected based on prior art, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended as indicated.

<

¶ *7.43.04 Suggestion of Allowable Drafted Claim(s), Pro Se*

The following claim **[1]** drafted by the examiner and considered to distinguish patentably over the art of record in this application, **[2]** presented to applicant for consideration:

[3].

Examiner Note:

1. If the suggested claim is not considered to be embraced by the original oath or declaration, a supplemental oath or declaration should be required under 37 CFR 1.67.
2. In bracket 2, insert --is-- or -- are--.
3. In bracket 3, insert complete text of suggested claim(s).

Form paragraph 7.97 may be used to indicate allowance of claims.

¶ *7.97 Claims Allowed*

[1] allowed.

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

707.07(l) Comment on Examples

The results of the tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims should be rejected as being based on an insufficient disclosure under 35 U.S.C. 112, first paragraph. *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). See MPEP § 2161 through § 2164.08(c) for a discussion of the written description and enablement requirements of 35 U.S.C 112, first paragraph. The applicant must reply to the rejection, for example, by providing the results of an actual test or example which has been conducted, or by providing relevant arguments that there is strong reason to believe that the result would be as predicted. Care should be taken that new matter is not entered into the application.

If questions are present as to operability or utility, consideration should be given to the applicability of a rejection under 35 U.S.C. 101. See MPEP § 706.03(a) and § 2107 *et seq.*

707.08 Reviewing and Initialing by Assistant Examiner [R-3]

The full surname of the examiner who prepares the Office action will, in all cases, be typed at the end of the action. The telephone number below this should be called if the application is to be discussed or an interview arranged. Form paragraph 7.100, 7.101 or 7.102 should be used.

¶ *7.100 Name And Number of Examiner To Be Contacted*

Any inquiry concerning this communication should be directed to **[1]** at telephone number **[2]**.

Examiner Note:

1. This form paragraph, form paragraph 7.101, or form paragraph 7.102 should be used at the conclusion of all actions.

2. In bracket 1, insert the name of the examiner designated to be contacted first regarding inquiries about the Office action. This could be either the non-signatory examiner preparing the action or the signatory examiner.

3. In bracket 2, insert the individual area code and phone number of the examiner to be contacted.

**>

¶ *7.101 Telephone Inquiry Contacts- Non 5/4/9 Schedule*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **[1]** whose telephone number is **[2]**. The examiner can normally be reached on **[3]** from **[4]** to **[5]**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **[6]**, can be reached on **[7]**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off every Friday.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 5:00 PM."
5. In bracket 6, insert your SPE's name.
6. In bracket 7, insert your SPE's area code and phone number.

¶ *7.102 Telephone Inquiry Contacts- 5/4/9 Schedule*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **[1]** whose telephone number is **[2]**. The examiner can normally be reached on **[3]** from **[4]** to **[5]**. The examiner can also be reached on alternate **[6]**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **[7]**, can be reached on **[8]**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off on alternate Fridays.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 4:00 PM."
5. In bracket 6, insert the day in each pay-period that is your compressed day off, e.g. "Fridays" for an examiner on a 5/4/9 work schedule with the first Friday off.

6. In bracket 7, insert your SPE's name.
7. In bracket 8, insert your SPE's area code and phone number.

<

After the action is typed, the examiner who prepared the action reviews it for correctness. The surname or initials of the examiner who prepared the action and the date on which the action was typed should appear below the action. If this examiner does not have the authority to sign the action, he or she should initial above the typed name or initials, and forward the action to the authorized signatory examiner for signing.

707.09 Signing by Primary or Other Authorized Examiner

Although only the original is signed, the word "Examiner" and the name of the signer should appear on the original and copies.

All Office actions and other correspondence should be signed promptly.

707.10 Entry [R-2]

The original, signed by the authorized examiner, is the copy which is placed in the file wrapper. The character of the action, its paper number and the date of mailing are entered in black ink on the outside of the file wrapper under "Contents." >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.<

707.11 Date

The mailing date should not be typed when the Office action is written, but should be stamped or printed on all copies of the action after it has been signed by the authorized signatory examiner and the copies are about to be mailed.

707.12 Mailing [R-2]

Copies of the examiner's action are mailed by the Technology Center after the original, initialed by the assistant examiner and signed by the authorized signatory examiner, has been placed in the file. After the copies are mailed the original is returned for placement in the file. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.<

707.13 Returned Office Action [R-3]

Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. **>Upon receipt of the returned Office action, the Technology Center (TC) technical support staff will check the application file record to ensure that the Office action was mailed to the correct correspondence address. If the Office action was not mailed to the correct correspondence address, it should be stamped "remailed" with the remailing date and mailed to the correct correspondence address. The period running against the application begins with the date of remailing. If the Office action was mailed to the correct correspondence address and it was addressed to an attorney or agent<, a letter may be written to the inventor or assignee informing him or her of the returned action. The period running against the application begins with the date of remailing. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. For an Image File Wrapper (IFW), a copy of the letter* and a copy of the envelope should be added to the IFW (see IFW Manual). If the period dating from the remailing elapses with no communication from applicant, the application is abandoned.

708 Order of Examination [R-2]

Nonprovisional applications filed in the U.S. Patent and Trademark Office and accepted as complete applications are assigned for examination to the respective examining Technology Centers (TCs) having the classes of inventions to which the applications relate. Nonprovisional applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to 37 CFR 1.102. See 37 CFR 1.496 and MPEP § 1893.03 for the order of examination of international applications in the national stage, including taking up out of order certain national stage applications which have been indicated as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability.

Applications which have been acted upon by the examiner, and which have been placed by the appli-

cant in condition for further action by the examiner (amended applications) shall be taken up for action in such order as shall be determined by the *>Director of the USPTO<.

Each examiner will give priority to that application in his or her docket, whether amended or new, which has the *oldest effective U.S. filing date*. Except as rare circumstances may justify Technology Center Directors in granting individual exceptions, this basic policy applies to all applications.

The actual filing date of a continuation-in-part application is used for docketing purposes. However, the examiner may act on a continuation-in-part application by using the effective filing date, if desired.

If at any time an examiner determines that the "effective filing date" status of any application differs from what the records show, the technical support staff should be informed, who should promptly amend the records to show the correct status, with the date of correction.

The order of examination for each examiner is to give priority to reissue applications and to reexamination proceedings, with top priority to reissue applications in which litigation has been stayed (MPEP § 1442.03)*>,< to >*ex parte*< reexamination proceedings involved in litigation (MPEP § 2261), >and to *inter partes* reexamination proceedings involved in litigation (MPEP § 2661),< then to those special cases having a fixed 30-day due date, such as examiner's answers and decisions on motions. Most other cases in the "special" category (for example, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U.S. filing date among them normally controlling priority.

All amendments before final rejection should be responded to within two months of receipt.

708.01 List of Special Cases [R-2]

37 CFR 1.102. Advancement of examination.

**>

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.<

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

Certain procedures by the examiners take precedence over actions even on special cases.

For example, all papers typed and ready for signature should be completed and mailed.

All issue cases returned with a "Printer Waiting" slip must be processed and returned within the period indicated.

Reissue applications, particularly those involved in stayed litigation, should be given priority.

Applications in which practice requires that the examiner act within a set period, such as 2 months after appellants brief to furnish the examiner's answers (MPEP § 1208), necessarily take priority over special cases without specific time limits.

If an examiner has an application in which he or she is satisfied that it is in condition for allowance, or in which he or she is satisfied will have to be finally rejected, he or she should give such action forthwith instead of making the application await its turn.

The following is a list of special cases (those which are advanced out of turn for examination):

(A) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the *>Director of the USPTO< so orders (37 CFR 1.102).

(B) Applications made special as a result of a petition. (See MPEP § 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the *>Director of the USPTO< or **>a< Commissioner) will continue to be special throughout its entire course of prosecution in the U.S. Patent and Trademark Office, including appeal, if any, to the Board of Patent Appeals and Interferences.

(C) Applications for reissues, particularly those involved in stayed litigation (37 CFR 1.176).

(D) Applications remanded by an appellate tribunal for further action.

(E) An application, once taken up for action by an examiner according to its effective filing date, should be treated as special by an examiner, art unit or Technology Center to which it may subsequently be transferred; exemplary situations include new cases transferred as the result of a telephone election and cases transferred as the result of a timely reply to any official action.

(F) Applications which appear to interfere with other applications previously considered and found to be allowable, or which will be placed in interference with an unexpired patent or patents.

(G) Applications ready for allowance, or ready for allowance except as to formal matters.

(H) Applications which are in condition for final rejection.

(I) Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years. See MPEP § 707.02.

(J) Reexamination proceedings, MPEP § 2261 >and § 2661<.

See also MPEP § 714.13, § 1207 and § 1309.

708.02 Petition To Make Special [R-3]

37 CFR 1.102. Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.<

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

**>

(c) A petition to make an application special may be filed without a fee if the basis for the petition is:

(1) The applicant's age or health; or

(2) That the invention will materially:

(i) Enhance the quality of the environment;

(ii) Contribute to the development or conservation of energy resources; or

(iii) Contribute to countering terrorism.<

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

New applications ordinarily are taken up for examination in the order of their effective United States filing dates. Certain exceptions are made by way of petitions to make special, which may be granted under the conditions set forth below.>Any statement in support of a petition to make special must be based on a good faith belief that the invention in fact qualifies for special status. See 37 CFR 1.56 and 10.18.<

I. MANUFACTURE

An application may be made special on the ground of prospective manufacture upon the filing of a petition accompanied by the fee under 37 CFR 1.17(h) and a statement by the applicant, assignee or an attorney/agent registered to practice before the Office alleging:

(A) The possession by the prospective manufacturer of sufficient presently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) to manufacture the invention in quantity or that sufficient capital and facilities will be made available if a patent is granted;

If the prospective manufacturer is an individual, there must be a corroborating statement from some responsible party, as for example, an officer of a bank, showing that said individual has the required available capital to manufacture;

(B) That the prospective manufacturer will not manufacture, or will not increase present manufacture, unless certain that the patent will be granted;

(C) That the prospective manufacturer obligates himself, herself or itself, to manufacture the invention, in the United States or its possessions, in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities; and

(D) That the applicant or assignee has made or caused to be made a careful and thorough search of the prior art, or has a good knowledge of the pertinent prior art.

Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

II. INFRINGEMENT

Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon payment of the fee under 37 CFR 1.17(h) and the filing of a petition accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office alleging:

(A) That there is an infringing device or product actually on the market or method in use;

(B) That a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and

(C) That he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.

Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

Models or specimens of the infringing product or that of the application should not be submitted unless requested.

III. APPLICANT'S HEALTH

An application may be made special upon a petition by applicant accompanied by any evidence showing that the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate. No fee is required for such a petition. See 37 CFR 1.102(c).

>Personal/medical information submitted as evidence to support the petition will be available to the public if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14. If applicant does not wish to have this information become part of the application file record, the information must be submitted pursuant to MPEP § 724.02.<

IV. APPLICANT'S AGE

An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant's statement. No fee is required with such a petition. See 37 CFR 1.102(c).

>Personal/medical information submitted as evidence to support the petition will be available to the public if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14. If applicant does not wish to have this information become part of the application file record, the information must be submitted pursuant to MPEP § 724.02.<

V. ENVIRONMENTAL QUALITY

The U.S. Patent and Trademark Office will accord "special" status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements, i.e., air, water, and soil.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. **>The petition under 37 CFR 1.102 must state that special status is sought because the invention materially enhances the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements.< No fee is required for such a petition. See 37 CFR 1.102(c). >If the application disclosure is not clear on its face that the claimed invention materially enhances the quality of the environment by contributing to the restoration or maintenance of one of the basic life-sustaining natural elements, the petition must be accompanied by a statement under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could materially enhance the quality of the environment. Nor does such standard permit an applicant to enjoy the benefit of advanced examination merely because some minor aspect of the claimed invention may enhance the quality of the environment.<

VI. ENERGY

The U.S. Patent and Trademark Office will, on petition, accord "special" status to all patent applications for inventions which materially contribute to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources. Examples of inventions in category (A) would be developments in fossil fuels (natural gas, coal, and petroleum), hydrogen fuel technologies, nuclear energy, solar energy, etc. Category (B) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. **>The petition under 37 CFR 1.102 must state that special status is sought because the invention materially contributes to category (A) or (B) set forth above.< No fee is required for such a petition, 37 CFR 1.102(c).>If the application disclosure is not clear on its face that the claimed invention materially contributes to category (A) or (B), the petition must be accompanied by a statement under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could materially contribute to category (A) or (B). Nor does such standard permit an applicant to enjoy the benefit of advanced examination merely because some minor aspect of the claimed invention may be directed to category (A) or (B).<

VII. INVENTIONS RELATING TO RECOMBINANT DNA

In recent years revolutionary genetic research has been conducted involving recombinant deoxyribonucleic acid ("recombinant DNA"). Recombinant DNA research appears to have extraordinary potential benefit for mankind. It has been suggested, for example, that research in this field might lead to ways of controlling or treating cancer and hereditary defects. The technology also has possible applications in agriculture and industry. It has been likened in importance to the discovery of nuclear fission and fusion. At the same time, concern has been expressed over the safety of this type of research. The National Institutes of Health (NIH) has released guidelines for the conduct of research concerning recombinant DNA. These "Guidelines for Research Involving Recombination DNA Molecules," were published in the *Federal Register* of July 7, 1976, 41 FR 27902-27943. NIH is sponsoring experimental work to identify possible hazards and safety practices and procedures.

In view of the exceptional importance of recombinant DNA and the desirability of prompt disclosure of developments in the field, the U.S. Patent and Trademark Office will accord "special" status to patent applications relating to safety of research in the field of recombinant DNA. Upon appropriate petition and payment of the fee under 37 CFR 1.17(h), the Office will make special patent applications for inventions relating to safety of research in the field of recombinant DNA. Petitions for special status should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or statements by an attorney/agent registered to practice before the Office explaining the relationship of the invention to safety of research in the field of recombinant DNA research. The fee set forth under 37 CFR 1.17(h) must also be paid.

VIII. SPECIAL EXAMINING PROCEDURE FOR CERTAIN NEW APPLICATIONS — ACCELERATED EXAMINATION

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement if the claims in the corresponding foreign application are of the same or similar scope to the claims in the U.S. application for which special status is requested;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Technology Center (TC) Special Program Examiner.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

The special examining procedure of VIII (accelerated examination) involves the following procedures:

(A) The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The examiner's search will be restricted to the *subject matter encompassed by the claims*. A first action rejection will set a 3-month shortened period for reply.

(B) During the 3-month period for reply, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. In order to afford the examiner time for reflective consideration before the interview, applicant or his or her representative should cause to be placed in the hands of the examiner at least one working day prior to the interview, a copy (clearly denoted as such) of the amendment that he or she proposes to file in response to the examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

(C) Subsequent to the interview, or responsive to the examiner's first action if no interview was had, applicant will file the "record" reply. The reply at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as an improper reply.

(D) The examiner will, within 1 month from the date of receipt of applicant's formal reply, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a 3-month period for reply, or a notice of allowance. The examiner's reply to any amendment submitted after final rejection should be prompt and by way of form PTOL-303, by passing the application to issue, or by an examiner's answer should applicant choose to file an appeal brief at this time. The use of these forms is not intended to open the door to further prosecution. Of course, where relatively minor issues

or deficiencies might be easily resolved, the examiner may use the telephone to inform the applicant of such.

(E) A personal interview after a final Office action will not be permitted unless requested by the examiner. However, telephonic interviews will be permitted where appropriate for the purpose of correcting any minor outstanding matters.

After allowance, these applications are given top priority for printing. See MPEP § 1309.

IX. SPECIAL STATUS FOR PATENT APPLICATIONS RELATING TO SUPERCONDUCTIVITY

In accordance with the President's mandate directing the U.S. Patent and Trademark Office to accelerate the processing of patent applications and adjudication of disputes involving superconductivity technologies when requested by the applicant to do so, the U.S. Patent and Trademark Office will, on request, accord "special" status to all patent applications for inventions involving superconductivity materials. Examples of such inventions would include those directed to superconductive materials themselves as well as to their manufacture and application. In order that the U.S. Patent and Trademark Office may implement this procedure, we invite all applicants desiring to participate in this program to request that their applications be accorded "special" status. Such requests should be accompanied by a statement under 37 CFR 1.102 that the invention involves superconductive materials. No fee is required.

X. INVENTIONS RELATING TO HIV/AIDS AND CANCER

In view of the importance of developing treatments and cures for HIV/AIDS and cancer and the desirability of prompt disclosure of advances made in these fields, the U.S. Patent and Trademark Office will accord "special" status to patent applications relating to HIV/AIDS and cancer.

Applicants who desire that an application relating to HIV/AIDS or cancer be made special should file a petition and the fee under 37 CFR 1.17(h) requesting the U.S. Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

XI. INVENTIONS FOR COUNTERING TERRORISM

In view of the importance of developing technologies for countering terrorism and the desirability of prompt disclosure of advances made in these fields, the U.S. Patent and Trademark Office will accord "special" status to patent applications **>for inventions which materially contribute to countering terrorism<.

International terrorism as defined in 18 U.S.C. 2331 includes "activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (i) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping..." The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.

**>All applicants desiring to participate in this program should petition that their applications be accorded special status. The petition under 37 CFR 1.102 must state that special status is sought because the invention materially contributes to countering terrorism. No fee is required for such a petition. See 37 CFR 1.102(c). If the application disclosure is not clear on its face that the claimed invention is materially directed to countering terrorism, the petition must be accompanied by a statement under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the invention materiality contributes to countering terrorism. The materiality standard does not permit an applicant to speculate as to how a hypothetical end-user might specially apply the invention in a manner that could counter terrorism. Nor does such standard permit an applicant to enjoy the benefit of advanced examination merely because some minor aspect of the claimed invention may be directed to countering terrorism.<

XII. SPECIAL STATUS FOR APPLICATIONS RELATING TO BIOTECHNOLOGY FILED BY APPLICANTS WHO ARE SMALL ENTITIES

Applicants who are small entities may request that their biotechnology applications be granted "special" status. Applicant must file a petition with the petition fee under 37 CFR 1.17(h) requesting the special status and must:

(A) state that small entity status has been established or include a statement establishing small entity status;

(B) state that the subject of the patent application is a major asset of the small entity; and

(C) state that the development of the technology will be significantly impaired if examination of the patent application is delayed, including an explanation of the basis for making the statement.

FORMAL REQUIREMENTS OF PETITION TO MAKE SPECIAL

Any petition to make special should:

(A) be in writing; and

(B) identify the application by application number and filing date.

HANDLING OF PETITIONS TO MAKE SPECIAL

Applications which have been made special will be advanced out of turn for examination and will continue to be treated as special throughout the entire prosecution in the Office.

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is made of record in the application file, together with the decision thereon. The part of the Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the "Contents" of the file. The decision will be accorded a separate paper number and similarly entered. To ensure entries in the "Contents" in proper order, the technical support staff in the TC will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. Note MPEP § 1002.02 (s). For Image File Wrapper (IFW) processing, see IFW Manual.

Petitions to make special are decided by the Special Program Examiner of the TC to which the application is assigned.

708.03 Examiner Tenders Resignation [R-2]

Whenever an examiner tenders his or her resignation, the supervisory patent examiner should see that the remaining time as far as possible is used in winding up the old complicated cases or those with involved records and getting as many of his or her amended cases as possible ready for final disposition.

If the examiner has considerable experience in his or her particular art, it is also advantageous to the Office if he or she indicates (in pencil) in the file wrappers of application in his or her docket, the field of search or other pertinent data that he or she considers appropriate. >For Image File Wrapper (IFW) processing, see IFW Manual.<

709 Suspension of Action [R-3]

37 CFR 1.103. Suspension of action by the Office.

(a) *Suspension for cause*. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

**>

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.<

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d)*. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued application (RCE) under § 1.114*. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examina-

tion in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(d) *Deferral of examination.* On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code. A request for deferral of examination under this paragraph must include the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). A request for deferral of examination under this paragraph will not be granted unless:

(1) The application is an original utility or plant application filed under § 1.53(b) or resulting from entry of an international application into the national stage after compliance with § 1.495;

(2) The applicant has not filed a nonpublication request under § 1.213(a), or has filed a request under § 1.213(b) to rescind a previously filed nonpublication request;

(3) The application is in condition for publication as provided in § 1.211(c); and

(4) The Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(e) *Notice of suspension on initiative of the Office.* The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

(f) *Suspension of action for public safety or defense.* The Office may suspend action by the Office by order of the Director if the following conditions are met:

(1) The application is owned by the United States;

(2) Publication of the invention may be detrimental to the public safety or defense; and

(3) The appropriate department or agency requests such suspension.

**>

(g) *Statutory invention registration.* The Office will suspend action by the Office for the entire pendency of an application if the Office has accepted a request to publish a statutory invention registration in the application, except for purposes relating to patent interference proceedings under part 41, subpart D, of this title.<

Suspension of action (37 CFR 1.103) should not be confused with extension of time for reply (37 CFR 1.136). It is to be noted that a suspension of action applies to an impending Office action by the examiner whereas an extension of time for reply applies to action by the applicant. In other words, the action cannot be suspended in an application which contains an outstanding Office action or requirement awaiting reply by the applicant. It is only the action by the examiner which can be suspended under 37 CFR 1.103.

Suspension of action under 37 CFR 1.103(a)-(d) at the applicant's request will cause a reduction in patent term adjustment accumulated (if any) under 37 CFR 1.703. The reduction is equal to the number of days beginning on the date a request for suspension of action was filed and ending on the date of the termination of the suspension. See 37 CFR 1.704(c)(1).

I. REQUEST BY THE APPLICANT

Request, 37 CFR Section	Requirement	Fee(s), 37 CFR Section	Maximum length of Suspension
1.103(a)	Petition with a showing of good and sufficient cause.	1.17(*>g<)	6 months
1.103(b)	Request at the time of filing a CPA	1.17(i)	3 months
1.103(c)	Request at the time of filing an RCE	1.17(i)	3 months
1.103(d)	See below in "Deferral of Examination"	1.17(i)&1.18(d)	3 yrs. from earliest filing date for which a benefit is claimed under Title 35.

A. Petition Under 37 CFR 1.103(a) With a Showing of Good and Sufficient Cause

A request that action in an application be delayed will be granted only under the provisions of 37 CFR 1.103, which provides for "Suspension of Action." A petition for suspension of action under 37 CFR 1.103(a) must:

(A) be presented as a separate paper;

(B) be accompanied by the petition fee set forth in 37 CFR 1.17(*>g<);

(C) request a specific and reasonable period of suspension not greater than 6 months; and

(D) present good and sufficient reasons why the suspension is necessary.

If the requirements of 37 CFR 1.103(a) are not met, applicants should expect that their applications, whether new or amended, will be taken up for action by the examiner in the order provided in MPEP § 708, Order of Examination.

A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 CFR 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner.

In new applications, the mere inclusion in the transmittal form letter of a request that action be delayed cannot be relied upon to avoid immediate action in the application. However, applicant may consider filing a request for deferral of examination under 37 CFR 1.103(d) (see below for the requirements). Applicants should be aware of the possibility of requesting suspension of action by the Office under 37 CFR 1.103(b) or (c) for a period not exceeding three months at the time of filing a continued prosecution application (CPA) under 37 CFR 1.53(d) if the application is a design application, or a request for continued examination (RCE) under 37 CFR 1.114. Note that effective July 14, 2003, CPA practice does not apply to utility and plant applications. Many Technology Center (TC) art units and examiners have short pendency to first action, and new applications may be taken up for action before preliminary amendments are filed in those applications. Where a preliminary amendment and petition to suspend action have been filed, it would be helpful to telephone the examiner in that regard to avoid having the amendment and the first Office action cross in the mail. The following form paragraphs should be used to notify the grant or denial of the petition under 37 CFR 1.103(a):

¶ *7.54 Suspension of Action, Applicant's Request*

Pursuant to applicant's request filed on **[1]**, action by the Office is suspended on this application under 37 CFR 1.103(a) for a period of **[2]** months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

Examiner Note:

1. Maximum period for suspension is 6 months.
2. Only the Technology Center Director can grant second or subsequent suspensions. See MPEP § 1003. Such approval must appear on the Office letter.

¶ *7.56 Request for Suspension, Denied, Outstanding Office Action*

Applicant's request filed **[1]**, for suspension of action in this application under 37 CFR 1.103(a), is denied as being improper. Action cannot be suspended in an application awaiting a reply by the applicant. See MPEP § 709.

>A supplemental reply will be entered if it is filed within the period during which action is suspended by the Office under 37 CFR 1.103(a). See MPEP § 714.03(a) regarding supplemental reply.<

B. Request for Suspension Under 37 CFR 1.103(b) or (c)

Applicants may request a suspension of action by the Office under 37 CFR 1.103(b) or (c) for a period not exceeding three months in a continued prosecution application (CPA) filed under 37 CFR 1.53(d) if the application is a design application, or in a continued examination (RCE) filed under 37 CFR 1.114. The request for suspension must be filed at the time of filing of the CPA or RCE.

>A supplemental reply will be entered if it is filed within the period during which action is suspended by the Office under 37 CFR 1.103(c). See MPEP § 714.03(a) regarding supplemental reply.<

1. Requirements

The Office will not grant the requested suspension of action unless the following requirements are met:

(A) the request must be filed with the filing of a design CPA or an RCE (applicants may use the check box provided on the transmittal form PTO/SB/29 or PTO/SB/30, or submit the request on a separate paper);

(1) if the request is filed with an RCE, the RCE must be in compliance with 37 CFR 1.114, i.e., the RCE must be accompanied by a submission and the fee set forth in 37 CFR 1.17(e). Note that the payment of the RCE filing fee may not be deferred and the request for suspension cannot substitute for the submission;

(2) if the request is filed with a CPA, a filing date must be assigned to the CPA;

(B) the request should specify the period of suspension in a whole number of months (maximum of 3 months>)<. If the request specifies no period of suspension or a period of suspension that exceeds 3 months, the Office will assume that a 3-month suspension is requested; and

(C) the request must include the processing fee set forth in 37 CFR 1.17(i).

2. Missing Parts for the CPA (Filing Date Granted)

If the Office assigns a filing date to the design CPA, the request for suspension will be processed, even if the CPA was not accompanied by the CPA >basic< filing fee>, the search fee, and the examination fee<. The suspension request acts to suspend a first Office action by the examiner but will not affect the processing of the CPA for a missing part. The applicant will be given a notice that provides a time period of 2 months from the date of the notification to pay the CPA >basic< filing fee>, the search fee, the examination fee,< and the surcharge set forth in 37 CFR 1.16(*>f<). Applicant must pay the CPA >basic< filing fee>, the search fee, the examination fee,< and the surcharge within 2 months to avoid the abandonment of the CPA. Pursuant to applicant's request for suspension, the action by the Office will be suspended on the CPA for the period requested by the applicant, starting on the filing date of the CPA.

3. Improper RCE or CPA (No Filing Date Granted)

If the CPA or the RCE is improper (e.g., a filing date was not accorded in the CPA or the RCE was filed without a submission or the RCE fee), the Office will not recognize the request for suspension, and action by the Office will not be suspended. A notice of improper CPA or RCE will be sent to applicant as appropriate. The time period set in the previous Office communication (e.g., a final Office action or a notice of allowance) continues to run from the mailing date of that communication. If applicant subsequently files another RCE, the request for suspension should be resubmitted to ensure that the Office processes the request for suspension properly. The request for suspension of action will not be processed until the Office accords a filing date to the CPA or receives a proper RCE in compliance with 37 CFR 1.114.

4. Improper Request for Suspension

If the CPA or the RCE is properly filed, but the request for suspension is improper (e.g., the request for suspension was filed untimely or without the processing fee set forth in 37 CFR 1.17(i)), action by the Office will not be suspended on the application. The Office will process the CPA or RCE and place the application on the examiner's docket. The examiner will notify the applicant of the denial of the request in the next Office communication using the following form paragraph:

¶ *7.56.01 Request for Suspension of Action under 37 CFR 1.103, Denied*

Applicant's request filed **[1],** for suspension of action in this application under 37 CFR 1.103(b) or (c) is denied as being improper. The request was (1) not filed at the time of filing a CPA or RCE, and/or (2) not accompanied by the requisite fee as set forth in 37 CFR 1.17(i). See MPEP § 709.

Examiner Note:

In bracket 1, insert the filing date of the request for suspension of action.

5. Proper Request for Suspension

If the CPA or the RCE and the request for suspension of action are proper, the Office's technical support staff will process the CPA or RCE, and the request for suspension of action. A notification of the approval of the request for suspension will be sent to the applicant. The application will be placed in suspension status until the end of the suspension period. The suspension request acts to suspend a first Office action by the examiner. Once the suspension period has expired, the application will be placed on the examiner's docket for further prosecution.

C. Request for Deferral of Examination Under 37 CFR 1.103(d)

In new applications, applicants may request a deferral of examination under 37 CFR 1.103(d) for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 119(a)-(d), (e), (f), 120, 121, or 365. The request must be filed before the Office issues an Office action under 35 U.S.C. 132 or a notice of allowance in the application. The suspension will start on the day that the Office grants the request for deferral of examination. Once the deferral of examination has been granted, the application will not be taken up for action by the examiner until the suspension period expires. For example, if an applicant files a request for deferral of examination under 37 CFR 1.103(d) for the maximum period permitted under the rule in an application that claims priority of a foreign application filed 1/3/00, the action by the Office on the application will be suspended and the application will automatically be placed in a regular new case status on the examiner's docket on 1/4/03 (36 months from the effective filing date of the application, i.e., 1/3/00).

1. Requirements

Form PTO/SB/37 (reproduced at the end of this section) may be used to submit a request for deferral of examination under 37 CFR 1.103(d).

A request for deferral of examination under 37 CFR 1.103(d) must include:

(A) a period of suspension, in a whole number of months, not extending beyond three years from the earliest effective filing date (if the request includes no period of suspension or a period that exceeds the maximum period permitted under the rule, i.e., beyond 3 years from the earliest effective filing date, the Office will assume that the maximum period is requested);

(B) the publication fee set forth in 37 CFR 1.18(d); and

(C) the processing fee set forth in 37 CFR 1.17(i).

The Office will not grant a deferral of examination unless the following conditions are met:

(A) the application must be

(1) an original utility or plant application filed under 37 CFR 1.53(b) **or**

(2) an application resulting from entry of an international application into the national stage after compliance with 37 CFR 1.495 (the application cannot be a design application, a reissue application, or a CPA under 37 CFR 1.53(d));

(B) the application must be filed on or after November 29, 2000 (the effective date of the eighteen month publication provisions of the AIPA); **

(C) the applicant has not filed a nonpublication request under 37 CFR 1.213(a), **or** if a nonpublication request has been filed in the application, the applicant must file a request under 37 CFR 1.213(b) to rescind a previously filed nonpublication request (see the second check box on the form PTO/SB/37);

(D) the application must be in condition for publication as provided in 37 CFR 1.211(c) (if the application has been forwarded to the Technology Center by the Office of Initial Patent Examination (OIPE), the application can be assumed to be in condition for publication); and

(E) the Office has not issued either an Office action under 35 U.S.C. 132 (e.g., a restriction, a first Office action on the merits, or a requirement under 37 CFR 1.105) or a notice of allowance under 35 U.S.C. 151.

2. Improper Request

If the request is improper, the following form paragraphs may be used to notify the applicant of the denial of the request:

¶ *7.56.02 Request for Deferral of Examination under 37 CFR 1.103(d), Denied*

Applicant's request filed on **[1]**, for deferral of examination under 37 CFR 1.103(d) in the application is denied as being improper. **[2]**

See MPEP § 709.

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.

2. In bracket 2, insert the reason(s) for denying the request. For example, if appropriate insert --The applicant has not filed a request under 37 CFR 1.213(b) to rescind the previously filed nonpublication request--; --A first Office action has been issued in the application--; or --Applicant has not submitted a request for voluntary publication under 37 CFR 1.221--.

3. Proper Request

A supervisory patent examiner's approval is required for the grant of a deferral of examination in

an application. If the request is proper, the following form paragraph may be used to notify applicant that the request for deferral has been granted:

¶ *7.54.01 Request for Deferral of Examination under 37 CFR 1.103(d), Granted*

Applicant's request filed on **[1]**, for deferral of examination under 37 CFR 1.103(d) in the application has been approved. The examination of the application will be deferred for a period of **[2]** months.

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.
2. In bracket 2, insert the number of months for the deferral.

D. Termination of Suspension of Action

Once the request for suspension of action under 37 CFR 1.103 has been approved, action on the application will be suspended until the suspension period has expired, unless the applicant submits a request for termination of the suspension of action prior to the end of the suspension period. The request for termination of a suspension of action will be effective when an appropriate official of the Office takes action thereon. If the request for termination properly identifies the application and the period of suspension has not expired when the Office acts on the request, the Office will terminate the suspension and place the application on the examiner's docket. An acknowledgment should be sent to the applicant using the following form paragraph:

¶ *7.54.02 Request for Termination of a Suspension of Action, Granted*

Applicant's request filed on **[1]**, for termination of a suspension of action under 37 CFR 1.103, has been approved. The suspension of action has been terminated on the date of mailing this notice.

Examiner Note:

In bracket 1, insert the filing date of the request for termination of the suspension of action.

II. AT THE INITIATIVE OF THE OFFICE

Suspension of action at the initiative of the Office should be avoided, if possible, because such suspension will cause delays in examination, will increase pendency of the application, and may lead to a shortening of the effective patent term or, conversely, patent term extension, or adjustment, due to the suspension. Once a suspension of action has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists, even if the suspension period has not expired.

37 CFR 1.103(e) provides that the Office will notify applicant if the Office suspends action in an application on its own initiative. Every suspension of action initiated by the Office will be limited to a time period of a maximum of 6 months. An examiner may grant an initial suspension of Office action on his or her own initiative, as in MPEP § 709.01 and *>MPEP Chapter 2300<, for a maximum period of 6 months. A notification of suspension must be mailed to the applicant for each Office-initiated suspension of action, even for second or subsequent suspensions, and must include a suspension period (a maximum of 6 months). When the suspension period has expired, the examiner should take up action on the application or evaluate all possibilities for giving an action on the merits. For example, if a reference is still not available after waiting for six months, the examiner should try to find another source for the information or update the search to find another reference that can be used to make a rejection. If, in an extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director's approval (see MPEP § 1003) and prepare another suspension notification with a suspension period (a maximum of 6 months). The notification for a second or subsequent suspension must be signed by the TC Director.

Suspension of action under 37 CFR 1.103(f) is decided by the TC Director of work group 3640.

The following form paragraphs should be used in actions relating to suspension of action at the initiative of the Office.

¶ *7.52 Suspension of Action, Awaiting New Reference*

A reference relevant to the examination of this application may soon become available. *Ex parte* prosecution is SUSPENDED FOR A PERIOD OF **[1]** MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.

¶ *7.53 Suspension of Action, Possible Interference*

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF

[1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.

**>

PTO/SB/37 (04-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Request for Deferral of Examination 37 CFR 1.103(d)

Application Number		Art Unit	
Filing Date		Examiner Name	
First Named Inventor		Attorney Docket Number	

Address to: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby request deferral of examination under 37 CFR 1.103(d) for the above-identified (non-reissue) utility or plant application filed under 37 CFR 1.53(b) for a period of _____ months (maximum 3 years), from the earliest filing date for which a benefit is claimed. Deferral of examination under 37 CFR 1.103(d) is suspension of action. As a result, any patent term adjustment may be reduced. See 37 CFR 1.704(c)(1).

***Note**: The request will not be granted unless the application is in condition for publication as provided in 37 CFR 1.211(c) and the Office has not issued either an Office action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.*

If applicant previously filed a nonpublication request under 37 CFR 1.213(a):

☐ I hereby rescind under 37 CFR 1.213(b) the previous filed request that the above-identified application not be published under 35 U.S.C. 122(b).

***Note**: Application will be scheduled for publication at 18 months from the earliest claimed filing date for which a benefit is claimed.*

Fees

a. ☐ The Director is hereby authorized to charge the following fees, or credit any overpayment, to Deposit Account No._____. I have enclosed a duplicative copy of this form for fee processing.

- i. ☐ Processing fee set forth in 37 CFR 1.17(i) for request for deferral of examination.
- Ii. ☐ Publication fee set forth in 37 CFR 1.18(d).
- Iii. ☐ Processing fee set forth in 37 CFR 1.17(i) for voluntary publication.
- iv. ☐ Other _____.

b. ☐ Check in the amount of $_____ is enclosed.

c. ☐ Payment by credit card (*Form PTO-2038 enclosed*).

WARNING: Information in this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

***Note**: The publication fee set forth in 37CFR 1.18(d) and the processing fee in 37 CFR 1.17(i) for deferral of examination are required when the request of deferral of examination is filed.*

Signature		Date	
Name (Print/Typed)		Registration Number	

***Note**: Signature of all the inventors or assignees of record of the entire interest or their representative(s) are inquired. Submit multiple forms for more than one signature, see below*.*

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.103(d). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee [R-3]

Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant. See *Ex parte Jones*, 1924 C.D. 59, 327 O.G. 681 (Comm'r Pat. 1924).

Because of this, where one of several applications of the same inventor which contain overlapping claims gets into an interference, it was formerly the practice to suspend action by the Office on the applications not in the interference in accordance with *Ex parte McCormick*, 1904 C.D. 575, 113 O.G. 2508 (Comm'r Pat 1924).

However, the better practice would appear to be to reject claims in an application related to another application in interference over the counts of the interference and in the event said claims are not canceled in the outside application, prosecution of said application should be suspended pending the final determination of priority in the interference. See MPEP *>Chapter 2300<.

If, on the other hand, applicant wishes to prosecute the outside application, and presents good reasons in support, prosecution should be continued. *Ex parte Bullier*, 1899 C.D. 155, 88 O.G. 1161 (Comm'r Pat 1899); *In re Seebach*, 88 F.2d 722, 33 USPQ 149 (CCPA 1937); *In re Hammell*, 332 F.2d 796, 141 USPQ 832 (CCPA 1964). See MPEP § 804.03.

710 Period for Reply

35 U.S.C. 133. Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

35 U.S.C. 267. Time for taking action in Government applications.

Notwithstanding the provisions of sections 133 and 151 of this title, the Director may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Director that the invention disclosed therein is important to the armament or defense of the United States.

See MPEP Chapter 1200 for period for reply when appeal is taken or court review sought.

Extension of time under 35 U.S.C. 267 is decided by the Technology Center Director of work group 3640.

710.01 Statutory Period [R-3]

37 CFR 1.135. Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

The maximum statutory period for reply to an Office action is 6 months. 35 U.S.C. 133. Shortened periods are currently used in practically all cases. See MPEP § 710.02(b).

37 CFR 1.135 provides that if no reply is filed within the time set in the Office action under 37 CFR 1.134 or as it may be extended under 37 CFR 1.136, the application will be abandoned unless an Office action indicates**>otherwise<.

37 CFR 1.135(b) specifies that: (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.135(c) was amended to change the practice of providing a non-statutory time limit (generally 1 month) during which an applicant may supply an omission to a previous reply. Under the current practice, the examiner may set a shortened statutory time period (generally 1 month) during which an

applicant must supply the omission to the previous reply to avoid abandonment.

The prior practice under 37 CFR 1.135(c) was to set a time limit during which the applicant could supply the omission to the previous reply. Failure to supply the omission resulted in the abandonment of the application as of the due date for the previous reply. Filing a new application during the time limit, but beyond the due date for the previous reply, could have caused a loss of patent rights due to the lack of copendency between the applications.

37 CFR 1.135(c) now authorizes the examiner to accept a reply to a non-final Office action that is *bona fide* and is substantially complete but for an inadvertent omission as an adequate reply to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135. When a *bona fide* attempt to reply includes an inadvertent omission that precludes action on the merits of the application (e.g., an amendment is unsigned or improperly signed, or presents an amendment with additional claims so as to require additional fees pursuant to 37 CFR 1.16(*>h<), (*>i<), or (*>j<)), the examiner may consider that reply adequate to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135, and give the applicant a shortened statutory time period of 1 month to correct the omission (e.g ., provide a duplicate paper or ratification, or submit the additional claims fees or cancel the claims so that no fee is due). The failure to timely supply the omission will result in abandonment under 35 U.S.C. 133 and 37 CFR 1.135. Extensions of time under 37 CFR 1.136(a) or (b) will be available, unless the action setting the shortened statutory period indicates otherwise.

