









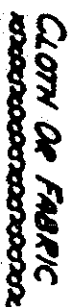





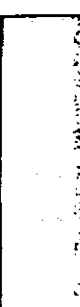





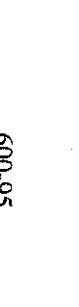

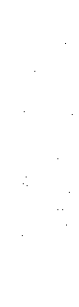



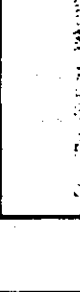



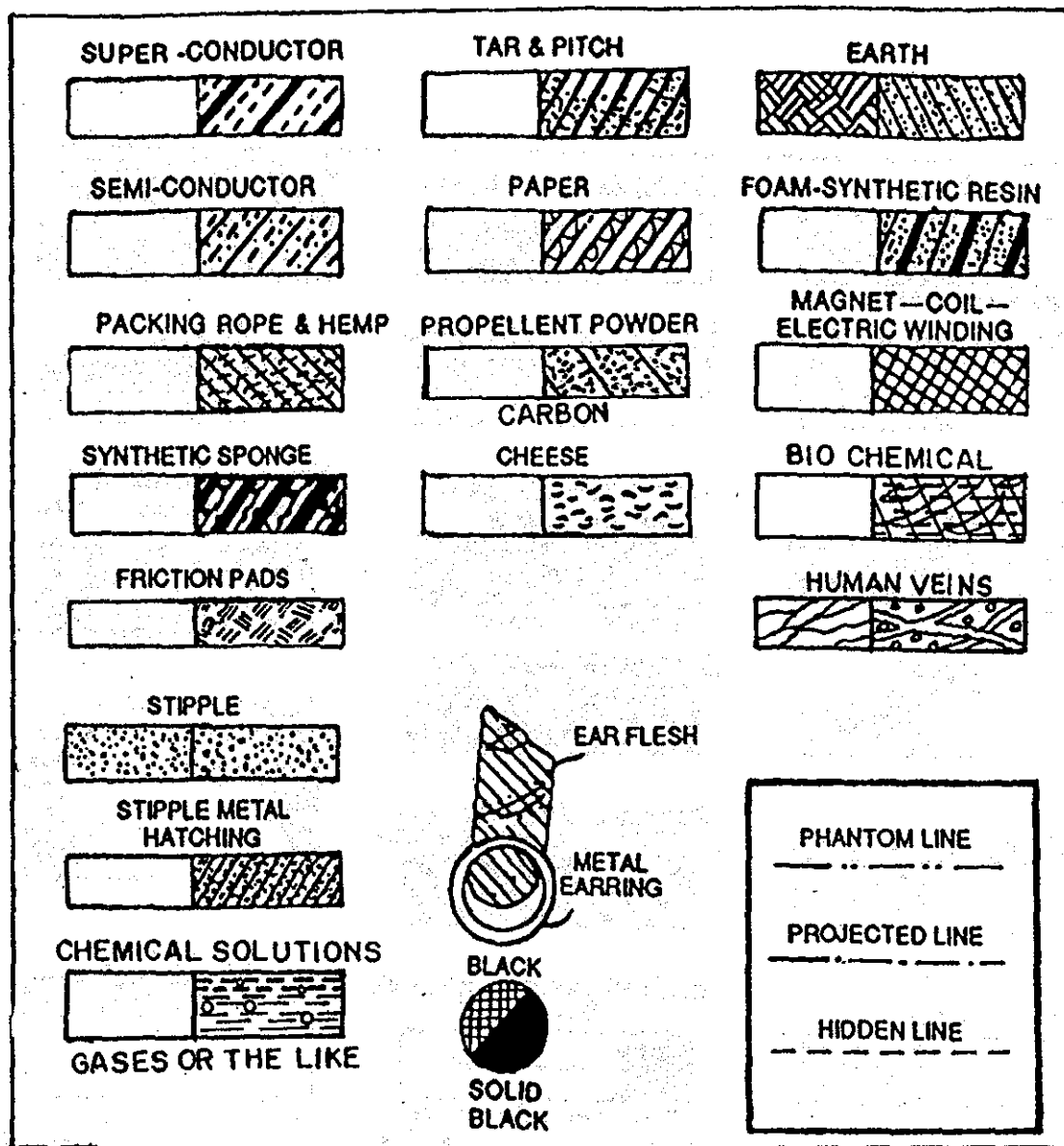
 <p><b>METAL</b></p>	 <p><b>FOAM, LEATHER, CORKING</b></p>	 <p><b>SECTION OF SYNTHETIC RESIN OR PLASTIC</b></p>
 <p><b>ELEVATION SECTION</b></p>	 <p><b>HEAT OR COLD INSULATION</b></p>	 <p><b>LIQUID</b></p>
 <p><b>TRANSPARENT MATERIAL</b></p>	 <p><b>SECTION OF SAND OR THE LIKE</b></p>	 <p><b>WIRE OR SCREENING</b></p>
 <p><b>CONCRETE</b></p>	 <p><b>SECTION OF SAND OR SOME RUBBER</b></p>	 <p><b>LOOSE METAL</b></p>
 <p><b>WOOD</b></p>	 <p><b>SECTION OF RUBBER OR ELECTRICAL INSULATION</b></p>	 <p><b>SECTION OF FABRIC</b></p>
 <p><b>REFRACTORY MATERIAL</b></p>	 <p><b>ELEVATION OF ELECTRON INSULATION</b></p>	 <p><b>ADHESIVE</b></p>
 <p><b>CORK</b></p>	 <p><b>SMALL - LARGE SURFACES INSULATION</b></p>	
 <p><b>VOILET &amp; BLUE</b></p>	 <p><b>YELLOW &amp; ORANGE</b></p>	
 <p><b>PURPLE</b></p>	 <p><b>GOLD</b></p>	
 <p><b>GREEN</b></p>	 <p><b>RED</b></p>	
 <p><b>BLUE</b></p>	 <p><b>PINK</b></p>	
 <p><b>BROWN</b></p>	 <p><b>BLACK</b></p>	
 <p><b>BLACK</b></p>	 <p><b>GRAY</b></p>	
 <p><b>SILVER</b></p>		