When a *bona fide* attempt to reply includes an omission that does not preclude action on the merits of the application (e.g., a reply fails to address a rejection or objection), the examiner may waive the deficiency in the reply and act on the application. The examiner may repeat and make final the rejection, objection, or requirement that was the subject of the omission. Thus, a reply to a non-final Office action that is *bona fide* but includes an omission may be treated by: (A) issuing an Office action that does not treat the reply on its merits but requires the applicant to supply the omission to avoid abandonment; or (B) issuing an Office action that does treat the reply on its merits (and which can also require the applicant to supply the omission to avoid abandonment).

Finally, whether a 1-month shortened statutory time period is provided to the applicant to supply the omission to the previous reply is within the discretion of the examiner. Where the examiner determines that the omission was not inadvertent (e.g., the applicant is abusing the provisions of 37 CFR 1.135(c) to gain additional time to file a proper reply or to delay examination of the application), the examiner should notify the applicant of the omission in the reply and advise the applicant that the omission to the previous reply must be supplied within the period for reply to the prior action, including extensions of time under 37 CFR 1.136(a), if permitted. See also MPEP § 714.03.

710.01(a) Statutory Period, How Computed

The actual time taken for reply is computed from the date stamped or printed on the Office action to the date of receipt by the Office of applicant's reply. No cognizance is taken of fractions of a day and applicant's reply is due on the corresponding day of the month 6 months or any lesser number of months specified after the Office action.

For example, reply to an Office action with a 3-month shortened statutory period dated November 30 is due on the following February 28 (or 29 if it is a leap year), while a reply to an Office action dated February 28 is due on May 28 and not on the last day of May. *Ex parte Messick*, 7 USPQ 57 (Comm'r Pat. 1930).

A 1-month extension of time extends the time for reply to the date corresponding to the Office action date in the following month. For example, a reply to an Office action mailed on January 31 with a 3-month shortened statutory period would be due on April 30. If a 1-month extension of time were given, the reply would be due by May 31. The fact that April 30 may have been a Saturday, Sunday, or Federal holiday has no effect on the extension of time. Where the period for reply is extended by some time period other than "1-month" or an even multiple thereof, the person granting the extension should indicate the *date* upon which the extended period for reply will expire.

When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of

the date the period for reply expired. In the above example where May 31 is not a Saturday, Sunday, or Federal holiday and no further extensions of time are obtained prior to the end of the 6-month statutory period, the application would be abandoned as of June 1. The fact that June 1 may be a Saturday, Sunday, or Federal holiday does not change the abandonment date since the reply was due on May 31, a business day. See MPEP § 711.04(a) regarding the pulling and forwarding of abandoned applications.

A 30-day period for reply in the Office means 30 calendar days including Saturdays, Sundays, and federal holidays. However, if the period ends on a Saturday, Sunday, or Federal holiday, the reply is timely if it is filed on the next succeeding business day. If the period for reply is extended, the time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

The date of receipt of a reply to an Office action is given by the "Office date" stamp which appears on the reply paper.

In some cases the examiner's Office action does not determine the beginning of a statutory reply period. In all cases where the statutory reply period runs from the date of a previous action, a statement to that effect should be included.

Since extensions of time are available pursuant to 37 CFR 1.136(a), it is incumbent upon applicants to recognize the date for reply so that the proper fee for any extension will be submitted. Thus, the date upon which any reply is due will normally be indicated only in those instances where the provisions of 37 CFR 1.136(a) are not available. See MPEP Chapter 2200 for reexamination proceedings.

710.02 Shortened Statutory Period and Time Limit Actions Computed [R-3]

37 CFR 1.136. Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

**>

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or

(v) The application is involved in a contested case 41.101(§ (a) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences.<

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

**>

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Inter-

ferences. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).<

(c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

(1) The period for submitting an oath or declaration in compliance with § 1.63;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

37 CFR 1.136 implements 35 U.S.C. 41(a)(8) which directs the Director of the USPTO to charge fees for extensions of time to take action in patent applications.

Under 37 CFR 1.136 (35 U.S.C. 133) an applicant may be required to reply in a shorter period than 6 months, not less than 30 days. Some situations in which shortened periods for reply are used are listed in MPEP § 710.02(b).

In other situations, for example, the rejection of a copied patent claim, the examiner may require applicant to reply on or before a specified date. These are known as time limit actions and are established under authority of 35 U.S.C. 2 and 3. Some situations in which time limits are set are noted in MPEP § 710.02(c). The time limit requirement should be typed in capital letters where required.

An indication of a shortened time for reply should appear prominently on the first page of all copies of actions in which a shortened time for reply has been set so that a person merely scanning the action can easily see it.

Shortened statutory periods are subject to the provisions of 37 CFR 1.136(a) unless applicant is notified otherwise in an Office action. See MPEP § 710.02(e) for a discussion of extensions of time. See Chapter 2200 for *ex parte* reexamination proceedings and Chapter 2600 for *inter partes* reexamination proceedings.

710.02(b) Shortened Statutory Period: Situations in Which Used [R-3]

Under the authority given him or her by 35 U.S.C. 133, the Director of the USPTO has directed the examiner to set a shortened period for reply to every action. The length of the shortened statutory period to be used depends on the type of reply required. Some specific cases of shortened statutory periods for reply are given below. These periods may be changed under special, rarely occurring circumstances.

A shortened statutory period may not be less than 30 days (35 U.S.C. 133).

1 MONTH (NOT LESS THAN 30 DAYS)

(A) Requirement for restriction or election of species only (no action on the merits) ..... MPEP § 809.02(a) and § 817.

(B) When a reply by an applicant for a nonfinal Office action is *bona fide* but includes an inadvertent omission, the examiner may set a 1 month (not less than 30 days) shortened statutory time period to correct the omission .... MPEP § 710.01 and § 714.03.

2 MONTHS

(A) Winning party in a terminated interference to reply to an unanswered Office action ..... MPEP *>Chapter 2300<.

Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered Office action, final rejection or any other action, the primary examiner notifies the applicant of this fact. In this case reply to the Office action is required within a shortened statutory period running from the date of such notice. See *Ex parte Peterson*, 49 USPQ 119, 1941 C.D. 8, 525 O.G. 3 (Comm'r Pat. 1941).

(B) To reply to an *Ex parte Quayle* Office action ..... MPEP § 714.14.

When an application is in condition for allowance, except as to matters of form, such as correction of the specification, a new oath, etc., the application will be considered special and prompt action taken to require correction of formal matters. Such action should include an indication on the Office Action Summary form PTOL-326 that prosecution on the merits is closed in accordance with the decision in *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). A 2-month shortened statutory period for reply should be set.

(C) Multiplicity rejection — no other rejection ..... MPEP § 2173.05(n).

3 MONTHS

To reply to any Office action on the merits.

PERIOD FOR REPLY RESTARTED

Where the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. See MPEP § 710.06.

710.02(c) Specified Time Limits: Situations in Which Used [R-3]

There are certain situations in which the examiner specifies a time for the applicant to take some action, and the applicant's failure to timely take the specified action results in a consequence other than abandonment. Situations in which a specified time limit for taking an action is set are as follows:

(A) Where a member of the public files a petition under 37 CFR 1.14(a) for access to an application, the Office may give the applicant a specified time (usually 3 weeks) within which to state any objections to the granting of the petition for access and the reasons why it should be denied. The failure to timely reply will not affect the prosecution of the application (assuming that it is still pending), but will result in the Office rendering a decision on the petition for access without considering any objections by the applicant. See MPEP § 103.

(B) Where an information disclosure statement complies with the requirements set forth in 37 CFR 1.97 (including the requirement for fees or statement under 37 CFR 1.97(e) based upon the time of filing), but part of the content requirement of 37 CFR 1.98 has been inadvertently omitted, the examiner may set a 1-month time limit for completion of the information disclosure statement. The failure to timely comply will not result in abandonment of the application, but will result in the information disclosure statement being placed in the application file with the noncomplying information not being considered. See MPEP § 609.05(a).

(C) Where an application is otherwise allowable but contains a traverse of a restriction requirement, the applicant may be given a specified time (e.g., a 1-month time limit) to cancel claims to the nonelected invention or species or take other appropriate action (i.e., petition the restriction requirement under 37 CFR 1.144). The failure to timely file a petition under 37 CFR 1.144 (or cancel the claims to the non-elected invention or species) will not result in abandonment of the application, but will be treated as authorization to cancel the claims to the non-elected invention or species, and the application will be passed to issue. See 37 CFR 1.141 and 1.144, and MPEP ** § 821.01 >and § 821.04(a)<.

(D) A portion of 37 CFR *>41.202(c)< provides that in suggesting claims for interference:

> **>An examiner may require an applicant to add a claim to provoke an interference. Failure to satisfy the requirement within a period (not less than one month) the examiner sets will operate as a concession of priority for the subject matter of the claim.<

The failure to timely present the suggested claim will not result in abandonment of the application, but will be treated as a **>concession by the applicant of the priority of the subject matter of the claim<. See MPEP *>Chapter 2300<.

Where the failure to take the specified action may result in abandonment (e.g., filing a new complete appeal brief correcting the deficiencies in a prior appeal brief), a time period should be set for taking the specified action. Where the condition of the application requires that such action not be subject to extensions under 37 CFR 1.136, the action should specify that the provisions of 37 CFR 1.136 (or 1.136(a)) do not apply to the time period for taking action (i.e., a specified time limit should not be set simply to exclude the possibility of extending the period for reply under 37 CFR 1.136).

710.02(d) Difference Between Shortened Statutory Periods for Reply and Specified Time Limits [R-3]

Examiners and applicants should not lose sight of the distinction between a specified time for a particular action and a shortened statutory period for reply under 35 U.S.C. 133:

(A) The penalty attaching to failure to take a particular action within a specified time is a loss of rights in regard to the particular matter (e.g., the failure to

timely copy suggested claims results in a disclaimer of the involved subject matter). On the other hand, a failure to reply within the set statutory period under 35 U.S.C. 133 results in abandonment of the entire application. Abandonment of an application is not appealable, but a petition to revive may be granted if the delay was unavoidable (37 CFR 1.137(a)) or unintentional (37 CFR 1.137(b)).

(B) As a specified time or time limit is not a shortened statutory period under 35 U.S.C. 133, the Office may specify a time for taking action (or a time limit) of less than the 30 day minimum specified in 35 U.S.C. 133. See MPEP § 103.

(C) Where an applicant replies a day or two after the specified time, the delay may be excused by the examiner if satisfactorily explained. The examiner may use his or her discretion to request an explanation for the delay if the reason for the delay is not apparent from the reply. A reply 1 day late in an application carrying a shortened statutory period under 35 U.S.C. 133, no matter what the excuse, results in abandonment. Extensions of the statutory period under 35 U.S.C. 133 may be obtained under 37 CFR 1.136, provided the extension does not go beyond the 6-month statutory period from the date of the Office action (35 U.S.C. 133).

The 2-month time period for filing an appeal brief on appeal to the Board of Patent Appeals and Interferences (37 CFR *>41.37(a)<) and the 1-month time period for filing a new appeal brief to correct the deficiencies in a defective appeal brief (37 CFR *>41.37(d)<) are time periods, but are not (shortened) statutory periods for reply set pursuant to 35 U.S.C. 133. Thus, these periods are, unless otherwise provided, extendable by up to 5 months under 37 CFR 1.136(a), and, in an exceptional situation, further extendable under 37 CFR 1.136(b) (i.e., these periods are not statutory periods subject to the 6-month maximum set in 35 U.S.C. 133). In addition, the failure to file an appeal brief (or a new appeal brief) within the time period set in 37 CFR *>41.37(a)< (or (d)) results in dismissal of the appeal. The dismissal of an appeal results in abandonment, unless there is any allowed claim(s) (see MPEP § 1215.04), in which case the examiner should cancel the nonallowed claims and allow the application.

The 2-month time period for reply to A Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions of time of up to 5 months under 37 CFR 1.136(a), followed by additional time under 37 CFR 1.136(b), when appropriate, are permitted.

710.02(e) Extension of Time [R-3]

37 CFR 1.136. Extensions of time.

(a)(1)If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

**>

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or

(v) The application is involved in a contested case 41.101(§ (a) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings, § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences.<

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

**>

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g).<

(c) If an applicant is notified in a "Notice of Allowability" that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the "Notice of Allowability" or in an Office action having a mail date on or after the mail date of the "Notice of Allowability":

(1) The period for submitting an oath or declaration in compliance with § 1.63;

(2) The period for submitting formal drawings set under § 1.85(c); and

(3) The period for making a deposit set under § 1.809(c).

37 CFR 1.136 provides for two distinct procedures to extend the period for action or reply in particular situations. The procedure which is available for use in a particular situation will depend upon the circumstances. 37 CFR 1.136(a) permits an applicant to file a petition for extension of time and a fee as set forth in 37 CFR 1.17(a) up to 5 months after the end of the time period set to take action except:

(A) where prohibited by statute,

(B) where prohibited by one of the items listed in the rule, or

(C) where applicant has been notified otherwise in an Office action.

The petition and fee must be filed within the extended time period for reply requested in the petition and can be filed prior to, with, or without the reply. The filing of the petition and fee will extend the time period to take action up to 5 months dependent on the amount of the fee paid except in those circumstances noted above. 37 CFR 1.136(a) will effectively reduce the amount of paperwork required by applicants and the Office since the extension will be effective upon filing of the petition and payment of the appropriate fee and without acknowledgment or action by the Office and since the petition and fee can be filed with or without the reply. 37 CFR 1.136(b) provides for requests for extensions of time upon a showing of sufficient cause when the procedure of 37 CFR 1.136(a) is not available. Although the petition and fee procedure of 37 CFR 1.136(a) will normally be available within 5 months after a set period for reply has expired, an extension request for cause under 37 CFR 1.136(b) must be filed during the set period for reply. Extensions of time in interference proceedings are governed by 37 CFR *>41.4(a)<.

It should be very carefully noted that neither the primary examiner nor the Director of the USPTO has authority to extend the shortened statutory period unless a petition for the extension is filed. While the shortened period may be extended within the limits of the statutory 6 months period, no extension can operate to extend the time beyond the 6 months.

Any request under 37 CFR 1.136(b) for extension of time for reply must state a reason in support thereof >and supply the fee under 37 CFR 1.17(g)<. Such extensions will only be granted for sufficient cause and must be filed prior to the end of the set period for reply.

Extensions of time with the payment of a fee pursuant to 37 CFR 1.136>(a)< are possible in reply to most Office actions of the examiner. Exceptions include:

(A) all extensions in a reexamination proceeding (see 37 CFR 1.550(c) and MPEP § 2265)>for *ex parte* reexamination, and 37 CFR 1.956 and MPEP § 2665 for *inter partes* reexamination<;

(B) all extensions during an interference proceeding (but not preparatory to an interference where a claim is suggested for interference);

(C) those specific situations where an Office action states that the provisions of 37 CFR 1.136(a) are not applicable (e.g., reply to a notice of allowability, in reissue applications associated with litigation, or where an application in allowable condition has nonelected claims and time is set to cancel such claims); and

(D) those limited instances where applicant is given a specified time limit to take certain actions.

The fees for extensions of time >under 37 CFR 1.136(a)< are set forth in 37 CFR 1.17(a) and are sub-

ject to a 50% reduction for persons or concerns qualifying as small entities. The fees itemized at 37 CFR 1.17(a) are cumulative. Thus, if an applicant has paid an extension fee in the amount set forth in 37 CFR 1.17(a)(l) for a 1-month extension of time and thereafter decides that an additional 1 month is needed, the proper fee would be the amount set forth in 37 CFR 1.17(a)(2) less the amount set forth in 37 CFR 1.17(a)(l) which was previously paid.

37 CFR 1.136(a)(3) provides that:

(A) a written request may be submitted in an application that is an authorization to treat any concurrent or future reply that requires a petition for an extension of time under 37 CFR 1.136(a) to be timely, as incorporating a petition for extension of time for the appropriate length of time;

(B) an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under 37 CFR 1.136(a) to be timely; and

(C) submission of the fee set forth in 37 CFR 1.17(a) will be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under 37 CFR 1.136(a) to be timely.

This is a change in practice, in that applicants were previously required to file a petition (some writing that manifested an intent to obtain an extension of time) in reply to the Office action for which the extension was requested.

37 CFR 1.136(a)(3) is a "safety net" to avoid a potential loss of patent rights for applicants who inadvertently omitted a petition, but who had:

(A) previously filed a written request to treat a reply requiring an extension of time as incorporating a petition for such extension of time;

(B) previously filed an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees; or

(C) submitted the fee set forth in 37 CFR 1.17(a) with the reply.

The Office strongly recommends including a written petition for any desired extension of time in reply to the Office action for which the extension was requested to avoid processing delays.

A proper petition may be only a few sentences such as

> The applicant herewith petitions the Director of the United States Patent and Trademark Office to extend the time for reply to the Office action dated ____ for ____ month(s) from ____ to ____ . Submitted herewith is a check for $____ to cover the cost of the extension [Please Charge my deposit account number ____ , in the amount of $ ____ to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.]

37 CFR 1.136(a)(2) provides, in part, that "[t]he date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee." Thus, a petition under 37 CFR 1.136(a) need not be accompanied by a reply (e.g., in situations in which the extension is necessary for copendency with a continuing application). 37 CFR 1.136(a)(2), however, clarifies that "[a] reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application" under 35 U.S.C. 133 and 37 CFR 1.135 (e.g., where the extension is obtained solely for the purpose of copendency with a continuing application, and no reply is filed, the application will become abandoned upon expiration of the so-extended period for reply).

While a petition for an extension of time under 37 CFR 1.136(a) must be filed within the extended period for reply, the petition need not be filed within the original shortened statutory period for reply. If a petition for an extension of time under 37 CFR 1.136(a) (with or without a reply) requests an insufficient period of extension such that the petition would be filed outside the so-extended period for reply, but the period for reply could be further extended under 37 CFR 1.136(a) such that the petition would be filed within the further extended period for reply, it is Office practice to simply treat the petition for extension of time as requesting the period of extension necessary to make the petition filed within the further extended period for reply if the petition or application contains an authorization to charge extension fees or fees under 37 CFR 1.17 to a deposit account. That is, in such situations a petition for an extension of time under 37 CFR 1.136(a) is simply construed as requesting the appropriate period of extension. For

example, if a petition (and requisite fee) for a two-month extension of time containing an authorization to charge fee deficiencies to a deposit account are filed in an application four and one-half months after the date a notice of appeal was filed in that application, it is Office practice to treat the petition as requesting the period of extension (three months) necessary to make the petition filed within the extended period for reply. This practice applies even if no further reply (appeal brief or continued prosecution application (CPA) under 37 CFR 1.53(d)) is filed in the application to be treated as a constructive petition for an extension of time under 37 CFR 1.136(a)(3).

To facilitate processing, any petition for an extension of time (or petition to revive under 37 CFR 1.137) in which a continuing application is filed in lieu of a reply should specifically refer to the filing of the continuing application and also should include an express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

Applicants are cautioned that an extension of time will not be effected in the prior application by filing a petition for an extension of time, extension fee, or fee authorization, in the continuing application. This is because the petition for an extension of time (or constructive petition under 37 CFR 1.136(a)(3)) must be directed toward and filed in the application to which it pertains in accordance with 37 CFR 1.4 and 1.5.

Where a reply is filed after the set period for reply has expired and no petition or fee accompanies it, the reply will not be accepted as timely until the petition (which may be a constructive petition under 37 CFR 1.136(a)(3)) and the appropriate fee are submitted. For example, if an Office action sets a 3-month period for reply and applicant replies in the 4th month and includes only the petition for a 1-month extension of time, the reply is not acceptable until the fee is filed. If the fee is not filed until the 5th month, an additional fee for the 2nd month extension would also be required in order to render the reply timely.

An extension of time under 37 CFR 1.136 is not necessary when submitting a supplemental reply to an Office action if a complete first reply was timely filed in reply to the Office action.

When the provisions of 37 CFR 1.136(a) are not applicable, extensions of time for cause pursuant to 37 CFR 1.136(b) may be possible. Any such extension must be filed on or before the day on which the reply is due. The mere filing of such a request will not effect any extension. All such requests are to be decided by the Technology Center (TC) Director. No extension can operate to extend the time beyond the 6-month statutory period. Extensions of time under 37 CFR 1.136(b) (or 37 CFR 1.136(a)) are not available to extend the time period set in a Notice of Allowability, or in an Office action having a mail date after the mail date of the Notice of Allowability, to submit an oath or declaration in compliance with 37 CFR 1.63, to submit formal drawings, or to make a deposit of biological material.

If a request for extension of time under 37 CFR 1.136(b) is filed in duplicate and accompanied by a stamped return-addressed envelope, the Office will indicate the action taken on the duplicate and return it promptly in the envelope. For Image File Wrapper (IFW) processing, see IFW Manual. Utilization of this procedure is optional on the part of applicant. In this procedure, the action taken on the request should be noted on the original and on the copy which is to be returned. The notation on the original, which becomes a part of the file record, should be signed by the person granting or denying the extension, and the name and title of that person should also appear in the notation on the copy which is returned to the person requesting the extension.

When the request is granted, no further action by the Office is necessary. When the request is granted in part, the extent of the extension granted will be clearly indicated on both the original and on the copy which is to be returned. When the request is denied, the reason for the denial will be indicated on both the original and on the copy which is to be returned or a formal decision letter giving the reason for the denial will be forwarded promptly after the mailing of the duplicate.

If the request for extension of time is granted, the due date is computed from the date stamped or printed on the action, as opposed to the original due date. See MPEP § 710.01(a). For example, a reply to an action with a 3-month shortened statutory period, dated November 30, is due on the following February 28 (or 29, if it is a leap year). If the period for reply is

extended an additional month, the reply becomes due on March 30, not on March 28.

Hand-carried requests for extensions of time will no longer be accepted in the TCs. Hand-carried requests for extensions of time may only be delivered to the Customer Window, which is located at:

U.S. Patent and Trademark Office
**>Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314<

Applicant should be advised promptly regarding action taken on the request for extension of time under 37 CFR 1.136(b) so that the file record will be complete.

Form paragraphs 7.98 or 7.98.01 may be used where a reply is filed late but an extension of time is possible.

¶ *7.98 Reply Is Late, Extension of Time Suggested*

Applicant's reply was received in the Office on **[1]**, which is after the expiration of the period for reply set in the last Office action mailed on **[2]**. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office action under 37 CFR 1.136(a).

Examiner Note:

Since the provisions of 37 CFR 1.136(a) do not apply to reexamination proceedings or to litigation related reissue applications, do not use this form paragraph in these cases.

**>

¶ *7.98.01 Reply Is Late, Extension of Time Suggested, Pro Se*

Applicant's reply to the Office Action of **[1]** was received in the Patent and Trademark Office on **[2]**, which is after the expiration of the period for reply set in the above noted Office action. The application will become abandoned unless applicant obtains an extension of the period for reply set in the above noted Office action. An extension of the reply period may be obtained by filing a petition under 37 CFR 1.136(a). The petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(a) (copy of current fee schedule attached). The date on which the reply, the petition, and the fee have been filed is the date of the reply and also the date for purposes of determining the period of extension and the corresponding amount of the fee due. The expiration of the time period is determined by the amount of the fee paid. Applicant is advised that in no case can any extension carry the date for reply to an Office action beyond the maximum period of SIX MONTHS set by statute. Additionally, extensions may not be granted under 37 CFR 1.136(a) for more than FIVE MONTHS beyond the time period set in an Office action.

Examiner Note:

Enclose a photocopy of current fee schedule with action so that applicant can determine the required fee.

<

I. FINAL REJECTION — TIME FOR REPLY

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection.

> A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, if a petition for extension of time is granted, the due date for a reply is computed from the date stamped or printed on the Office action with the final rejection. See MPEP § 710.01(a). If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner

mails the advisory action and any extension of time fee may be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than 6 months from the mailing date of the final Office action.

See also MPEP § 706.07(f).

II. EXTENSIONS OF TIME TO SUBMIT AFFIDAVITS AFTER FINAL REJECTION

Frequently, applicants request an extension of time, stating as a reason therefor that more time is needed in which to submit an affidavit. When such a request is filed after final rejection, the granting of the request for extension of time is without prejudice to the right of the examiner to question why the affidavit is now necessary and why it was not earlier presented. If applicant's showing is insufficient, the examiner may deny entry of the affidavit, notwithstanding the previous grant of an extension of time to submit it. The grant of an extension of time in these circumstances serves merely to keep the application from becoming abandoned while allowing the applicant the opportunity to present the affidavit or to take other appropriate action. Moreover, prosecution of the application to save it from abandonment must include such timely, complete and proper action as required by 37 CFR 1.113. The admission of the affidavit for purposes other than allowance of the application, or the refusal to admit the affidavit, and any proceedings relative thereto, shall not operate to save the application from abandonment.

Implicit in the above practice is the fact that affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection. **>See 37 CFR 1.116(c).<.

Failure to file a reply during the shortened statutory period results in abandonment of the application.

Extensions of time to appeal to the courts under 37 CFR 1.304 is covered in MPEP § 1216.

III. NO EXTENSIONS OF TIME AFTER PAYMENT OF ISSUE FEE

The statutory (nonextendable) time period for payment of the issue fee is 3 months from the date of the Notice of Allowance (35 U.S.C. 151). In situations where informalities such as drawing corrections or submission of supplemental or corrected declarations are outstanding at the time of allowance, applicants will be notified on the PTOL-37 (Notice of Allowability) of such informalities. Extensions of time under 37 CFR 1.136(a) or (b) are NOT available to correct such informalities. Any such informalities must be corrected and the issue fee and the publication fee, if required, must be paid within the 3-month period.

710.04 Two Periods Running [R-3]

There sometimes arises a situation where two different periods for reply are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception involving suggested claims, see MPEP *>Chapter 2300<.

710.04(a) Copying Patent Claims [R-3]

Where, in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for reply are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for reply to the rejection (either first or final). The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. See *Ex parte Milton*, 63 USPQ 132 (P.O. Super Exam. 1938). See also MPEP *>Chapter 2300<.

710.05 Period Ending on Saturday, Sunday, or a Federal Holiday

35 U.S.C. 21. Filing date and day for taking action.

*****

(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia the action may be taken, or the fee paid, on the next succeeding secular or business day.

37 CFR 1.7. Times for taking action; Expiration on Saturday, Sunday, or Federal holiday.

(a) Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or

paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

(b) If the day that is twelve months after the filing date of a provisional application under 35 U.S.C. 111(b) and § 1.53(c) falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the period of pendency shall be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday.

The Federal holidays under 5 U.S.C. 6103(a) are New Year's Day, January 1; Martin Luther King's birthday, the third Monday in January; Washington's Birthday, the third Monday in February; Memorial Day, the last Monday in May; Independence Day, July 4; Labor Day, the first Monday in September; Columbus Day, the second Monday in October; Veteran's Day, November 11; Thanksgiving Day, the fourth Thursday in November; and Christmas Day, December 25. Whenever a Federal holiday falls on a Sunday, the following day (Monday) is also a Federal holiday. Exec. Order No. 10,358, 17 Fed. Reg., 5269; 5 U.S.C. 6103.

When a Federal holiday falls on a Saturday, the preceding day, Friday, is considered to be a Federal holiday and the U.S. Patent and Trademark Office will be closed for business on that day (5 U.S.C. 6103). Accordingly, any action or fee due on such a Federal holiday Friday or Saturday is to be considered timely if the action is taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

Pursuant to 5 U.S.C. 6103(c), Inauguration Day (January 20, every 4 years) "is a legal public holiday for the purpose of statutes relating to pay and leave of employees . . ." employed in the District of Columbia and surrounding areas. It further provides that when Inauguration Day falls on a Sunday, the next day selected for the observance of the Inauguration is considered a legal public holiday for purposes of this subsection. No provision is made for an Inauguration Day falling on a Saturday.

When an amendment is filed a day or two later than the expiration of the period fixed by statute, care should be taken to ascertain whether the last day of that period was Saturday, Sunday, or a Federal holiday and if so, whether the amendment was filed or the fee paid on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

An amendment received on such succeeding day which was due on Saturday, Sunday, or Federal holiday is endorsed on the file wrapper with the date of receipt. The Saturday, Sunday, or Federal holiday is also indicated.

The period of pendency of a provisional application will be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday, if the day that is twelve months after the filing date of the provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c) falls on Saturday, Sunday, or a Federal holiday within the District of Columbia. See 35 U.S.C. 119(e)(3) and MPEP § 201.04(b).

710.06 Situations When Reply Period Is Reset or Restarted [R-3]

Where the citation of a reference is incorrect or an Office action contains some other *>error that affects applicant's ability to reply to the Office action< and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to remail any action (MPEP § 707.13), the action should be correspondingly redated, as it is the remailing date that establishes the beginning of the period for reply. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924). For Image File Wrapper (IFW) processing, see IFW Manual.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons

more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be restarted and any appropriate extension fee will be required to render a reply timely. The Office letter correcting the error will note that the time period for reply remains as set forth in the previous Office action.

See MPEP § 505, § 512, and § 513 for U.S. Patent and Trademark Office practice on date stamping documents.

In the event that correspondence from the Office is received late (A) due to delays in the U.S. Postal Service, or (B) because the mail was delayed in leaving the USPTO (the postmark date is later than the mail date printed on the correspondence), applicants may petition to reset the period for reply, which petition shall be evaluated according to the guidelines which follow. Where the Office action involved in the petition was mailed by a Technology Center (TC), the authority to decide such petitions has been delegated to the TC Director. See Notice entitled "Petition to reset a period for response due to late receipt of a PTO action," 1160 O.G. 14 (March 1, 1994).

I. PETITIONS TO RESET A PERIOD FOR REPLY DUE TO LATE RECEIPT OF AN OFFICE ACTION

The Office will grant a petition to restart the previously set period for reply to an Office action to run from the date of receipt of the Office action at the correspondence address when the following criteria are met:

(A) the petition is filed within 2 weeks of the date of receipt of the Office action at the correspondence address;

(B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g., at least 1 month of a 2- or 3-month reply period had elapsed); and

(C) the petition includes (1) evidence showing the date of receipt of the Office action at the correspondence address (e.g., a copy of the Office action having the date of receipt of the Office action at the correspondence address stamped thereon, a copy of the envelope (which contained the Office action) having the date of receipt of the Office action at the correspondence address stamped thereon, etc.), and (2) a statement setting forth the date of receipt of the Office action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the Office action at the correspondence address.

There is no statutory requirement that a shortened statutory period of longer than 30 days to reply to an Office action be reset due to delay in the mail or in the Office. However, when a substantial portion of the set reply period had elapsed on the date of receipt at the correspondence address (e.g., at least 1 month of a 2- or 3-month period had elapsed), the procedures set forth above for late receipt of action are available. Where an Office action was received with less than 2 months remaining in a shortened statutory period of 3 months the period may be restarted from the date of receipt. Where the period remaining is between 2 and 3 months, the period will be reset only in extraordinary situations, e.g., complex Office action suggesting submission of comparative data.

II. PETITIONS TO RESET A PERIOD FOR REPLY DUE TO A POSTMARK DATE LATER THAN THE MAIL DATE PRINTED ON AN OFFICE ACTION

The Office will grant a petition to restart the previously set period for reply to an Office action to run from the postmark date shown on the Office mailing envelope which contained the Office action when the following criteria are met:

(A) the petition is filed within 2 weeks of the date of receipt of the Office action at the correspondence address;

(B) the reply period was for payment of the issue fee, or the reply period set was 1 month or 30 days; and

(C) the petition includes (1) evidence showing the date of receipt of the Office action at the correspondence address (e.g., copy of the Office action having the date of receipt of the Office action at the correspondence address stamped thereon, etc.), (2) a copy of the envelope which contained the Office action showing the postmark date, and (3) a statement setting forth the date of receipt of the Office action at the cor-

respondence address and stating that the Office action was received in the postmarked envelope.

The provisions of 37 CFR 1.8 and 1.10 apply to the filing of the above-noted petitions with regard to the requirement that the petition be filed within 2 weeks of the date of receipt of the Office action.

The showings outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been delayed after receipt rather than a conclusion that the Office action was delayed in the mail or in the Office.

711 Abandonment of Patent Application [R-3]

37 CFR 1.135. Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

37 CFR 1.138. Express abandonment.

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this section including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicant should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application, in accordance with 37 CFR 1.135 and 1.138, is one which is removed from the Office docket of pending applications through:

(A) formal abandonment

(1) by the applicant (acquiesced in by the assignee if there is one),

(2) by the attorney or agent of record **, or

(3) by a registered attorney or agent acting in a representative capacity under 37 CFR 1.34(a) when filing a continuing application; or

(B) failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the application.

Where an applicant, himself or herself, formally abandons an application and there is a corporate assignee, the acquiescence must be made through an officer whose official position is indicated and is authorized to sign on behalf of the corporate assignee.

711.01 Express or Formal Abandonment [R-3]

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.

A letter of abandonment properly signed becomes effective when an appropriate official of the Office takes action thereon. When so recognized, the date of abandonment may be the date of recognition or a *>later< date if so specified in the letter itself. For

example, where a continuing application is filed with a request to abandon the prior application as of the filing date accorded the continuing application, the date of the abandonment of the prior application will be in accordance with the request once it is recognized.

>A letter of express abandonment or a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application (see 37 CFR 1.211(a)(1)) accompanied by the petition fee set forth in 37 CFR 1.17(h) may be:

(A) mailed to Mail Stop Express Abandonment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; or

(B) transmitted by facsimile transmission to the Pre-Grant Publication Division at (703) 305-8568.

Since a petition under 37 CFR 1.138(c) will not stop publication of the application unless it is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication, applicants should transmit the petition by facsimile transmission in all instances where the projected publication date is less than 3 months from the date of the petition. This will increase the chance of such petition being received by the appropriate officials in sufficient time to recognize the abandonment and remove the application from the publication process. If the issue fee has been paid, the letter of express abandonment should be directed to the Office of Petitions instead of the Pre-Grant Publication Division and be accompanied by a petition to withdraw an application from issue under 37 CFR 1.313(c). See subsection "I. After Payment of Issue Fee."<

Action in recognition of an express abandonment may take the form of an acknowledgment ** by the Publishing Division of the receipt of the express abandonment, indicating that it is in compliance with 37 CFR 1.138.

It is suggested that divisional applications be reviewed before filing to ascertain whether the prior application should be abandoned. Care should be exercised in situations such as these as the Office looks on express abandonments as acts of deliberation, intentionally performed.

Applications may be expressly abandoned as provided for in 37 CFR 1.138. When a letter expressly abandoning an application (not in issue) is received, the *>Office< should acknowledge receipt thereof, and indicate whether it does or does not comply with the requirements of 37 CFR 1.138.

The filing of a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) >in a design application< is considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application.

**

If the letter expressly abandoning the application does comply with 37 CFR 1.138, the *>Office personnel< should respond by using a "Notice of Abandonment" form PTO-1432, and by checking the appropriate box(es). ** If such a letter does not comply with the requirements of 37 CFR 1.138, a fully explanatory letter should be sent.

**

A letter of express abandonment which is not timely filed (because it was not filed within the period for reply), is not acceptable to expressly abandon the application. The letter of express abandonment should be ** placed in the application file but not formally entered. **

The application should be pulled for abandonment after expiration of the maximum permitted period for reply (see MPEP § 711.04(a)) and applicant notified of the abandonment for failure to reply within the statutory period. See MPEP § 711.02 and § 711.04(c).

In view of the doctrine set forth in *Ex parte Lasscell*, 1884 C.D. 66, 29 O.G. 861 (Comm'r Pat. 1884), an amendment canceling all of the claims, even though said amendment is signed by the applicant himself/herself and the assignee, is not an express abandonment. The Office, however, will not enter any amendment that would cancel all of the claims in an application without presenting any new or substitute claims. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001). Such an amendment is regarded as nonresponsive and is not a *bona fide* attempt to advance the application to final action. The practice set forth in 37 CFR 1.135(c) does not apply to such amendment. Applicant should be notified as explained in MPEP § 714.03 to § 714.05.

An attorney or agent not of record in an application may file a withdrawal of an appeal under 37 CFR 1.34(a) except in those instances where such with-

drawal would result in abandonment of the application. In such instances the withdrawal of appeal is in fact an express abandonment.

I. AFTER **>PAYMENT OF ISSUE FEE<

If a letter of express abandonment is being submitted in an allowed application >after the payment of the issue fee<, the express abandonment *>must< be accompanied by a petition to withdraw from issue under 37 CFR 1.313>(c)< and the fee set forth in 37 CFR 1.17(h). Also see MPEP § 1308. The express abandonment may not be recognized by the Office unless it is actually received by appropriate officials in time to withdraw the application from issue. **>A petition under 37 CFR 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate official before the date of issue. After< the issue fee has been paid, *>the application< will not be withdrawn upon petition by the applicant for any reason except those reasons listed in 37 CFR 1.313(c), which include express abandonment of the application. An application may be withdrawn from issue for express abandonment of the application in favor of a continuing application. The petition under 37 CFR 1.313>(c)< accompanied by the petition fee should be addressed to the Office of Petitions. If the petition and the letter of abandonment are received by appropriate officials in sufficient time to act on the petition and remove the application from the issue process, the letter of abandonment will be acknowledged by the Office of Patent Publication after the petition is granted. Petitions to withdraw an application from issue under 37 CFR 1.313(c) may be:

(A) mailed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450;

(B) transmitted by facsimile transmission to *>(571) 273-0025<; or

(C) hand-carried to the Office of Petitions, **>Madison West, 7th Floor, 600 Dulany Street, Alexandria, VA 22314. At the guard station in Madison West, the security guard should call the Office of Petitions at (571) 272-3282 for delivery assistance.<

Applicants are strongly encouraged to >either transmit by facsimile or< hand-carry the petition to the Office of Petitions to allow sufficient time to process the petition and if the petition can be granted, withdraw the application from issue.

See MPEP § 711.05 and § 1308. In cases where 37 CFR 1.313 precludes giving effect to an express abandonment, the appropriate remedy is a petition, with fee, under 37 CFR 1.183, showing an extraordinary situation where justice requires suspension of 37 CFR 1.313.

II. TO AVOID PUBLICATION OF APPLICATION

>A< petition under 37 CFR 1.138(c) will not stop publication of the application unless it is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication. The petition will be granted when it is recognized in sufficient time to avoid publication of the application. The petition will be denied when it is not recognized in time to avoid publication. Generally, a petition under 37 CFR 1.138(c) will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication. It is unlikely that a petition filed within four weeks of the projected date of publication will be effective to avoid publication. Also note that withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of an application under 35 U.S.C. 122(b). See 37 CFR 1.313(d).

>

III. < APPLICATION IN INTERFERENCE

A written declaration of abandonment of the application signed only by an attorney or agent of record, when the application sought to be expressly or formally abandoned is the subject of an interference proceeding under 35 U.S.C. 135, is not effective to terminate the interference, and will not be considered until after *ex parte* prosecution is resumed. In order to be effective to terminate an interference proceeding, an abandonment of the application must be signed by the inventor with the written consent of the assignee where there has been an assignment.

IV. FORM FOR FILING EXPRESS ABANDONMENT

**>Form PTO/SB/24 may be used for filing a letter of express abandonment or a letter of express abandonment in favor of a continuing application. Form PTO/SB/24A may be used for filing a petition for express abandonment under 37 CFR 1.138(c) to avoid publication of the application.<

**>

PTO/SB/24 (06-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

EXPRESS ABANDONMENT UNDER 37 CFR 1.138

Fax directly to the Pre-Grant Publication Division at (703) 305-8568; or mail to: Mail Stop Express Abandonment
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

Please **check only one** of boxes 1 or 2 below:
(If no box is checked, this paper will be treated as a request for express abandonment as of the filing date of this paper.)

1. ☐ **Express Abandonment**
I request that the above-identified application be expressly abandoned as of the filing date of this paper.

2. ☐ **Express Abandonment in Favor of a Continuing Application**
I request that the above-identified application be expressly abandoned as of the filing date accorded the continuing application filed previously or herewith.