**608.02(a) New Drawing — When Replacement is Required Before Examination**

See MPEP § 608.02 for the procedure to follow when drawings have not been filed, but a drawing will aid in the understanding of the invention. See MPEP § 601.01(f) for the procedure to follow when applications appear to be missing sheets of drawings. Draw-

ings in utility and plant applications filed on or after November 29, 2000, other than continued prosecution applications (CPAs), will be reviewed by the Office of Initial Patent Examination (OIPE) for compliance with certain requirements of 37 CFR 1.84. OIPE will send a Notice to File Corrected Application Papers if the drawings are not acceptable for purposes of publication. The notice will give applicant a time period of 2 months from the mailing date of the notice to file

acceptable drawings. This time period for reply is extendable under 37 CFR 1.136(a). OIPE will not release applications to the Technology Centers until acceptable drawings are filing in the applications.

Utility and design patent applications should be taken up for the first Office action without a request for corrected drawings unless the informal drawings are so unclear that they do not facilitate an understanding of the invention as to permit examination of the application. If at the time of the initial assignment of an application to an examiner's docket, or if at the time the application is taken up for action, the supervisory patent examiner believes the informal drawings to be of such a condition as to not permit reasonable examination of the application, applicant should be required to immediately submit corrected drawings. However, if the informal drawings do permit reasonable examination and the supervisory patent examiner believes the drawings are of such a character as to render the application defective under 35 U.S.C. 112, examination should begin immediately with a requirement for corrected drawings and a rejection of the claims as not being in compliance with 35 U.S.C. 112, first paragraph, being made.

If the drawings have been indicated by the applicant as informal, but no objection has been made to the drawings, the examiner should not require replacement of the "informal" drawings with new drawings. If the examiner does make objections to the drawings, the examiner should require correction in reply to the Office action and not permit the objection to be held in abeyance. See MPEP § 608.02(b), § 608.02(d) - § 608.02(h) and § 608.02(p) for further information on specific grounds for finding drawings informalities.

### UNTIMELY FILED DRAWINGS

If a drawing is not timely received in reply to a notice from the Office or a letter from the examiner who requires a drawing, the application becomes abandoned for failure to reply.

For the handling of additional, duplicate, or substitute drawings, see MPEP § 608.02(h).