NOTE: A paper requesting express abandonment of an application is not effective unless and until an appropriate USPTO official recognizes and acts on the paper. See the Manual of Patent Examining Procedure (MPEP), section 711.01.

TO AVOID PUBLICATION, PLEASE USE FORM PTO/SB/24A INSTEAD OF THIS FORM.

I am the:
☐ applicant.
☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
☐ attorney or agent of record. Registration Number _____
☐ attorney or agent acting under 37 CFR 1.34 (may act under 37 CFR 1.34 only if box 2 above, stating that the application is expressly abandoned in favor of a continuing application, is checked). Attorney or agent registration number if acting under 37 CFR 1.34. _____.
(Attorney or agent registration number)

_____ Signature
_____ Date
_____ Typed or printed name
_____ Telephone Number

Note: Signature of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.
☐ Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process an application). Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Express Abandonment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/24A (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR EXPRESS ABANDONMENT TO AVOID PUBLICATION UNDER 37 CFR 1.138(c)

Fax the petition directly to the Pre-Grant Publication Division at (703) 305-8568
Or **Mail** the petition to:
Mail Stop Express Abandonment
Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

Petition for Express Abandonment to Avoid Publication under 37 CFR 1.138(c)

I hereby petition to expressly abandon the above-identified application to avoid publication.

Petition Fee – must be filed with petition to avoid delays in recognizing the petition.

a. ☐ The Director is hereby authorized to charge the petition fee under 37 CFR 1.17(h) to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.

b. ☐ Check in the amount of $ _____ is enclosed.

c. ☐ Payment by credit card (Form PTO-2038 is enclosed).

NOTE: A paper requesting express abandonment of an application is not effective unless and until an appropriate USPTO official recognizes and acts on the paper. See the Manual of Patent Examining Procedure (MPEP), section 711.01. In addition, the paper will not stop publication of the application unless a petition under 37 CFR 1.138(c) is recognized and acted on by the Pre-Grant Publication Division in sufficient time to avoid publication (e.g., more than four (4) weeks prior to the projected publication date).

I am the: ☐ applicant.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☐ attorney or agent of record. Registration Number _____

_____ _____
Signature Date

_____ _____
Typed or printed name Telephone Number

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.138(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, **P.O. Box 1450**, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Express Abandonment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO 9199 and select option 2.

<

711.02 Failure To Take Required Action During Statutory Period [R-3]

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to reply" to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a "complete and proper reply, as the condition of the case may require" within the statutory period (37 CFR 1.135(b)).

When an amendment is filed after the expiration of the statutory period, the application is abandoned and the remedy is to petition to revive it. The examiner should notify the applicant or attorney at once that the application has been abandoned by using Notice of Abandonment form PTOL-1432. The proper boxes on the form should be checked and the blanks for the dates of the proposed amendment and the Office action completed. The late amendment is **>placed in< the file wrapper but not formally entered. See MPEP § 714.17.

Form paragraph 7.90 or 7.98.02 may also be used.

¶ *7.90 Abandonment, Failure to Reply*

This application is abandoned in view of applicant's failure to submit a proper reply to the Office action mailed on **[1]** within the required period for reply.

Examiner Note:

1. A letter of abandonment should not be mailed until after the period for requesting an extension of time under 37 CFR 1.136(a) has expired.
2. In *pro se* cases see form paragraph 7.98.02.

**>

¶ *7.98.02 Reply Is Late, Petition To Revive Suggested, Pro Se*

Applicant's reply to the Office Action of **[1]** was received in the Patent and Trademark Office on **[2]**, which is after the expiration of the period for reply set in the last Office Action. Since no time remains for applicant to obtain an extension of the period for reply by filing a petition under 37 CFR 1.136(a), this application is *abandoned*. Applicant is advised that the abandonment of this application may only be overcome by filing a petition to revive under 37 CFR 1.137. A petition to revive may be appropriate if applicant's failure to reply was either unavoidable or unintentional, as set forth below.

A. Failure to reply was unavoidable.

A petition to revive an abandoned application on the grounds that the failure to reply was unavoidable (37 CFR 1.137(a)) must be accompanied by: (1) the required reply (which has been filed); (2) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(d); and (4) the $**[3]** petition fee as set forth in 37 CFR 1.17(l). No consideration to the substance of a petition will be given until this fee is received.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable, as well as inadvertent. This must include: (1) a satisfactory showing that the cause of the delay resulting in failure to reply in timely fashion to the Office action was unavoidable; and (2) a satisfactory showing that the cause of any delay during the time period between abandonment and filing of the petition to revive was also unavoidable.

A terminal disclaimer and the $**[4]** terminal disclaimer fee is required under 37 CFR 1.137(d) if the application is: (1) a design application, (2) a utility application filed before June 8, 1995, or (3) a plant application filed before June 8, 1995. The terminal disclaimer must dedicate to the public a terminal part of the term of any patent granted the application equivalent to the period of abandonment of the application, and must also apply to any patent granted on any application containing a specific reference under 35 U.S.C. 120, 121 or 365(c) to the application for which revival is sought.

B. Failure to reply was unintentional.

A petition to revive an abandoned application on the grounds that the failure to reply was unintentional (37 CFR 1.137(b)) must be accompanied by: (1) the required reply (which has been filed); (2) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(d) (see above discussion); and (4) the $**[5]** petition fee as set forth in 37 CFR 1.17(m). No consideration to the substance of a petition will be given until this fee is received. The Director may require additional information where there is a question whether the delay was unintentional.

The required items and fees must be submitted promptly under a cover letter entitled "Petition to Revive."

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX:

571-273-8300
Attn: Office of Petitions

Telephone inquiries with respect to this matter should be directed to the Office of Petitions Staff at (571) 272-3282. For more detailed information, see MPEP § 711.03(c).

<

To pass on questions of abandonment, it is essential that the examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant's reply must reach the Office within the set shortened statutory period for reply dating from the date stamped or printed on the Office letter or within the extended time period obtained under 37 CFR 1.136. (See MPEP § 710 to § 710.06.)

For a petition to withdraw a holding of abandonment based upon failure to receive an Office action, see MPEP § 711.03(c).

711.02(a) Insufficiency of Reply

Abandonment may result from a situation where applicant's reply is within the period for reply but is not fully responsive to the Office action. But see MPEP § 710.02(c). See also MPEP § 714.02 to § 714.04.

¶ *7.91 Reply Is Not Fully Responsive, Extension of Time Suggested*

The reply filed on **[1]** is not fully responsive to the prior Office action because: **[2]**. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Examiner Note:

1. In bracket 2, set forth why the examiner considers there to be a failure to take "complete and proper action" within the statutory period.

2. If the reply appears to be a *bona fide* attempt to respond with an inadvertent omission, do not use this form paragraph; instead use form paragraph 7.95.

711.02(b) Special Situations Involving Abandonment [R-3]

The following situations involving questions of abandonment often arise, and should be specially noted:

(A) Copying claims from a patent when not suggested by the U.S. Patent and Trademark Office does not constitute a reply to the last Office action and will not save the application from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

(B) An application may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Patent Appeals and Interferences. See MPEP § 1215.01 to § 1215.04.

(C) An application may become abandoned through dismissal of appeal to the Court of Appeals for the Federal Circuit or civil action, where there was not filed prior to such dismissal an amendment putting the application in condition for issue or fully responsive to the Board's decision. Abandonment results from failure to perfect an appeal as required by the Court of Appeals for the Federal Circuit. See MPEP § 1215.04 and § 1216.01.

(D) Where claims are suggested for interference near the end of the period for reply running against the application**>. See MPEP Chapter 2300.

(E) < Where a continued prosecution application (CPA) under 37 CFR 1.53(d) is filed. See MPEP § 201.06(d) and § 711.01.

*>

(F) < Prior to a decision by the Board, an application on appeal that has no allowed claims may become abandoned when a **>Request for Continued Examination (RCE)< is improperly filed without the appropriate fee or a submission (37 CFR 1.114(d)) in the application. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant. See MPEP § 706.07(h), paragraph X.

*>

(G) < When a reply to a final Office action is outstanding, an application may become abandoned if an RCE is filed without a timely submission that meets the reply requirements of 37 CFR 1.111. The filing of an improper RCE will not operate to toll the running of any time period set in the previous Office action for

reply to avoid abandonment of the application. See MPEP § 706.07(h), paragraph VI.

*>

(H) < Prior to payment of the issue fee, an allowed application may become abandoned if an RCE is improperly filed without the appropriate fee or a submission in the application. The improper RCE will not operate to toll the running of the time period for payment of the issue fee. See MPEP § 706.07(h), paragraph IX.

711.02(c) Termination of Proceedings

"Termination of proceedings" is an expression found in 35 U.S.C. 120. As there stated, a second application is considered to be copending with an earlier application if it is filed before

(A) the patenting,

(B) the abandonment of, or

(C) termination of proceedings on the earlier application.

"Before" has consistently been interpreted, in this context, to mean "not later than."

In each of the following situations, proceedings are terminated:

(A) When the issue fee is not paid and the application is abandoned for failure to pay the issue fee, proceedings are terminated as of the date the issue fee was due and the application is the same as if it were abandoned after midnight on that date (but if the issue fee is later accepted, on petition, the application is revived). See MPEP § 711.03(c).

(B) If an application is in interference wherein all the claims present in the application correspond to the counts and the application loses the interference as to all the claims, then proceedings on that application are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

(C) Proceedings are terminated in an application after decision by the Board of Patent Appeals and Interferences as explained in MPEP § 1214.06.

(D) Proceedings are terminated after a decision by the court as explained in MPEP § 1216.01.

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his or her application, applicant may either ask for reconsideration of such holding, if he or she disagrees with it on the basis that there is no abandonment in fact; or petition for revival under 37 CFR 1.137.

711.03(a) Holding Based on Insufficiency of Reply

Applicant may deny that the reply was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for reply, he or she may reverse his or her holding as to whether or not an amendment received during such period was responsive and act on an application of such character which he or she has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the application was never abandoned. See also MPEP § 714.03.

711.03(b) Holding Based on Failure To Reply Within Period

When an amendment reaches the U.S. Patent and Trademark Office after the expiration of the period for reply and there is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the examiner and the applicant may disagree as to the date on which the period for reply commenced to run or ends. In this situation, as in the situation involving sufficiency of reply, the applicant may take issue with the examiner and point out to him or her that his or her holding was erroneous.

711.03(c) Petitions Relating to Abandonment [R-3]

37 CFR 1.135. Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may

require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(a) *Unavoidable.* If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply*. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(d) *Terminal disclaimer*.

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

**>

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.<

(e) *Request for reconsideration*. Any request for reconsideration or review of a decision refusing to revive an abandoned application, a terminated reexamination proceeding, or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under:

(1) The provisions of § 1.136 for an abandoned application or lapsed patent;

(2) The provisions of § 1.550(c) for a terminated *ex parte* reexamination proceeding filed under § 1.510; or

(3) The provisions of § 1.956 for a terminated *inter partes* reexamination proceeding filed under § 1.913.

(f) *Abandonment for failure to notify the Office of a foreign filing*: A nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing, may be revived only pursuant to paragraph (b) of this section. The reply requirement of paragraph (c) of this section is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under this section will not operate to stay any period for reply that may be running against the application.

(g) *Provisional applications:* A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section. Subject to the provisions of 35 U.S.C. 119(e)(3) and § 1.7(b), a provisional application will

not be regarded as pending after twelve months from its filing date under any circumstances.

37 CFR 1.181. Petition to the Director.

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

**>

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.<

*****

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

*****

I. PETITION TO WITHDRAW HOLDING OF ABANDONMENT

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based on unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment.

Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 CFR 1.10(c) through 1.10(e) >and 1.10(g)< set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 CFR 1.10(c), (d), * (e)>, or (g)< (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

>37 CFR 1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 CFR 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.<

C. Treatment of Untimely Petition To Withdraw Holding of Abandonment

37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.

1. Design Applications, Utility Applications Filed Before June 8, 1995, and Plant Applications Filed Before June 8, 1995

(a) Applicant Receives Notice of Abandonment

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, if applicant receives a notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within two months of the mail date of the notice of abandonment will **not** (absent extraordinary circumstances) be treated on its merits **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted on the application, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c), equivalent to the period between:

(A) the date that is two months after the mail date of the notice of abandonment; and

(B) the filing date of a grantable petition to withdraw the holding of abandonment.

Form PTO/SB/62 is the appropriate terminal disclaimer to be used.

(b) Applicant Does Not Receive Notice of Abandonment

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, if applicant never receives the notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within twelve months from the date of applicant's filing (or date of submission, if the correspondence was never received by the Office) of correspondence with the Office for which further action by the Office can reasonably be expected, will **not** (absent extraordinary circumstances) be treated on its merit **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted thereon, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c), equivalent to the period between:

(A) the date that is twelve months from the date of applicant's filing or submission of correspondence with the Office, for which further action by the Office can reasonably be expected; and

(B) the filing date of a grantable petition to withdraw the holding of abandonment.

Form PTO/SB/62 is the appropriate terminal disclaimer to be used.

2. Utility and Plant Applications Filed on or After June 8, 1995 but Before May 29, 2000

In utility and plant applications filed on or after June 8, 1995, but before May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. However, the Office of Patent Legal Administration (OPLA) must be consulted in such situations if the holding of abandonment involves a period during: (A) appellate review by the Board of Patent Appeals and Interferences; (B) an interference proceeding under 35 U.S.C. 135(a), including any suspension due to an interference proceeding; or (C) which the application was in a sealed condition or prosecution was suspended due to a secrecy order under 35 U.S.C. 181. This is because it is necessary to effect (if appropriate) a reduction of patent term extension under the "due diligence" provisions of 37 CFR 1.701(d)(2).

3. Utility and Plant Applications Filed on or After May 29, 2000

In utility and plant applications filed on or after May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. This is because any patent term adjustment is automatically reduced under the provisions of 37 CFR 1.704(c)(4) in applications subject to the patent term adjustment provisions of the American Inventors Protection Act of 1999 (AIPA) if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, and if applicant does not receive the notice of abandonment, any patent term adjustment is reduced under the pro-

visions of 37 CFR 1.704(a) by a period equal to the period of time during which the applicant "failed to engage in reasonable efforts to conclude prosecution" (processing or examination) of the application.

Where the record indicates that the applicant intentionally delayed the filing of a petition to withdraw the holding of abandonment, the Office may simply dismiss the petition as untimely (37 CFR 1.181(f)) solely on the basis of such intentional delay in taking action in the application without further addressing the merits of the petition. Obviously, intentional delay in seeking the revival of an abandoned application precludes relief under 37 CFR 1.137(a) or (b) (discussed below).

II. PETITIONS TO REVIVE AN ABANDONED APPLICATION, OR ACCEPT LATE PAYMENT OF ISSUE FEE

37 CFR 1.137 provides for the revival of abandoned applications and lapsed patents for the failure:

(A) to timely reply to an Office requirement in a provisional application;

(B) to timely prosecute in a nonprovisional application;

(C) to timely pay the issue fee for a design application;

(D) to timely pay the issue fee for a utility or plant application; and

(E) to timely pay any outstanding balance of the issue fee (lapsed patents).

A petition under 37 CFR 1.137(a) requires:

(A) the required reply, unless previously filed;

(B) the petition fee as set forth in 37 CFR 1.17(l);

(C) a showing to the satisfaction of the Director of the USPTO that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(D) any terminal disclaimer required pursuant to 37 CFR 1.137(d).

A petition under 37 CFR 1.137(b) requires:

(A) the required reply, unless previously filed;

(B) the petition fee as set forth in 37 CFR 1.17(m);

(C) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and

(D) any terminal disclaimer required pursuant to 37 CFR 1.137(d).

The Director of the USPTO may require additional information where there is a question whether the delay was unintentional.

A. Reply Requirement

Unlike a petition to withdraw the holding of abandonment, a petition to revive under 37 CFR 1.137 must be accompanied by, *inter alia*, the required reply. See *Ex parte Richardson*, 1906 Dec. Comm'r Pat. 83 (1905) ("This Office has no authority to revive a case upon which no action has been taken within [the period for reply], but merely has authority to determine after an action is taken whether the delay in presenting it was unavoidable."). Generally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed. A petition for an extension of time under 37 CFR 1.136 and a fee for such an extension of time are not required to be included with the reply.

37 CFR 1.137(c) applies to the reply requirement for petitions under 37 CFR 1.137(a) and (b). In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination (RCE) in compliance with 37 CFR 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. See below for more details on the reply requirement in specific situations of abandonment.

1. Abandonment for Failure To Pay the Issue Fee or Publication Fee

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR

1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive. See *Brenner v. Ebbert*, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968). 35 U.S.C. 151 authorizes the acceptance of a delayed payment of the issue fee, if the issue fee "is submitted ... and the delay in payment is shown to have been unavoidable." 35 U.S.C. 41(a)(7) likewise authorizes the acceptance of an "unintentionally delayed payment of the fee for issuing each patent." Thus, 35 U.S.C. 41(a)(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Therefore, the filing of a continuing application without payment of the issue fee or any outstanding balance thereof is not an acceptable reply in an application abandoned or patent lapsed for failure to pay the issue fee or any portion thereof.

The Notice of Allowance requires the timely payment of the issue fee in effect on the date of its mailing to avoid abandonment of the application. In instances in which there is an increase in the issue fee by the time of payment of the issue fee required in the Notice of Allowance, the Office will mail a notice requiring payment of the balance of the issue fee then in effect. See *In re Mills*, 12 USPQ2d 1847, 1848 (Comm'r Pat. 1989). The phrase "for failure to pay the issue fee or any portion thereof" applies to those instances in which the applicant fails to pay either the issue fee required in the Notice of Allowance or the balance of the issue fee required in a subsequent notice. In such instances, the reply must be the issue fee then in effect, if no portion of the issue fee was previously submitted, or any outstanding balance of the issue fee then in effect, if a portion of the issue fee was previously submitted.

In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee. Even if an application abandoned for failure to pay the publication fee is being revived solely for purposes of continuity with a continuing application, the petition to revive under 37 CFR 1.137 must include payment of the publication fee.

2. Abandonment for Failure To Reply in a Nonprovisional Application

(a) Abandonment for Failure To Reply to a Non-Final Action

The required reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either:

(A) an argument or an amendment under 37 CFR 1.111;

(B) the filing of a continuing application under 37 CFR 1.53(b) (or a continued prosecution application (CPA) under 37 CFR 1.53(d) if the application is a design application).

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

(b) Abandonment for Failure To Reply to a Final Action

A reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance;

(C) the filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114 for

utility or plant applications filed on or after June 8, 1995 (see paragraph **(d)** below); or

(D) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR *>41.37< for filing the appeal brief will be set by the Director of the USPTO in the decision granting the petition.

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. *>Form< PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition. The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection. For Image File Wrapper (IFW) processing, see IFW Manual.

(c) Abandonment for Failure To File an Appeal Brief

In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either:

(A) an appeal brief in compliance with 37 CFR *>41.37(c)< and appeal brief fee;

(B) the filing of an RCE accompanied by a submission and the requisite fee in compliance with 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph **(d)** below); or

(C) the filing of a continuing application under 37 CFR 1.53(b) (or a CPA under 37 CFR 1.53(d) if the application is a design application).

(d) Filing an RCE as the Required Reply

For utility or plant applications abandoned for failure to reply to a final Office action or for failure to file an appeal brief, the required reply may be the filing of an RCE accompanied by a submission and the requisite fee. When an RCE is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) to revive such an application, the submission accompanying the RCE must be a reply responsive within the meaning of 37 CFR 1.111 to the last Office action. Consideration of whether the submission is responsive within the meaning of 37 CFR 1.111 to the last Office action is done without factoring in the "final" status of such action. The submission may be a previously filed amendment after final or a statement that incorporates by reference the arguments in a previously filed appeal or reply brief. See MPEP § 706.07(h), paragraph II.

The petition may be granted if the submission appears to be a *bona fide* attempt to provide a complete reply to the last Office action. After revival of the application, the examiner may, upon a more detailed review, determine that the reply is lacking in some respect. In this limited situation, the examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If the applicant does not correct the omission within the time period set in the letter (including any extension), the application is again abandoned.

(e) A Continuing Application or RCE May Be Required by the Office

The Office may require the filing of a continuing application or an RCE (if the prosecution prior to abandonment was closed) (or request for further examination pursuant to 37 CFR 1.129(a)) to

meet the reply requirement of 37 CFR 1.137(a)(1) (or 37 CFR 1.137(b)(1)) where, under the circumstances of the application, treating a reply under 37 CFR 1.111 or 1.113 would place an inordinate burden on the Office. Exemplary circumstances of when treating a reply under 37 CFR 1.111 or 1.113 may place an inordinate burden on the Office are where:

(A) an application has been abandoned for an inordinate period of time;

(B) an application file contains multiple or conflicting replies to the last Office action; or

(C) the reply or replies submitted under 37 CFR 1.137(a)(1) (or 37 CFR 1.137(b)(1)) are questionable as to compliance with 37 CFR 1.111 or 1.113.

3. Abandonment for Failure To Notify the Office of a Foreign Filing After the Submission of a Non-Publication Request

If an applicant makes a nonpublication request upon filing with the appropriate certifications, the utility or plant application filed on or after November 29, 2000 will not be published under 35 U.S.C. 122(b)(1). See 35 U.S.C. 122(b)(2)(B)(i). If an applicant makes a nonpublication request and then rescinds, pursuant to 35 U.S.C. 122(b)(2)(B)(ii), the nonpublication request before or on the date a counterpart application is filed in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, the nonpublication request will be treated as annulled and the application will be treated as if the nonpublication request were never made. See MPEP § 1123 and § 1124. An applicant who has made a nonpublication request, but who subsequently files an application directed to the invention disclosed in the U.S. application in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication before the nonpublication request is rescinded, must, in addition to the rescission, notify the Office of such filing within forty-five days after the date of such filing. The requirement in 35 U.S.C. 122(b)(2)(B)(iii) for notice of the foreign filing is in addition to any rescission of the nonpublication request under 35 U.S.C. 122(b)(2)(B)(ii). If an applicant files a counterpart application in a foreign country after having filed an application in the USPTO with a nonpublication request, filing a rescission of the nonpublication request under 35 U.S.C. 122(b)(2)(B)(ii) without also providing a notice of the foreign filing in a timely manner will result in the abandonment of the U.S. application under 35 U.S.C. 122(b)(2)(B)(iii). 35 U.S.C. 122(b)(2)(B)(iii), however, also provides that an application abandoned as a result of the failure to timely provide such a notice to the Office is subject to revival if the "delay in submitting the notice was unintentional."

35 U.S.C. 122(b)(2)(B)(iii) provides for revival only on the basis of unintentional delay, and not on the basis of unavoidable delay. Therefore, a nonprovisional application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires eighteen-month publication may be revived only on the basis of unintentional delay pursuant to 37 CFR 1.137(b). The reply requirement of 37 CFR 1.137(c) is met by the notification of such filing in a foreign country or under a multinational treaty, but the filing of a petition under 37 CFR 1.137(b) will not operate to stay any period for reply that may be running against the application. Since the Office cannot ascertain whether an application is abandoned under 35 U.S.C. 122(b)(2)(B)(iii), the Office may continue to process and examine the application until the Office is notified of applicant's failure to meet the forty-five days notice requirement of 35 U.S.C. 122(b)(2)(B)(iii). Therefore, the filing of a petition under 37 CFR 1.137(b) to revive such an application will not operate to stay any period for reply that may be running against the application. Applicants may use form PTO/SB/64a to file a petition for revival under 37 CFR 1.137(b).

B. Petition Fee Requirement

35 U.S.C. 41(a)(7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory

prerequisite to revival of the abandoned application, and cannot be waived.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

The phrase "unless the petition is filed under [35 U.S.C.] 133 or 151" signifies that petitions to revive filed on the basis of "unavoidable" delay (under 35 U.S.C. 133 or 151) are a subset of petitions to revive filed on the basis of unintentional delay. That is, "unavoidable" delay and "unintentional" delay are not alternatives; "unavoidable" delay is the epitome of "unintentional" delay. Any petition to revive an abandoned application or lapsed patent must meet the minimal "unintentional" delay threshold, and an applicant need only pay the fee specified in 37 CFR 1.17(l) (rather than the fee specified in 37 CFR 1.17(m)) if the petition is also accompanied by an adequate showing that the entire delay in filing the required reply, from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a), was unavoidable.

C. Unintentional and Unavoidable Delay

Petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file and are evaluated under the less stringent "unintentional delay" standard. Applicants determining whether to file a petition to revive an application under 37 CFR 1.137(b) or 1.137(a) should take the following into account:

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR 1.137(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent resulting from the application. See *Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished)(patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay…was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a).

Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually

must render a number of interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b).

1. Unintentional Delay

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), reveals that the purpose of 35 U.S.C. 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion stating that "[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b).

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

(A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;

(B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;

(C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;

(D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or

(E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

In order to expedite treatment, applicants filing a petition under 37 CFR 1.137(b) to revive an abandoned application are advised to include the statement "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional," even if applicant chooses to include a statement of the facts concerning the delay. Applicants may use the forms provided by the Office (PTO/SB/64, PTO/SB/64a, or PTO/SB/64PCT).

**>

PTO/SB/64 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)	Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1.Petition fee
☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee
A. The reply and/or fee to the above-noted Office action in the form of _____(identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.
☐ has been paid previously on _____.
☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/64 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

_____ _____
Signature Date

_____ _____
Typed or printed name Registration Number, if applicable

_____ _____
Address Telephone Number

_____
Address

Enclosures: ☐ Fee Payment
☐ Reply
☐ Terminal Disclaimer Form
☐ Additional sheets containing statements establishing unintentional delay
☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

_____ _____
Date Signature

_____
Typed or printed name of person signing certificate

[Page 2 of 2]

**>

PTO/SB/64a (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OFA FOREIGN OR INTERNATIONAL FILING (37 CFR 1.137(f))	Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational international treaty that requires publication of applications eighteen months after filing. The date of abandonment is the day after the expiration date of the forty-five (45) day period set in 35 U.S.C. 122(b)(2)(B)(iii).

PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREYBY PETITIONS FOR REVIVAL OF THIS APPLICATION UNDER 37 CFR 1.137(b)

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))

Subsequent to the filing of the above-identified application, an application was filed in another country, or under a multinational international treaty (e.g., filed under the Patent Cooperation Treaty), that requires publication of applications eighteen months after the filing. The filing date of the subsequently filed foreign or international application is _____.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/64a (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT: The entire delay in filing the required notice of a foreign or international filing from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

_____ Signature

_____ Date

_____ Typed or printed name

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

Enclosures: ☐ Fee Payment

☐ Additional sheets containing statements establishing unintentional delay

☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ Date

_____ Signature

_____ Typed or printed name of person signing certificate

[Page 2 of 2]

PTO/SB/64/PCT (12-04)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)	Docket Number (Optional)

First Named Inventor:

International (PCT) Application No.: U.S. Application No.: (if known)

Filed:

Title:

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee
(2) Proper reply
(3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity - fee $_____(37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee $_____(37 CFR 1.17(m))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of _____ (identify type of reply):

☐ has been filed previously on _____.

☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/64/PCT (12-04)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

☐ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $_____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature	Date
Typed or Printed Name	Registration Number, if applicable
Address	Telephone Number
Address	

Enclosures:
☐ Response
☐ Fee Payment
☐ Terminal Disclaimer
☐ Other (please identify):

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

2. Unavoidable Delay

As discussed above, "unavoidable" delay is the epitome of "unintentional" delay. Thus, an intentional delay precludes revival under 37 CFR 1.137(a) ("unavoidable" delay) or 37 CFR 1.137(b) ("unintentional" delay). See *Maldague*, 10 USPQ2d at 1478.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting *Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988). For example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

(A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or

(C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest

that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay. See *Krahn*, 15 USPQ2d at 1825. Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

35 U.S.C. 133 and 151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See *In re Application of Takao*, 17 USPQ2d 1155 (Comm'r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under 37 CFR 1.137(a) "promptly" upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. The removal of the language in 37 CFR 1.137(a) requiring that any petition thereunder be "promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment" should **not** be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment of the application, to delay the filing of a petition under 37 CFR 1.137(a); or (B) changing (or modifying) the result in *In re Application of S*, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under 37 CFR 1.137(a) was denied due to the applicant's deliberate deferral in filing a petition under 37 CFR 1.137. An applicant who deliberately chooses to delay the filing of a petition under 37 CFR 1.137 (as in *Application of S*, 8 USPQ2d at 1632) will not be able to show that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 CFR 1.137(a)] was unavoidable" or even make an appropriate statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 CFR 1.137(b)] was unintentional."

The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 CFR 1.137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 CFR 1.137(a) indicates otherwise). In such an instance, a petition under 37 CFR 1.137(b) may be filed accompanied by the fee set forth in 37 CFR 1.17(m), the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and any terminal disclaimer required by 37 CFR 1.137(c).

Form PTO/SB/61 or PTO/SB/61PCT may be used to file a petition for revival of an unavoidably abandoned application.

**>

PTO/SB/61 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional)

First Named Inventor: Art Unit:

Application Number: Examiner:

Filed:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United Sates Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.

NOTE: A grantable petition requires the following items:
(1) Petition fee.
(2) Reply and/or issue fee.
(3) Terminal disclaimer with disclaimer fee-required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
(4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☐ Small entity – fee $_____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $_____ (37 CFR 1.17(l)).

2. Reply and/or fee

A The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):

☐ has been filed previously on _____ .

☐ is enclosed herewith.

B The issue fee of $ _____

☐ has been filed previously on _____ .

☐ is enclosed herewith.

[Page 1 of 3]

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/61 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

_____ _____
Signature Date

_____ _____
Typed or printed name Registration Number, if applicable

_____ _____
Address Telephone Number

_____
Address

Enclosure ☐ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unavoidable delay

☐ _____

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ _____
Date Signature

_____
Typed or printed name of person signing certificate

[Page 2 of 3]

PTO/SB/61 (07-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

Signature	Date
Typed or printed name	Registration Number, if applicable

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

(Please attach additional sheets if additional space is needed.)

[Page 3 of 3]

PTO/SB/61/PCT (12-04)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional)

First named inventor:

U.S. Application No.: (if known)

International (PCT) Application Number:

Filed:

Title:

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) (as applicable). The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Proper reply;
(3) Terminal disclaimer with disclaimer fee—required for all international applications having an international filing date before June 8, 1995; and
(4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☐ small entity – fee $_____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee $ _____ (37 CFR 1.17(l))

2. Proper reply

A. The proper reply (the missing 35 U.S.C. 371(c) requirements) in the form of _____ (identify the type of reply):

☐ was previously filed on _____

☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8.0 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/61/PCT (12-04)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)

3. Terminal disclaimer with disclaimer fee

☐ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the 35 U.S.C. 371(c) requirements (or a continuing U.S. application) from their due date until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

_____ _____
Signature Date

_____ _____
Typed or Printed Name Registration Number, if applicable

_____ _____
Address Telephone Number

_____
Address

Enclosures: ☐ Additional sheets containing statements establishing unavoidable delay
☐ Fee Payment
☐ Reply
☐ Terminal Disclaimer Form
☐ Other (please identify):

[Page 2 of 3]

PTO/SB/61/PCT (12-04)
Approved for use through 03/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional)

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

Signature _____ Date _____

Typed or Printed Name _____ Registration Number, if applicable _____

(In the space provided below, please explain in detail why the 35 U.S.C. 371(c) elements (or continuing U.S. application) were not timely filed.)

[Page 3 of 3]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<

D. Delay Until the Filing of a Grantable Petition

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

(A) the delay in reply that originally resulted in the abandonment;

(B) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and

(C) the delay in filing a **grantable** petition pursuant to 37 CFR 1.137 to revive the application.

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See *Application of G*, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

(A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;

(B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or

(C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldague*, 10 USPQ2d at 1478.

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to 37 CFR 1.137(a) or (b), when such petition is filed: (A) within 3 months of the date the applicant is first notified that the application is abandoned; **and** (2) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to 37 CFR 1.137 within 3 months of the first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application).

Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 3 months of the date the applicant is first notified that the application is abandoned, the Office will consider there to be a question as to whether the delay was unavoidable or unintentional. In such instances,

(A) the Office will require a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was "unavoidable"; or

(B) the Office may require further information as to the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(b) petition was filed, and how such delay was "unintentional."

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within 3 months of the date the applicant was first notified that the application was abandoned, applicants should include a showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under 37 CFR 1.137 was (A) "unavoidable" in a petition under 37 CFR 1.137(a); or (B) "unintentional" in a petition under 37 CFR 1.137(b).

Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment) the Office will require:

(A) further information as to when the applicant (or the applicant's representative) first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative) (see *Pratt*, 1887 Dec. Comm'r Pat. at 32-33).

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

(A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

E. Party Whose Delay Is Relevant

The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party has reassigned the application to the applicant prior to the due date for the reply. *Id.*

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

F. Burden of Proof To Establish Unavoidable or Unintentional Delay

37 CFR 1.137(a)(3) requires a showing to the satisfaction of the Director of the USPTO that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Therefore, the Office will require the applicant in every petition under 37 CFR 1.137(a) to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unavoidable. See *Haines*, 673 F. Supp. at 316-17, 5 USPQ2d at 1131-32.

37 CFR 1.137(b)(3) requires that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, but also provides that "[t]he Director may require additional information where there is a question whether the delay was unintentional." While the Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, the Office may require an applicant to carry the burden of proof to establish that the delay

from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) where there is a question whether the entire delay was unintentional. See *Application of G*, 11 USPQ2d at 1380.

G. Terminal Disclaimer Requirement

37 CFR 1.137(d) requires that a petition under either 37 CFR 1.137(a) or 1.137(b) be accompanied by a terminal disclaimer (and fee), regardless of the period of abandonment, in:

(A) a design application;

(B) a nonprovisional utility application >(other than a reissue application)< filed before June 8, 1995; or

(C) a nonprovisional plant application >(other than a reissue application)< filed before June 8, 1995.

In addition, a terminal disclaimer (and fee) is also required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order. The reason being that utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. 154(b) (as a result of the Uruguay Round Agreements Act (URAA)). See 35 U.S.C. 154(b) (1999); see also 37 CFR 1.701. If such an application is abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order, the patentee of a patent issuing from such an application is eligible for patent term extension for the entire period of abandonment. The requirement for a terminal disclaimer for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public. For utility and plant applications filed on or after May 29, 2000, a terminal disclaimer (and fee) is not required since the period of abandonment is reduced from the patent term adjustment pursuant to 37 CFR 1.704.

The terminal disclaimer submitted in a design application must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer submitted in either a utility or plant application filed before June 8, 1995 must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of: (1) the period of abandonment of the application; or (2) the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. The terminal disclaimer must also apply to any patent granted on any continuing utility or plant application filed before June 8, 1995, or any continuing design application, entitled under 35 U.S.C. 120, 121, or 365(c) to the benefit of the filing date of the application for which revival is sought. The terminal disclaimer requirement of 37 CFR 1.137(d) does not apply to >(A)< applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, **>(B)< lapsed patents>, (C) reissue applications, or (D) reexamination proceedings<.

The Office cannot determine (at the time a petition to revive is granted) the period disclaimed (i.e., which period is lesser: the period of abandonment of the application, or the period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed). Therefore, the Office will not indicate the period disclaimed under 37 CFR 1.137(d) in its decision granting a petition to revive an abandoned application.

The filing of a terminal disclaimer is not a substitute for unavoidable or unintentional delay. See *Application of Takao*, 17 USPQ2d at 1159. The requirement that the entire delay have been unavoidable (37 CFR 1.137(a)) or at least unintentional (37 CFR 1.137(b)) is distinct from the requirement for a terminal disclaimer. Therefore, the filing of a terminal disclaimer cannot excuse an intentional delay in filing a petition or renewed petition to revive an abandoned application. Likewise, an unavoidable or unintentional delay in filing a petition or renewed petition to revive an abandoned application will not warrant waiver of the terminal disclaimer requirement of 37 CFR 1.137(d).

In the event that an applicant considers the requirement for a terminal disclaimer to be inappropriate under the circumstances of the application at issue, the applicant should file a petition under 37 CFR 1.183 (and petition fee) to request a waiver of this requirement of 37 CFR 1.183. Such a petition may request waiver of this requirement *in toto*, or to the extent that such requirement exceeds the period considered by applicant as the appropriate period of disclaimer. The grant of such a petition, however, is strictly limited to situations wherein applicant has made a showing of an "extraordinary situation" in which "justice requires" the requested relief. An example of such a situation is when the abandonment of the application caused no actual delay in prosecution (e.g., an application awaiting decision by the Board of Appeals and Interferences during period of abandonment).

Forms PTO/SB/62 and PTO/SB/63 may be used when filing a terminal disclaimer in accordance with 37 CFR 1.137(d).

**>

PTO/SB/62 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO ACCOMPANY PETITION (Period Specified)	Docket Number (Optional)

In re Application of:

Name:

Application Number:

Filed:

For:

The owner*, _____ of _____ percent interest in the above-identified application hereby disclaims the terminal _____ months of any patent granted on the above-identified application or on any application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to this application. This disclaimer is binding upon the grantee, its successors or assigns.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the person signing is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

2. ☐ The undersigned is an attorney of record. Registration Number _____

_____ Signature

_____ Date

_____ Typed or printed name

_____ Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

* Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/63 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO ACCOMPANY PETITION	Docket Number (Optional)

In re Application of:

Name:

Application Number:

Filed:

For:

The owner*, _____ of _____ percent interest in the above-identified application hereby disclaims a terminal part of the term of any patent granted the above-identified application equivalent to: (1) if the above-identified application is a design application, the period of abandonment of the above-identified application, and (2) if the above-identified application is a utility or plant application, the lesser of: (a) the period of abandonment of the application; or (b) the period extending beyond twenty years from the date on which the above-identified application was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed. This disclaimer also applies to any patent granted on a utility or plant application filed before June 8, 1995, or a design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. This disclaimer is binding upon the grantee, and its successors or assigns.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

2. ☐ The undersigned is an attorney or agent of record. Registration Number_____.

_____ _____
Signature Date

_____ _____
Typed or Printed Name Telephone Number

☐ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

* Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

<

H. Request for Reconsideration

37 CFR 1.137(e) requires that any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent must be filed within 2 months of the decision refusing to revive or within such time as set in the decision. 37 CFR 1.137(e) further provides that, unless a decision indicates otherwise, this time period for requesting reconsideration or review may be extended under the provisions of 37 CFR 1.136.

37 CFR 1.137(e) specifies a time period within which a renewed petition pursuant to 37 CFR 1.137 must be filed to be considered timely. Where an applicant files a renewed petition, request for reconsideration, or other petition seeking review of a prior decision on a petition pursuant to 37 CFR 1.137 outside the time period specified in 37 CFR 1.137(e), the Office may require, *inter alia*, a specific showing as to how the entire delay was "unavoidable" (37 CFR 1.137(a)) or "unintentional" (37 CFR 1.137(b)). As discussed above, a delay resulting from the applicant deliberately choosing not to persist in seeking the revival of an abandoned application cannot be considered "unavoidable" or "unintentional" within the meaning of 37 CFR 1.137, and the correctness or propriety of the decision on the prior petition pursuant to 37 CFR 1.137, the correctness of the applicant's (or the applicant's representative's) decision not to persist in seeking revival, the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision to not persist in seeking revival are immaterial to such intentional delay caused by the deliberate course of action chosen by the applicant.

I. Provisional Applications

37 CFR 1.137 is applicable to a provisional application abandoned for failure to reply to an Office requirement. A petition under 37 CFR 1.137(a) or (b) must be accompanied by any outstanding reply to an Office requirement, since 37 CFR 1.137(a)(1) and 1.137(b)(1) permit the filing of a continuing application in lieu of the required reply only in a nonprovisional application.

35 U.S.C. 111(b)(5) provides that a provisional application shall be regarded as abandoned 12 months after its filing date and shall not be subject to revival after such 12-month period. 37 CFR 1.137(g) provides that a provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to 37 CFR 1.137, however a provisional application will not be regarded as pending after twelve months from its filing date under any circumstances. Note that the pendency of a provisional application is extended to the next succeeding secular or business day if the day that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See 35 U.S.C. 119(e)(3).