### 608.02(b) Informal Drawings

37 CFR 1.85. *Corrections to drawings.*

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been

corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PTO-948 or in an examiner's action, and that the drawing is admitted for examination purposes only (see MPEP § 707.07(a)). To be fully responsive, an amendment must include either corrected drawings or proposed drawing corrections. See 37 CFR 1.85(c) and 37 CFR 1.121(d). The objection to the drawings will not be held in abeyance.

### INFORMAL DRAWINGS

To expedite filing, applicants sometimes submit applications with informal drawings. Such applications will be accepted by the Office of Initial Patent Examination (OIPE) if the drawings are readable and reproducible for publication purposes. See MPEP § 507.

Examiners should review the drawings for disclosure of the claimed invention and for proper use of reference numerals. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance. A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (37 CFR 1.135(c)). Drawing corrections should be made promptly before allowance of the application in order to avoid delays in issuance of the application as a

patent or a reduction to any term adjustment. See 37 CFR 1.704(c)(10).

### NOTIFYING APPLICANT

If the original drawings are informal, a 2-part form, PTO-948, may be used to indicate what the informalities are and that new corrected drawings are required. In either case, the informal drawings will be accepted as satisfying the requirements of 37 CFR 1.51. The examiners are directed to advise the applicants by way of form PTO-948 (see MPEP § 707.07(a)) in the first Office action of the reasons why the drawings are considered to be informal. If the examiner discovers a defect in the content of the drawing, one or more of the form paragraphs reproduced below may be used to notify applicant.

#### ¶ 6.21 *New Drawings, Competent Draftsperson*

New corrected drawings are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held abeyance.

#### ¶ 6.22 *Drawings Objected To*

The drawings are objected to because [1]. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.26 *Informal Drawings Do Not Permit Examination*

The informal drawings are not of sufficient quality to permit examination. Accordingly, new drawings are required in reply to this Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit new drawings will result in **ABANDONMENT** of the application.

#### Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to the poor quality of the drawings resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

### WHEN CORRECTED DRAWINGS MAY BE DEFERRED OR HELD IN ABEYANCE

In the unusual situation where a proposed drawing correction is required before corrected drawings can be filed, the examiner may allow an applicant to defer correction until after the proposed drawing correction has been considered. See 37 CFR 1.121(d) and MPEP § 608.02(v) and (w).

#### ¶ 6.27 *Corrected Drawings May Be Held in Abeyance*

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

#### Examiner Note:

Use of this form paragraph should be limited to those instances where a proposed drawing correction is necessary before corrected drawings can be filed. See MPEP § 608.02(v) and for an explanation as to when a proposed drawing correction is necessary, 37 CFR 1.85(a) states that correction to drawings may not be held in abeyance unless the applicant is otherwise notified in an Office action. Applicants should be encouraged to submit corrected drawings before allowance in order to avoid having any term adjustment reduced pursuant to 37 CFR 1.704(c)(10).

### HANDLING OF REPLACEMENT OR SUBSTITUTE DRAWINGS

In those situations where an application is filed with informal drawings, applicants are requested to file new acceptable drawings before allowance of the application, or within the later of one month after the filing date of the application, or fourteen months after the earliest filing date relied upon, if the drawings are intended to be included in the patent application publication. See MPEP § 507. The letter of transmittal accompanying the new drawings should identify the art unit. If the informal notification appears on the notice of allowability (PTOL-37), the drawings must be filed within three months of the date of mailing of the notice of allowability. Also, each sheet of the drawing should include the application number and the art unit in the upper right margin. In the past, some drawings have been misdirected because the art unit indicated on the filing receipt was used rather than that indicated on the informal notice forms.



In utility applications, the examination will normally be conducted using any informal drawings presented. The sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the informal drawings. IT IS APPLICANT'S RESPONSIBILITY TO SEE THAT NO NEW MATTER IS ADDED when submitting substitute or replacement drawings after allowance since they will not normally be reviewed by an examiner. Of course, if the examiner notices new matter in the substitute or replacement drawings, appropriate action to have the new matter deleted should be undertaken.

### 608.02(c) Drawing Print Kept in File Wrapper

The drawing prints must always be kept on top of the papers on the right side of the file wrapper under any bibliographic data sheet.