A provisional application may be abandoned prior to 12 months from its filing date for failure to reply to an Office requirement (e.g., failure to submit the filing fee and/or cover sheet). Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than 12 months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than 12 months from the filing date of the provisional application but only to revive the application for the 12-month period following the filing of the provisional application. Thus, even if the petition were granted to establish the pendency up to the end of the 12-month period, the provisional application would not be considered pending after 12 months from its filing date.

711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding [R-2]

37 CFR 1.181 states that the examiner **>"may be directed by the Director to furnish a written statement within a specific time setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy thereof to the petitioner."< Unless requested, however, such a statement should not be prepared. See MPEP § 1002.01.

711.04 Public Access to Abandoned Applications [R-2]

**>Access will be provided to the application file itself for any non-Image File Wrapper (IFW) abandoned published application. When access to the IFW system is available in the File Information Unit (FIU)

and/or Internet access to abandoned published IFW applications, such files will be provided to the public via the FIU and/or Internet. Since there is no paper file wrapper for IFW applications, if electronic access is not available to the public, then access to IFW files is only available by ordering a copy of the application-as-filed, the file contents of the published application or a specific document in the file of the published application from the Office of Public Records and payment of the appropriate fee set forth in 37 CFR 1.19(b). See 37 CFR 1.14(a)(1)(ii).

Access to an abandoned unpublished application may be provided to any person if a written request for access is submitted, and the abandoned application is identified or relied upon:

(A) in a U.S. patent application publication or patent;

(B) in statutory invention registration; or

(C) in an international application that is published in accordance with PCT Article 21(2).

An application is considered identified in a document such as a patent when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the identification is made in a paper in the file contents of the patent and is not included in the printed patent. See 37 CFR 1.14(a)(1)(iv). A copy of the application-as-filed, the file contents of the abandoned application, or a specific document in the file of the abandoned application may also be provided to any person upon written request, and payment of the fee set forth in 37 CFR 1.19(b). See 37 CFR 1.14(a)(1)(iv). See also MPEP § 103. Form PTO/SB/68 may be used to request access of an abandoned application under 37 CFR 1.14(a)(1)(iv).<

711.04(a) Pulling and Forwarding Abandoned Applications [R-1]

The files of abandoned applications are pulled and forwarded to the Files Repository on a biweekly basis 1 month after the full 6-month statutory period has expired. However, the date of abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired.

The applications should be carefully scrutinized by the appropriate examiner to verify that they are actually abandoned. A check should be made of files containing a decision of the Board of Patent Appeals and *>Interferences< for the presence of allowed claims to avoid their being erroneously sent to the Files Repository.

Although the abandoned files are not pulled until the maximum permissible period for which an extension of time under 37 CFR 1.136(a) plus 1 month has expired, the date of the abandonment is after midnight of the date the period for reply actually expired. This is normally the end of the 3-month shortened statutory period.

711.04(b) Ordering of Patented and Abandoned Files [R-2]

In examination of an application it is sometimes necessary to inspect the application papers of a previously patented or abandoned application. It is always necessary to do so in the examination of a reissue application.

Recently patented and abandoned files are stored at the Files Repository located near the other USPTO buildings in Crystal City (Arlington, VA). Older files are housed in warehouses located off site (outside of Crystal City). >Image File Wrapper (IFW) applications are stored electronically and do not have a paper file wrapper to be stored. The electronic file is the official record of the application. See the IFW Manual section 3.7.<

Patented and abandoned files are ordered by means of a PALM video display transaction. To place such an order, the examiner is required to input his/her PALM location code, employee number, and patent number(s) and/or application number(s) of the file(s) that are needed. After transmission of the request transaction by the examiner, a “response” screen appears on the video display terminal which informs him/her of the status of the request for each file. The examiner is informed that the request is:

(A) accepted;

(B) accepted, but for which the file is stored at a warehouse off site (in which case delivery time is increased);

(C) not accepted since the file is not located at the repository or warehouse;

(D) not accepted since a previous request for the file has not yet been filled; or

(E) not accepted since the patent or application number inputted is not valid.

Periodically each day, personnel at the Files Repository perform a PALM print transaction which produces a list of all accepted requests in patent number order and, for requests for abandoned files, in application number order. The printed record of each request is detached from the list when its associated file is found. It is then stapled to it. Throughout the day, periodic deliveries of files are made directly to the offices of their requestors by Files Repository personnel. Upon delivery of files at the various locations, files that are ready to be returned to the repository are picked up. >For applications stored in IFW, this process is no longer necessary.<

With the exception of certain older files, the drawings of patented and abandoned files, if any, are now stored within their respective application file wrappers. Since it is desired not to separate one from the other, both the file and its drawings are delivered when a file is ordered. >For applications stored in IFW, it is no longer necessary to order or deliver the files.<

711.04(c) Notifying Applicants of Abandonment

The Patent Examining Corps currently mails to the correspondence address of record, a Notice of Abandonment form PTOL-1432 in all applications which become abandoned in the Corps for failure to prosecute. However, in no case will mere failure to receive a notice of abandonment affect the status of an abandoned application.

This procedure should enable applicants to take appropriate and diligent action to reinstate an application inadvertently abandoned for failure to timely reply to an official communication. In most cases, a petition to revive under 37 CFR 1.137 will be the appropriate remedy. It may be that a reply to the Office action was mailed to the Office with a certificate of mailing declaration as a part thereof (MPEP § 512) but was not received in the Office. In this instance, adequate relief may be available by means of a petition to withdraw the holding of abandonment.

In any instance, if action is not taken promptly after receiving the notice of abandonment, appropriate relief may not be granted. If a lack of diligent action is predicated on the contention that neither the Office action nor the notice of abandonment was received, one may presume that there is a problem with the correspondence address of record. Accordingly, attention is directed to MPEP § 402 and § 601.03 dealing with changes of address. In essence, it is imperative that a paper notifying the Office of a change of address be filed promptly in each application in which the correspondence address is to be changed (except as provided for under Customer Number practice — see MPEP § 403).

711.05 Letter of Abandonment Received After Application Is Allowed

Receipt of a letter of abandonment while an application is allowed is acknowledged by the Publishing Division.

An express abandonment arriving after the issue fee has been paid will not be accepted without a showing of one of the reasons indicated in 37 CFR 1.313(c), or else a showing under 37 CFR 1.183 justifying suspension of 37 CFR 1.313. See also MPEP § 711.01.

711.06 Abstracts, Abbreviatures, and Defensive Publications [R-2]

>

I. < ABSTRACTS

Abstracts were prepared and published in accordance with the Notice of January 25, 1949, 619 O.G. 258. Each abstract includes a summary of the disclosure of the abandoned application, and in applications having drawings, a figure of the drawing. The publication of such abstracts was discontinued in 1953.

>

II. < ABBREVIATURES

Abbreviatures were prepared and published in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviature contains a specific portion of the disclosure of the abandoned application, preferably a detailed representative claim, and, in applications having drawings, a

figure of the drawing. The publication of such abbreviatures was discontinued in 1965.

>

III. < DEFENSIVE PUBLICATIONS

The Defensive Publication Program, which provided for the publication of the abstract of the technical disclosure of a pending application if the applicant waived his or her rights to an enforceable patent, was available between April 1968 and May 8, 1985. The program was ended in view of the applicant's ability to obtain a Statutory Invention Registration.

An application was laid open for public inspection under the Defensive Publication Program and the applicant provisionally abandoned the application, retaining rights to an interference for a limited period of 5 years from the earliest effective U.S. filing date.

The defensive publication of an application precluded a continuing application (divisional, continuation-in-part, or continuation) filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application unless a continuing application was filed within 30 months after the earliest effective U.S. filing date. Where a similar application was not filed until after expiration of the 30 month period, the application was examined, but it was not entitled to claim the benefit of the earlier filing date of the defensive publication application.

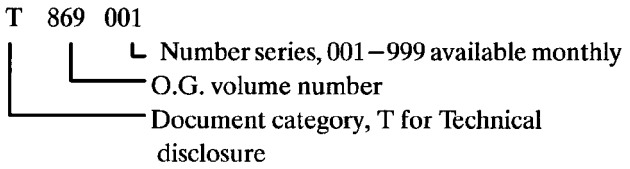
If a first continuing application was filed within 30 months from the earliest U.S. effective filing date of the application published under the Defensive Publication Program, later copending continuing applications (such as divisions if restriction is required during the prosecution of the first continuing application) were not barred and could be filed during the pendency of the first continuing application, even though beyond the 30 month period, without loss of the right to claim the benefit of the filing date of the Defensive Publication application.

The Defensive Publication Abstract and a selected figure of the drawing, if any, were published in the *Official Gazette*. Defensive Publication Search Copies, containing the defensive publication abstract and suitable drawings, if any, were provided for the application file, the Patent Search Room and the examiner's search files. A defensive publication is not a patent or an application publication under 35 U.S.C. 122(b); it is a publication. Therefore, it is prior art only as of its publication date. See MPEP § 2136.

The defensive publication application files are maintained in the File Information Unit (Record Room).

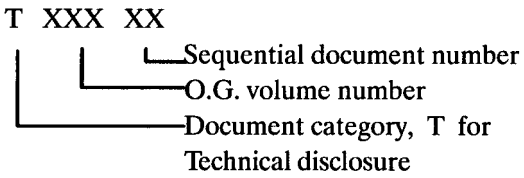
Defensive Publication Number

Distinct numbers are assigned to all Defensive Publications published December 16, 1969 through October 1980, for example.



For Defensive Publications published on and after November 4, 1980, a different numbering system is used.

The revised numbering system is as follows:



Defensive Publications are included in subclass lists and subscription orders. The distinct numbers are used for all official reference and document copy requirements.

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687.

711.06(a) Citation and Use of Abstracts, Abbreviatures, and Defensive Publications as References [R-2]

It is important that abstracts, abbreviatures, and defensive publications (O.G. Defensive Publication and Defensive Publication Search Copy) be referred to as publications.

These printed publications are cited as prior art under 35 U.S.C. 102(a) or 102(b) effective from the date of publication in the *Official Gazette*. See *Ex parte Osmond,* 191 USPQ 334 (Bd. App. 1973) and

**>*Ex Parte*< *Osmond*, 191 USPQ 340 (Bd. App. 1976). See also MPEP § 2136.

An application or portion thereof from which an abstract, abbreviature or defensive publication has been prepared ** may be used as a reference under 35 U.S.C.102(a), effective from the actual date of filing in the United States>, only for evidence of prior knowledge of another<.

These publications may be used alone or in combination with other prior art in rejecting claims under 35 U.S.C. 102 and 103.

Defensive Publications are listed with "U.S. Patent Documents." Abstracts and Abbreviatures are listed under "Other References" in the citation thereof as follows:

(A) Abstracts and Abbreviatures

Brown, (abstract or abbreviature) of Serial No. ....., filed ....., published in O.G. ....., on ....., (list classification).

(B) Applications or designated portions thereof, abstracts, abbreviatures, and defensive publications

Jones, Application Serial No. ....., filed ....., laid open to public inspection on ..... as noted at ..... O.G. (portion of application relied on), (list classification, if any).

713 Interviews

The personal appearance of an applicant, attorney, or agent before the examiner or a telephone conversation or video conference or electronic mail between such parties presenting matters for the examiner's consideration is considered an interview.

713.01 General Policy, How Conducted [R-3]

37 CFR 1.133. Interviews.

(a)(1)Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.

(2) An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application.

(3) The examiner may require that an interview be scheduled in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

Interviews must be conducted on the Office premises, such as in examiner's offices, conference rooms or the video conference center.

Interviews are permissible during normal business hours on Monday through Friday except the hours in which the examiner is working overtime.

I. SPECIAL PROCEDURES FOR USING INTERNET ELECTRONIC MAIL

Internet e-mail shall NOT be used to conduct an exchange or communications similar to those exchanged during telephone or personal interviews unless a written authorization from the applicants or an attorney/agent of record has been given to use Internet e-mail. See MPEP § 502.03. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form is entered.

II. VIDEO CONFERENCE CENTER

In the interest of providing better service to its customers, the U.S. Patent and Trademark Office (USPTO) has established a Video Conference Center (VCC) to expedite patent and trademark prosecution. The VCC is presently administered by the **>Office of Patent Training< and is available for authorized official business during normal business hours (8:30 AM - 5:00 PM, EST). The VCC equipment includes a high resolution document camera, direct computer input, VCR display capability, and a high speed, high resolution G-4 facsimile machine. The Patent and Trademark Depository Library Program office maintains a current list of all the off-site locations where a video conference may be held. At this time, use of the VCC will be limited to our partnership Patent and Trademark Depository Libraries (PTDLs) located at Sunnyvale, Calif. and the Great Lakes Patent and Trademark Center at the Detroit Public Library, which have duplicate video equipment. Customers wishing to utilize the facilities at the above noted PTDLs, rather than coming to the USPTO for a face-to-face interview, should contact the patent examiner and identify two alternative dates and times for a video

conference. The patent examiner will then contact **>Office of Patent Training< personnel who will, in turn, make all the arrangements. The customer will be notified as to the date and time of the video conference by Office personnel.

III. SCHEDULING AND CONDUCTING AN INTERVIEW

An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present and available in the Office. When applicant is initiating a request for an interview, an "Applicant Initiated Interview Request" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed "Applicant Initiated Interview Request" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative. Applicants are encouraged to use form PTO-413A, however, the fact that applicant does not submit an "Applicant Initiated Interview Request" form is not, by itself, grounds for the examiner to deny a request for an interview. An interview in the Video Conference Center must be arranged at least 3 days in advance. When a second art unit is involved (Patentability Report), the availability of the second examiner should also be checked. See MPEP § 705.01(f). An appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington or off-site video conferencing locations in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be made.

When a telephone call is made to an examiner and it becomes evident that a lengthy discussion will ensue or that the examiner needs time to restudy the situation, the call should be terminated with an agreement that the examiner will call back at a specified time. Such a call and all other calls originated by the examiner should be made through the Office's telephone system even though a collect call had been authorized. It is helpful if amendments and other papers, such as the letter of transmittal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examiner may well justify his or her refusal of the interview at that time, particularly in an involved case.

An examiner's suggestion of allowable subject matter may justify indicating the possibility of an interview to accelerate early agreement on allowable claims.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus, the attorney when presenting himself or herself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted. It is desirable that the attorney or applicant indicate in advance what issues he or she desires to discuss at the interview by submitting, in writing, a proposed amendment. This would permit the examiner to prepare in advance for the interview and to focus on the matters set forth in the proposed amendment.

Examiners should avoid unnecessary interruptions during interviews with attorneys or inventors. In this regard, examiners should not take incoming telephone calls unless such are of an emergency nature. As appropriate, examiners should familiarize themselves with the status and existing issues in an application or reexamination proceeding before an interview.

The examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the

examiner. However, the examiner should attempt to identify issues and resolve differences during the interview as much as possible.

It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than 30 minutes. It is the duty of the primary examiner to see that an interview is not extended beyond a reasonable period even when he or she does not personally participate in the interview.

During an interview with an applicant who is prosecuting his or her own case and is not familiar with Office procedure the examiner may make suggestions that will advance the prosecution of this case; this lies wholly within his or her discretion. Too much time, however, should not be allowed for such interviews.

Examiners may grant one interview after final rejection. See MPEP § 713.09.

Where the reply to a first complete action includes a request for an interview, a telephone consultation to be initiated by the examiner or a video conference, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he or she has considered the effect of the reply, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Consideration of a filed amendment may be had by hand delivery of a duplicate copy of the amendment.

Early communication of the results of the consideration should be made to applicant; if requested, indicate on attorney's copy any agreement; initial and date both copies.

Although entry of amendatory matter usually requires actual presence of the original paper, examiner and technical support staff processing should proceed as far as practicable based on the duplicate copy. The extent of processing will depend on each amendment. For Image File Wrapper (IFW) processing, see IFW Manual section 3.5.

The substance of any interview, whether in person, by video conference, by electronic mail or by telephone must be made of record in the application. See MPEP § 502.03 and § 713.04.

IV. VIEWING OF VIDEO TAPES DURING INTERVIEWS

The U.S. Patent and Trademark Office has video tape equipment available ** for viewing video tapes from applicants during interviews with patent examiners.

The video tape equipment may use VHS and UHS (3/4-inch tape) cassettes.

Attorneys or applicants wishing to show a video tape during an examiner interview must be able to demonstrate that the content of the video tape has a bearing on an outstanding issue in the application and its viewing will advance the prosecution of the application. Prior approval of viewing of a video tape during an interview must be granted by the supervisory patent examiner. Also, use of the room and equipment must be granted by the **>Office of Patent Training. The central training facility is located on the second floor of Madison West, 600 Dulany Street, Alexandria, VA 22314<.

Requests to use video tape viewing equipment for an interview should be made at least 1 week in advance to allow the **>Office of Patent Training< staff sufficient time to ensure the availability and proper scheduling of both a room and equipment.

Interviews using Office video tape equipment will be held only in the **>Office of Patent Training< facilities **. Attorneys or applicants should not contact the **>Office of Patent Training< directly regarding availability and scheduling of video equipment. All scheduling of rooms and equipment should be done through and by the examiner conducting the interview. The substance of the interview, including a summary of the content of the video tape must be made of record in the application. See MPEP § 713.04.

V. EXAMINATION BY EXAMINER OTHER THAN THE ONE WHO CONDUCTED THE INTERVIEW

Sometimes the examiner who conducted the interview is transferred to another Technology Center or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See MPEP § 812.01 for a statement of telephone practice in restriction and election of species situations.

**>

PTOL-413A (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.:_____ First Named Applicant:_____
Examiner:_____ Art Unit:_____ Status of Application:_____

Tentative Participants:
(1)_____ **(2)**_____

(3)_____ **(4)**_____

Proposed Date of Interview:_____ **Proposed Time:**_____ **(AM/PM)**

Type of Interview Requested:
(1) [ ] Telephonic (2) [ ] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [ ] YES [ ] NO
If yes, provide brief description:_____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1)_____	_____	_____	[ ]	[ ]	[ ]
(2)_____	_____	_____	[ ]	[ ]	[ ]
(3)_____	_____	_____	[ ]	[ ]	[ ]
(4)_____	_____	_____	[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached

Brief Description of Arguments to be Presented:

_____

_____

_____

An interview was conducted on the above-identified application on _____.
NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).
This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

_____ _____
Applicant/Applicant's Representative Signature Examiner/SPE Signature

_____
Typed/Printed Name of Applicant or Representative

_____
Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

<

713.02 Interviews Prior to First Official Action [R-1]

Prior to filing, no interview is permitted. However, in the examiner's discretion, a limited amount of time may be spent in indicating the field of search to an attorney, searcher or inventor.

A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).

SEARCHING IN GROUP

Search in the Technology Center art unit should be permitted only with the consent of a primary examiner.

EXPOUNDING PATENT LAW

The U.S. Patent and Trademark Office cannot act as an expounder of the patent law, nor as a *>counselor< for individuals.

713.03 Interview for "Sounding Out" Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

713.04 Substance of Interview Must Be Made of Record [R-3]

A complete written statement as to the substance of any face-to-face, video conference, electronic mail or telephone interview with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See 37 CFR 1.133(b), MPEP § 502.03 and § 713.01.

37 CFR 1.133. Interviews.

*****

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

37 CFR 1.2. Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the U.S. Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, except where the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form (PTOL-413B) that the examiner will provide a written summary. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. If applicant initiated the interview, a copy of the completed "Applicant Initiated Interview Request" form, PTOL-413A (if available), should be attached to the Interview Summary form, PTOL-413 and a copy be given to the applicant (or applicant's attorney or agent), upon completion of the interview. If the examiner initiates an interview, the examiner should complete part I of the "Examiner Initiated Interview Summary" form, PTOL-413B, in advance of the interview identifying the rejections, claims and prior art documents to be discussed with applicant. The examiner should complete parts II and III of the "Examiner Initiated Interview Summary" form at the conclusion of the interview. The completed PTOL-413B form will be considered a proper interview summary record and it will not be necessary for the examiner to complete a PTOL-413 form. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview

recordation is otherwise provided for in MPEP § 812.01, or pointing out typographical errors in Office actions or the like, are excluded from the interview recordation procedures below. Where a complete record of the interview has been incorporated in an examiner's amendment, it will not be necessary for the examiner to complete an Interview Summary form.

The Interview Summary form PTOL 413 shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. For Image File Wrapper (IFW) processing, see IFW Manual. In a personal interview, the duplicate copy of the Interview Summary form along with any attachment(s) is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic, electronic mail or video conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. In addition, a copy of the form may be faxed to applicant (or applicant's attorney or agent) at the conclusion of the interview. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Interview Summary form should be mailed promptly after the telephonic, electronic mail or video conference interview rather than with the next official communication.

The PTOL-413 form provides for recordation of the following information:

(A) application number;

(B) name of applicant;

(C) name of examiner;

(D) date of interview;

(E) type of interview (personal, telephonic, electronic mail or video conference);

(F) name of participant(s) (applicant, attorney, or agent, etc.);

(G) an indication whether or not an exhibit was shown or a demonstration conducted;

(H) an identification of the claims discussed;

(I) an identification of the specific prior art discussed;

(J) an indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.);

(K) the signature of the examiner who conducted the interview;

(L) names of other U.S. Patent and Trademark Office personnel present.

The PTOL-413 form also contains a statement reminding the applicant of his or her responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview in each case unless the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form, PTOL-413B, that the examiner will provide a written summary.

Where an interview initiated by the applicant results in the allowance of the application, the applicant is advised to file a written record of the substance of the interview as soon as possible to prevent any possible delays in the issuance of a patent. Where an examiner initiated interview directly results in the allowance of the application, the examiner may check the appropriate box on the "Examiner Initiated Interview Summary" form, PTOL-413B, to indicate that the examiner will provide a written record of the substance of the interview with the Notice of Allowability.

It should be noted, however, that the Interview Summary form will not be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant, or the examiner to include, all of the applicable items required below concerning the substance of the interview.

The complete and proper recordation of the substance of any interview should include at least the following applicable items:

(A) a brief description of the nature of any exhibit shown or any demonstration conducted;

(B) identification of the claims discussed;

(C) identification of specific prior art discussed;

(D) identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner;

(E) the general thrust of the principal arguments of the applicant and the examiner should

also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner;

(F) a general indication of any other pertinent matters discussed;

(G) if appropriate, the general results or outcome of the interview; and

(H) in the case of an interview via electronic mail, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form, PTOL 413, is entered.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner may give the applicant a 1-month time period to complete the reply under 37 CFR 1.135(c) where the record of the substance of the interview is in a reply to a nonfinal Office action.

¶ *7.84 Amendment Is Non-Responsive to Interview*

The reply filed on **[1]** is not fully responsive to the prior Office action because it fails to include a complete or accurate record of the substance of the **[2]** interview. **[3]** Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Examiner Note:

1. In bracket 2, insert the date of the interview.
2. In bracket 3, explain the deficiencies.

EXAMINER TO CHECK FOR ACCURACY

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him or her.

If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials. For Image File Wrapper (IFW) processing, see IFW Manual.

**>

Examiner-Initiated Interview Summary	**Application No.**	**Applicant(s)**	
	Examiner	**Art Unit**	

All Participants:

(1) _____.

(2) _____.

Status of Application: _____

(3) _____.

(4) _____.

Date of Interview: _____

Time: _____

Type of Interview:

☐ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☐ No
If Yes, provide a brief description: .

Part I.

Rejection(s) discussed:

Claims discussed:

Prior art documents discussed:

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

Part III.

☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

_____ (Examiner/SPE Signature)

_____ (Applicant/Applicant's Representative Signature – if appropriate)

U.S. Patent and Trademark Office
PTOL-413B (04-03) Examiner Initiated Interview Summary Paper No.

<

713.05 Interviews Prohibited or Granted, Special Situations [R-2]

>For< Saturday interviews, see MPEP § 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after an application has been passed to issue.

An interview may be appropriate before applicant's first reply when the examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Office employees are forbidden to hold either oral or written communication with an unregistered or a suspended or excluded attorney or agent regarding an application unless it is one in which said attorney or agent is the applicant. See MPEP § 105.

Interviews (MPEP § 713) are frequently requested by persons whose credentials are of such informal character that there is serious question as to whether such persons are entitled to any information under the provisions of 37 CFR 1.14. In general, interviews are not granted to persons who lack proper authority from the applicant or attorney or agent of record in the form of a paper on file in the application **. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

**>Interviews are generally not< granted to registered individuals who are known to be the local representatives of the attorney in the application **>unless< a power of attorney to them is * of record in the particular application. **>Note that pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure. Furthermore, a practitioner can not authorize a nonpractitioner to conduct interviews since this would be contrary to 37 CFR 10.47.<

While a registered practitioner not of record may request a telephone interview (if the practitioner is authorized to do so by the applicant or the attorney of record), it is recommended that a facsimile transmission of a power of attorney be filed prior to the interview. Otherwise, the examiner will conduct the telephone interview with the Office's file closed and work solely from the practitioner's file, which may be difficult to do over the phone.

Interviews normally should not be granted unless the requesting party has authority to bind the principal concerned.

The availability of personal interviews in the "Conference Period," which is the time between the filing of applicant's thorough first reply and a concluding action by the examiner, for attorneys resident or frequently in the Washington, D.C. area is obvious. For others, more remote, telephone, electronic mail, or video conference interviews may prove valuable. However, present Office policy places great emphasis on telephone interviews initiated by the examiner to attorneys and agents of record. See MPEP § 408.

The examiner, by making a telephone call, may be able to suggest minor, probably quickly acceptable changes which would result in allowance. If there are *major* questions or suggestions, the call might state them concisely, and suggest a further telephone, electronic mail, or personal interview, at a prearranged later time, giving applicant more time for consideration before discussing the points raised.

For an interview with an examiner who does not have negotiation authority, arrangements should always include an examiner who does have such authority, and who is familiar with the application, so that authoritative agreement may be reached at the time of the interview.

GROUPED INTERVIEWS

For attorneys remote from the Washington, D.C. area who prefer personal or video conference interviews, the grouped interview practice is effective. If in any case there is a prearranged interview, *with agreement to file a prompt supplemental amendment putting the case as nearly as may be in condition for concluding action,* prompt filing of the supplemental amendment gives the application special status, and brings it up for immediate special action.

713.06 No *Inter Partes* Questions Discussed *Ex Parte*

The examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties.

713.07 Exposure of Other Cases

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

713.08 Demonstration, Exhibits, Models [R-3]

The invention in question may be exhibited or demonstrated during the interview by a model >or exhibit< thereof. *>A model or exhibit will not generally be admitted as part of the record of an application. See 37 CFR 1.91. However, a< model **>or exhibit submitted by< the applicant ** which complies with 37 CFR 1.91 **>would be< made part of the application record **. See MPEP § 608.03 and § 608.03(a). For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.

** If the model or exhibit is merely used for demonstration purpose **>during the course of the interview, it will not be< made part of the record (does not comply with 37 CFR 1.91)**>. A< full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances.

714 Amendments, Applicant's Action [R-3]

37 CFR 1.121. Manner of making amendments in application.

(a) *Amendments in applications, other than reissue applications.* Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) *Specification.* Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) *Amendment to delete, replace, or add a paragraph.* Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and;

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) *Amendment by replacement section*. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and;

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) *Amendment by substitute specification*. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) *Reinstatement of previously deleted paragraph or section*. A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) *Presentation in subsequent amendment document*. Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be represented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn— currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

**>

(d) *Drawings*: One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled "Replacement Sheet". Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as "New Sheet". All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner. <

(e) *Disclosure consistency.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

(g) *Exception for examiner's amendments.* Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) *Amendment sections.* Each section of an amendment document (*e.g.*, amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) *Amendments in reexamination proceedings.* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) *Amendments in provisional applications.* Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

I. WHEN APPLICANT MAY AMEND

The applicant may amend:

(A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; *

(C) >after the date of filing a notice of appeal pursuant to 37 CFR 41.31(a), if the amendment meets the criteria of 37 CFR 41.33; and

(D) < when and as specifically required by the examiner.

Amendments in provisional applications are not normally made. If an amendment is made to a provisional application, however, it must comply with the provisions of 37 CFR 1.121. Any amendments to a provisional application will be placed in the provisional application file, but may not be entered.

II. MANNER OF MAKING AMENDMENTS >UNDER 37 CFR 1.121<

All amendments filed on or after July 30, 2003 must comply with 37 CFR 1.121 as revised in the notice of final rule making published in the *Federal Register* on June 30, 2003 at 65 *Fed. Reg*. 38611. The manner of making amendments has been revised to assist in the implementation of beginning-to-end electronic image processing of patent applications. Specifically, changes have been made to facilitate electronic image data capture and processing and streamline the patent application process. If an amendment filed on or after July 30, 2003 does not comply with revised 37 CFR 1.121, the Office will notify applicants via a Notice of Non-Compliant Amendment that the amendment is not accepted. **

The revised amendment practice is summarized as follows.

A. Amendment Sections

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet to facilitate separate indexing and electronic scanning of each section of an amendment document for placement in an image file wrapper.

It is recommended that applicants use the following format when submitting amendment papers. The amendment papers should include, in the following order:

(A) a cover sheet, or introductory comments, providing the appropriate application information (e.g., application number, applicant, filing date) and which serves as a table of contents to the amendment document by indicating on what page of the amendment document each of the following sections begin;

(B) a section (must begin on a separate sheet) entitled "Amendments to the Specification" (if there are any amendments to the specification). This section should include all amendments to the specification including amendments to the abstract of the disclosure;

(C) a section (must begin on a separate sheet) entitled "Amendments to the Claims" which includes a complete listing of all claims ever presented in the application (if there are any amendments to the claims);

(D) a section (must begin on a separate sheet) entitled "Amendments to the Drawings" in which all changes to the drawings are discussed (if there are any amendments to the drawings);

(E) a remarks section (must begin on a separate sheet); and

(F) any drawings being submitted including any "Replacement Sheet," "New Sheet," or "Annotated **>Sheet<."

B. Amendments to the Specification

Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification. In order to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining).

Where paragraph numbering has been included in an application as provided in 37 CFR 1.52(b)(6), applicants can easily refer to a specific paragraph by number when presenting an amendment. If a numbered paragraph is to be replaced by a single paragraph, the added replacement paragraph should be numbered with the same number of the paragraph being replaced. Where more than one paragraph is to replace a single original paragraph, the added paragraphs should be numbered using the number of the original paragraph for the first replacement paragraph, followed by increasing decimal numbers for the second and subsequent added paragraphs, e.g., original paragraph [0071] has been replaced with paragraphs [0071], [0071.1], and [0071.2]. If a numbered paragraph is deleted, the numbering of the subsequent paragraphs should remain unchanged.

37 CFR 1.121(b)(1)(ii) requires that the full text of any replacement paragraph be provided with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters (e.g., [[eroor]]). >The term "brackets" set forth in 37 CFR 1.121 means square brackets – [ ], and not parentheses – ( ).<The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived (e.g., deletion of the number "4" must be shown as [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as). For added paragraphs, 37 CFR 1.121(b)(2)(iii) requires that the full text of any added paragraph(s) be presented in clean form without any underlining. Similarly, under 37 CFR 1.121(b)(2)(iv), a marked up version does not have to be supplied for any deleted paragraph(s). It is sufficient to merely indicate or identify any paragraph that has been deleted. The instruction to delete may identify a paragraph by its paragraph number, page and line number, or include a few words from the beginning, and end,

or the paragraph, if needed for paragraph identification.

Applicants are also permitted to amend the specification by replacement sections (e.g., as provided in 37 CFR 1.77(b), 1.154(b), or 1.163(c)). As with replacement paragraphs, the amended version of a replacement section is required to be provided with markings to show all the changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted subject matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show the deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) and (c) are met. >Under 37 CFR 1.125, a clean version of the substitute specification, a< separate marked up version showing the changes in the specification relative to the previous version **>, and a statement that the substitute specification contains no new matter are< required.

Any previously deleted paragraph or section can only be reinstated by a subsequent amendment presenting the previously deleted subject matter. A direction by applicant to remove a previously entered amendment will not be permitted.

C. Amendments to the Claims

Each amendment document that includes a change to an existing claim, including the deletion of an existing claim, or submission of a new claim, must include a complete listing of all claims >ever presented (including previously canceled and non-entered claims)< in the application. After each claim number, the status >identifier< of the claim must be *>presented< in a parenthetical expression, and the text of each claim under examination as well as all withdrawn claims (each with markings if any, to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

(A) >**Status Identifiers:**< The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following >status identifiers<: (original), (currently amended), (previously presented), (canceled), (withdrawn), (new), or (not entered). **>The status identifier (withdrawn – currently amended) is also acceptable for a withdrawn claim that is being currently amended. See paragraph (E) below for acceptable alternative status identifiers.

Claims added by a preliminary amendment must have the status identifier (new) instead of (original), even when the preliminary amendment is present on the filing date of the application and such claim is treated as part of the original disclosure. If applicant files a subsequent amendment, applicant must use the status identifier (previously presented) if the claims are not being amended, or (currently amended) if the claims are being amended, in the subsequent amendment. Claims that are canceled by a preliminary amendment that is present on the filing date of the application are required to be listed and must have the status identifier (canceled) in the preliminary amendment and in any subsequent amendment.

The status identifier (not entered) is used for claims that were previously proposed in an amendment (e.g., after-final) that was denied entry.

For any amendment being filed in response to a restriction or election of species requirement and any subsequent amendment, any claims which are non-elected must have the status identifier (withdrawn). Any non-elected claims which are being amended must have either the status identifier (withdrawn) or (withdrawn – currently amended) and the text of the non-elected claims must be presented with markings to indicate the changes. Any non-elected claims that are being canceled must have the status identifier (canceled).<

(B) >**Markings to Show the Changes:**< All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by strike-through (for deleted matter) or underlining (for added matter) with 2 exceptions: (1) for deletion of five or fewer consecutive characters, double brackets may be used (e.g., [[eroor]]); (2) if strike-through cannot be easily perceived (e.g., deletion of number “4”

or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strike-through, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" or "withdrawn" will include markings.

>Any claims added by amendment must be indicated as "new" and the text of the claim must not be underlined.<

(C) >**Claim Text:** The text of all pending claims under examination and withdrawn claims must be submitted each time any claim is amended.< The text of pending claims not being currently amended, including withdrawn claims, must be presented in clean version, i.e., without any markings. Any claim presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims. >A claim being canceled must be indicated as "canceled;" the text of the claim must not be presented. Providing an instruction to cancel is optional. Canceled and not entered claims must be listed by only the claim number and status identifier, without presenting the text of the claims. When applicant submits the text of canceled or not-entered claims in the amendment, the Office may accept such an amendment, if the amendment otherwise complies with 37 CFR 1.121, instead of sending out a notice of noncompliant amendment to reduce the processing time.<

**>

(D) **Claim Numbering:**< All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or not entered claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. >The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. For example, when applicant cancels all of the claims in the original specification and adds a new set of claims, the claim listing must include all of the canceled claims with the status identifier (canceled) (the canceled claims may be aggregated into one statement). The new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not) in compliance with 37 CFR 1.126.<

Example of listing of claims:

Claims 1-5 (canceled)

Claim 6 (withdrawn): A process for molding a bucket.

Claim 7 (previously presented): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn): The process for molding a bucket of claim 6 using molten plastic material.

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (previously presented): A bucket having a circumferential upper lip.

Claim 13 (not entered)

Claim 14 (new): A bucket with plastic sides and bottom.

**>

(E) **Acceptable Alternative Status Identifiers***:* To prevent delays in prosecution, the Office will waive certain provisions of 37 CFR 1.121 and accept alternative status identifiers not specifically set forth in 37 CFR 1.121(c). See *Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)*, O.G. (July 5, 2005). Accordingly claim listings that include alternative status identifiers as set forth below may be accepted if the amendment otherwise complies with 37 CFR 1.121.

Status Identifiers Set Forth in 37 CFR 1.121(c)	**Acceptable Alternatives**
1. Original	Original Claim; and Originally Filed Claim
2. Currently amended	Presently amended; and Currently amended claim
3. Canceled	Canceled without prejudice; Cancel; Canceled; Canceled herein; Previously canceled; Canceled claim; and Deleted
4. Withdrawn	Withdrawn from consideration; Withdrawn – new; Withdrawn claim; and Withdrawn – currently amended
5. Previously presented	Previously amended; Previously added; Previously submitted; and Previously presented claim
6. New	Newly added; and New claim
7. Not entered	Not entered claim

The Office may also accept additional variations of the status identifiers provided in 37 CFR 1.121(c) not listed above if an Office personnel determines that the status of the claims is accurate and clear. When accepting alternative status identifiers, the examiner is not required to correct the status identifiers using an examiner's amendment. Applicant will not be notified and will not be required to submit a corrective compliant amendment. The examiner does not need to make a statement on the record that the alternative status identifiers have been accepted.<

D. Amendments to the Drawing

Any changes to an application drawing must comply with 37 CFR 1.84 and must be submitted on a replacement sheet of drawings>, even when applicant is only submitting better quality drawings without any substantive changes. Any additional new drawings must be submitted on a new sheet of drawings<. The replacement >or new< sheet of drawings must be an attachment to the amendment document and must be identified in the top margin as "Replacement Sheet." >The new drawing sheet must be identified in the top margin as "New Sheet."< The replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as "Annotated **>Sheet<" and must be presented in the amendment or remarks section that explains the change to the drawings. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

An explanation of the changes made must be presented in the "Amendments to the Drawings" or the remarks section of the amendment document. If the changes to the drawing figure(s) are not approved by the examiner, applicant will be notified in the next Office action. >Applicant must amend the brief and detailed description of drawings sections of the specification if they are not consistent with the changes to the drawings. For example, when applicant files a new drawing sheet, an amendment to the specification is required to add the brief and detailed description of the new drawings.

The proposed drawing correction practice has been eliminated. For any changes to the drawings, applicant is required to submit a replacement sheet of drawings with the changes made. No proposed changes in red ink should be submitted. Any proposed drawing corrections will be treated as non-compliant under 37 CFR 1.121(d). In response to any drawing objections, applicant should submit drawing changes by filing a replacement sheet of drawings or a new sheet of drawings with the corrections made. A letter to the official draftsman is no longer required.

Drawing submissions without any amendments to the specification and claims after allowance should be forwarded to the Office of Patent Publication.

E. Examiner's Amendments

37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Additions or deletions of subject matter in the specification, including the claims, may be made by instructions to make the change at a precise location in the specification or the claims. Examiner's amendments do not need to comply with paragraphs (b)(1), (b)(2), or (c) of 37 CFR 1.121. See MPEP § 1302.04.

If a non-compliant amendment would otherwise place the application in condition for allowance, the examiner may enter the non-compliant amendment and provide an examiner's amendment to correct the non-compliance (e.g., an incorrect status identifier). Similarly, if an amendment under 37 CFR 1.312 after allowance is non-compliant under 37 CFR 1.121 and the entry of the amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance (e.g., an incorrect status identifier) using an examiner's amendment. See subsection "F. Non-Compliant Amendments" for more information on non-compliant amendments. For example, if some of the status identifiers are incorrect in an amendment, the examiner may enter the non-compliant amendment and:

(A) provide a claim listing presenting all of the claims with the proper status identifiers in an examiner's amendment;

(B) print a copy of the claim listing of the non-compliant amendment, cross out the improper status identifiers, write in the correct status identifiers and include it as an attachment to an examiner's amendment; or

(C) correct the improper status identifiers by instructions in an examiner's amendment.

The examiner's amendment should include the reason why the amendment is non-compliant and indicate how it was corrected. Authorization from the applicant or attorney/agent of record and appropriate extensions of time are not required if the changes are not substantive (e.g., corrections of format errors or typographical errors). Such an examiner's amendment may be made after the time period for reply, or after the shortened statutory period without any extensions of time, as long as the non-compliant amendment was timely filed.

Authorization and appropriate extensions of time are required if the changes made in the examiner's amendment are substantive (e.g., the examiner's amendment would include a cancellation of a claim or change the scope of the claims). The authorization must be given within the time period for reply set forth in the last Office action. See MPEP § 1302.04.