Applications may be sent to issue or to the Files Repository without the original drawing, if any, if the drawing cannot be located. For an application sent to issue with missing drawings, see MPEP § 608.02(z). For abandoned applications sent to the Files Repository, a notation should be made on the Contents portion of the file wrapper that the drawings were missing.

Upon initial processing, the original drawings are placed in the center portion of the application file wrapper under the specification and the executed oath or declaration by the Scanning Division.

### 608.02(d) Complete Illustration in Drawings

#### 37 CFR 1.83. Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration

within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

Any structural detail that is of sufficient importance to be described should be shown in the drawing. (*Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911).)

Form paragraph 6.22.01, 6.22.04, or 6.36, where appropriate, may be used to require illustration.

#### ¶ 6.22.01 Drawings Objected To, Details Not Shown

The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, identify the structural details not shown in the drawings.
2. Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.22.04 Drawings Objected to, Incomplete

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. Supply a full explanation, if it is not readily apparent how the drawings are incomplete.
2. Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.36 Drawings Do Not Show Claimed Subject Matter

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

In bracket 1, insert the features that must be shown.

See also MPEP § 608.02.

### 608.02(e) Examiner Determines Completeness and Consistency of Drawings

The examiner should see to it that the figures are correctly described in the brief description of the several views of the drawing section of the specification, that the reference characters are properly applied, that no single reference character is used for two different parts or for a given part and a modification of such part, and that there are no superfluous illustrations.

One or more of the following form paragraphs may be used to require correction.

#### ¶ 6.22.02 Drawings Objected to, Different Numbers Refer to Same Part

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "[1]" and "[2]" have both been used to designate [3]. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In brackets 1 and 2, identify the numbers which refer to the same part.
2. In bracket 3, identify the part which is referred to by different numbers.
3. Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.22.03 Drawings Objected to, Different Parts Referred to by Same Number

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "[1]" has been used to designate both [2] and [3]. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, identify the number which refers to the different parts.
2. In brackets 2 and 3, identify the parts which are referred to by the same number.
3. Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.22.06 Drawings Objected to, Reference Numbers Not in Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: [1]. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the drawings, including the page and line number where they first occur in the specification.
2. Follow with form paragraph 6.27, if appropriate.

#### ¶ 6.22.07 Drawings Objected to, Reference Numbers Not in Specification

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: [1]. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the specification, including the figure in which they occur.
2. Follow with form paragraph 6.27, if appropriate.

### 608.02(f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. *Ex parte Badger*, 1901 C.D. 195, 97 O.G. 1596 (Comm'r Pat. 1901).

All modifications described must be illustrated, or the text canceled. (*Ex parte Peck*, 1901 C.D. 136, 96 O.G. 2409 (Comm'r Pat. 1901).) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

Form paragraph 6.22.05 may be used to require correction.

#### ¶ 6.22.05 Drawings Objected to, Modifications in Same Figure

The drawings are objected to under 37 CFR 1.84(h)(5) because Figure [1] show(s) modified forms of construction in the same view. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, insert the appropriate Figure number(s).
2. Follow with form paragraph 6.27, if appropriate.

### 608.02(g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliott*, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's inven-

tion, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, form paragraph 6.36.01 may be used.

#### ¶ 6.36.01 Illustration of "Prior Art"

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### 608.02(h) Additional, Duplicate, or Substitute Drawings

When an amendment is filed stating that substitute or additional sheets of drawings are filed with the amendment and such drawings have not been transmitted to the Technology Center (TC), the technical support staff in the TC should attempt to locate the missing drawings. In the next communication of the examiner, the applicant is notified if the drawings have been received and whether or not the substitute or additional drawings have been entered in the application. If the substitute or additional drawings are not entered, the examiner should give the applicant a concise and complete explanation as to why the drawings were not entered.

Additional and substitute drawings, together with the file wrapper, may be routed through the TC Draftsperson if the examiner would like the draftsperson's assistance in identifying errors in the drawings. The draftsperson will note any defects of the drawings on a PTO-948.

The examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. The technical support staff will routinely enter all additional and substitute sheets on the file wrapper. If the examiner decides that the sheets should not be entered, the examiner should provide the applicant with the complete, explicit reasoning for the denial of entry. The entries made by the technical support staff will be marked "(N.E.)."