F. Non-Compliant Amendments

If an amendment submitted on or after July 30, 2003, fails to comply with 37 CFR 1.121 (as revised on June 30, 2003), the Office will notify applicant by a Notice of Non-Compliant Amendment, Form PTOL-324, that the amendment fails to comply with the requirements of 37 CFR 1.121 and identify: (1) which section of the amendment is non-compliant (e.g., the amendments to the claims section); (2) items that are required for compliance (e.g., a claim listing in compliance with 37 CFR 1.121(c)); and (3) the reasons why the section of the amendment fails to comply with 37 CFR 1.121 (e.g., the status identifiers are missing). The type of amendment will determine whether applicant will be given a period of time in which to comply with the rule and whether applicant's reply to a notice should consist of the corrected section of the amendment (e.g., a complete claim listing in compliance of 37 CFR 1.121(c)) instead of the entire corrected amendment. If the noncompliant amendment is:

(A) A **preliminary amendment filed after the filing date of the application**, the technical support staff (TSS) will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the preliminary amendment. Applicant's reply is required to include the corrected section of the amendment.

(B) A **preliminary amendment that is present on the filing date of the application**, the Office of Initial Patent Examination (OIPE) will send applicant a notice (e.g., Notice to File Corrected Application

Papers) which sets a time period of 2 months for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to the OIPE notice will result in abandonment of the application. Applicant's reply is required to include either a substitute specification under 37 CFR 1.125 if the amendment is to the specification, or a complete claim listing under 37 CFR 1.121(c) if the amendment is to the claims.

(C) A **non-final amendment** including an amendment filed as a submission for an RCE, the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to this notice will result in abandonment of the application. Applicant's reply is required to include the corrected section of the amendment.

(D) An **after-final amendment**, the amendment will be forwarded in unentered status to the examiner. In addition to providing reasons for non-entry when the amendment is not in compliance with 37 CFR 1.116 (e.g., the proposed amendment raises new issues that would require further consideration and/or search), the examiner should also indicate in the advisory action any non-compliance in the after-final amendment. The examiner should attach a Notice of Non-Compliant Amendment to the advisory action. The notice provides no new time period for correcting the non-compliance. The time period for reply continues to run from the mailing of the final Office action. Applicant still needs to respond to the final Office action to avoid abandonment of the application. If the applicant wishes to file another after-final amendment, the entire corrected amendment (not only the corrected section of the amendment) must be submitted within the time period set forth in the final Office action.

(E) A **supplemental amendment filed when there is no suspension of action** under 37 CFR 1.103(a) or (c), the amendment will be forwarded to the examiner. Such a supplemental amendment is not entered as a matter of right. See 37 CFR 1.111(a)(2)(ii). The examiner will notify the applicant if the amendment is not approved for entry. The examiner may use form paragraph 7.147. See MPEP § 714.03(a).

(F) A **supplemental amendment filed within a suspension period** under 37 CFR 1.103(a) or (c) (e.g., applicant requested a suspension of action at the time of filing an RCE), the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the supplemental amendment. Applicant's reply is required to include the corrected section of the amendment.

(G) An **amendment filed in response to a *Quayle action***, the TSS will send the notice which sets a time period of 30 days or one month, whichever is later, for reply. Extensions of time are available under 37 CFR 1.136(a). Failure to reply to this notice will result in abandonment of the application. Applicant's reply is required to include the corrected section of the amendment.

(H) An **after-allowance amendment** under 37 CFR 1.312, the amendment will be forwarded to the examiner. Amendments under 37 CFR 1.312 are not entered as matter of right. The examiner will notify the applicant if the amendment is not approved for entry. The examiner may attach a Notice of Non-Compliant Amendment (37 CFR 1.121) to the form PTO-271, Response to Rule 312 Communication (see MPEP § 714.16(d)). The notice provides no new time period. If applicant wishes to file another after-allowance amendment under 37 CFR 1.312, the entire corrected amendment must be submitted before the payment of the issue fee.

Any amendments (including after-final amendments) that add new claims in excess of the number of claims previously paid for in an application must be accompanied by the payment of the required excess claims fees. Failure to pay the excess claims fees will result in non-entry of the amendment. See MPEP § 607.

G. Entry of Amendments, Directions for, Defective

The directions for the entry of an amendment may be defective. Examples include inaccuracy in the paragraph number and/or page and line designated, or a lack of precision where the paragraph or section to which insertion of the amendment is directed occurs. If the correct place of entry is clear from the context, the amendatory paper will be properly amended in the Technology Center and notation thereof, initialed in ink by the examiner, who will assume full responsibil-

ity for the change, will be made on the margin of the amendatory paper. In the next Office action, the applicant should be informed of this alteration in the amendment and the entry of the amendment as thus amended. The applicant will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

H. Amendment of Amendments

When a replacement paragraph or section of the specification is to be amended, it should be wholly rewritten and the original insertion canceled. A marked-up version of the replacement paragraph or section of the specification should be presented using underlining to indicate added subject matter and strike-through to indicate deleted subject matter. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion. A claim cancelled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.<

>

Notice of Non-Compliant Amendment (37 CFR 1.121)	**Application No.**	**Applicant(s)**	
	Examiner	**Art Unit**	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on _____ is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____.

☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____.

☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
- ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
- ☐ C. Other _____.

☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
- ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf .

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.

2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

   Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

   Failure to timely respond to this notice will result in:
   Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
   Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

U.S. Patent and Trademark Office
PTOL-324 (11-04)

Notice of Non-Compliant Amendment (37 CFR 1.121)

Part of Paper No.

<

III. AMENDMENT IN REEXAMINATION PROCEEDINGS AND REISSUE APPLICATIONS

Amendments in reissue applications must be made in accordance with 37 CFR 1.173. Amendments in *ex parte* and *inter partes* reexamination proceedings must be made in accordance with 37 CFR 1.530. In patent-owner-filed *ex parte* reexaminations, the patent owner may amend at the time of the request for *ex parte* reexamination in accordance with 37 CFR 1.510(e). In any *ex parte* reexamination proceeding, no amendment or response can be filed between the date of the request for *ex parte* reexamination and the order for *ex parte* reexamination. See 37 CFR 1.530(a). Following the order for *ex parte* reexamination under 37 CFR 1.525 and prior to the examination phase of *ex parte* reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the *ex parte* reexamination proceeding, an amendment may be filed:

(A) after the first examination as specified in 37 CFR 1.112;

(B) after final rejection or an appeal has been taken, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in *ex parte* reexamination proceedings see MPEP § 2250 and § 2266. For amendments by patent owner in an *inter partes* reexamination proceeding, see MPEP § 2666.01 and § 2672. For amendments in reissue applications, see MPEP § 1453.

714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

714.01(a) Unsigned or Improperly Signed Amendment [R-3]

37 CFR 1.33. Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

*****

**>

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34;<

(3) An assignee as provided for under § 3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

*****

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

**

When an unsigned or improperly signed amendment is received the amendment will be listed in the contents of the application file, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of form paragraph 7.84.01.

¶ *7.84.01 Paper Is Unsigned*

The proposed reply filed on **[1]** has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney or agent of record, since he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

714.01(c) Signed by Attorney or Agent Not of Record

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he or she does not have a power of attorney in the application. See MPEP § 402.

714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney or agent, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other directly to the applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

714.01(e) Amendments Before First Office Action [R-3]

>

37 CFR 1.115. Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104. The patent application publication may include preliminary amendments (§ 1.215 (a)).

(1) A preliminary amendment that is present on the filing date of an application is part of the original disclosure of the application.

(2) A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application.

*****

<

A preliminary amendment is an amendment that is received in the Office on or before the mail date of the first Office action under 37 CFR 1.104. See 37 CFR 1.115(a). >For applications filed on or after September 21, 2004 (the effective date of 37 CFR 1.115(a)(1)), a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed before September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration under 37 CFR 1.63 filed in the application. See MPEP § 602. Any amendment filed after the filing date of the application is not part of the original disclosure of the application. See MPEP § 706.03(o) regarding new matter. When the Office publishes the application under 35 U.S.C. 122(b), the Office may include preliminary amendments in the patent application publication. See MPEP § 1121.<

Since a request for continued examination (RCE) is not a new application, an amendment filed before the first Office action after the filing of the RCE is not a preliminary amendment. See MPEP § 706.07(h). >Any amendment canceling claims in order to reduce the excess claims fees should be filed before the expiration of the time period set forth in a notice that requires excess claims fees. Such an amendment would be effective to reduce the number of claims to be considered in calculating the excess claims fees. See MPEP § 607.<

I. PRELIMINARY AMENDMENTS MUST COMPLY WITH 37 CFR 1.121

Any preliminary amendment, regardless of when it is filed, must comply with 37 CFR 1.121, e.g., the preliminary amendment must include a complete listing of all of the claims and each section of the amendment must begin on a separate sheet of paper. See MPEP § 714. Preliminary amendments made in a transmittal letter of the application will not comply

with 37 CFR 1.121. For example, applicants should include the reference to a prior filed application in the first sentence>(s)< of the specification following the title or in an application data sheet in compliance with 37 CFR 1.78 instead of submitting the reference in a preliminary amendment in a transmittal letter. See MPEP § 201.11. If a preliminary amendment >filed after the filing date of the application< fails to comply with 37 CFR 1.121, applicant will be notified by way of a Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121. If the applicant takes no corrective action, examination of the application will commence without consideration of the proposed changes in the non-compliant preliminary amendment. >If a preliminary amendment that is present on the filing date of the application fails to comply with 37 CFR 1.121, the Office of Initial Patent Examination (OIPE) will notify applicant of the non-compliance and give a two-month time period to correct the non-compliance to avoid the abandonment of the application.< See MPEP § *>714<.

Filing a preliminary amendment is not recommended because the changes made by the preliminary amendment may not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration. If there is insufficient time to have the preliminary amendment be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun, the preliminary amendment will not be reflected in the patent application publication. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. For more information on publication of applications, see MPEP § 1121. Applicants may avoid preliminary amendments by incorporating any desired amendments into the text of the specification including a new set of claims, even where the application is a continuation or divisional application of a previously filed patent application. In such a continuation or divisional application, a clean copy of a specification (i.e., reflecting amendments made in the parent application) may be submitted together with a copy of the oath or declaration from the previously filed application so long as no new matter is included in the specification. See 37 CFR 1.63(d)(1)(iii) and MPEP § 201.06(c).

II. PRELIMINARY AMENDMENTS **> PRESENT ON THE FILING DATE OF< THE APPLICATION

**>For applications filed on or after September 21, 2004 (the effective date of 37 CFR 1.115(a)(1)), a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed before September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration under 37 CFR 1.63 filed in the application. See MPEP § 602 and § 608.04(b).

If a preliminary amendment is present on the filing date of an application, and the oath or declaration under 37 CFR 1.63 does not refer to the preliminary amendment, the normal operating procedure is to not screen the preliminary amendment to determine whether it contains subject matter not otherwise included in the specification or drawings of the application as filed (i.e., subject matter that is "new matter" relative to the specification and drawings of the application). As a result, it is applicant's obligation to review the preliminary amendment to ensure that it does not contain subject matter not otherwise included in the specification or drawings of the application as filed. If the preliminary amendment contains subject matter not otherwise included in the specification and drawings of the application, applicant must provide a supplemental oath or declaration under 37 CFR 1.67 referring to such preliminary amendment. The failure to submit a supplemental oath or declaration under 37 CFR 1.67 referring to a preliminary amendment that contains subject matter not otherwise included in the specification or drawings of the application as filed removes safeguards that are implied in the oath or declaration requirements that the inventor review and understand the contents of the application, and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined in 37 CFR 1.56.

Applicants can avoid the need to file an oath or declaration referring to any preliminary amendment by incorporating any desired amendments into the text of

the specification including a new set of claims when filing the application instead of filing a preliminary amendment, even where the application is a continuation or divisional application of a prior-filed application. Furthermore, applicants are strongly encouraged to avoid submitting any preliminary amendments so as to minimize the burden on the Office in processing preliminary amendments and reduce delays in processing the application. During examination, if an examiner determines that a preliminary amendment that is present on the filing date of the application includes subject matter not otherwise supported by the originally filed specification and drawings, and the oath or declaration does not refer to the preliminary amendment, the examiner may require the applicant to file a supplemental oath or declaration under 37 CFR 1.67 referring to the preliminary amendment. In response to the requirement, applicant must submit (1) an oath or declaration that refers to the preliminary amendment, (2) an amendment that cancels the subject matter not supported by the originally filed specification and drawings, or (3) a request for reconsideration.

For applications filed prior to September 21, 2004, a preliminary amendment that is present on the filing date of an application may be considered a part of the original disclosure if it is referred to in a first filed oath or declaration in compliance with 37 CFR 1.63. If the preliminary amendment was not referred to in the oath or declaration, applicant will be required to submit a supplemental oath or declaration under 37 CFR 1.67 referring to both the application and the preliminary amendment filed with the original application. A surcharge under 37 CFR 1.16(f) will also be required unless it has been previously paid.<

III. PRELIMINARY AMENDMENTS MUST BE TIMELY

Any preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date so that the preliminary amendments would include the appropriate identifications (e.g., the application number and filing date). See MPEP § 502. Any amendments filed after the mail date of the first Office action is not a preliminary amendment. If the date of receipt (37 CFR 1.6) of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment. See MPEP § 714.03.
>

IV. PRELIMINARY AMENDMENTS MAY BE DISAPPROVED

37 CFR 1.115. Preliminary amendments.

*****

(b) A preliminary amendment in compliance with § 1.121 will be entered unless disapproved by the Director.

(1) A preliminary amendment seeking cancellation of all the claims without presenting any new or substitute claims will be disapproved.

(2) A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(3) A preliminary amendment will not be disapproved under (b)(2) of this section if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53 (b);

(ii) The filing date of a continued prosecution application under § 1.53 (d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(4) The time periods specified in paragraph (b)(3) of this section are not extendable.<

A preliminary amendment >filed in compliance with 37 CFR 1.121< will be entered unless it is disapproved by the Director. A preliminary amendment *>will be disapproved by the Director if the preliminary amendment cancels all the claims in the application without presenting any new or substitute claims. A preliminary amendment may also< be disapproved by the Director if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b). **
>

A. Cancellations of All the Claims

If applicant files a preliminary amendment (whether submitted prior to, on or after the filing date

of the application) seeking cancellation of all claims in the application without presenting any new claims, the Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co*., 265 F.3d 1249, 60 USPQ2d 1369 (Fed. Cir. 2001), 37 CFR 1.115(b)(1), and MPEP § 601.01(e). Thus, the application will not be denied a filing date merely because such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim. In most cases, an amendment that cancels all the claims in the application without presenting any new claims would not meet the requirements of 37 CFR 1.121(c) that requires a complete claim listing. See MPEP § 714. The Office will send a notice of noncompliant amendment (37 CFR 1.121) to applicant and require an amendment in compliance with 37 CFR 1.121.

B. Unduly Interferes With the Preparation of an Office Action

Once the examiner has started to prepare a first Office action, entry of a preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of the first Office action. Applicants are encouraged to file all preliminary amendments as soon as possible. Entry of a preliminary amendment will not be disapproved under 37 CFR 1.115(b)(2) if it is filed no later than:

(A) 3 months from the filing date of the application under 37 CFR 1.53(b);

(B) 3 months from the date the national stage is entered as set forth in 37 CFR 1.491 in an international application;

(C) the filing date of a CPA under 37 CFR 1.53(d) in a design application; or

(D) the last day of any suspension period requested by applicant under 37 CFR 1.103 (see MPEP § 709).

Even if the examiner has spent a significant amount of time preparing the first Office action, entry of a preliminary amendment filed within these time periods should not be disapproved under 37 CFR 1.115(b)(2). These time periods are not extendable. See 37 CFR 1.115(b)(4).

If a preliminary amendment is filed after these time periods and the conditions set forth below are met, entry of the preliminary amendment may be denied subject to the approval of the supervisory patent examiner (MPEP § 1002.02(d)).

1. When Disapproval is Appropriate

The factors that will be considered for denying entry of preliminary amendments under 37 CFR 1.115 include:

(A) The state of preparation of a first Office action as of the date of receipt (37 CFR 1.6) of the preliminary amendment; and

(B) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

The entry of a preliminary amendment that would unduly interfere with the preparation of an Office action may be denied if the following two conditions are met:

(A) the examiner has devoted a significant amount of time on the preparation of an Office action before the amendment is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment); and

(B) the entry of the amendment would require significant additional time in the preparation of the Office action.

For example, if the examiner has spent a significant amount of time to conduct a prior art search or draft an Office action before a preliminary amendment is received by the Office, the first condition is satisfied. Entry of the amendment may be denied if it:

(A) amends the claims;

(B) adds numerous new claims;

(C) amends the specification to change the scope of the claims;

(D) amends the specification so that a new matter issue would be raised;

(E) includes arguments;

(F) includes an affidavit or declaration under 37 CFR 1.131 or 37 CFR 1.132; or

(G) includes evidence traversing rejections from a prior Office action in the parent application,

and would require the examiner to spend significant additional time to conduct another prior art search or revise the Office action (i.e., the second condition is satisfied). This list is not an exhaustive list, and the entry of a preliminary amendment may be denied in

other situations that satisfy the two conditions set forth above. Once these conditions are met, the examiner should obtain the approval of the SPE before the entry of the amendment may be denied.

2. When Disapproval is Inappropriate

Denying entry of a preliminary amendment under 37 CFR 1.115(b)(2) is inappropriate if either:

(A) the examiner has NOT devoted a significant amount of time on the preparation of an Office action before the amendment is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment); or

(B) the entry of the amendment would NOT require significant additional time in the preparation of the Office action.

Thus, the amendment will be entered unless it is denied entry for other reasons such as those listed in MPEP § 714.19.

For example, if before the preliminary amendment is received in the Office, the examiner has not started working on the Office action or has started, but has merely inspected the file for formal requirements, then the examiner should enter and consider the preliminary amendment.

Furthermore, even if the examiner has devoted a significant amount of time to prepare an Office action prior to the date the preliminary amendment is received in the Office, it is not appropriate to disapprove the entry of such an amendment if it:

(A) merely cancels some of the pending claims;

(B) amends the claims to overcome rejections under 35 U.S.C. 112, second paragraph;

(C) amends the claims to place the application in condition for allowance; or

(D) only includes changes that were previously suggested by the examiner, and would not require the examiner to spend significant additional time to revise the Office action.

3. Form Paragraph

Form paragraph 7.46 should be used to notify applicant that the entry of a preliminary amendment is denied because the amendment unduly interferes with the preparation of an Office action.

¶ *7.46 Preliminary Amendment Unduly Interferes with the Preparation of an Office Action*

The preliminary amendment filed on **[1]** was not entered because entry of the amendment would unduly interfere with the preparation of the Office action. See 37 CFR 1.115(b)(2). The examiner spent a significant amount of time on the preparation of an Office action before the preliminary amendment was received. On the date of receipt of the amendment, the examiner had completed **[2]**.

Furthermore, entry of the preliminary amendment would require significant additional time on the preparation of the Office action. Specifically, entry of the preliminary amendment would require the examiner to **[3]**.

A responsive reply (under 37 CFR 1.111 or 37 CFR 1.113 as appropriate) to this Office action must be timely filed to avoid abandonment.

If this is not a final Office action, applicant may wish to resubmit the amendment along with a responsive reply under 37 CFR 1.111 to ensure proper entry of the amendment.

Examiner Note:

1. In bracket 1, provide the date that the Office received the preliminary amendment (use the date of receipt under 37 CFR 1.6, not the certificate of mailing date under 37 CFR 1.8).
2. In bracket 2, provide an explanation on the state of preparation of the Office action as of the receipt date of the preliminary amendment. For example, where appropriate insert --the claim analysis and the search of prior art of all pending claims-- or --the drafting of the Office action and was waiting for the supervisory patent examiner's approval--.
3. In bracket 3, provide a brief explanation of how entry of the preliminary amendment would require the examiner to spend significant additional time in the preparation of the Office action. For example, where appropriate insert --conduct prior art search in another classification area that was not previously searched and required-- or --revise the Office action extensively to address the new issues raised and the new claims added in the preliminary amendment--.

<

714.02 Must Be Fully Responsive [R-3]

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

**>

(2) *Supplemental replies.* (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (e.g., typographical errors); or

(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).<

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary for further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters, although the filing of drawing corrections in reply to an objection to the drawings cannot normally be held in abeyance. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b), (c), (d), and (h) may be held not fully responsive. See MPEP § *>714<.

Replies to requirements to restrict are treated under MPEP § 818.

714.03 Amendments Not Fully Responsive, Action To Be Taken [R-3]

37 CFR 1.135. Abandonment for failure to reply within time period.

*****

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

**

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. Similarly, an amendment that would cancel all of the claims in an application and does not present any new or substitute claims is not a *bona fide* attempt to advance the application to final action. The Office will not enter such an amendment. See *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001). If there is time remaining to reply to the non-final Office action (or within any extension of time pursuant to 37 CFR 1.136(a)), applicant will be notified to complete the reply within the remaining time period to avoid abandonment. Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time

period to supply the omission would not be appropriate under 37 CFR 1.135(c).

37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR 1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment.

The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a *bona fide* reply does **not** apply after a final Office action. Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment should be denied entry if some point necessary for a complete reply under 37 CFR 1.113 (after final) was omitted, even if the omission was through an apparent oversight or inadvertence. Where a submission after a final Office action ** (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (e.g., whether the amendment raises new issues, or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to file another or supplemental amendment in order to supply the omission.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner's amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the finality of the last Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution on the merits in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 435 O.G. 213 (Comm'r Pat. 1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113.

Where there is an informality as to the fee in connection with an amendment to a **non-final** Office action presenting additional claims, the applicant is notified by the technical support staff. See MPEP § 607 and § 714.10.

Form paragraph 7.95, and optionally form paragraph 7.95.01, should be used where a *bona fide* reply >to a non-final Office action< is not fully responsive.

¶ *7.95 Bona Fide, Non-Responsive Amendments*

The reply filed on **[1]** is not fully responsive to the prior Office action because of the following omission(s) or matter(s): **[2]**. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

¶ *7.95.01 Lack of Arguments in Response*

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.95.

2. This form paragraph is intended primarily for use in *pro se* applications.

714.03(a) >Supplemental< Amendment ** [R-3]

37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

**>

(2) *Supplemental replies*. (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

(D) Reply to an Office requirement made after the first reply was filed;

(E) Correction of informalities (*e.g.*, typographical errors); or

(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).<

*****

**

Applicants are encouraged to include a complete *>fully responsive reply in compliance with 37 CFR 1.111(b)< to an outstanding Office action in the first reply to prevent the need for supplemental replies. **>Supplemental replies will not be entered as a matter of right, except when a supplemental reply is filed within a suspended period under 37 CFR 1.103(a) or (c) (e.g., a suspension of action requested by the applicant when filing an RCE). See MPEP § 709 regarding suspension of action. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) cancellation of a claim;

(B) adoption of the examiner's suggestions;

(C) placement of the application in condition of allowance;

(D) reply to an Office requirement made after the first reply was filed;

(E) correction of informalities (e.g., typographical errors); or

(F) simplification of issues for appeal.

When a supplemental reply is filed in sufficient time to be entered into the application before the examiner considers the prior reply, the examiner may approve the entry of the supplemental reply if, after a cursory review, the examiner determines that the supplemental reply is limited to one of the situations set forth above. This list is not exhaustive. The examiner has the discretion to approve the entry of a supplemental reply that is not listed above. If a supplemental reply is a non-compliant amendment under 37 CFR 1.121 (see MPEP § 714), the supplemental reply will not be entered. If a supplemental reply is not approved for entry, the examiner should notify the applicant in the subsequent Office action. If applicant wishes to have a not-entered supplemental reply considered, applicant should include the changes in a reply filed in response to the next Office action. Applicant cannot simply request for its entry in the subsequent reply. The submission of a supplemental reply will cause a reduction of any accumulated patent term adjustment under 37 CFR 1.704(c)(8). If the supplemental reply is approved for entry, the examiner should clearly indicate that the subsequent Office action is responsive to the first reply and the supplemental reply.

Examiners may use form paragraph 7.147 to notify applicants that a supplemental reply is not approved for entry.

¶ *7.147 Supplemental Reply Not Approved for Entry*

The supplemental reply filed on **[1]** was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR 1.111(a)(2)(ii). **[2]**.

Examiner Note:

1. Use this form paragraph to notify applicant that the supplemental reply filed on or after October 21, 2004 is not approved for entry.

2. Do not use this form paragraph if the supplemental reply has been entered. Use the Office Action Summary (PTOL-326) or the Notice of Allowability (PTOL-37), whichever is appropriate, to indicate that the Office action is responsive to the reply filed in compliance with 37 CFR 1.111(b) and the supplemental reply.

3. Do not use this form paragraph if the supplemental reply was filed within the period during which action is suspended by the Office under 37 CFR 1.103(a) or (c). Such supplemental reply must be entered. If the supplemental reply filed during the suspended period is not in compliance with 37 CFR 1.121, a notice of non-compliant amendment (PTOL-324) should be mailed to the applicant.

4. In bracket 1, provide the date that the Office received the supplemental reply (use the date of receipt under 37 CFR 1.6, not the certificate of mailing date under 37 CFR 1.8).

5. In bracket 2, insert a reason for non-entry as noted in 37 CFR 1.111(a)(2)(i). For example, "The supplemental reply is clearly not limited to placement of the application in condition for allowance."

<

If a supplemental reply is received in the Office after the mail date of an Office action, and it is not responsive to that Office action, the Office will not mail a new Office action responsive to that supplemental reply. As a courtesy, applicant may be notified that the supplemental reply is nonresponsive to the mailed Office action and that a responsive reply (under 37 CFR 1.111 or 1.113 as the situation may be) to the mailed Office action must be timely filed to avoid abandonment. Also see MPEP § 714.03 for replies not fully responsive and MPEP § 714.05 when the Office action crosses in the mail with a supplemental reply.

**

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. See 37 CFR 1.111 and MPEP § 714.02.

An amendment failing to point out the patentable novelty which the applicant believes the claims present in view of the state of the art disclosed by the references cited or the objections made may be held to be not fully responsive and a time period set to furnish a proper reply if the statutory period has expired or almost expired (MPEP § 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

714.05 Examiner Should Immediately Inspect [R-3]

Actions by applicant, especially those filed near the end of the period for reply, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the reply within the period. See MPEP § 714.03.

All amended applications forwarded to the examiner should be inspected at once to determine the following:

(A) If the amendment is properly signed (MPEP § 714.01(a)).

(B) If the amendment has been filed within the statutory period, set shortened period, or time limit (MPEP § 710 - § 710.05).

(C) If the amendment is fully responsive (MPEP § 714.03 and § 714.04) and complies with 37 CFR 1.121 >(MPEP § 714)<.

(D) If the changes made by the amendment warrant transfer (MPEP § 903.08(d)).

(E) If the application is special (MPEP § 708.01).

(F) If claims suggested to applicant for interference purposes have been copied. (MPEP *>Chapter 2300<).

(G) If there is a traversal of a requirement for restriction (MPEP § 818.03(a)).

(H) If "easily erasable" paper or other nonpermanent method of preparation or reproduction has been used (MPEP § 714.07).

(I) If applicant has cited references (MPEP § 707.05(b) and § 1302.12).

(J) If a terminal disclaimer has been filed (MPEP * § 804.02, § 804.03, and § 1490).

(K) If any matter involving security has been added (MPEP § 115).

ACTION CROSSES AMENDMENT

A supplemental action **>may be< necessary when an amendment is filed on or before the mailing date of the regular action but reaches the Technology Center later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for reply runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)."

714.06 Amendments Sent to Wrong Technology Center

See MPEP § 508.01.

714.07 Amendments Not in Permanent Ink [R-3]

37 CFR 1.52(a) requires "permanent dark ink or its equivalent" to be used on papers which will become part of the record and *In re Benson*, 122 USPQ 279, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959), holds that documents on so-called "easily erasable" paper violate the requirement. The fact that 37 CFR 1.52(a) has not been complied with may be discovered as soon as the amendment reaches the TC or later when the application is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered and is required to file a permanent copy within 1 month or to order a copy to be made by the U.S. Patent and Trademark Office at his or her expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate reply within the 1-month limit, a copy is made by the Patent and Trademark Office, applicant being notified and required to remit the charges or authorize charging them to his or her deposit account or credit card. See MPEP § 509.

In the second instance, when the nonpermanence of the amendment is discovered only when the application is reached for action, similar steps are taken, but action on the application is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

A good direct or indirect copy, such as photocopy or facsimile transmission, on satisfactory paper is acceptable. But see *In re Application Papers Filed Jan. 20, 1956*, 706 O.G. 4 (Comm'r Pat. 1956). **

See MPEP § 608.01 for more discussion on acceptable copies.

**

714.10 Claims Added in Excess of **>Claims Previously Paid For< [R-3]

**>Applicant is required to pay excess claims fees for each claim that is in excess of 3 in independent form or in excess of 20 (whether dependent or independent). Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers (37 CFR 1.75(c)) and a separate fee is also required in each application containing a proper multiple dependent claim. See MPEP § 607. When applicant adds a new excess claim that is in excess of the number of claims that were previously paid for after taking into account claims that have been canceled, applicant must pay the required excess claims fees before the examiner considers the new claim. For example, in an application that contains 6 independent claims and 30 total claims for which the excess claims fees were previously paid, when applicant cancels 10 claims, 2 of which are independent, and adds 11 claims, 3 of which are independent, excess claims fees for a 7th independent claim and a 31st claim are required.<

714.11 Amendment Filed During Interference Proceedings [R-3]

See MPEP *>Chapter 2300<.

714.12 Amendments >and Other Replies< After Final Rejection or Action [R-3]

**>

37 CFR 1.116. Amendments and affidavits or other evidence after final action and prior to appeal.

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under §

1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under §1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.<

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments >filed after a final rejection, but before or on the date of filing an appeal,< complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). >Amendments filed after the date of filing an appeal may be entered if the amendment complies with 37 CFR 41.33. See MPEP § 1206.< Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § *>1206<.

>An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal.<

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal interview may be initiated by the *examiner* if in his or her judgment this would materially assist in placing the application in condition for *allowance*.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

714.13 Amendments >and Other Replies< After Final Rejection or Action, Procedure Followed [R-3]

I. FINAL REJECTION — TIME FOR REPLY

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection:

> A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.41.03, and 7.42.09. Form paragraph 7.39 appears in MPEP § 706.07. Form paragraphs 7.40 and 7.40.01 appear in MPEP § 706.07(a). Form paragraphs 7.41, 7.41.03, and 7.42.09 appear in MPEP § 706.07(b).

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date. In the event that a first reply is not filed within 2 months of the mailing date of the final rejection, any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the end of the reply period set in the final rejection.

Failure to file a reply during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

II. ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR *>1.116(b)(3)< is expected in all amendments after final rejection. >An affidavit or other evidence filed after a final rejection, but before or on the same date of filing an appeal, may be entered upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e). See 37 CFR 41.33 and MPEP § 1206 for information on affidavit or other evidence filed after appeal.< Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

(A) an amendment complying with 37 CFR 1.116;

(B) a Notice of Appeal (and appeal fee); or

(C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

Further examination of the application may be obtained by filing a continued prosecution application (CPA) under 37 CFR 1.53(d), if the application is a design application. See MPEP § 201.06(d). Effective July 14, 2003, CPA practice does not apply to utility and plant applications.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

See also MPEP § *>1206< and § 1211.

The U.S. Patent and Trademark Office does not recognize "conditional" authorizations to charge an appeal fee if an amendment submitted after a final Office action is not entered. Any "conditional" authorization to charge an appeal fee set forth in 37 CFR 1.17(b) will be treated as an unconditional payment of the fee set forth in 37 CFR 1.17(b).

III. ACTION BY EXAMINER

See also MPEP § 706.07(f).

In the event that a proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(B) The claims, if amended as proposed, would raise the issue of new matter.

(C) The claims as amended present new issues requiring further consideration or search.

(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper. Whenever such an amendment is entered for appeal purposes, the examiner must indicate on the advisory action which individual rejection(s) set forth in the action from which the appeal was taken (e.g., the final rejection) would be used to reject the new or amended claim(s).

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Advisory Action >Before the Filing of an Appeal Brief< form PTOL-303 should be used to acknowledge receipt of a reply from applicant after final rejection where such reply is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should be mailed within 30 days of the date the amendment is received by the Office. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of the allowability of the claims by a Notice of Allowability form PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Examiner Initiated Interview Summary PTOL-413B should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for reply expires.

If no appeal has been filed within the period for reply and no amendment has been submitted to make the application allowable or which can be entered in part (see MPEP § 714.20), the application stands abandoned.

It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See MPEP § *>1206< for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under 37 CFR 1.131 and 1.132, see MPEP § 715.09 and § 716.

**>Form paragraph 7.169 may be used to notify applicant in the Advisory Action that the proposed amendment(s) will be entered upon appeal and how the new or amended claim(s) would be rejected.

¶ *7.169 Advisory Action, Proposed Rejection of Claims, Before Appeal Brief*

For purposes of appeal, the proposed amendment(s) will be entered and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal:

Claim(s) **[1]** would be rejected for the reasons set forth in **[2]** of the final Office action mailed **[3]**.

Examiner Note:

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (e.g., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. Use this form paragraph if item 7 of the Advisory Action form, PTOL-303 (Rev. 9-04 or later) has been checked to indicate that the proposed amendment(s) will be entered upon appeal.

<

IV. HAND DELIVERY OF PAPERS

Hand carried papers for the Technology Centers (TCs) may only be delivered to the Customer Window which is located at:

U.S. Patent and Trademark Office
**>Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314<

Effective December 1, 2003, all official patent application related correspondence for organizations reporting to the Commissioner of Patents (e.g., TCs, the Office of Patent Publication, and the Office of Petitions) that is hand-carried (or delivered by other delivery services, e.g., FedEx, UPS, etc.) must be delivered to the Customer Window, with a few limited exceptions. See MPEP § 502. Hand-carried amendments and other replies after final rejection (37 CFR 1.116) will no longer be accepted in the TCs. Any courier who attempts delivery of such after final correspondence at a TC (or where it is no longer permitted) will be re-directed to the Customer Window. ** Patent application related compact disks (CDs) and other non-paper submissions that are hand-carried must be delivered to the Customer Window.

V. EXPEDITED PROCEDURE FOR PROCESSING AMENDMENTS AND OTHER REPLIES AFTER FINAL REJECTION (37 CFR 1.116)

In an effort to improve the timeliness of the processing of amendments and other replies under 37 CFR 1.116, and thereby provide better service to the public, an expedited processing procedure has been established which the public may utilize in filing amendments and other replies after final rejection under 37 CFR 1.116. In order for an applicant to take advantage of the expedited procedure, the amendment or other reply under 37 CFR 1.116 will have to be marked as a "Reply under 37 CFR 1.116 — Expedited Procedure - Technology Center (Insert Technology Center Number)" on the upper right portion of the amendment or other reply and the envelope must be marked "Mail Stop AF" in the lower left hand corner. The markings preferably should be written in a bright color with a felt point marker. If the reply is mailed to the Office, the envelope should contain only replies under 37 CFR 1.116 and should be mailed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450." Instead of mailing the envelope to "Mail Stop AF" as noted above, the reply may be hand-carried to the Customer Window located at **>the above address.< The outside of the envelope should be marked "Reply Under 37 CFR 1.116 - Expedited Procedure - Technology Center (Insert Technology Center Number)."

Upon receipt by the U.S. Patent and Trademark Office from the U.S. Postal Service of an envelope appropriately marked "Mail Stop AF," the envelope will be specially processed by the Mail Center and for non-Image File Wrapper applications (non-IFW) forwarded promptly to the examining TC, via the Office of Finance if any fees have to be charged or otherwise processed. For IFW application processing, see IFW Manual. Upon receipt of the reply in the TC it will be promptly processed by a designated technical support staff member and forwarded to the examiner, via the supervisory patent examiner (SPE), for action. The SPE is responsible for ensuring that prompt action on the reply is taken by the examiner. If the examiner to which the application is assigned is not available and will not be available for an extended period, the SPE will ensure that action on the application is promptly taken to assure meeting the USPTO goal described below. Once the examiner has completed his or her consideration of the reply, the examiner's action will be promptly typed and printed, and mailed by technical support staff or other Office personnel designated to expedite the processing of replies filed under this procedure. The TC supervisory personnel, e.g., the supervisory patent examiner, supervisory applications examiner, and TC Director are responsible for ensuring that actions on replies filed under this procedure are promptly processed and mailed. The U.S. Patent and Trademark Office goal is to mail the examiner's action on the reply within 1 month from the date on which the amendment or reply is received by the U.S. Patent and Trademark Office.

Applicants are encouraged to utilize this expedited procedure in order to facilitate U.S. Patent and Trademark Office processing of replies under 37 CFR 1.116. If applicants do not utilize the procedure by appropriately marking the envelope and enclosed papers, the benefits expected to be achieved therefrom will not be attained. The procedure cannot be expected to result in achievement of the goal in applications in which the delay results from actions by the applicant, e.g., delayed interviews, applicant's desire to file a further reply, or a petition by applicant which requires a decision and delays action on the reply. In any application in which a reply under this procedure has been filed and no action by the examiner has been received within the time referred to herein, plus normal mailing time, a telephone call to the SPE of the relevant TC art unit would be appropriate in order to permit the SPE to determine the cause for any delay. If the SPE is unavailable or if no satisfactory reply is received, the TC Director should be contacted.

714.14 Amendments After Allowance of All Claims [R-3]

Under the decision in *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm'r Pat. 1935), after all claims in an application have been allowed the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See MPEP § 714.12 and § 714.13.

See MPEP § 714.20 for amendments entered in part.

See MPEP § 607 for additional fee requirements.

>See MPEP § 714 for non-compliant amendments.<

Use form paragraph 7.51 to issue an *Ex parte Quayle* action.

¶ *7.51 Quayle Action*

This application is in condition for allowance except for the following formal matters: **[1]**.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Examiner Note:

Explain the formal matters which must be corrected in bracket 1.

714.15 Amendment Received in Technology Center After Mailing of Notice of Allowance [R-3]

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under 37 CFR 1.312. Its entry is a matter of grace. For discussion of amendments filed under 37 CFR 1.312, see MPEP § 714.16 to § 714.16(e).

If * the amendment is filed in the Office prior to the mailing * of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it **>may also not be approved for entry. If the amendment is a supplemental reply filed when action is not suspended, such an amendment will not be approved for entry because supplemental replies are not entered as matter of right. See 37 CFR 1.111(a)(2) and MPEP § 714.03(a). If the amendment is a preliminary amendment, such an amendment may be disapproved under 37 CFR 1.115(b). See MPEP § 714.01(e). If the amendment is approved for entry, the examiner may enter the amendment and provide a supplemental notice of allowance, or withdraw the application from issue and provide an Office action.<

**>The< application will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the application to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the application is a matter of grace and not of right. *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 453 O.G. 213 (Comm'r Pat. 1935).

714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-3]

37 CFR 1.312. Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

The amendment of an application by applicant after allowance falls within the guidelines of 37 CFR 1.312. Further, the amendment of an application broadly encompasses any change in the file record of the application. Accordingly, the following are examples of "amendments" by applicant after allowance which must comply with 37 CFR 1.312:

(A) an amendment to the specification,
(B) a change in the drawings,
(C) an amendment to the claims,
(D) a change in the inventorship,
(E) the submission of prior art,
>
(F) a petition to correct the spelling of an inventor's name,
(G) a petition to change the order of the names of the inventors,< etc.

Finally, it is pointed out that an amendment under 37 CFR 1.312 must be filed on or before the date the issue fee is paid, except where the amendment is required by the Office of Patent Publication, see MPEP § 714.16(d), subsection III. An amendment under 37 CFR 1.312 must comply with the provisions of 37 CFR 1.121. >If the amendment is non-compliant under 37 CFR 1.121 and the entry of the amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance (e.g., an incorrect status identifier) using an examiner's amendment. See MPEP § 714.<

The Director has delegated the approval of recommendations under 37 CFR 1.312 to the supervisory patent examiners.

With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312. See MPEP § 603.01. A supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with 37 CFR 1.312 in the manner set forth in this section.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He or she can, however, make examiner's amendments (see MPEP § 1302.04) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the supervisory patent examiner for approval.

Amendments other than those which merely embody the correction of formal matters without changing the scope of the claims require approval by the supervisory patent examiner. The Technology

Center (TC) Director establishes TC policy with respect to the treatment of amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent, namely, (A) that its disclosure be adequately clear, and (B) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under 37 CFR 1.312 cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (A) to be needed for proper disclosure or protection of the invention, and (B) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of 37 CFR 1.111(c) (MPEP § 714.02) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment under 37 CFR 1.312, as in ordinary amendments. See MPEP § 713.04 and § 713.10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

(A) why the amendment is needed;

(B) why the proposed amended or new claims require no additional search or examination;

(C) why the claims are patentable; and

(D) why they were not presented earlier.

I. NOT TO BE USED FOR CONTINUED PROSECUTION

37 CFR 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

(A) an additional search is required;

(B) more than a cursory review of the record is necessary; or

(C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.

Where claims added by amendment under 37 CFR 1.312 are all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

II. AMENDMENTS FILED AFTER PAYMENT OF ISSUE FEE

No amendments should be filed after the date the issue fee has been paid.

¶ *13.10 Amendment Filed After the Payment of Issue Fee, Not Entered*

Applicant's amendment filed on **[1]** will not be entered because the amendment was filed after the issue fee was paid. 37 CFR 1.312 no longer permits filing an amendment after the date the issue fee has been paid.

Examiner Note:

1. Use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the date of the amendment.

714.16(a) Amendments Under 37 CFR 1.312, Copied Patent Claims [R-3]

See MPEP *>Chapter 2300< for the procedure to be followed when an amendment is received after notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See MPEP § 714.19.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

714.16(b) Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR *>41.208< [R-3]

Where an amendment filed with a motion under 37 CFR *>41.208(c)(2)< applies to an application in

issue, the amendment is not entered unless and until the motion has been granted.

714.16(c) Amendments Under 37 CFR 1.312, Additional Claims

If the amendment under 37 CFR 1.312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the examiner unless accompanied by the full fee required. See MPEP § 607 and 35 U.S.C. 41.

714.16(d) Amendments Under 37 CFR 1.312, Handling [R-3]

I. AMENDMENTS AFFECTING THE DISCLOSURE OF THE SPECIFICATION, ADDING CLAIMS, OR CHANGING THE SCOPE OF ANY CLAIM

Amendments under 37 CFR 1.312 are sent by the Office of Initial Patent Examination (OIPE) to the Publishing Division which, in turn, forwards, for non-Image File Wrapper applications (non-IFW), the proposed amendment, file, and drawing (if any) to the Technology Center (TC) which allowed the application. For IFW applications, amendments under 37 CFR 1.312 must be sent to the Office of Initial Patent Examination (OIPE) Central Scanning. OIPE Central Scanning will scan the amendments. Upon upload of the images, OIPE Central Scanning will message the Office of Patent Publication (PUBS). PUBS will review the messages and forward the messages to the Technology Center (TC), which allowed the application. Once the TC completes the action, the TC will message PUBS that issue processing can resume. If an amendment under 37 CFR 1.312 has been filed directly with the TC, the paper will be forwarded to the OIPE Central Scanning.

Hand delivered amendments under 37 CFR 1.312 are no longer accepted in the TC. Hand delivered amendments (unless specifically required by PUBS, see subsection III. below) may only be delivered to the Customer Window located at:

U.S. Patent and Trademark Office
**>Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314<

In the event that the class and subclass in which the application is classified has been transferred to another TC after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other TC and the Publishing Division notified. If the examiner who allowed the application is still employed in the U.S. Patent and Trademark Office but not in said other TC, he or she may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration.

The amendment is PROMPTLY considered by the examiner who indicates whether or not its entry is recommended by writing "Enter — 312," "Do Not Enter" or "Enter In Part" thereon in red ink in the upper left corner. For IFW processing, **>the examiner should print the first page of the amendment and write either "Enter – 312" or "Do Not Enter" in the upper left corner, and have the page scanned into IFW with the appropriate document code.<

In addition, the amendment must comply with the provisions of 37 CFR 1.121. >See MPEP § 714.<

If the amendment is favorably considered, it is entered and a Response to Rule 312 Communication (PTO-271) is prepared. The primary examiner indicates his or her recommendation by stamping and signing his or her name on the PTO-271. Form paragraph 7.85 may also be used to indicate entry.

¶ *7.85 Amendment Under 37 CFR 1.312 Entered*

The amendment filed on **[1]** under 37 CFR 1.312 has been entered.

Examiner Note:

Use this form paragraph both for amendments under 37 CFR 1.312 that do not affect the scope of the claims (may be signed by primary examiner) and for amendments being entered under 37 CFR 1.312 which do affect the scope of the claims (requires signature of supervisory patent examiner). See MPEP § 714.16.

If the examiner's recommendation is completely adverse, a report giving the reasons for nonentry is typed on the Response to Rule 312 Communication form PTO-271 and signed by the primary examiner.

Form paragraph 7.87 may also be used to indicate nonentry.

¶ *7.87 Amendment Under 37 CFR 1.312 Not Entered*

The proposed amendment filed on **[1]** under 37 CFR 1.312 has not been entered. **[2]**

Examiner Note:

The reasons for non-entry should be specified in bracket 2:

-- The amendment changes the scope of the claims.--; or

-- The amendment was filed in a reissue application and was not accompanied by a supplemental reissue oath or declaration, 37 CFR 1.175(b). --

In either case, whether the amendment is entered or not entered, the file, drawing, and unmailed notices are forwarded to the supervisory patent examiner for consideration, approval, and mailing.

For entry-in-part, see MPEP § 714.16(e).

The filling out of the appropriate form by the technical support staff does not signify that the amendment has been admitted; for, though actually entered it is not officially admitted unless and until approved by the supervisory patent examiner.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

II. AMENDMENTS WHICH EMBODY MERELY THE CORRECTION OF FORMAL MATTERS IN THE SPECIFICATION, FORMAL CHANGES IN A CLAIM WITHOUT CHANGING THE SCOPE THEREOF, OR THE CANCELLATION OF CLAIMS

The examiner indicates approval of amendments concerning merely formal matters by writing "Enter Formal Matters Only" thereon. Such amendments do not require submission to the supervisory patent examiner prior to entry. See MPEP § 714.16. The Response to Rule 312 Communication form PTO-271 is date stamped and mailed by the TC. If such amendments are disapproved either in whole or in part, they require the signature of the supervisory patent examiner. **>IFW processing is substantially the same, with the first page of the amendment being printed, the examiner writing "Enter" and the page being scanned into IFW with the appropriate document code.<

III. AMENDMENTS REQUIRED BY THE OFFICE OF PATENT PUBLICATION

In preparation of a patent for issuance as a patent grant, if the Office of Patent Publication (PUBS) discovers an error in the text, or drawings of a patent application, including any missing text, or an inconsistency between the drawings and the application papers, PUBS may require an appropriate amendment to the specification or drawings. 37 CFR 1.312, however, does not permit an amendment after the payment of the issue fee without withdrawal of the application from issue. In order to be able to accept such an amendment as may be required without having to withdraw an application from issue, effective February 24, 2004, PUBS has been delegated the authority to waive the requirement of 37 CFR 1.312 and accept an amendment filed after the payment of the issue fee. Furthermore, these amendments required by PUBS may be hand delivered to PUBS located at:

Office of Patent Publication
**>South Tower Building
2900 Crystal Drive, Room 8A24<
Arlington, VA 22202

Applicants may also fax these amendments required by PUBS to (703) 746-4000.

714.16(e) Amendments Under 37 CFR 1.312, Entry in Part [R-3]

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under 37 CFR 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the application >if the application is a paper file<. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment. For Image File Wrapper (IFW) processing, see IFW Manual.

The examiner should then submit a Response to Rule 312 Communication form PTO-271 recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his or her reasons therefor. The claims

entered should be indicated by number in this response. Applicant may also be notified by using form paragraph 7.86.

¶ *7.86 Amendment Under 37 CFR 1. 312 Entered in Part*

The amendment filed on **[1]** under 37 CFR 1.312 has been entered-in-part. **[2]**

Examiner Note:

When an amendment under 37 CFR 1.312 is proposed containing plural changes, some of which may be acceptable and some not, the acceptable changes should be entered. An indication of which changes have and have not been entered with appropriate explanation should follow in bracket 2.

Handling is similar to complete entry of a 37 CFR 1.312 amendment.

Entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See MPEP § 607 and § 714.16(c).

714.17 Amendment Filed After the Period for Reply Has Expired [R-3]

When an application is not prosecuted within the period set for reply and thereafter an amendment is filed without a petition for extension of time and fee pursuant to 37 CFR 1.136(a), such amendment shall be **>placed in< the file * of the application, but not formally entered. The technical support staff shall immediately notify the applicant, by telephone and letter, that the amendment was not filed within the time period and therefore cannot be entered and that the application is abandoned unless a petition for extension of time and the appropriate fee are timely filed. See MPEP § 711.02. **

See MPEP § 710.02(e) for a discussion of the requirements of 37 CFR 1.136(a).

714.18 Entry of Amendments [R-3]

Amendments >in paper files< are stamped with the date of their receipt in the Technology Center (TC). It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the TC ("Technology Center Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his or her amendment. **

All amendments received in the technical support staff sections are processed and with the applications delivered to the supervisory patent examiner for his or her review and distribution to the examiners.

Every mail delivery should be carefully screened to remove all amendments replying to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all applications where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these applications pass over the supervisory patent examiner's desk, he or she will be made aware of the need for any special treatment, if the situation so warrants. For example, the supervisory patent examiner will know whether or not the examiner in each application is on extended leave or otherwise incapable of moving the application within the required time periods (see MPEP § 714.13). In cases of this type, the applicant should receive an Office communication in sufficient time to adequately consider his or her next action if the application is not allowed. Consequently, technical support staff handling will continue to be special when these applications are returned by the examiners to the technical support staff.

Evaluation of the amendment after final rejection for compliance with 37 CFR 1.121 should be left to the examiner, and not treated by the technical support staff before forwarding the amendment to the examiner. If the examiner determines that the proposed amendment is not in compliance with 37 CFR 1.121, the examiner should notify applicant of this fact and attach a Notice of Non-Compliant Amendment to the advisory action. >See MPEP § 714.<

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink. For IFW processing, **>amendments are entered as papers into the IFW.<

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the application must be

given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action." It is forwarded to the examiner, and he or she is responsible for its proper disposal. The examiner should immediately inspect the amendment as set forth in MPEP § 714.05. After inspection, if no immediate or special action is required, the application awaits examination in regular order.

See MPEP § *>714< for the treatment of ** amendments that are not in compliance with 37 CFR 1.121. **

714.19 List of Amendments, Entry Denied [R-3]

The following types of amendments are ordinarily denied entry:

(A) An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in an application whose prosecution before the primary examiner has been closed, as where

(1) All claims have been allowed,

(2) All claims have been finally rejected (for exceptions see MPEP § 714.12, § 714.13, and § 714.20, item (D)),

(3) Some claims have been allowed and the remainder finally rejected. See MPEP § 714.12 to § 714.14.

(B) Substitute specification that does not comply with 37 CFR 1.125. See MPEP § 608.01(q) and § 714.20.

(C) A patent claim suggested by the examiner and not presented within the time limit set or an extension thereof, unless entry is authorized by the Director. See MPEP *>Chapter 2300<.

(D) While copied patent claims are generally admitted even though the application is under final rejection or on appeal, under certain conditions, the claims may be refused entry. See MPEP *>Chapter 2300<.

(E) An unsigned or improperly signed amendment or one signed by a suspended or excluded attorney or agent.

(F) An amendment filed in the U.S. Patent and Trademark Office after the expiration of the statutory period or set time period for reply and any extension thereof. See MPEP § 714.17.

(G) An amendment so worded that it cannot be entered with certain accuracy. See MPEP § 714.23.

(H) An amendment canceling all of the claims and presenting no substitute claim or claims. See >37 CFR 1.115(b)(1),< MPEP § 711.01 >and § 714.01(e)<.

(I) An amendment in an application no longer within the examiner's jurisdiction with certain exceptions in applications in issue, except on approval of the Director. See MPEP § 714.16.

(J) Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of nonentry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims. See MPEP § 608.04 and § 706.03(o).

(K) An amendatory paper containing objectionable remarks that, in the opinion of the examiner, brings it within the condemnation of 37 CFR 1.3, will be submitted to the Technology Center (TC) Director. See MPEP § 714.25 and MPEP § 1003. If the TC Director determines that the remarks are in violation of 37 CFR 1.3, he or she will notify the applicant of the non-entry of the paper.

(L) Amendments not in permanent ink. Amendments on so-called "easily erasable paper." See MPEP § 714.07.

(M) An amendment presenting claims (total and independent) in excess of the number previously paid for and not accompanied by the full fee for the claims or an authorization to charge the fee to a deposit account or credit card. See MPEP § 509 >and § 607<.

(N) An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified as directed in MPEP § 714.03 and § 714.05. See MPEP § 821.03.

(O) An amendment including changes to the specification/claims which is not in compliance with 37 CFR 1.121, e.g., one which does not include replacement paragraphs or claim listings. See MPEP § *>714<.

(P) A preliminary amendment that unduly interferes with the preparation of a first Office action. Fac-

tors to be considered in denying entry of the preliminary amendment are set forth in 37 CFR 1.115(b). See MPEP § *>714.01(e)<.

(Q) **>A supplemental reply is not entered as a matter of right unless it is filed during a suspension period under 37 CFR 1.103(a) or (c). See 37 CFR 1.111(a)(2) and MPEP § 714.03(a).<

While amendments falling within any of the foregoing categories should not be entered by the examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

714.20 List of Amendments Entered in Part [R-2]

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. **>At times<, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for reply. Thus:

(A) An "amendment" presenting an unacceptable substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry *in toto*. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been entered.

See 37 CFR 1.125 and MPEP § 608.01(q) for information regarding the submission of a substitute specification.

Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A proper substitute specification will normally be accepted by the Office even if it has not been required by the examiner. >However, entry of a substitute specification filed after the notice of allowance has been mailed (37 CFR 1.312) is not a matter of right.<

(B) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See MPEP § 714.16(e).

(C) In an application in which prosecution on the merits is closed, i.e., after the issuance of an *Ex Parte Quayle* action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution.

(D) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted.

**

NOTE. The examiner writes "Enter" in red ink and his or her initials in the left margin opposite the enterable portions. >For Image File Wrapper (IFW) processing, see IFW Manual.<

714.21 Amendments Inadvertently Entered, No Legal Effect [R-2]

If the technical support staff inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as "Not Officially Entered." >For Image File Wrapper (IFW) processing, see IFW Manual.<

If an amendatory paper is to be retained in the file, even though not entered, it should be given a paper number and listed on the file wrapper with the notation "Not Entered." See 37 CFR 1.3 and MPEP § 714.25 for an example of a paper which may be *>denied entry<.

**

714.25 Discourtesy of Applicant or Attorney [R-2]

**>

37 CFR 1.3. Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided.

Complaints against examiners and other employees must be made in correspondence separate from other papers.<

All papers received in the U.S. Patent and Trademark Office should be briefly reviewed by the technical support staff, before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney or agent is discourteous in the remarks or arguments in his or her amendment, either the discourtesy should be entirely ignored or the paper submitted to the Technology Center (TC) Director **>for review<. See MPEP § 1003. If the TC Director determines that the remarks are in violation of 37 CFR 1.3, the TC Director will **>send a notice of non-entry of the paper to the applicant<.

715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131 [R-3]

37 CFR 1.131. Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country. Prior invention may not be established under this section if either:

**>

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to § 41.202(a) of this title; or<

(2) The rejection is based upon a statutory bar.

**>

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.<

37 CFR 1.131(a) has been amended to implement the relevant provisions of Public Law 103-182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Act), Public Law 103-465, 108 Stat. 4809 (1994) (Uruguay Round Agreements Act), and Public Law 106-113, 113 Stat. 1501 (1999) (American Inventors Protection Act), respectively. Under 37 CFR 1.131(a) as amended, which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act (URAA). Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

If a country joined the WTO after January 1, 1996, the effective date for proving inventive activity in that country for the purpose of 35 U.S.C. 104 and 37 CFR 1.131 is the date the country becomes a member of the WTO. See MPEP § 201.13 for a list that includes WTO member countries (the notation "W^{o}" indicates the country became a WTO member after January 1, 1996).

Any printed publication or activity dated prior to an applicant's or patent owner's effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application or patent under reexamination. In addition, patent application publications and certain international application publications having an effective prior art date prior to the application being examined may be used in a rejection of the claims. See MPEP § 706.02(a) and § 2136 - § 2136.03.

Such a rejection may be overcome, in certain instances noted below, by filing of an affidavit or declaration under 37 CFR 1.131, known as "swearing back" of the reference.

It should be kept in mind that it is the rejection that is withdrawn and not the reference.

I. SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED

Affidavits or declarations under 37 CFR 1.131 may be used, for example:

(A) To antedate a reference or activity that qualifies as prior art under 35 U.S.C. 102(a) and not under 35 U.S.C. 102(b), e.g., where the prior art date under 35 U.S.C. 102(a) of the patent, the publication or activity used to reject the claim(s) is less than 1 year prior to applicant's or patent owner's effective filing date. >If the prior art reference under 35 U.S.C. 102(a) is a U.S. patent or U.S. patent application publication, the reference may not be antedated if it claims the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention."<

(B) To antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention." See MPEP § 706.02(a) and § 2136 through § 2136.03 for an explanation of what references qualify as prior art under 35 U.S.C. 102(e).

II. SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE

An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations:

(A) Where the reference publication date is more than 1 year prior to applicant's or patent owner's effective filing date. Such a reference is a "statutory bar" under 35 U.S.C. 102(b) as referenced in 37 CFR 1.131(a)(2). A reference that only qualifies as prior art under 35 U.S.C. 102(a) or (e) is not a "statutory bar."

(B) Where the reference U.S. patent or U.S. patent application publication claims the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention" and MPEP *>Chapter 2300<. Where the reference patent and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

(C) Where the reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than 12 months prior to the filing date of the domestic application. See 35 U.S.C. 102(d).

(D) Where the effective filing date of applicant's or patent owner's parent application or an International Convention proved filing date is prior to the effective date of the reference, an affidavit or declaration under 37 CFR 1.131 is unnecessary because the reference should not have been used. See MPEP § 201.11 to § 201.15.

(E) Where the reference is a prior U.S. patent to the same entity, claiming the same invention. The question involved is one of "double patenting."

(F) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending. The question is one of dedication to the public. Note however, *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971) which substantially did away with the doctrine of dedication.

(G) Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964).

(H) Where the subject matter relied upon is prior art under 35 U.S.C. 102(f).

(I) Where the subject matter relied on in the reference is prior art under 35 U.S.C. 102(g). 37 CFR 1.131 is designed to permit an applicant to overcome rejections based on references or activities which are not statutory bars, but which have dates prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 CFR 1.131 affidavit or declaration cannot be used to overcome it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his or her invention. By contrast, references under 35 U.S.C. 102(a) and (e), for example, merely establish a presumption that their subject matter was made before applicant's invention date. It is this presumption which may be rebutted by evidence submitted under 37 CFR 1.131.

(J) Where the subject matter corresponding to a lost count in an interference is either prior art under 35 U.S.C. 102(g) or barred to applicant by the doctrine of interference estoppel. *In re Bandel*, 348 F.2d 563, 146 USPQ 389 (CCPA 1965); *In re Kroekel*, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986). See also *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (Under the principles of *res judicata* and *collateral estoppel*, applicant was not entitled to claims that were patentably indistinguishable from the claim lost in interference even though the subject matter of the lost count was not available for use in an obviousness rejection under 35 U.S.C. 103). But see *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989) (A losing party to an interference, on showing that the invention now claimed is not "substantially the same" as that of the lost count, may employ the procedures of 37 CFR 1.131 to antedate the filing date of an interfering application). On the matter of when a "lost count" in an interference constitutes prior art under 35 U.S.C. 102(g), see *In re McKellin*, 529 F.2d 1342, 188 USPQ 428 (CCPA 1976) (A count is not prior art under 35 U.S.C. 102(g) as to the loser of an interference where the count was lost based on the winner's foreign priority date). Similarly, where one party in an interference wins a count by establishing a date of invention in a NAFTA or WTO member country (see 35 U.S.C. 104), the subject matter of that count is unpatentable to the other party by the doctrine of interference estoppel, even though it is not available as statutory prior art under 35 U.S.C. 102(g). See MPEP § 2138.01 and § 2138.02.

III. REFERENCE DATE TO BE OVERCOME

The date to be overcome under 37 CFR 1.131 is the effective date of the reference (i.e., the date on which the reference is available as prior art).

A. U.S. Patents, U.S. Patent Application Publications, and International Application Publications

See MPEP § 706.02(a), § 706.02(f)(1), and § 2136 through § 2136.03 for a detailed discussion of the effective date of a U.S. patent, U.S. patent application publication, or WIPO publication of an international application as a reference.

U.S. patents, U.S. patent application publications, and WIPO publications of international applications are available as prior art under 35 U.S.C. 102(e) against all patent applications and patents under reexamination.

**The effective date of a domestic patent when used as a reference is not the foreign filing date to which the application for patent may have been entitled under 35 U.S.C. 119(a) during examination. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Therefore, the date to be overcome under 37 CFR 1.131 is the effective U.S. filing date, not the foreign priority date. When a U.S. patent or U.S. patent application publication reference is entitled to claim the benefit of an earlier filed application, its effective filing date is determined under 35 U.S.C. 102(e). See MPEP § 706.02(a), § 706.02(f)(1), and § 2136 through § 2136.03.

B. Foreign Patents

See MPEP § 2126 through § 2127 regarding date of availability of foreign patents as prior art.

C. Printed Publications

A printed publication, including a published foreign patent application, is effective as of its publication date, not its date of receipt by the publisher. For

additional information regarding effective dates of printed publications, see MPEP § 2128 through § 2128.02.

D. Activities

An applicant may make an admission, or submit evidence of use of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was used or known by others in this country. See MPEP § 706.02(c) and § 2133.03. The effective date of the activity used to reject the claim(s) is the date the activity was first known to have occurred.

FORM PARAGRAPHS

Form paragraphs 7.57-7.64 may be used to respond to 37 CFR 1.131 affidavits.

¶ *7.57 Affidavit or Declaration Under 37 CFR 1.131: Ineffective- Heading*

The **[1]** filed on **[2]** under 37 CFR 1.131 has been considered but is ineffective to overcome the **[3]** reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.

2. This form paragraph must be followed by one or more of form paragraphs 7.58 to 7.63 or a paragraph setting forth proper basis for the insufficiency, such as failure to establish acts performed in this country, or that the scope of the declaration or affidavit is not commensurate with the scope of the claim(s).

**>

¶ *7.58 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Claiming Same Invention*

The **[1]** reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP Chapter 2300. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Examiner Note:

1. If used to respond to the submission of an affidavit under 37 CFR 1.131, this paragraph must be preceded by paragraph 7.57.

2. This form paragraph may be used without form paragraph 7.57 when an affidavit has not yet been filed, and the examiner desires to notify applicant that the submission of an affidavit under 37 CFR 1.131 would be inappropriate.

<

¶ *7.59 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction to Practice Before Reference Date*

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the **[1]** reference. **[2]**

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. An explanation of the lack of showing of the alleged reduction to practice must be provided in bracket 2.

¶ *7.60 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Reference Is a Statutory Bar*

The **[1]** reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.57.

¶ *7.61 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Conception*

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the **[1]** reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler* v. *Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). **[2]**

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. An explanation of the deficiency in the showing of conception must be presented in bracket 2.

3. If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this form paragraph should be followed by form paragraph 7.62 and/or 7.63. If either diligence or a reduction to practice is established, a statement to that effect should follow this paragraph.

¶ *7.62 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking*

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the **[1]** reference to either a constructive reduction to practice or an actual reduction to practice. **[2]**

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. If the affidavit additionally fails to establish conception, this paragraph must also be preceded by form paragraph 7.61. If the affidavit establishes conception, a statement to that effect should be added to this paragraph.

3. If the affidavit additionally fails to establish an alleged reduction to practice prior to the application filing date, this paragraph must be followed by form paragraph 7.63. If such an alleged reduction to practice is established, a statement to that effect should be added to this paragraph.

4. An explanation of the reasons for a holding of non-diligence must be provided in bracket 2.

5. See MPEP § 715.07(a), Ex parte Merz, 75 USPQ 296 (Bd. App. 1947), which indicates that diligence is not required after reduction to practice.

¶ *7.63 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Actual Reduction to Practice*

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the **[1]** reference. **[2]**.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. If the alleged reduction to practice is prior to the effective date of the reference, do not use this paragraph. See form paragraph 7.59.

3. If the affidavit additionally fails to establish either conception or diligence, form paragraphs 7.61 and/or 7.62 should precede this paragraph. If either conception or diligence is established, a statement to that effect should be included after this paragraph.

4. An explanation of the lack of showing of the alleged reduction to practice must be given in bracket 2.

¶ *7.64 Affidavit or Declaration Under 37 CFR 1.131: Effective To Overcome Reference*

The **[1]** filed on **[2]** under 37 CFR 1.131 is sufficient to overcome the **[3]** reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.

2. In bracket 2, insert the filing date of the affidavit or declaration.

3. In bracket 3, insert the name of the reference.

715.01 37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits

The purpose of a 37 CFR 1.131 affidavit or declaration is to overcome a prior art rejection by proving invention of the claimed subject matter by applicant prior to the effective date of the reference or activity relied upon in the rejection.

In some situations, an applicant may, alternatively, be able to overcome prior art rejections relying on references or activities which are available as prior art under 35 U.S.C. 102(a) or references which are available as prior art under 35 U.S.C. 102(e) by proving that the subject matter relied upon in the reference or activity was applicant's own invention.

Similarly, where the reference relied upon in a 35 U.S.C. 103 rejection qualifies as prior art only under 35 U.S.C. 102(f) or (g), or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e), applicant may be able to overcome this rejection by proving that the subject matter relied upon and the claimed invention were commonly owned or subject to common assignment at the time the later invention was made. See MPEP § 706.02(l)(1) through § 706.02(l)(3).

715.01(a) Reference Is a Joint Patent or Published Application to Applicant and Another [R-2]

When subject matter, disclosed but not claimed in a patent or application publication filed jointly by S and another, is claimed in a later application filed by S, the joint patent or application publication is a valid reference >under 35 U.S.C. 102(a) or (e)< unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent or application publication and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent or application publication was the invention of the applicant. Disclaimer by the other patentee or applicant of the application publication should not be required but, if submitted, may be accepted by the examiner.

Although affidavits or declarations submitted for the purpose of establishing that the reference discloses applicant's invention are properly filed under 37 CFR 1.132, rather than 37 CFR 1.131, such affidavits submitted improperly under 37 CFR 1.131 will be considered as though they were filed under 37 CFR 1.132

to traverse a ground of rejection. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

715.01(b) Reference and Application Have Common Assignee

The mere fact that the reference patent or application publication which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of a showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from the applicant (MPEP § 716.10). The common assignee does not obtain any rights in this regard by virtue of common ownership which he or she would not have in the absence of common ownership. *In re Frilette*, 412 F.2d 269, 162 USPQ 163 (CCPA 1969); *Pierce v. Watson*, 275 F.2d 890, 124 USPQ 356 (D.C. Cir. 1960); *In re Beck*, 155 F.2d 398, 69 USPQ 520 (CCPA 1946). Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. See MPEP § 706.02(l) and § 706.02(l)(1).

715.01(c) Reference Is Publication of Applicant's Own Invention [R-2]

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. *Ex parte Lemieux*, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); *Ex parte Powell*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

>

I. < CO-AUTHORSHIP

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

>

II. < DERIVATION

When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection>, which is not a statutory bar,< on that patent or publication may be removed by submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

715.01(d) Activities Applied Against the Claims

Unless it is a statutory bar, a rejection based on an activity showing that the claimed invention was used or known prior to the filing date of the application may be overcome by an affidavit or declaration under 37 CFR 1.131 establishing a date of invention prior to the date of the activity. Alternatively, the applicant(s) may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 showing that the activity was performed by the applicant(s).

715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims [R-2]

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) (Where applicant claims an alloy comprising both nitrogen and molybdenum, an affidavit showing applicant made an alloy comprising nitrogen but not molybdenum is not sufficient under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 103 based on the combined teachings of one reference disclosing an alloy comprising nitrogen but not molybdenum and a second reference disclosing an alloy comprising molybdenum but not nitrogen). Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974) (Claimed invention was use of electrostatic forces to adhere dry starch particles to a wet paper web on the Fourdrinier wire of a paper-making machine. 37 CFR 1.131 affidavit established use of electrostatic forces to adhere starch particles to wet blotting paper moved over a fluidized bed of starch particles prior to the applied reference date. Affidavit was sufficient in view of prior art reference showing that deposition of dry coatings directly on wet webs on the Fourdrinier wire of a paper-making machine was well known in the art prior to the date of the applied reference. The affidavit established possession of the basic invention, i.e., use of electrostatic forces to adhere starch to wet paper.).

>

I. < SWEARING BEHIND ONE OF A PLURALITY OF COMBINED REFERENCES

Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to

show if the reference does not teach the basic inventive concept.

Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A. However, the 37 CFR 1.131 affidavit or declaration must still establish possession of the claimed invention, not just what Reference A shows, if Reference A does not teach the basic inventive concept.

>

II. < GENERAL RULE AS TO GENERIC CLAIMS

A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference or activity (assuming, of course, that the reference or activity is not a statutory bar or a patent, or an application publication, claiming the same invention). See *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964). See, also, *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968) (distinguishing chemical species of genus compounds from embodiments of a single invention). See, however, MPEP § 715.03 for practice relative to cases in unpredictable arts.

715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question [R-2]

Where generic claims have been rejected on a reference or activity which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn, subject to the rules set forth below, unless the applicant is able to establish that he or she was in possession of the generic invention prior to the effective date of the reference or activity. In other words, the affidavit or declaration under 37 CFR 1.131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

>

I. < REFERENCE OR ACTIVITY DISCLOSES SPECIES

A. Species Claim

Where the claim under rejection recites a species and the reference or activity discloses the claimed species, the rejection can be overcome under 37 CFR 1.131 directly by showing prior completion of the claimed species or indirectly by a showing of prior completion of a different species coupled with a showing that the claimed species would have been an obvious modification of the species completed by applicant. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).

B. Genus Claim

The principle is well established that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a "generic claim." *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960).

Where the only pertinent disclosure in the reference or activity is a single species of the claimed genus, the applicant can overcome the rejection directly under 37 CFR 1.131 by showing prior possession of the species disclosed in the reference or activity. On the other hand, a reference or activity which discloses several species of a claimed genus can be overcome directly under 37 CFR 1.131 only by a showing that the applicant completed, prior to the date of the reference or activity, all of the species shown in the reference. *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957).

Proof of prior completion of a species different from the species of the reference or activity will be sufficient to overcome a reference indirectly under 37 CFR 1.131 if the species shown in the reference or activity would have been obvious in view of the species shown to have been made by the applicant. *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966). Alternatively, if the applicant cannot

show possession of the species of the reference or activity in this manner, the applicant may be able to antedate the reference or activity indirectly by, for example, showing prior completion of one or more species which put him or her in possession of the claimed genus prior to the reference's or activity's date. The test is whether the species completed by applicant prior to the reference date or the activity's date provided an adequate basis for inferring that the invention has generic applicability. *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA 1957).

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference or activity. *In re Schaub*, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).

C. Species Versus Embodiments

References or activities which disclose one or more embodiments of a single claimed invention, as opposed to species of a claimed genus, can be overcome by filing a 37 CFR 1.131 affidavit showing prior completion of a single embodiment of the invention, whether it is the same or a different embodiment from that disclosed in the reference or activity. See *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961) (Where applicant discloses and claims a washing solution comprising a detergent and polyvinylpyrrolidone (PVP), with no criticality alleged as to the particular detergent used, the PVP being used as a soil-suspending agent to prevent the redeposition of the soil removed, the invention was viewed as the use of PVP as a soil-suspending agent in washing with a detergent. The disclosure in the reference of the use of PVP with two detergents, both of which differed from that shown in applicant's 37 CFR 1.131 affidavit, was considered a disclosure of different embodiments of a single invention, rather than species of a claimed genus); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968).

>

II. < REFERENCE OR ACTIVITY DISCLOSES CLAIMED GENUS

In general, where the reference or activity discloses the claimed genus, a showing of completion of a single species within the genus is sufficient to antedate the reference or activity under 37 CFR 1.131. *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964).

In cases where predictability is in question, on the other hand, a showing of prior completion of one or a few species within the disclosed genus is generally not sufficient to overcome the reference or activity. *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA 1957). The test is whether the species completed by applicant prior to the reference date or the date of the activity provided an adequate basis for inferring that the invention has generic applicability. *In re Mantell*, 454 F.2d 1398, 172 USPQ 530 (CCPA 1973); *In re Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re DeFano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1965). In the case of a small genus such as the halogens, which consists of four species, a reduction to practice of three, or perhaps even two, species might show possession of the generic invention, while in the case of a genus comprising hundreds of species, reduction to practice of a considerably larger number of species would be necessary. *In re Shokal, supra*.

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species he or she actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference. *In re Schaub*, 537 F. 509, 190 USPQ 324 (CCPA 1976).

715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations [R-2]

>

I. < WHO MAY MAKE AFFIDAVIT OR DECLARATION

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) **>If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.<

.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

>

II. < FORMAL REQUIREMENTS OF AFFIDAVITS AND DECLARATIONS

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits.

37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

715.05 U.S. Patent or Application Publication Claiming Same Invention [R-3]

When the reference in question is a noncommonly owned U.S. patent or patent application publication claiming the same invention as applicant and its publication date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 CFR *>41.202< instead of 37 CFR 1.131. If the reference is claiming the same invention as the application and its publication date is less than 1 year prior to the presentation of claims to that invention in the application, this fact should be noted in the Office action. The reference can then be overcome only by way of interference. See MPEP *>Chapter 2300<. If the reference is a U.S. patent which claims the same invention as the application and its issue date is more than 1 year prior to the presentation of claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b)(1) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.). >The expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. 135(b) includes the one-year anniversary date of the issuance of a patent. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964).<

If the reference is a U.S. application publication under 35 U.S.C. 122(b), or a WIPO publication on an international application filed on or after November

29, 2000, which claims the same invention as the application being examined and its publication date is more than 1 year prior to the presentation of claims to that invention in the application being examined, a rejection of the claims of the application (being examined) under 35 U.S.C. 135(b)(2) should be made only if the application being examined was filed after the publication date of the reference.

Form paragraph 23.14 or 23.14.01 may be used when making a rejection under 35 U.S.C. 135(b).
**>

¶ *23.14 Claims Copied More Than One Year From Patent Issue Date*

Claim **[l]** rejected under 35 U.S.C. 135(b) as being made more than one year from the date on which U.S. Patent No. **[2]** was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

¶ *23.14.01 Claims Copied More Than One Year From Application Publication Date*

Claim **[l]** rejected under 35 U.S.C. 135(b) as being made more than one year from the date on which **[2]** was published under 35 U.S.C. 122(b). See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

Examiner Note:

1. In bracket 2, insert the publication number of the published application.

2. This form paragraph should only be used if the application being examined was filed after the publication date of the published application.

<

Where the reference and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the reference are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims. *In re Clark*, 457 F.2d 1004, 173 USPQ 359 (CCPA 1972); *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Wagenhorst*, 62 F.2d 831, 16 USPQ 126 (CCPA 1933).

If the application (or patent under reexamination) and the domestic reference contain claims which are identical, or which are not patentably distinct, then the application and patent are claiming the "same patentable invention." **

As provided in 37 CFR *>41.203(a)<, an interference **>exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa.< An applicant who is claiming an invention which is identical to, or obvious in view of, the invention as claimed in a domestic patent or patent application publication cannot employ an affidavit under 37 CFR 1.131 as a means for avoiding an interference with the reference. To allow an applicant to do so would result in the issuance of two patents to the same invention.

Since 37 CFR 1.131 defines "same patentable invention" in the same way as the interference rules (37 CFR *>41.203(a)<), the USPTO cannot prevent an applicant from overcoming a reference by a 37 CFR 1.131 affidavit or declaration on the grounds that the reference claims applicant's invention and, at the same time, deny applicant an interference on the grounds that the claims of the application and those of the reference are not for substantially the same invention. See *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979). Where, in denying an applicant's motion in interference to substitute a broader count, it is held that the limitation to be deleted was material for the opponent patentee, this constitutes a holding that the proposed count is for an invention which is not the "same patentable invention" claimed by the reference. Therefore, the applicant may file an affidavit or declaration under 37 CFR 1.131 to overcome a prior art rejection based on the reference. *Adler v. Kluver*, 159 USPQ 511 (Bd. Pat. Int. 1968).

Form paragraph 7.58 (reproduced in MPEP § 715) may be used to note such a situation in the Office action.

715.07 Facts and Documentary Evidence [R-3]

I. GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(A) attached sketches;
(B) attached blueprints;
(C) attached photographs;
(D) attached reproductions of notebook entries;
(E) an accompanying model;
(F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
(G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905);
(H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated

> If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

II. ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she

may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

III. THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) >(actual)< reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Asahi/America Inc.*, 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing *Newkirk v. Lulejian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his or her remedy is by appeal from the continued rejection.

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

For the most part, the terms "conception," "reasonable diligence," and "reduction to practice" have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

> The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, *per se*, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, "[t]he parallel

> to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity." *Id*. at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, "the 'conception' and 'reduction to practice' which must be established under the rule need not be the same as what is required in the 'interference' sense of those terms." *Id*.; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. *In re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); *In re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Form paragraph 7.59 or 7.63 (both reproduced in MPEP § 715) may be used where insufficient evidence is included in a 37 CFR 1.131 affidavit.

715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

715.07(b) Interference Testimony Sometimes Used

In place of an affidavit or declaration the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of 37 CFR 1.131 affidavit or declaration.

The part of the testimony to form the basis of priority over the reference should be pointed out. *Ex parte Bowyer*, 1939 C.D. 5, 42 USPQ 526 (Comm'r Pat. 1939).

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country

35 U.S.C. 104. Invention Made Abroad.

(a) IN GENERAL.—

(1) PROCEEDINGS.—In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) RIGHTS.—If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,

(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or

(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) USE OF INFORMATION.—To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) DEFINITIONS.—As used in this section—

(1) The term "NAFTA country" has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and

(2) The term "WTO member country" has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

The 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104.

Under 37 CFR 1.131(a), which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act. Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

715.07(d) Disposition of Exhibits

Exhibits, such as those filed as part of an affidavit or declaration under 37 CFR 1.131, must comply with the requirements of 37 CFR 1.91 to be entered into an application file. Exhibits that do not comply with the requirements of 37 CFR 1.91 will be disposed of or returned to applicant at the discretion of the Office. See also MPEP § 608.03(a).

715.08 Passed Upon by Primary Examiner

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition. Such petitions are answered by the Technology Center Directors (MPEP § 1002.02(c)).

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

715.09 Seasonable Presentation [R-3]

Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

(A) prior to a final rejection;

(B) before appeal in an application not having a final rejection; *

(C) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or

(D) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.<

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action.

For affidavits or declarations under 37 CFR 1.131 filed after appeal, see 37 CFR *>41.33(d)< and MPEP § *>1206 and § 1211.03<.

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations.

715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode

Any affidavits or declarations submitted under 37 CFR 1.131 and the accompanying evidence must be reviewed carefully by the examiner in order to determine whether they show that the claimed invention was "in public use" or "on sale" in this country more than one year prior to the effective filing date of the application, which acts constitute a statutory bar under 35 U.S.C. 102(b). Although the rejection based on the reference(s) or activity sought to be antedated may actually be overcome by such an affidavit or declaration, the effect of the applicant's prior "public use" or "on sale" activities may not be overcome under 37 CFR 1.131. See MPEP § 2133.03 regarding rejections based on "public use" and "on sale" statutory bars.

Where the 37 CFR 1.131 evidence relies on an embodiment of the invention not disclosed in the application, the question of whether the application includes the "best mode" must be considered. However, a "best mode" rejection should not be made unless the record, taken as a whole, establishes by a preponderance of the evidence that applicant's specification has not set forth the best mode contemplated by the inventor of carrying out the invention. See MPEP § 2165 - § 2165.04 regarding the best mode requirement of the first paragraph of 35 U.S.C. 112.