Form paragraph 6.37 may be used to acknowledge corrected or substituted drawings.

#### ¶ 6.37 Acknowledgment of Corrected or Substitute Drawings

The corrected or substitute drawings were received on [1]. These drawings are [2].

#### Examiner Note:

1. In bracket 2, insert either --acceptable-- or --not acceptable--.
2. If not acceptable, an explanation must be provided.
3. If not acceptable because of informalities noted on PTO-948, use form paragraph 6.43.

Alternatively, PTOL-326 Office Action Summary includes a block for acknowledgment of corrected or substitute drawings.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

For return of drawing, see MPEP § 608.02(y).

### 608.02(i) Transfer of Drawings From Prior Applications

Transfer of drawings from a first pending application to another will be made only upon the granting of a petition filed under 37 CFR 1.182 which must set forth a hardship situation requiring such transfer of drawings.

### 608.02(m) Drawing Prints

Preparation and distribution of drawing prints is discussed in MPEP § 508.

Prints are made of the drawings of an acceptable application. These prints are kept on top of the papers on the right side of the file wrapper under any bibliographic data sheet. See MPEP § 719.01(b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the application number.

The print should not be permanently marked or in any way altered. The original drawing, of course, should not be marked up by the examiner. Where, as in an electrical wiring application, it is desirable to identify the various circuits by different colors, or in any more or less complex application, it is advantageous to apply legends, arrows, or other indicia, an additional print for such use should be made by the examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in MPEP § 608.02(c).

### INTERFERENCE PRINTS

A print is prepared of each drawing in all applications having a filing date. This interference print is in addition to the drawing print on white paper. The classification of the application should be placed on the interference print. All interference prints are then placed in the interference cabinets.

If an application has several sheets of drawings, the interference prints should be stapled together at their top edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the interference prints are removed from the drawing cabinets is determined by the Technology Center Director.

The drawings filed by applicant remain in the file wrapper.

### 608.02(n) Duplicate Prints in Patentability Report Applications

In patentability report cases having drawings, the examiner to whom the application is assigned should normally obtain a duplicate set of the interference prints of the drawing for filing in the Technology Center (TC) to which the application is referred.

When an application that has had patentability report prosecution is passed for issue or becomes abandoned, notification of this fact is given by the TC having jurisdiction of the case to each TC that submitted a patentability report. The examiner of each such reporting TC notes the date of allowance or abandonment on his or her duplicate set of prints. At such time as these prints become of no value to the reporting TC, they may be destroyed.

For patentability reports, see MPEP § 705 to § 705.01(f).

### 608.02(o) Notations Entered on Drawing

Drawing sheets received by the Mail Center are endorsed with the application number in the left-hand margin. If the drawings are filed in the Technology Center (TC), the TC date of receipt stamp should be applied to the back of the drawing near the top.

A draftsman's "stamp" to indicate approval is no longer required on patent drawings, and these stamps are no longer used by draftsmen. If the drawings in an allowed application are not indicated as having been disapproved or canceled, the most-recently filed drawings will be used for printing the patent.

### 608.02(p) Correction of Drawings

37 CFR 1.121. *Manner of making amendments in application.*

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(d) Drawings. Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

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37 CFR 1.85. *Corrections to drawings*

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in § 1.215(c), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action (§ 1.135(c)). If a drawing in a design application meets the requirements of § 1.84(e), (f), and (g) and is suitable for reproduction, but is not otherwise in compliance with § 1.84, the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).

For corrections which are deferrable, see MPEP § 608.02(b). For correction at allowance and issue, see MPEP § 608.02(w) and MPEP § 1302.05.

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description of the view if a canceled figure is reinstated.

The following form paragraphs may be used to notify applicants of drawing corrections.

¶ 6.38 *Acknowledgment of Proposed Drawing Correction*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been [2]. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

**Examiner Note:**

1. In bracket 2, insert either --approved-- or --disapproved--.
2. If approved, form paragraph 6.39 and one or more of paragraphs 6.40 or 6.41 or 6.44 must follow.
3. If disapproved, an explanation must be provided.

¶ 6.38.01 *Proposed Drawing Correction Disapproved, Changes Not Highlighted*

The proposed drawing correction filed on [1] has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

¶ 6.38.02 *Proposed Drawing Correction Disapproved, New Matter*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of [2].

**Examiner Note:**

In bracket 2, explain which feature(s) of the proposed drawing correction constitute(s) new matter.

¶ 6.39 *USPTO No Longer Makes Drawing Changes*

The United States Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

**Examiner Note:**

This form paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

¶ 6.40 *Information on How To Effect Drawing Changes*

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be

obtained under the provisions of 37 CFR 1.136(a) or for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

¶ 6.41 *Reminder That USPTO No Longer Makes Drawing Changes*

Applicant is reminded that the U.S. Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in Paper No. [1], mailed on [2].

**Examiner Note:**

This form paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes (i.e., either by way of form paragraph 6.40 or a PTO-948 has been previously sent).

¶ 6.42 *Reminder That Applicant Must Make Drawing Changes*

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in Paper No. [1], mailed on [2].

**Examiner Note:**

This form paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes (i.e., by way of form paragraph 6.40 or a PTO-948 has been previously sent).

¶ 6.43 *Drawings Contain Informalities, Application Allowed*

The drawings filed on [1] are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

**Examiner Note:**

Use this form paragraph when allowing the application, particularly at time of first action issue. Form paragraph 6.40 or 6.41 must follow.

**¶ 6.44 Drawing Informalities Previously Indicated**

In order to avoid abandonment, the drawing informalities noted in Paper No. [1], mailed on [2], must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

**Examiner Note:**

Use this form paragraph when allowing the application and applicant has previously been informed of informalities in the drawings.

**¶ 6.47 Examiner's Amendment Involving Drawing Changes**

The following changes to the drawings have been approved by the examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make these agreed upon drawing changes.

**Examiner Note:**

1. In bracket 1, insert the agreed upon drawing changes.
2. Form paragraphs 6.39 and 6.40 should follow, as appropriate.

**608.02(q) Conditions Precedent to Amendment of Drawing**

See MPEP § 507 for changes to the patent drawings for purposes of a patent application publication.

If applicant wishes to amend the original drawings, at his or her own initiative, applicant is encouraged to submit new drawings as soon as possible, and preferably before allowance of the application.

**608.02(r) Separate Letter**

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter. Otherwise the application, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner.

For changes which may require sketches, see MPEP § 608.02(v).

**608.02(t) Cancellation of Figures**

Cancellation of one or more figures which do not occupy entire sheets of the drawings is done by the technical support staff in the Technology Center (TC) who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancellation or the date that substitute sheets are filed should be written in red ink within the red line. Applicant will be

required to submit a replacement sheet of drawings without the canceled figure. Cancellation of an entire sheet of drawings is done by stamping the words "CANCEL per" on the back side of the drawing sheet. Canceled drawing sheets should be placed upside down at the bottom of the papers on the right side of the file wrapper.

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the examiner should consult with the Draftsperson as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. Cancellation of a figure may necessitate renumbering of the remaining figures.

**608.02(v) Drawing Changes Which Require Sketches**

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch must be filed showing such changes in red ink or with the changes otherwise highlighted. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints.

**608.02(w) Drawing Changes Which May Be Made Without Applicant's Sketch**

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare a letter to the applicant indicating the change to be made and note in pencil on the drawing the addition or alteration to be made. The marked-up copy of the drawing should be attached to the letter to the applicant.

The correction must be made at applicant's expense.

As a guide to the examiner, the following corrections are illustrative of those that may be made by penciling in the change on the drawing without a sketch:

- (A) Adding two or three reference characters or exponents.

(B) Changing one or two numerals or figure ordinals. *Garrett v. Cox*, 233 F.2d 343, 346, 110 USPQ 52, 54 (CCPA 1956).

(C) Removing superfluous matter.

(D) Adding or reversing directional arrows.

(E) Changing Roman Numerals to Arabic Numerals to agree with specification.

(F) Adding section lines or brackets, where easily executed.

(G) Changing lead lines.

(H) Correcting misspelled legends.

### **608.02(x) Disposition of Applications with Proposed Drawing Corrections**

Where the correction of the drawing is approved by the examiner, the application and drawing are forwarded to the Publishing Division along with the Notice of Allowance.