716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

37 CFR 1.132. Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections. All affidavits or declarations presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

Form paragraph 7.65 or 7.66 and any of form paragraphs 7.66.01 through 7.66.05, as appropriate, should be used to comment on a 37 CFR 1.132 affidavit or declaration.

¶ *7.65 Affidavit or Declaration Under 37 CFR 1.132: Effective To Withdraw Rejection*

The **[1]** under 37 CFR 1.132 filed **[2]** is sufficient to overcome the rejection of claim **[3]** based upon **[4]**.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the affected claim or claims.

4. In bracket 4, indicate the rejection that has been overcome, including the statutory grounds, e.g.: insufficiency of disclosure under 35 U.S.C. 112, first paragraph; lack of utility under 35 U.S.C. 101; inoperativeness under 35 U.S.C. 101; a specific reference applied under 35 U.S.C. 103; etc. See MPEP § 716.

¶ *7.66 Affidavit or Declaration Under 37 CFR 1.132: Insufficient*

The **[1]** under 37 CFR 1.132 filed **[2]** is insufficient to overcome the rejection of claim **[3]** based upon **[4]** as set forth in the last Office action because:

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the claim or claims affected.
4. In bracket 4, indicate the rejection that has not been overcome, including the statutory grounds, i.e.: insufficiency of disclosure under 35 U.S.C. 112, first paragraph; lack of utility and/or inoperativeness under 35 U.S.C. 101; a specific reference applied under 35 U.S.C. 103; etc. See MPEP § 716.
5. Following this form paragraph, set forth the reasons for the insufficiency; e.g., categories include: --untimely--; --fails to set forth facts--; --facts presented are not germane to the rejection at issue--;--showing is not commensurate in scope with the claims--; etc. See MPEP § 716. Also include a detailed explanation of the reasons why the affidavit or declaration is insufficient. Any of form paragraphs 7.66.01 - 7.66.05 may be used, as appropriate.

¶ *7.66.01 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Affiant Has Never Seen Invention Before*

It includes statements which amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ *7.66.02 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Invention Works as Intended*

It includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ *7.66.03 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Refers Only to Invention, Not to Claims*

It refers only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ *7.66.04 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: No Evidence of Long-Felt Need*

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ *7.66.05 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Conclusion*

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Examiner Note:

This form paragraph should be presented as a conclusion to your explanation of why the affidavit or declaration under 37 CFR 1.132 is insufficient, and it must be preceded by form paragraph 7.66.

716.01 Generally Applicable Criteria [R-3]

The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) *Timeliness.*

Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

(1) prior to a final rejection,

(2) before appeal in an application not having a final rejection, *

(3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or

(4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.

For affidavits or declarations under 37 CFR 1.132 filed after appeal, see 37 CFR 41.33(d) and MPEP § 1206 and § 1211.03.<

(B) *Consideration of evidence.*

Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance. See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as "the declaration lacks technical validity" or "the evidence is not commensurate with the scope of the claims" without an explanation supporting such findings are insufficient.

716.01(a) Objective Evidence of Nonobviousness [R-2]

OBJECTIVE EVIDENCE MUST BE CONSIDERED *>WHEN TIMELY< PRESENT

Affidavits or declarations>, when timely presented,< containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham v. John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Anderson's-Black Rock Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976).

Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986). The lack of objective evidence of nonobviousness does not weigh in favor of obviousness. *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994). However, where a *prima facie* case of obviousness is established, the failure to provide rebuttal evidence is dispositive.

716.01(b) Nexus Requirement and Evidence of Nonobviousness

TO BE OF PROBATIVE VALUE, ANY SECONDARY EVIDENCE MUST BE RELATED TO THE CLAIMED INVENTION (NEXUS REQUIRED)

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States v. Adams*, 383 U.S. 39,148 USPQ 479 (1966).

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). The term "nexus" designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988).

716.01(c) Probative Value of Objective Evidence [R-2]

>

I. < TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

>

II. < ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF EVIDENCE

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.

See MPEP § 2145 generally for case law pertinent to the consideration of applicant's rebuttal arguments.

>

III. < OPINION EVIDENCE

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, "some weight ought to be given to a persuasively supported statement of one

skilled in the art on what was not obvious to him." 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the *prima facie* case of obviousness); *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a human b-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Carroll*, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).

An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953).

716.01(d) Weighing Objective Evidence [R-2]

IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING *PRIMA FACIE* CASE

When an applicant >timely< submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached, not against the conclusion itself. *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the *prima facie* case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989); *Richardson-Vicks, Inc., v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and pseudoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong *prima facie* case of obviousness). See *In*

re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a detailed discussion of the proper roles of the examiner's *prima facie* case and applicant's rebuttal evidence in the final determination of obviousness.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.). See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988). See also MPEP § 716.01. See MPEP § 2144.08, paragraph II.B., for guidance in determining whether rebuttal evidence is sufficient to overcome a *prima facie* case of obviousness.

716.02 Allegations of Unexpected Results

Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (differences in sedative and anticholinergic effects between prior art and claimed antidepressants were not unexpected). In *In re Waymouth*, 499 F.2d 1273, 1276, 182 USPQ 290, 293 (CCPA 1974), the court held that unexpected results for a claimed range as compared with the range disclosed in the prior art had been shown by a demonstration of "a marked improvement, over the results achieved under other ratios, as to be classified as a difference in kind, rather than one of degree." Compare *In re Wagner*, 371 F.2d 877, 884, 152 USPQ 552, 560 (CCPA 1967) (differences in properties cannot be disregarded on the ground they are differences in degree rather than in kind); *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) ("we generally consider a discussion of results in terms of 'differences in degree' as compared to 'differences in kind' . . . to have very little meaning in a relevant legal sense").

716.02(a) Evidence Must Show Unexpected Results [R-2]

>

I. < GREATER THAN EXPECTED RESULTS ARE EVIDENCE OF NONOBVIOUSNESS

"A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue." *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). In *Corkhill*, the claimed combination showed an additive result when a diminished result would have been expected. This result was persuasive of nonobviousness even though the result was equal to that of one component alone. Evidence of a greater than expected result may also be shown by demonstrating an effect which is greater than the sum of each of the effects taken separately (i.e., demonstrating "synergism"). *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). However, a greater than additive effect is not necessarily sufficient to overcome a *prima facie* case of obviousness because such an effect can either be expected or unexpected. Applicants must further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) (Evidence showing greater than additive sweetness resulting from the claimed mixture of saccharin and L-aspartyl-L-phenylalanine was not sufficient to outweigh the evidence of obviousness because the teachings of the prior art lead to a general expectation of greater than additive sweetening effects when using mixtures of synthetic sweeteners.).

>

II. < SUPERIORITY OF A PROPERTY SHARED WITH THE PRIOR ART IS EVIDENCE OF NONOBVIOUSNESS

Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. "Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima*

facie case of obviousness." No set number of examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) (Evidence showing that the claimed herbicidal compound was more effective than the closest prior art compound in controlling quackgrass and yellow nutsedge weeds in corn and soybean crops was sufficient to overcome the rejection under 35 U.S.C. 103, even though the specification indicated the claimed compound was an average performer on crops other than corn and soybean.). See also *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (unexpected superior therapeutic activity of claimed compound against anaerobic bacteria was sufficient to rebut *prima facie* obviousness even though there was no evidence that the compound was effective against all bacteria).

>

III. < PRESENCE OF AN UNEXPECTED PROPERTY IS EVIDENCE OF NONOBVIOUSNESS

Presence of a property not possessed by the prior art is evidence of nonobviousness. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); *Ex parte Thumm*, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing " 'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' "). The submission of evidence that a new product possesses unexpected properties does not necessarily require a conclusion that the claimed invention is nonobvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979). See the discussion of latent properties and additional advantages in MPEP § 2145.

>

IV. < ABSENCE OF AN EXPECTED PROPERTY IS EVIDENCE OF NONOBVIOUSNESS

Absence of property which a claimed invention would have been expected to possess based on the teachings of the prior art is evidence of unobviousness. *Ex parte Mead Johnson & Co.* 227 USPQ 78 (Bd. Pat. App. & Inter. 1985) (Based on prior art disclosures, claimed compounds would have been expected to possess beta-andrenergic blocking activity; the fact that claimed compounds did not possess such activity was an unexpected result sufficient to establish unobviousness within the meaning of 35 U.S.C. 103.).

716.02(b) Burden on Applicant [R-2]

>

I. < BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied *>upon< should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants' brief that the claimed polymer had an unexpectedly increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration."); *Ex parte C*, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

>

II. < APPLICANTS HAVE BURDEN OF EXPLAINING PROFFERED DATA

"[A]ppellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness." *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

>

III. < DIRECT AND INDIRECT COMPARATIVE TESTS ARE PROBATIVE OF NONOBVIOUSNESS

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP § 716.02(d) - § 716.02(e). See *In re Blondel*, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974) and *In re Fouche*, 439 F.2d 1237, 1241-42, 169 USPQ 429, 433 (CCPA 1971) for examples of cases where indirect comparative testing was found sufficient to rebut a *prima facie* case of obviousness.

The patentability of an intermediate may be established by unexpected properties of an end product "when one of ordinary skill in the art would reasonably ascribe to a claimed intermediate the 'contributing cause' for such an unexpectedly superior activity or property." *In re Magerlein*, 602 F.2d 366, 373, 202 USPQ 473, 479 (CCPA 1979). "In order to establish that the claimed intermediate is a 'contributing cause' of the unexpectedly superior activity or property of an end product, an applicant must identify the cause of the unexpectedly superior activity or property (compared to the prior art) in the end product and establish a nexus for that cause between the intermediate and the end product." *Id.* at 479.

716.02(c) Weighing Evidence of Expected and Unexpected Results [R-2]

>

I. < EVIDENCE OF UNEXPECTED AND EXPECTED PROPERTIES MUST BE WEIGHED

Evidence of unexpected results must be weighed against evidence supporting *prima facie* obviousness in making a final determination of the obviousness of the claimed invention. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (Claims directed to a method of effecting analgesia without producing physical dependence by administering the levo isomer of a compound having a certain chemical structure were rejected as obvious over the prior art. Evidence that the compound was unexpectedly nonaddictive was sufficient to overcome the obviousness rejection. Although the compound also had the expected result of potent analgesia, there was evidence of record showing that the goal of research in this area was to produce an analgesic compound which was nonaddictive, enhancing the evidentiary value of the showing of nonaddictiveness as an indicia of nonobviousness.). See MPEP § 716.01(d) for guidance on weighing evidence submitted to traverse a rejection.

Where the unexpected properties of a claimed invention are not shown to have a significance equal to or greater than the expected properties, the evidence of unexpected properties may not be sufficient to rebut the evidence of obviousness. *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) (Claims were directed to a display/memory device which was *prima facie* obvious over the prior art. The court found that a higher memory margin and lower operating voltage would have been expected properties of the claimed device, and that a higher memory margin appears to be the most significant improvement for a memory device. Although applicant presented evidence of unexpected properties with regard to lower peak discharge current and higher luminous efficiency, these properties were not shown to have a significance equal to or greater than that of the expected higher memory margin and lower operating voltage. The court held the evidence of nonobviousness was not sufficient to rebut the evidence of obviousness.); *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (Evidence of improved feed efficiency in steers was not sufficient to rebut *prima facie* case of obviousness based on prior art which specifically taught the use of compound X537A to enhance weight gain in animals because the evidence did not show that a significant aspect of the claimed invention would have been unexpected.).

>

II. < EXPECTED BENEFICIAL RESULTS ARE EVIDENCE OF OBVIOUSNESS

"Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." *In re Gershon*, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967) (resultant decrease of dental

enamel solubility accomplished by adding an acidic buffering agent to a fluoride containing dentifrice was expected based on the teaching of the prior art); *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a process of sterilizing a polyolefinic composition which contains an antioxidant with high-energy radiation. Although evidence was presented in appellant's specification showing that particular antioxidants are effective, the Board concluded that these beneficial results would have been expected because one of the references taught a claimed antioxidant is very efficient and provides better results compared with other prior art antioxidants.).

716.02(d) Unexpected Results Commensurate in Scope With Claimed Invention [R-2]

Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980) (Claims were directed to a process for removing corrosion at "elevated temperatures" using a certain ion exchange resin (with the exception of claim 8 which recited a temperature in excess of 100C). Appellant demonstrated unexpected results via comparative tests with the prior art ion exchange resin at 110C and 130C. The court affirmed the rejection of claims 1-7 and 9-10 because the term "elevated temperatures" encompassed temperatures as low as 60C where the prior art ion exchange resin was known to perform well. The rejection of claim 8, directed to a temperature in excess of 100C, was reversed.). See also *In re Peterson*, 315 F.3d 1325, 1329-31, 65 USPQ2d 1379, 1382-85 (Fed. Cir. 2003) (data showing improved alloy strength with the addition of 2% rhenium did not evidence unexpected results for the entire claimed range of about 1-3% rhenium); *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983) (Claims were directed to certain catalysts containing an alkali metal. Evidence presented to rebut an obviousness rejection compared catalysts containing sodium with the prior art. The court held this evidence insufficient to rebut the *prima facie* case because experiments limited to sodium were not commensurate in scope with the claims.).

>

I. < NONOBVIOUSNESS OF A GENUS OR CLAIMED RANGE MAY BE SUPPORTED BY DATA SHOWING UNEXPECTED RESULTS OF A SPECIES OR NARROWER RANGE UNDER CERTAIN CIRCUMSTANCES

The nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof. *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979) (Claims directed to mixtures of an herbicide known as "FENAC" with a diphenyl ether herbicide in certain relative proportions were rejected as *prima facie* obvious. Applicant presented evidence alleging unexpected results testing three species of diphenyl ether herbicides over limited relative proportion ranges. The court held that the limited number of species exemplified did not provide an adequate basis for concluding that similar results would be obtained for the other diphenyl ether herbicides within the scope of the generic claims. Claims 6-8 recited a FENAC:diphenyl ether ratio of 1:1 to 4:1 for the three specific ethers tested. For two of the claimed ethers, unexpected results were demonstrated over a ratio of 16:1 to 2:1, and the effectiveness increased as the ratio approached the untested region of the claimed range. The court held these tests were commensurate in scope with the claims and supported the nonobviousness thereof. However, for a third ether, data was only provided over the range of 1:1 to 2:1 where the effectiveness decreased to the "expected level" as it approached the untested region. This evidence was not sufficient to overcome the obviousness rejection.); *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the *prima facie* case of obviousness because there was "no ade-

quate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition.").

>

II. < DEMONSTRATING CRITICALITY OF A CLAIMED RANGE

To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

716.02(e) Comparison With Closest Prior Art [R-2]

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the *claimed* invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." *In re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, *In re Finley*, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. *In re Armstrong*, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

>

I. < THE CLAIMED INVENTION MAY BE COMPARED WITH PRIOR ART THAT IS CLOSER THAN THAT APPLIED BY THE EXAMINER

Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over nonchlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the *prima facie* case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.).

>

II. < COMPARISONS WHEN THERE ARE TWO EQUALLY CLOSE PRIOR ART REFERENCES

Showing unexpected results over one of two equally close prior art references will not rebut *prima facie* obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984) (Claimed compounds differed from the prior art either by the presence of a trifluoromethyl group instead of a chloride radical, or by the presence of an unsaturated ester group instead of a saturated ester group. Although applicant compared the claimed invention with the prior art compound containing a chloride radical, the court found this evidence insufficient to rebut the *prima facie* case of obviousness because the evidence did not show relative effectiveness over all compounds of the closest prior art. An applicant does not have to test all the compounds taught by each reference, "[h]owever, where an applicant tests less than all cited compounds, *the test must be sufficient to permit a conclusion respecting the relative effectiveness of applicant's claimed compounds and the compounds of the closest prior art." Id.* (quoting *In re Payne*, 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979)) (emphasis in original).).

>

III. < THE CLAIMED INVENTION MAY BE COMPARED WITH THE CLOSEST SUBJECT MATTER THAT EXISTS IN THE PRIOR ART

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted *prima facie* case by comparing claimed invention with the most relevant prior art. Note that the majority held the Office failed to establish a *prima facie* case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 "would be requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714.).

716.02(f) Advantages Disclosed or Inherent

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) (Although the purported advantage of placement of a selective catalytic reduction catalyst in the bag retainer of an apparatus for controlling emissions was not disclosed in the specification, evidence and arguments rebutting the conclusion that such placement was a matter of "design choice" should have been considered as part of the totality of the record. "We have found no cases supporting the position that a patent applicant's evidence or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of *ex parte* patent prosecution." 66 F.3d at 299, 36 USPQ2d at 1095.). See also *In re Zenitz*, 333 F.2d 924, 928, 142 USPQ 158, 161 (CCPA 1964) (evidence that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from disclosed use as tranquilizer); *Ex parte Sasajima*, 212 USPQ 103, 104 - 05 (Bd. App. 1981) (evidence relating to initially undisclosed relative toxicity of claimed pharmaceutical compound must be considered).

The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical. *In re Saunders*, 444 F.2d 599, 607, 170 USPQ 213, 220 (CCPA 1971).

716.02(g) Declaration or Affidavit Form

"The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001." Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. *Ex parte Gray*, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989). Publications may, however, be evidence of the facts in issue and should be considered to the extent that they are probative.

716.03 Commercial Success [R-2]

>

I. < NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

> In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. &

Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness).

The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

>

II. < COMMERCIAL SUCCESS ABROAD IS RELEVANT

Commercial success abroad, as well as in the United States, is relevant in resolving the issue of nonobviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

716.03(a) Commercial Success Commensurate in Scope With Claimed Invention [R-2]

>

I. < EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate *>in< scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

>

II. < REQUIREMENTS WHEN CLAIMED INVENTION IS NOT COEXTENSIVE WITH COMMERCIAL PRODUCT OR PROCESS

If a particular range is claimed, applicant does not need to show commercial success at every point in the range. "Where, as here, the claims are directed to a combination of ranges and procedures not shown by the prior art, and where substantial commercial success is achieved at an apparently typical point within those ranges, and the affidavits definitely indicate that operation throughout the claimed ranges approximates that at the particular points involved in the commercial operation, we think the evidence as to commercial success is persuasive." *In re Hollingsworth*, 253 F.2d 238, 240, 117 USPQ 182, 184 (CCPA 1958). See also *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (where the commercially successful product or process is not coextensive with the claimed invention, applicant must show a legally sufficient relationship between the claimed feature and the commercial product or process).

716.03(b) Commercial Success Derived From Claimed Invention [R-2]

>

I. < COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.").

See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising hyperbole.).

>

II. < COMMERCIAL SUCCESS MUST FLOW FROM THE FUNCTIONS AND ADVANTAGES DISCLOSED OR INHERENT IN THE SPECIFICATION DESCRIPTION

To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. Furthermore, the success of an embodiment within the claims may not be attributable to improvements or modifications made by others. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

>

III. < IN DESIGN CASES, ESTABLISHMENT OF NEXUS IS ESPECIALLY DIFFICULT

Establishing a nexus between commercial success and the claimed invention is especially difficult in design cases. Evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition, improved performance, or some other factor. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984) (showing of commercial success was not accompanied by evidence attributing commercial success of Litton microwave oven to the design thereof).

>

IV. < SALES FIGURES MUST BE ADEQUATELY DEFINED

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

716.04 Long-Felt Need and Failure of Others [R-2]

>

I. < THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a "do-it-yourself" window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

>

II. < LONG-FELT NEED IS MEASURED FROM THE DATE A PROBLEM IS IDENTIFIED AND EFFORTS ARE MADE TO SOLVE IT

Long-felt need is analyzed as of the date the problem is identified and articulated, and there is evidence of efforts to solve that problem, not as of the date of the most pertinent prior art references. *Texas Instruments Inc. v. Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

>

III. < OTHER FACTORS CONTRIBUTING TO THE PRESENCE OF A LONG-FELT NEED MUST BE CONSIDERED

The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

See also *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (presence of legislative regulations for controlling sulfur dioxide emissions did not militate against existence of long-felt need to reduce the sulfur content in the air); *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a *bona fide* licensing agreement entered into at arm's length).

716.05 Skepticism of Experts

"Expressions of disbelief by experts constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966)) (The patented process converted all the sulfur compounds in a certain effluent gas stream to hydrogen sulfide, and thereafter treated the resulting effluent for removal of hydrogen sulfide. Before learning of the patented process, chemical experts, aware of earlier failed efforts to reduce the sulfur content of effluent gas streams, were of the opinion that reducing sulfur compounds to hydrogen sulfide would not adequately solve the problem.).

"The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention." *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987) (testimony that the invention met with initial incredulity and skepticism of experts was sufficient to rebut the *prima facie* case of obviousness based on the prior art).

716.06 Copying

Another form of secondary evidence which may be presented by applicants during prosecution of an application, but which is more often presented during litigation, is evidence that competitors in the marketplace are copying the invention instead of using the prior art. However, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also *Vandenberg v. Dairy Equipment Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness) and *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1098-99, 227 USPQ 337, 348, 349 (Fed. Cir. 1985), *vacated on other grounds*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987) (evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after 10 years of effort and expense).

716.07 Inoperability of References

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability *(Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C.Cir. 1935),examiners should not express any opinion on the operability of a patent. Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results,

make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

Where the affidavit or declaration presented asserts inoperability in features of the reference which are not relied upon, the reference is still effective as to other features which are operative. *In re Shepherd*, 172 F.2d 560, 80 USPQ 495 (CCPA 1949).

Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, the claims represented by applicant must distinguish from the alleged inoperative reference disclosure. *In re Crosby*, 157 F.2d 198, 71 USPQ 73 (CCPA 1946). See also *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (lack of diagrams, flow charts, and other details in the prior art references did not render them nonenabling in view of the fact that applicant's own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references).

If a patent teaches or suggests the claimed invention, an affidavit or declaration by patentee that he or she did not intend the disclosed invention to be used as claimed by applicant is immaterial. *In re Pio*, 217 F.2d 956, 104 USPQ 177 (CCPA 1954). Compare *In re Yale*, 434 F.2d 66, 168 USPQ 46 (CCPA 1970) (Correspondence from a co-author of a literature article confirming that the article misidentified a compound through a typographical error that would have been obvious to one of ordinary skill in the art was persuasive evidence that the erroneously typed compound was not put in the possession of the public.).

716.08 Utility and Operability of Applicant's Disclosure

See MPEP § 2107.02, for guidance on when it is proper to require evidence of utility or operativeness, and how to evaluate any evidence which is submitted to overcome a rejection under 35 U.S.C. 101 for lack of utility. See MPEP § 2107 - § 2107.03 generally for utility examination guidelines and an overview of legal precedent relevant to the utility requirement of 35 U.S.C. 101.

716.09 Sufficiency of Disclosure

See MPEP § 2164 - § 2164.08(c) for guidance in determining whether the specification provides an enabling disclosure in compliance with 35 U.S.C. 112, first paragraph.

Once the examiner has established a *prima facie* case of lack of enablement, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). Evidence to supplement a specification which on its face appears deficient under 35 U.S.C. 112 must establish that the information which must be read into the specification to make it complete would have been known to those of ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981) (copies of patent specifications which had been opened for inspection in Rhodesia, Panama, and Luxembourg prior to the U.S. filing date of the applicant were not sufficient to overcome a rejection for lack of enablement under 35 U.S.C. 112, first paragraph).

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944). But see *Glaser v. Strickland*, 220 USPQ 446 (Bd. Pat. Int. 1983) which reexamines the rationale on which *In re Oppenauer* was based in light of the Federal Rules of Evidence. The Board stated as a general proposition "Opinion testimony which merely purports to state that a claim or count, is 'disclosed' in an application involved in an interference . . . should not be given any weight. Opinion testimony which purports to state that a particular feature or limitation of a

claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis."

716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author, patentee, or applicant of the published application of a first reference does not enable an applicant to step into the shoes of that author, patentee, or applicant of the published application in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

EXAMPLES

The following examples demonstrate the application of an attribution affidavit or declaration.

Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

Example 2

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130 [R-3]

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) **>[Reserved]<

See MPEP § 804.03 and § 706.02(l) through § 706.02(l)(3) for subject matter disqualified as prior art under 35 U.S.C. 103(c) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.130(a) addresses those situations in which the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent or U.S. patent application publication due to the requirement in 37 CFR 1.131 that any U.S. patent or U.S. patent application publication to be antedated not claim the same patentable invention (as defined in 37 CFR *>41.203(a)<) as the application or patent under reexamination. The applicant or patent owner is also prevented from proceeding in an interference due to the provision in 37 CFR *>41.206< that an interference will not normally be declared or continued between applications **>that are commonly owned<, or an application and an unexpired patent **>that are commonly owned<.

As 37 CFR 1.130(a) addresses those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent or patent application publication are not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321(c), and 37 CFR 1.130(a)(2) requires an oath or declaration stating, *inter alia*, that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject matter before the actual date of invention of the subject matter of the reference claims. The affidavit or declaration may be signed by the inventor(s), the attorney or agent of record, or assignee(s) of the entire interest.

The phrase "prior inventor under 35 U.S.C. 104" requires that the inventor named in the application or patent be the prior inventor within the meaning of 35 U.S.C. 104, in that an applicant or patent owner may not:

(A) establish a date of invention in a foreign country other than a NAFTA or WTO member country;

(B) establish a date of invention in a WTO member country other than a NAFTA country earlier than January 1, 1996; or

(C) establish a date of invention in a NAFTA country other than the U.S. earlier than December 8, 1993.

**

A U.S. patent or U.S. patent application publication that anticipates the claimed subject matter cannot be disqualified as prior art under 35 U.S.C. 103(c) or 37 CFR 1.130 or 1.131.

719 File Wrapper

The folder in which the U.S. Patent and Trademark Office maintains the application papers is referred to as a file wrapper.

719.01 Papers in File Wrapper [R-2]

Papers that do not become a permanent part of the record should not be entered on the "Contents" of the file wrapper. All papers legally entered on the "Contents" of the file wrapper are given a paper number. No paper legally entered on the "Contents" should ever be withdrawn or **>expunged from the application file<, especially a part of the original disclosure of the application, without special authority of the *>Director<. However, 37 CFR 1.59 provides that certain documents may be **>expunged< if they were unintentionally submitted or contain proprietary information which has not been made public and is not important to a decision of patentability. See MPEP § 724. Certain oaths executed abroad may be returned but a copy is retained in the file. See MPEP § 604.04(a). >For Image File Wrapper (IFW) processing, see IFW Manual sections 3.3 and 3.4.<

Form paragraph 7.214 may be used to notify applicant that papers in an application that has received a filing date ordinarily will not be returned.

¶ *7.214 Papers Not Returned, Pro Se*

Papers in an application that has received a filing date pursuant to 37 CFR 1.53 ordinarily will not be returned. If applicant has not preserved copies of the papers, the Office will furnish copies at applicant's expense. See 37 CFR 1.19 for a list of the current fees. See MPEP § 724.05 for information pertaining to petitions to expunge information.

719.01(a) Arrangement of Papers in File Wrapper [R-2]

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order, that is, the communication with the latest Mail Center "Office Date" is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the drawing print is always kept on top for the convenience of the examiner.

Where amendments are submitted in duplicate, the copy is destroyed except where the duplicate is received within the time period for reply and the original is late. In this latter situation both copies are placed in the file. The "original" is entered with reference made to the copy.

At allowance, only those papers required by the printer are placed in the left side (center section) of the file wrapper. >For Image File Wrapper (IFW) processing, see IFW Manual sections 3.3 and 3.4.<

719.01(b) Prints [R-2]

The prints of the drawing are fastened inside the file wrapper by the Office of Initial Patent Examination.

The white paper prints are always kept on top of the papers on the right of the file wrapper. >For Image File Wrapper (IFW) processing, see IFW Manual sections 3.3.<

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the application number of the corresponding application. Note MPEP § 608.02(m).

719.02 Data Entered on File Wrapper [R-2]

It is sometimes necessary to make corrections to the data on the file wrapper label or, for 09/series applications, the PALM bib-data sheet placed in the file wrapper.

If the examiner notices an error in any of the data originally entered on the file wrapper or on the PALM bib-data sheet, he or she should:

- for 08/ or earlier series applications: make the correction in red ink on the file wrapper and forward the application to the TC technical support staff for correction of the PALM database;

- for 09/series applications: make the correction in red ink on the PALM bib-data sheet and forward the application to the TC technical support staff for correction of the PALM database and printing of a new PALM bib-data sheet for placement in the file wrapper;

- for 10/ and above series applications: make the correction in red ink on the file wrapper and forward the application to the TC technical support staff for correction of the PALM database and printing of a

new adhesive file wrapper label to be placed on the file wrapper.

Instances where correction is necessary include:

(A) Correction of inventorship such as changes in the order of the names or a change in the name of an inventor, granted by petition, and additions or deletions of inventors under 37 CFR 1.48. See MPEP § 605.04(g).

(B) Correction of the filing date.

(C) Correction concerning prior U.S. applications which have application number errors. See MPEP § 202.02.

(D) Correction of a claim for benefit under 35 U.S.C. 120, 121, or 365(c). See MPEP § 201.11 and § 1302.09.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Division.

See also MPEP § 707.10 and § 719.01.

>For Image File Wrapper (IFW) processing, see IFW Manual sections 3.3 and 3.7.<

719.02(b) Name or Residence of Inventor or Title Changed [R-2]

The distinction between "residence" and **>mailing< address should not be lost sight of. See MPEP § 605.02 and § 605.03.

MPEP § 605.04(c) explains the procedure to be followed when applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

>For a patent application publication to be published with a new residence, the information must be entered into the Office electronic records at least nine weeks before the publication date of the application. For a patent to issue with the new residence, applicants are strongly encouraged to file an Application Data Sheet (37 CFR 1.76) showing the new residence information. Patents are printed from the documents in the application file and the data shown in the Office electronic records, other than the images of the papers in the file, are not necessarily relied upon.<

719.03 Classification During Examination [R-3]

When a new application is received in a Technology Center, the classification of the application and the initials or name of the examiner who will examine it or other assigned docket designation are noted in **>the application file. See Also MPEP § 903.08(b).<

719.04 Index of Claims [R-3]

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications >maintained in paper<. It should be kept up to date so as to be a reliable index of all claims standing in an application, and of the amendment in which the claims are to be found.

The preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented.

Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under 37 CFR 1.121(c), the original claim number should not be stricken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e., "Amend. 1"; if the claim is rewritten a second time, "Amend. 1" should be changed by striking out "1" and inserting "2" above it.

As any claim is canceled, a line in red ink should be drawn through its number.

A space is provided for completion by the examiner to indicate the date and type of each Office action together with the resulting status of each claim. A list of codes for identifying each type of Office action

appears below the Index. At the time of allowance, the examiner places the final patent claim numbers in the column marked "Final." >For Image File Wrapper (IFW) processing, see IFW Manual.<

719.05 Field of Search [R-3]

In the first action on the merits of an application, the examiner **>must record in the appropriate sections of the OACS "Search Notes" page the areas< in which the search for prior art was made. ** The examiner must also indicate the date(s) on which the search was conducted >and provide his/her initials<. In subsequent actions, where the search is brought up to date and/or where a further search is made, the examiner must **>indicate< that the search has been updated and/or identify the additional field of search **>and include the date and the examiner's initials in the appropriate sections of the OACS "Search Notes" page<. Any search updates should include **>the appropriate< databases and the search queries and classifications employed in the original search. See MPEP § 904. Great care should be taken so as to clearly indicate the places searched and the date(s) on which the search was conducted >and/or updated<.

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the U.S. Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation. **

Under the procedures, searches are separated into two categories and listed, as appropriate, in either the "SEARCHED" box or "SEARCH NOTES" box **>of the OACS "Search Notes" page<. For Image File Wrapper (IFW) processing, see IFW Manual section 3.7.

I. "SEARCHED" BOX ENTRIES

**>The< following searches will be recorded in the "SEARCHED" box >section of the OACS "Search Notes" page< by the examiner along with the date and the examiner's initials, according to the following guidelines:

**>

(A) *A classification search.* A classification search is defined as a complete search of all the documents in a particular subclass, whether filed by U.S. or IPC classification and it is not limited by any text query or other means. If a classification search was performed, the class and subclass must be recorded in the "SEARCHED" box section of the OACS "Search Notes" page along with the date that the search was performed (or updated) and the examiner's initials. Unless a classification search as defined was performed, it would be improper to merely record the class and subclass in the "SEARCHED" box without any indication that a limited classification search was performed.<

Examples

424/270, 272, 273
224/42.1 F
414/DIG. 4
D3/32 R
A61K 9/22
A61K 31/56 - A61K 31/585

**
>

(B) < When a >classification< search made in a parent application is updated during the examination of a continuing application, those searches updated, followed by "(updated from parent S.N. .....)" will be recorded. If the parent application has been patented, the patent number "Pat. N. ....." instead of application number in the above phrase will be recorded. The examiner should recopy the entire search updated from the parent on the file * of the continuing application to the extent pertinent to the continuing application.

Examples

273/29 BC (updated from
343/114.5 parent S.N. 08/495,123)
116/DIG.47 (updated from
D7/73, 74 parent Pat. N. 4,998,999)

For IFW processing, see IFW Manual section 3.7.

II. "SEARCH NOTES" BOX ENTRIES

Entries made in the "SEARCH NOTES" box are of equal importance to those placed in the

"SEARCHED" box **. They are intended to complete the application file record of areas and/or documents considered by the examiner in his or her search. The examiner *>will< record the following searches in this box and in the manner indicated, with each search dated and initialled:

**>

(A) *A limited classification search.* A limited classification search is defined as a search of a patent document classification database limited by a text query or a set of text queries or other means. If a limited classification search was performed, the class and subclass followed by an appropriate annotation must be recorded in the "SEARCH NOTES" box section of the OACS "Search Notes" page along with the date that the search was performed (or updated) and the examiner's initials.

Examples

414/1 (U.S. only)
238/6 (1954 to date)
250/13 (cursory)
705/14 (text search only – see search history printout)
4C083 AC10 (F-term, abstract only)
A61B 5/00N4P (ECLA, text search of full doc – see search history printout)
G06F1/2 (text search only – see search history printout)

(B) *Text search only was performed in a particular database (no classification or limited classification search was performed).* If a text search was performed in a particular database and no classification or limited classification search was performed, the following entry must be recorded in the "SEARCH NOTES" box section of the OACS "Search Notes" page: "See search history printout(s)" along with the date that the search was performed (or updated) and the examiner's initials. A copy of the search history printout must be included in the application file.

An on-line computerized literature searching service which uses key terms and index terms to locate relevant publications in many large bibliographic databases is available in the Scientific and Technical Information Center (STIC). Members of the STIC staff are assigned to assist examiners in selecting key terms and to conduct a search. A complete search history in the form of a printout must be included in the application file. The following entry must be recorded in the "SEARCH NOTES" box section of the OACS "Search Notes" page: "See search history printout(s)" along with the date that the search was performed (or updated) and the examiner's initials.

(C) < A *consultation* with other examiners to determine if relevant search fields exist in their areas of expertise.

If the subclass is not searched, record the class and subclass discussed, followed by "(consulted)." This entry may also include the name of the examiner consulted and the art unit.

Examples

24/ fasteners (consulted)
24/ fasteners (consulted J. Doe A.U. 3501)
24/201 R-230 AV (consulted)

*>

(D) < *A search of a publication **>in paper form* located through a manual search (non-electronic search)<, e.g., a library search, a text book search, a Chemical Abstracts search, etc. Record according to the following for each type of literature search:

(1) *Abstracting publications*, such as Chemical Abstracts, record name of publications, list terms consulted in index, and indicate period covered.

Examples

Chem. Abs, Palladium hydride Jan.-June 1975
Eng. Index, Data Conversion Analog to Digital 1975

(2) *Periodicals* — list by title, volume, issue, pages and date, as appropriate.

Examples

Popular Mechanics, June-Dec. 1974
Lubrication Engineering, vols. 20-24

(3) *Books* — list by title, author, edition or date, pages, as appropriate.

Example

Introduction to Hydraulic Fluids, Roger E. Hatton, 1962

(4) *Other types of literature* not specifically mentioned herein (i.e., catalogs, manufacturer's literature, private collections, etc.).

Record data as necessary to provide unique identification of material searched.

Example

Sears Roebuck catalog, Spring-Summer, 1973.

**

A cursory or browsing search through a number of materials that are not found to be of significant relevance may be indicated in a collective manner, e.g., "Browsed STIC shelves under QA 76.5" or "Browsed text books in STIC relating to....." More detailed reviews or searches through books and periodicals or any search of terms in abstracting publications should be specifically recorded, however.

**

(E) *A review of art cited in a parent application* or an original patent, as required for all continuation and continuation-in-part applications, divisional applications, reissue applications and reexamination proceedings, or a review of art cited in related applications.

Record the application number of a parent application that is still pending or abandoned, followed by "refs. checked" or "refs. ck'ed." If for any reason not all of the references have been checked because they are not available or clearly not relevant, such exceptions should be noted.

Examples

S. N. 495,123 refs. checked

S. N. 490,000 refs. checked

S. N. 480,111 refs. checked except for Greek patent to Kam

S. N.410,113 refs. not checked since the file was not available

Record the patent number of a parent or related application that is now patented or of an original patent now being reissued with "refs. checked" or "refs. ck'ed."

Examples

Pat. 3,900,000 refs. checked

Pat. 3,911,111 refs. ck'ed

**

A. >Search History< Printouts

>Any time that an electronic search was performed (i.e., limited classification search, or text search), examiners must include a complete search history in the form of a printout to be placed in the application file (scanned into IFW). The printout must include the following minimum information:

(1) all the search logic or chemical structure or sequence(s) used as a database query;

(2) all the name(s) of the file(s) searched and the database service;

(3) the date the search was made or updated; and

(4) the examiner's initials.

It would be improper to merely list the tool/database, e.g., "EAST" or identify the search queries in the "SEARCH NOTES" box section of the OACS "Search Notes" page. A search history printout should be devoid of result printouts to limit the "bulk search printouts."

Regarding nucleotide and peptide sequence searches, these searches must be documented by printout(s). A copy of a printout for each database source searched must be included in the application file. Each printout must include all the information up to the "ALIGNMENTS" section.<

Most of the database services accessed in application searches provide a command to display or print the search history which includes most, if not all, of the minimum required information for documenting database searches. Table 1 below lists the history command for each database service and which of the required minimum documentation elements are missing when the history command is entered. The missing elements may be documented by writing them on the printout of the search history or by supplying further portions of the search transcript which do include the missing elements. In some instances, depending on the database service, the log off command will supply the missing data element. ** For example, this is the case with searches in STN and Questel-Orbit; the name of the database service is not provided by entering the history command and must be supplied by the inclusion of the log off command. Another example is with WEST. Neither the Freeform Search page nor the Show S Numbers page prints the date of the search, therefore, the date of the WEST search

must be documented in writing. For IFW processing, see IFW Manual section 3.7.

If there are several search statements in the history, the statement or statements of which the results were reviewed should be indicated by circling them in BLACK INK. **

TABLE 1

History Commands and Missing Elements by Database Service

Database Service	History Command	Name of Database Service	Search Logic	Name of File Searched	Date of Search
Dialog	ds; show files[2]	no	yes	yes	missing[3]
STN[1]	d his full	no[5]	yes	yes	yes
Questel-Orbit	hi[2] or his[2]	no[5]	yes	yes	missing[3]
Lexis Nexis ™	r[2]	no	yes	yes	yes
ABSS System	none	yes[3]	yes[4]	yes	yes
EAST	Details grid[8]	no[10]	yes	yes	yes
WEST	Free Form Search page[9] Show S Numbers page	yes	yes	yes	missing[11]

[1] In a structure search in STN, in addition to "d his full", the structure should be printed out while in the Registry File. The command string for this is "d L# que stat," where L# is the number of the answer set of a full file structure search.

[2] Need to enter history command for each file searched before changing file or logging off.

[3] Information provided as part of search result file for each request.

[4] Search query sequence provided as part of search result file for each request.

[5] Displayed by log off command.

[6] Name and number of file provided at file entry; number only of file given when leaving the file; number only of last file accessed given at log off.

[7] Name of the file given at file entry and when leaving the file; name of last file accessed given at log off.

[8] Print details grid for Active folder to document current search; print Details grid for Saved folder to document saved search.

9	Print Freeform Search page to document current search; print Show S Numbers page to document saved search.
10	Shown on printed EAST cover page.
11	Must be written in BLACK INK.

B. Explanation of Table Terminology

History Command - Generally, a display of what the user has asked the search software to do. Will display the search logic entered by the user. Some histories are limited to display of the searches done only in the current file while others deliver a complete record of what file or files were accessed and all searches done since sign on. Dialog, Questel-Orbit, and Lexis-Nexis™ are services limited to display of the searches done only in the current file.

Name of Database Service - Most services do not display this information as part of the search transcript. None of the services in the table, except WEST, list that information as part of the history command. However, Questel-Orbit, and STN supply the name of the database service during log off.

Search Logic - Generally, a display of the search commands executed by the search software. For a structure or sequence search, this can be a printout of the structure or sequence used to query the system.

Name of File Searched - This is the name of the collection of data accessed. In some services, the file name is only displayed when the file is selected and not in response to the history display command; Dialog and Questel-Orbit are two such services. For example, Dialog supplies only the file number with the log off command. The file number alone is not adequate documentation of a search. The name of the file is required.

Date of Search - WEST, Dialog, and Questel-Orbit do not display the date of search as part of the history command. Dialog and Questel-Orbit supply the date of search during log off; the date of search for WEST must be written on the search report.

**

C. Other Databases

For other types of publicly accessible computer accessed databases (e.g., CD-ROM databases, specialized databases, etc.), record data as necessary to provide unique identification of material searched and sufficient information as to the search query or request so that the search can be updated. The record should also document the location of the database and its form (CD-ROM, etc.).

Example: Citing a biotech CD-ROM database

Entrez: Sequences, National Center for Biotechnology Information, Version 7.19.91b (CD-ROM, TC 1600) Searched HIV and vaccine; neighbored Galloway article dated 6/5/91 on April 1, 1990.

Example: Citing a nonbiotech CD-ROM database

Computer Select, (November, 1991), Ziff Davis Communications Co., (CD-ROM, STIC), Searched Unix and emulation on December 1, 1991.

III. INFORMATION NOT RECORDED *>IN< THE >APPLICATION< FILE *

For an indication of consideration or nonconsideration of prior art citations submitted by applicant in Information Disclosure Statements (37 CFR 1.97 and 1.98), see MPEP § 609 >*et seq*<.

Access DB# _____

SEARCH REQUEST FORM

Scientific and Technical Information Center

Requester's Full Name: _____ Examiner # :_____ Date: _____
Art Unit: _____ Phone Number 30_____ Serial Number: _____
Mail Box and Bldg/Room Location: _____ Results Format Preferred (circle): PAPER DISK E-MAIL

If more than one search is submitted, please prioritize searches in order of need.
****

Please provide a detailed statement of the search topic, and describe as specifically as possible the subject matter to be searched. Include the elected species or structures, keywords, synonyms, acronyms, and registry numbers, and combine with the concept or utility of the invention. Define any terms that may have a special meaning. Give examples or relevant citations, authors, etc, if known. Please attach a copy of the cover sheet, pertinent claims, and abstract.

Title of Invention: _____

Inventors (please provide full names): _____

_____

Earliest Priority Filing Date: _____

***For Sequence Searches Only* Please include all pertinent information (parent, child, divisional, or issued patent numbers) along with the appropriate serial number.**

****

STAFF USE ONLY	**Type of Search**	**Vendors and cost where applicable**
Searcher: _____	NA Sequence (#)_____	STN _____
Searcher Phone #: _____	AA Sequence (#)_____	Dialog _____
Searcher Location: _____	Structure (#) _____	Questel/Orbit _____
Date Searcher Picked Up: _____	Bibliographic _____	Dr.Link _____
Date Completed: _____	Litigation _____	Lexis/Nexis _____
Searcher Prep & Review Time: _____	Fulltext _____	Sequence Systems _____
Clerical Prep Time: _____	Patent Family _____	WWW/Internet _____
Online Time: _____	Other _____	Other (specify)_____

PTO-1590 (8-01)

**>

Search Notes	**Application/Control No.**	**Applicant(s)/Patent under Reexamination**	
	Examiner	**Art Unit**	

SEARCHED			
Class	Subclass	Date	Examiner
705	1	3/24/2005	JO

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
EAST (US and FOR)-See Attached	3/24/2005	JO
DIALOG (ALL MAND)-See Attached	3/24/2005	JO

U.S. Patent and Trademark Office Part of Paper No.

<

719.06 Foreign Filing Dates

See MPEP § 201.14(c), § 202.03 and § 201.14(d).

719.07 Related Applications [R-3]

The file wrapper or the PALM bib-data sheet (for 09/series applications) should identify earlier filed related applications >(e.g., the applications that are relied upon for benefit under 35 U.S.C. 120)<.

See MPEP § 202.02 and § 202.03.

**>If the application is maintained in the Image File Wrapper (IFW), a bib-data sheet should be printed and the examiner should verify the information on the sheet (e.g., the continuity data and foreign priority information, writing for example, "none," if there is no such data), and submit the copy of the initialed bib-data sheet for scanning.<

720 Public Use Proceedings [R-3]

37 CFR 1.292. Public use proceedings.

**>

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a prima facie showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Director to determine whether a public use proceeding should be instituted. If instituted, the Director may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by part 41, subpart D, of this title. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.<

(b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:

(1) The petition is accompanied by the fee set forth in § 1.17(j);

(2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

**>

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a motion under § 41.121(a)(1) of this title.<

Public use proceedings are provided for in 37 CFR 1.292. The institution of public use proceedings is discretionary with the Director of the USPTO. This section is intended to provide guidance when a question concerning public use proceedings arises.

Any member of the public other than the applicant, including private persons, corporate entities, and government agencies, may file a petition under 37 CFR 1.292. A petition may be filed by an attorney or other representative on behalf of an unnamed principal since 37 CFR 1.292 does not require that the principal be identified. A petition and fee (37 CFR 1.17(j)) are required to initiate consideration of whether to institute a public use proceeding. The petitioner ordinarily has information concerning a pending application which claims, in whole or in part, subject matter that the petitioner alleges was in "public use" or "on sale" in this country more than one year prior to the effective United States filing date of the pending application (see 35 U.S.C. 119 and 120). He or she thus asserts that a statutory bar (35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103) exists which prohibits the patenting of the subject matter of the application.

When public use petitions and accompanying papers are submitted they, or a notice in lieu thereof, will be entered in the application file if the petition is:

(A) accompanied by the fee set forth in 37 CFR 1.17(j);

(B) served on the applicant in accordance with 37 CFR 1.248, or filed with the Office in duplicate in the event service is not possible; and

(C) submitted prior to the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, whichever occurs first.

Duplicate copies should be submitted only when, after diligent effort, it has not been possible for petitioner to serve a copy of the petition on the applicant, or his or her attorney or agent in accordance with 37 CFR 1.248 in which case the Office of Patent Legal Administration of the Office of the Deputy Commissioner for Patent Examination Policy will attempt to get the duplicate copy to the applicant, or his or her attorney or agent.

Notice of a petition for a public use proceeding will be entered in the file in lieu of the petition itself when the petition and the accompanying papers are too bulky to accompany the file. Any public use papers

not physically entered in the file will be publicly available whenever the application file wrapper is available. For Image File Wrapper (IFW) processing, see IFW Manual section 3.3.

There are two types of public use proceedings: *ex parte* and *inter partes*. It is important to understand the difference. In the *ex parte* situation, the petitioner is not entitled, as a matter of right, to inspect the pending application. Thus, he or she stands in no better position than any other member of the public regarding access to the pending application. In the *inter partes* situation, the pending application is a reissue application. In the *inter partes* situation, the petitioner is privy to the contents of the pending application (37 CFR *>41.109<). Thus, as pointed out below, the petitioner in the *inter partes* situation participates in the public use proceedings to a greater degree than in the *ex parte* situation. A petitioner who was once involved in a terminated interference with a pending application is no longer privy to the application contents and will accordingly be treated as an *ex parte* petitioner. It should be noted that petitions filed on and after February 11, 1985 will not be allowed in accordance with 37 CFR 1.292(c) unless the petition arises out of an interference declared prior to February 11, 1985 or the interference was declared after February 11, 1985 but arose from an interference declared prior to that date.

Since February 11, 1985, a petition for institution of public use proceedings cannot be filed by a party to an interference as to an application involved in the interference. Public use issues can only be raised by a * motion under 37 CFR *>41.121<. However, if the issue of public use arises out of an interference declared prior to February 11, 1985, the petition may be filed by a party to the interference as to an application involved in the interference.

There may be cases where a public use petition has been filed in an application which has been restricted or is subject to a proper restriction requirement. If the petition alleges that subject matter covering both elected claims and nonelected claims is a statutory bar, only that part of the petition drawn to subject matter of the elected claims will be considered. However, if a public use proceeding is ultimately instituted, it will not necessarily be limited to the subject matter of the elected claims but may include the nonelected subject matter. Any evidence adduced on the nonelected subject matter may be used in any subsequently-filed application claiming subject matter without the requirement of a new fee (37 CFR 1.17(j)). The petitioner will not be heard regarding the appropriateness of any restriction requirement.

A petition under 37 CFR 1.292 must be submitted in writing, must specifically identify the application to which the petition is directed by application number or serial number and filing date, and should include a listing of all affidavits or declarations and exhibits relied on. The petition must contain a sufficient description of the subject matter that the petitioner alleges was in "public use" or "on sale," including any necessary photographs, drawings, diagrams, exhibits, or flowcharts, to enable the examiner to compare the claimed subject matter to the subject matter alleged to have been in "public use" or "on sale." In addition, the petition and any accompanying papers must either (A) reflect that a copy of the same has been served upon the applicant or upon the applicant's attorney or agent of record; or (B) be filed with the Office in duplicate in the event service is not possible.

It is important that any petition in a pending application specifically identify the application to which the petition is directed with the identification being as complete as possible. The following information, if known, should be placed on the petition:

(A) Name of Applicant(s).

(B) Application number.

(C) Confirmation number.

(D) Filing date of application.

(E) Title of invention.

(F) Technology Center art unit number.

(G) Name of examiner to whom the application is assigned.

(H) Current status and location of application.

(I) The word "ATTENTION:" followed by the area of the Office to which the petition is directed as set forth below.

In addition, to the above information, the petition itself should be clearly identified as a "PETITION UNDER 37 CFR 1.292." If the petition is accompanied by exhibits or other attachments, these should also contain identifying information thereon in order to prevent them from becoming inadvertently separated and lost.

Any petition under 37 CFR 1.292 can be submitted by mail to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, and should be directed to the attention of the director of the particular Technology Center (TC) in which the application is pending. If the petitioner is unable to specifically identify the application to which the petition is directed, but, nevertheless, believes such an application to be pending, the petition should be directed to the attention of the Office of Patent Legal Administration of the Office of the Deputy Commissioner for Patent Examination Policy or to "Mail Stop Petition," along with as much identifying data for the application as possible.

Where a petition is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the petition should be marked with the words "REISSUE LITIGATION." The notations preferably should be written in a bright color with a felt point marker. Any "REISSUE LITIGATION" petition mailed to the Office should be so marked and mailed to "Mail Stop Petition." However, in view of the urgent nature of most "REISSUE LITIGATION" petitions, petitioners may wish to hand-carry the petition in order to ensure prompt receipt and to avoid any unnecessary delays. These hand-carried petitions and replies may only be delivered to the Customer Window located at:

U.S. Patent and Trademark Office
**>Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314<

Every effort should be made by a petitioner to effect service of the petition upon the attorney or agent of record or upon the applicant if no attorney or agent is of record. Of course, the copy served upon applicant or upon applicant's attorney or agent should be a complete copy including a copy of each photograph, drawing, diagram, exhibit, flowchart, or other document relied on. The petition filed in the Office should reflect, by an appropriate "Certificate of Service," that service has been made as provided in 37 CFR 1.248. Only in those instances where service is not possible should the petition be filed in duplicate in order that the Office can attempt service. In addition, all other papers filed by the petitioner relating to the petition or subsequent public use proceeding must be served in accordance with 37 CFR 1.248.

720.01 Preliminary Handling [R-3]

A petition filed under 37 CFR 1.292 should be forwarded to the Office of Patent Legal Administration (OPLA) of the Office of the Deputy Commissioner for Patent Examination Policy. A member of the OPLA staff will ascertain whether the formal requirements of 37 CFR 1.292 have been fulfilled. In particular, the petition will be reviewed to see whether the petition has been filed prior to the earliest of the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, if the alleged use or sale occurred in this country more than 1 year before the effective filing date of the application, whether the petition contains affidavits or declarations and exhibits to establish the facts alleged, whether the papers have been filed in duplicate, or one copy has been served on applicant and whether the required fee has been tendered. The application file is ordered and its status ascertained so that appropriate action may be taken.

A petition under 37 CFR 1.292 must be "submitted prior to the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, whichever occurs first." As a practical matter, any petition should be submitted as soon as possible after the petitioner becomes aware of the existence of the application to which the petition is to be directed. By submitting a petition early in the examination process, i.e., before the Office acts on the application if possible, the petitioner ensures that the petition will receive maximum consideration and will be of the most benefit to the Office in its examination of the application.

Since a petition under 37 CFR 1.292 cannot be considered subsequent to issuance of the application as a patent or abandonment of the application, the petition will not be considered if the application is not pending when the petition and application are provided to the member of the OPLA staff (i.e., that the application was pending at the time the petition was filed would be immaterial to its ultimate consideration). A petition submitted prior to the earliest of the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, but not provided to the member of the OPLA staff with the application file prior to issuance or abandonment of the application,

will be entered in the application file, but will be dismissed as moot. A petition filed after final rejection will be considered if the application has not been published and is still pending when the petition and application are provided to the member of the OPLA staff. However, prosecution will not ordinarily be reopened after final rejection if the subject matter alleged in the petition to have been in "public use" or "on sale" is merely cumulative of the prior art cited in the final rejection. If a petition is filed after the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, it will be dismissed as untimely.

A petition with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the petition cannot be filed within the 2-month period provided by 37 CFR 1.176, the petition can be submitted at a later time, but petitioner must be aware that reissue applications are "special" and a later filed petition may be received after action by the examiner. Any request by a petitioner in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17*>(f)<. The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC). Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

If the petition is a "REISSUE LITIGATION" petition, it is particularly important that it be filed early if petitioner wishes it considered prior to the first Office action on the application. Petitioners should be aware that the Office will entertain petitions under 37 CFR 1.183, when accompanied by the petition fee set forth in 37 CFR 1.17*>(f)<, to waive the 2-month delay period of 37 CFR 1.176 in appropriate circumstances. Accordingly, petitioners in reissue applications cannot automatically assume that the full 2-month delay period of 37 CFR 1.176 will always be available.

In those *ex parte* situations where a petitioner cannot identify the pending application by application number, the petition papers will be forwarded to the appropriate TC Director for an identification search. Once the application file(s) is located, it should be forwarded to the OPLA.

If the petition filed in the Office does not indicate service on applicant or applicant's attorney or agent, and is not filed in duplicate, then the Office will undertake to determine whether or not service has been made by contacting applicant or applicant's attorney or agent by telephone or in writing to ascertain if service has been made. If service has not been made and no duplicate has been filed, then the Office may request petitioner to file such a duplicate before the petition is referred to the examiner. Alternatively, if the petition involves only a few pages, the Office may, in its sole discretion, elect to reproduce the petition rather than delay referring it to the examiner. If duplicate petition papers are mailed to applicant or applicant's attorney or agent by the Office, the application file should reflect that fact, either by a letter transmitting the petition or, if no transmittal letter is used, simply by an appropriate notation in the "Contents" section of the application file wrapper. For Image File Wrapper (IFW) processing, see IFW Manual section 3.4.

If the petition is not submitted prior to the earliest of the date the application was published or the mailing of a notice of allowance under 37 CFR 1.311, it should not be entered in the application file. The applicant should be notified that the petition is untimely and that it is not being entered in the application file. The handling of the petition will vary depending on the particular following situation.

(A) *Service Of Copy Included*

Where the petition includes an indication of service of copy on the applicant, the original petition should be discarded.

(B) *Service Of Copy Not Include*d

Where the petition does not include an indication of service and a duplicate copy of the petition is or is not present, the duplicate copy (if present) should be discarded and the original petition should be sent to the applicant along with the notification of nonentry.

720.02 Examiner Determination of *Prima Facie* Showing [R-2]

Once the Office of Patent Legal Administration (OPLA) staff member has determined that the petition meets the formal requirements of 37 CFR 1.292, and the application's status warrants consideration of the petition, he or she will prepare a letter ** forwarding the petition and the application file to the examiner for determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition. Any other papers that have been filed by the parties involved, such as a reply by the applicant or additional submissions by the petitioner, will also be forwarded to the examiner. Whether additional papers are accepted is within the discretion of the OPLA staff member. However, protracted paper filing is discouraged since the parties should endeavor to present their best case as to the *prima facie* showing at the earliest possible time. No oral hearings or interviews will be granted at this stage, and the examiner is cautioned not to answer any inquiries by the petitioner or applicant.

A *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103. See MPEP § 2133.03 *et seq*.

To make this determination, the examiner must identify exactly *what* was in public use or on sale, whether it was in use or on sale in this country more than 1 year before the effective filing date, and whether the pending claims "read" on or are obvious over what has been shown to be in public use or on sale. On this last point, the examiner should compare all pending claims with the matter alleged to have been in use or on sale, not just the claims identified by petitioner.

In situations where the petition alleges only that the claims are obvious over subject matter asserted to be in public use or on sale, the petition should include prior art or other information on which it relies and explain how the prior art or other information in combination with the subject matter asserted to be in public use or on sale renders the claims obvious. The examiner is not expected to make a search of the prior art in evaluating the petition. If, however, the examiner determines that a *prima facie* case of anticipation under 35 U.S.C. 102(b) has not been established but, at the time of evaluating the petition, the examiner is aware of prior art or other information which, in his or her opinion, renders the claims obvious over the subject matter asserted to be in public use or on sale the examiner may determine that a *prima facie* case is made out, even if the petition alleged only that the claims were anticipated under 35 U.S.C. 102(b).

After having made his/her determination, the examiner will forward a memorandum to the **>OPLA staff member<, stating his or her findings and his or her decision as to whether a *prima facie* case has been established. The findings should include a summary of the alleged facts, a comparison of at least one claim with the device alleged to be in public use or on sale, and any other pertinent facts which will aid the **>OPLA staff member< in conducting the preliminary hearing. The report should be prepared in triplicate and addressed to the **>OPLA staff member<.

720.03 Preliminary Hearing [R-2]

Where the examiner concludes that a *prima facie* showing has not been established, both the petitioner and the applicant are so notified by the Office of the Deputy Commissioner for Patent Examination Policy and the application proceedings are resumed without giving the parties an opportunity to be heard on the correctness of the examiner's decision. Where the examiner concludes that a *prima facie* case has been established, the *>Director of the USPTO< may hold a preliminary hearing. In such case, the parties will be notified by letter of the examiner's conclusion and of the time and date of the hearing. In *ex parte* cases, whether or not the examiner has concluded that a *prima facie* showing has been established, no copy of the examiner's memorandum to the **>Office of Patent Legal Administration (OPLA) staff member< will be forwarded to the petitioner. However, in such cases where the petition covers restrictable subject matter and it is evident that petitioner is not aware of a restriction requirement which has been or may be made, petitioner will be informed that the examiner's conclusion is limited to elected subject matter. While not so specifically captioned, the notification of this hearing amounts to an order to show cause why a public use proceeding should not be held. No new evi-

dence is to be introduced or discussed at this hearing. The format of the hearing is established by the member of the **>OPLA staff<. The examiner may attend as an observer only.

Where the hearing is held in the *ex parte* situation, great care will be taken to avoid discussion of any matters of the application file which are not already of knowledge to petitioner. Of course, applicant may of his or her own action or consent notify the petitioner of the nature of his or her claims or other related matters.

After the hearing is concluded, the **>OPLA staff member< will decide whether public use proceedings are to be initiated, and he/she will send appropriate notice to the parties.

720.04 Public Use Proceeding Testimony [R-3]

When the Office of Patent Legal Administration (OPLA) staff member decides to institute public use proceedings, the application is referred to the examiner who will conduct all further proceedings. The fact that the affidavits or declarations and exhibits presented with the petition for institution of the public use proceedings have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established. The statutory bar can only be established by testimony taken in accordance with normal rules of evidence, including the right of cross-examination. The affidavits or declarations are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them unless the affidavits or declarations are submitted as a part of the petitioner's testimony.

The procedure for taking testimony in a public use proceeding is similar to that for taking testimony in an interference. Normally, no representative of the Director of the USPTO need be present at the taking of the testimony. Note that 37 CFR *>41.157(a)< limits noncompelled direct testimony to affidavits. **

The examiner will set a schedule of times for taking testimony and for filing the record and briefs on the basis of the following:

I. SCHEDULE FOR TESTIMONY

(A) Testimony for petitioner to close . . . . . [specify a date, e.g., January 10, 1997, which is approximately 60 days after the letter]

(B) Time for the applicant to file objections to admissibility of petitioner's evidence to close . . . . . [specify a date which is approximately 20 days after date (A)]

(C) Time for the petitioner to file supplemental evidence to overcome objections to close 20 days from above date, i.e., ... [specify a date which is exactly 20 days after date (B), unless the date is a Saturday, Sunday or federal holiday, in which case use the next business day]

(D) Time for the applicant to request cross-examination of the petitioner's affiants to close . . . . . [specify a date which is approximately 20 days after date (C)]

(E) Time for cross-examination of the petitioner's affiants to close . . . . . [specify a date which is approximately 30 days after date (D)]

(F) Rebuttal testimony by applicant to close . . . . . [specify a date which is approximately 20 days after date (E)]

II. SCHEDULE FOR FILING AND SERVING COPIES OF RECORD AND BRIEFS

One copy of each of the petitioner's and the applicant's record and exhibits (see 37 *>CFR 41.154 and 41.157<) is due . . . . [specify a date which is approximately 30 days after date (F)]

Petitioner's brief is due . . . . . [specify a date which is approximately 30 days after previous date]

Applicant's brief is due . . . . . [specify a date which is approximately 20 days after previous date]

Applicant and petitioner may agree on a different schedule for testimony, records, and briefs, provided the last brief is due no later than the date set forth above and provided a copy of the new schedule is filed by either applicant or petitioner. No extension of time will be permitted under 37 CFR 1.136(a). Any petition to extend the time for filing the last brief must be filed under 37 CFR 1.136(b).

A certified transcript of a deposition must be filed in the U.S. Patent and Trademark Office within one

month after the date of deposition. 37 CFR *>41.157<.

All papers in the public use proceeding shall be served in accordance with 37 CFR 1.248.

It is understood from the above scheduling of times that a given time period begins with the close of the previous period, and that the completion of testimony or the filing of the record or a brief before the close of the corresponding period does not change its closing date. To avoid confusion, the examiner should indicate specific dates for the close of each period.

In *ex parte* cases and in *inter partes* cases where the pending application is a reissue, an oral hearing is ordinarily not held.

In all public use proceedings, whether the ultimate issue is anticipation under 35 U.S.C. 102(b) or obviousness over 35 U.S.C. 103, testimony will be limited to the issues of public use or on sale. No testimony will be received on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale.

720.05 Final Decision [R-2]

The final decision of the examiner should be "analogous to that rendered by the [Board of Patent Appeals and Interferences] in an interference proceeding, analyzing the testimony" and stating conclusions. *In re Townsend*, 1913 C.D. 55, 188 O.G. 513 (Comm'r Pat. 1913). In reaching his or her decision, the examiner is not bound by the prior finding that a *prima facie* case has been established.

If the examiner concludes that a public use or sale bar exists, he or she will enter a rejection to that effect in the application file, predicating that rejection on the evidence considered and the findings and decision reached in the public use proceeding. Even if a rejection is not made, the examiner's written action should reflect that the evidence of 35 U.S.C. 102(b) activity has in fact been considered. Likewise, if the examiner concludes that a *prima facie* case (A) has not been established, or (B) has been established and rebutted (MPEP § 2133.03(e) *et seq.*) then the examiner's written action should so indicate. Strict adherence to this format should cause the rationale employed by the examiner in the written action to be self-evident. In this regard, the use of reasons for allowance pursuant to 37 CFR 1.104(e) may also be appropriate. See MPEP § 1302.14. In *ex parte* cases where the petitioner does not have access to the file, no copy of the examiner's action is mailed to the petitioner by the Office.

There is no review from the final decision of the examiner in the public use proceedings. A petition under 37 CFR 1.181, requesting that the *>Director of the USPTO< exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). Once the application returns to its *ex parte* status, appellate review under 35 U.S.C. 134 and 141-145 may be had of any adverse decision rejecting claim(s), as a result of the examiner's decisions as to public use or sale.

724 Trade Secret, Proprietary, and Protective Order Materials

Situations arise in which it becomes necessary, or desirable, for parties to proceedings in the Patent and Trademark Office relating to pending patent applications or reexamination proceedings to submit to the Office trade secret, proprietary, and/or protective order materials. Such materials may include those which are subject to a protective or secrecy order issued by a court or by the International Trade Commission (ITC). While one submitting materials to the Office in relation to a pending patent application or reexamination proceeding must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes imposes. The Office is also cognizant of the sentiment expressed by the court in *In re Sarkar*, 575 F.2d 870, 872, 197 USPQ 788, 791 (CCPA 1978), which stated:

> [T]hat wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

Parties bringing information to the attention of the Office for use in the examination of applications and

reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.

Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

> information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and
>
> (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
>
> (2) It refutes, or is inconsistent with, a position the applicant takes in:
>
> (i) Opposing an argument of unpatentability relied on by the Office, or
>
> (ii) Asserting an argument of patentability.
>
> A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

Somewhat the same problem faces a protestor under 37 CFR 1.291(a) who believes that trade secret, proprietary, or protective order material should be considered by the Office during the examination of an application.

In some circumstances, it may be possible to submit the information in such a manner that legitimate trade secrets, etc., will not be disclosed, e.g., by appropriate deletions of nonmaterial portions of the information. This should be done only where there will be no loss of information material to patentability under 37 CFR 1.56 or 1.555.

The provisions of this section do not relate to material appearing in the description of the patent application.

724.01 Completeness of the Patent File Wrapper

It is the intent of the Office that the patent file wrapper be as complete as possible insofar as "material" information is concerned. The Office attempts to minimize the potential conflict between full disclosure of "material" information as required by 37 CFR 1.56 and protection of trade secret, proprietary, and protective order material to the extent possible.

The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material.

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials [R-3]

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

DO NOT SCAN
In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

B. "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

DO NOT SCAN
In re Application of
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

C. "MATERIAL SUBJECT TO PROTECTIVE ORDER — NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

DO NOT SCAN
Tribunal Issuing Protective Order:
Civil Action or Other Identification No.:
Date of Order:
Current Status of Proceeding: (Pending, Stayed, etc.)
In re application of:
Application No.
Filed:
For: (Title of Invention)
TC Art Unit:
Examiner:

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(*>g<)) to expunge the information, if found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, should accompany the envelope or container.

In order to ensure that such an envelope or container is not mishandled, either prior to reaching the Office, or in the Office, the envelope or container should be hand-carried to the Customer Window located at:

U.S. Patent and Trademark Office
**>Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314<

The envelope or container may also be mailed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Upon receipt of the envelope or container, the Office will place the envelope or container in an Artifact folder if the application is an Image File Wrapper (IFW) application. If the application is maintained in paper, the confidential or proprietary information will be retained in the envelope or container.

724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02

The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/ or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR

1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

Insofar as protestors under 37 CFR 1.291(a) are concerned, submissions can be made in accordance with MPEP § 724.02 before the patent application is published, if protestor or petitioner has access to the application involved. After the patent application has been published under 35 U.S.C. 122(b)(1), no protest may be filed without the express consent of the applicant. Any submission filed by a protestor must follow the requirements for service. The Office cannot ensure that the party or parties served will maintain the information secret. If the party or parties served find it necessary or desirable to comment on material submitted under MPEP § 724 before it is, or without its being, found "material to patentability," such comments should either (A) not disclose the details of the material or (B) be submitted in a separate paper under MPEP § 724.02.

724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02 [R-2]

The exact methods of treating and handling materials submitted under MPEP § 724.02 will differ slightly depending upon whether the materials are submitted in an original application subject to the requirements of 35 U.S.C. 122 or whether the submission is made in a reissue application or reexamination file open to the public under 37 CFR 1.11(b) or (d). Prior to publication, an original application is not open to the public under 35 U.S.C. 122(a). After the application has been published under 35 U.S.C. 122(b)(1), copies of the file wrapper of the pending application are available to any member of the public who has filed a request under **>37 CFR 1.14(a)(1)(ii) or (a)(1)(iii)<. See MPEP § 103.

**>If the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14, any materials submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied. Prior to the mailing of the notice of allowability or notice of abandonment, the examiner will review the patent application file and determine if a petition to expunge is in the application file but not acted upon. If the application is being allowed, if the materials submitted under MPEP § 724.02 are found not to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the petition to expunge will be granted and the materials will be expunged. If the materials are found to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the petition to expunge will be denied and the materials will become part of the application record and will be available to the public upon issuance of the application as a patent. With the mailing of the notice of abandonment, if a petition to expunge has been filed, irrespective of whether the materials are found to be important or not to a reasonable examiner in deciding on patentability, the petition to expunge will be granted and the materials expunged.<

Upon receipt of the submission, the transmittal letter and the envelope or container will be date stamped and brought to the attention of the examiner or other Office employee responsible for evaluating the submission. The receipt of the transmittal letter and envelope or container will be noted on the "Contents" of the application or reexamination file. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.< In addition, the face of the application or reexamination file will have the notation placed thereon to indicate that trade secret, proprietary, or protective order material has been filed. >For Image File Wrapper (IFW) processing, see IFW Manual section 3.6.< The location of the material will also be specified. The words "TRADE SECRET MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" on the face of the file are sufficient to indicate the presence of trade secret material. Similar notations will be made for either proprietary or protective order materials.

724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122 [R-2]

Any materials submitted under MPEP § 724.02 in an application covered by 35 U.S.C. 122 will be treated in the following manner:

(A) The submitted material will be maintained in the original envelope or container (clearly marked "Not Open To The Public") and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether to allow the application to issue as a patent. **>Prior to publication, an original application is not available to the public under 35 U.S.C. 122(a). After publication of the application under 35 U.S.C. 122(b)(1), where the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14, any materials submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.<

(B) >If the application is to be abandoned, prior to the mailing of a notice of abandonment, the examiner will review the patent application file and determine if a petition to expunge is in the application file but not acted upon. If a petition to expunge has been filed, irrespective of whether the materials are found to be important or not to a reasonable examiner in deciding on patentability, the petition to expunge will be granted and the materials expunged. If no petition to expunge has been filed, the materials will be available to the public under 37 CFR 1.14(a)(1)(ii) or (a)(1)(iv).

(C) If the application is being allowed, prior to the mailing of a notice of allowability, the examiner will review the patent application file and determine if a petition to expunge is in the application file but not acted upon.< The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

>

(D) < If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, >the petition to expunge will be denied and the information< will become a part of the file history >(and scanned, if the application is an Image File Wrapper (IFW) application)<, which upon issuance of the application as a patent would become available to the public.

>

(E) < If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, **>the petition to expunge will be granted and the information expunged.<

(F) ** >If a petition to expunge is not filed prior to the mailing of the notice of allowability, the materials submitted under MPEP § 724.02 will be released to the public upon the issuance of the application as a patent and upon the filing of a request and the appropriate fee (37 CFR 1.14).<

(G) Any petition to expunge the submitted information or any portion thereof under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b) [R-2]

Any materials submitted under MPEP § 724.02 in a reissue application open to the public under 37 CFR 1.11(b) will be treated in the following manner:

(A) >Materials submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.< The submitted information will be maintained separate from the reissue application file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(B) >If the reissue application is to be abandoned, prior to the mailing of a notice of abandonment, the

examiner will review the reissue application file and determine if a petition to expunge is in the reissue application file but not acted upon. If a petition to expunge has been filed, irrespective of whether the materials are found to be important or not to a reasonable examiner in deciding on patentability, the petition to expunge will be granted and the materials expunged. If no petition to expunge has been filed, the materials will be available to the public under 37 CFR 1.11(b).

(C) If the reissue application is being allowed, prior to the mailing of a notice of allowability, the examiner will review the reissue application file and determine if a petition to expunge is in the reissue application file but not acted upon.< The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

*>

(D) < If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, **>the petition to expunge will be denied and the information< will thereafter become a permanent part of the reissue application file and open to the public.

*>

(E) < If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, **>the petition to expunge will be granted and the information expunged.<

(F) **>If a petition to expunge is not filed prior to the mailing of the notice of allowability, the materials submitted under MPEP § 724.02 will become a permanent part of the reissue application file and open to the public under 37 CFR 1.11(b).<

(G) Any petition to expunge a portion or all of the submitted information will be treated in accordance with MPEP § 724.05.

724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d) [R-2]

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) >Materials submitted under MPEP § 724.02 will only be released to the public with any other papers in the reexamination file if no petition to expunge (37 CFR 1.59) was filed prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC), or if a petition to expunge was filed and the petition was denied.< The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) >Prior to the mailing of a NIRC, the examiner will review the reexamination file and determine if a petition to expunge is in the reexamination file but not acted upon.< The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, **>the petition to expunge will be denied and the information< will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, **>the petition to expunge will be granted and the information expunged.<

(E) >If a petition to expunge is not filed prior to the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d).<

*>

(F) < Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

724.05 Petition To Expunge Information or Copy of Papers in Application File [R-3]

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(*>g<)) is filed and the information has been found *not* to be important to a reasonable examiner in deciding on patentability. If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR 1.17(*>g<) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) for reexamination proceedings. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If a petition to expunge is not filed prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to the mailing of a NIRC for reexamination proceedings, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(*>g<) is included.

A request to expunge information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

III. INFORMATION SUBMITTED IN INCORRECT APPLICATION

37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request that the papers be expunged rather than transferred to the correct application file. For Image File Wrapper (IFW) processing, see IFW Manual. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g., application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the papers to the correct application file for which they were intended without the need of a petition.

IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions. The petition must explain why justice requires waiver of the rules to permit the requested material to be expunged. It should be noted that petitions to expunge information which is a part of the original disclosure, such as the specification and drawings, will ordinarily not be favorably entertained. The original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the USPTO record of the originally filed application be changed, which may not be possible.

724.06 Handling of Petitions To Expunge Information or Copy of Papers in Application File [R-3]

37 CFR 1.59. Expungement of information or copy of papers in application file.

(a)(1)Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

**>

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expunge of the information is appropriate in which case a notice granting the petition for expungement will be provided.<

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

*****

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(*>g<) are filed, and further that petitioner has established to the satisfaction of the Director that the return of the information is appropriate. Expungement of information that was originally submitted to the Office under MPEP § 724.02, or that should have been submitted in a sealed envelope as discussed in MPEP § 724.02, is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the information is not important to a reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability). Expungement of information that was inadvertently submitted to the Office is appropriate provided that

items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

Where the information to be expunged was not submitted pursuant to MPEP § 724.02 or as part of an Information Disclosure Statement, the petition should be sent to the Office of Petitions for decision.

The decision on the petition to expunge should be held in abeyance until the application is allowed or an *Ex parte Quayle* action, or a Notice of Abandonment is mailed, at which time the petition will be decided. However, where it is clear that the information was submitted in the wrong application, then the decision on the petition should not be held in abeyance. See MPEP § 724.05, paragraph III. In a pending application that has not been allowed or in which an *Ex parte Quayle* action has not been mailed, the examiner may not have finally considered what is material to a decision of patentability of the claims. Petitioner may be notified that the decision on the petition under 37 CFR 1.59(b) to expunge information in an application will be held in abeyance and be decided upon allowance of the application, or the mailing of an *Ex parte Quayle* action or a Notice of Abandonment using form paragraph 7.204.

**>

¶ *7.204 Petition Under 37 CFR 1.59(b) To Expunge Information: Decision Held in Abeyance*

In re Application of **[1]**	:
Appl. No.: **[2]**	: RESPONSE TO PETITION
Filed: **[3]**	: UNDER 37 CFR 1.59
For: **[4]**	:

This is a response to the petition under 37 CFR 1.59(b), filed **[5]**, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until allowance of the application or mailing of an *Ex parte Quayle* action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that a document entitled **[6]**, filed **[7]**, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be removed from the official file.

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted either pursuant to MPEP § 724.02 or in an information disclosure statement.
2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to MPEP § 724.02 or in an information disclosure statement. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.
4. In bracket 6, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.
5. Mail with PTO-90C cover sheet.

<

When an application has been allowed, an *Ex parte Quayle* action has been mailed, or an application is abandoned, a petition to expunge should be decided by a TC Director (see MPEP § 1002.02(c)). At this time a determination must be made as to whether the information in question is material. Form paragraph 7.205 should be used to grant a petition to expunge, whereas form paragraphs 7.206-7.213 should be used to dismiss such a petition.

**>

¶ *7.205 Petition Under 37 CFR 1.59(b) To Expunge Information Granted*

In re Application of **[1]**	:
Appl. No.: **[2]**	: DECISION ON PETITION
Filed: **[3]**	: UNDER 37 CFR 1.59
For: **[4]**	:

This is a decision on the petition under 37 CFR 1.59(b), filed **[5]**, to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled **[6]**, filed **[7]**, be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been removed from the official file.

Enclosure: **[8]**

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted either pursuant to MPEP § 724.02 or in an information disclosure statement. Furthermore, a petition to expunge may not be granted unless the application has been allowed or is abandoned, or an *Ex Parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to MPEP § 724.02 or in an information disclosure statement. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In brackets 6 and 8, clearly identify the expunged document. For example, refer to the author and title of the document.

5. Mail with PTO-90C cover sheet.

¶ *7.206 Petition Under 37 CFR 1.59(b) To Expunge Information Dismissed*

In re Application of **[1]**	:
Appl. No.: **[2]**	: DECISION ON PETITION
Filed: **[3]**	: UNDER 37 CFR 1.59
For: **[4]**	:

This is a decision on the petition under 37 CFR 1.59(b), filed **[5]**, to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled **[6]**, filed **[7]**, be expunged from the record.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims.

The petition is deficient because: **[8]**

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted either pursuant to MPEP § 724.02 or in an information disclosure statement. However, the petition should not be granted until the application has been allowed or abandoned, or an *Ex parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to MPEP § 724.02 or in an information disclosure statement. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In bracket 6, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.

5. This form paragraph must be followed with one or more of form paragraphs 7.207 through 7.213.

¶ *7.207 Petition To Expunge, Conclusion, Lacks Fee*

the petition was not accompanied by the required fee under 37 CFR1.17(g).

<

¶ *7.208 Petition to Expunge, Conclusion, Material to Determination of Patentability*

the information that petitioner requests to expunge is considered to be material to the determination of patentability because **[1]**.

Examiner Note:

In bracket 1, provide an explanation of basis for conclusion that information is material to the determination of patentability.

¶ *7.209 Petition To Expunge, Conclusion, Information Made Public*

the information has been made public. **[1]**

Examiner Note:

In bracket 1, provide explanation of basis for conclusion that information has been made public.

¶ *7.210 Petition to Expunge, Conclusion, No Commitment to Retain Information*

the petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the period of any patent with regard to which such information is submitted.

¶ *7.211 Petition to Expunge, Conclusion, No Clear Statement That Information is Trade Secret, Proprietary, and/or Subject to Protective Order, or that Submission Was Unintentional*

the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted. **[1]**

Examiner Note:

In bracket 1, indicate whether any such statement was provided and, if so, explain why such statement is not clear.

¶ *7.212 Petition to Expunge, Conclusion, No Clear Identification of Information to be Expunged*

the petition does not clearly identify the information requested to be expunged. **[1]**

Examiner Note:

In bracket 1, explain why the identification of the information requested to be expunged is not clear.

¶ *7.213 Petition to Expunge, Conclusion, No Statement That Petition Is Submitted By, or on Behalf of, Party in Interest Who Originally Submitted the Information*

the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.