#### **CORRECTION NOT APPROVED**

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the examiner should explicitly and clearly set forth all the reasons for not approving the corrections to the drawings in the next communication to the applicant. See MPEP § 608.02(p) for suggested form paragraphs that may be used by examiners to notify applicants of drawing corrections.

### **608.02(y) Return of Drawing**

If there is an acceptable drawing in the application, nonentered drawings that have been finally denied admission will not be returned to the applicant.

### **608.02(z) Allowable Applications Needing Drawing Corrections or Corrected Drawings**

If an application is being allowed, and corrected drawings have not been filed, form PTOL-37 provides an appropriate check box for requiring corrected drawings.

Allowable applications with informal drawings should be turned in for counting and forwarding to the

Publishing Division without the drawings having been corrected. Examiners should not require new drawings merely because the applicant indicated that the drawings submitted on filing were informal. The drawings requiring correction should be placed as the top papers in the center fold of the file wrapper. A proposed drawing correction, for example a drawing sheet with corrections marked in pencil, should be stapled to the right outside flap of the file wrapper over the area having the search information. Care should be taken to make certain that the corrections have been approved by the examiner. Such approval should be made by the examiner prior to counting the allowance of the application by writing "Approved," the examiner's initials or full name, and the date, on the front page of the proposed drawing corrections.

Extensions of time to provide acceptable drawings after the mailing of a notice of allowability are no longer permitted. A "yellow tag" is no longer required to be used in allowable applications that need drawing corrections. If the Office of Publications receives drawings that cannot be scanned or are otherwise unacceptable for publication, the Office of Publication will mail a requirement for corrected drawings, giving applicant a shortened statutory period of two months (with no extensions of time permitted) to reply. The drawings will ordinarily not be returned to the examiner for corrections.

#### **APPLICATIONS HAVING LOST DRAWINGS**

A replacement drawing should be obtained from the Office of Initial Patent Examination's records of the application as originally filed. If the reproduced drawings are not acceptable for publishing, applicant should be required to submit corrected drawings.

The Notice of Allowability is verified and printed using PALM, and the Notice is mailed to the applicant.

The application is then forwarded to Licensing and Review or the Publishing Division, as appropriate, using the PALM transaction code after the application has been revised for issue.

#### **UTILITY PATENT APPLICATIONS RECEIVING FORMAL DRAWINGS AFTER THE NOTICE OF ALLOWABILITY**

Where substitute drawings are received in utility patent applications examined with informal drawings

and the Notice of Allowability was mailed prior to the receipt of the substitute drawings, the technical support staff should forward the substitute drawings to the Publishing Division. Submission to the examiner is not necessary unless an amendment accompanies the drawings which changes the specification, such as where the description of figures is added or canceled.

### BORROWING FILES FROM PUBLISHING DIVISION

Allowed files requiring drawing corrections are sent to the Publishing Division. At times, examiners have a need to borrow these applications. When borrowing applications, examining corps personnel must submit a request to the Office of Patent Publications Customer Service Center.

### 37 CFR 1.312 AMENDMENTS

In handling 37 CFR 1.312 amendments, the examining corps should process drawings canceled in the normal manner. If there are corrections to the drawing, approval, if appropriate, is indicated by the examiner on form PTOL-271 in conjunction with form paragraph 6.48; the paragraph sets the appropriate period for effecting the approved drawing change.

#### ¶ 6.48 Drawing Changes in 37 CFR 1.312 Amendment

Applicant is hereby given **ONE MONTH** from the mailing date of this letter or until the expiration of the period set in the "Notice of Allowance" (PTOL-85) or "Notice of Allowability" (PTOL-37 or PTO-37), whichever is longer, to file corrected drawings.

#### Examiner Note:

Use with the 37 CFR 1.312 amendment notice where there is a drawing correction proposal or request.

### 608.03 Models, Exhibits, Specimens

#### 35 U.S.C. 114. Models, specimens.

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

#### 37 CFR 1.91. Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of § 1.52 or § 1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in § 1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

Models or exhibits are generally not admitted as part of an application or patent unless the requirements of 37 CFR 1.91 are satisfied.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

A physical exhibit, not to be part of the application, is generally not refused except when bulky or dangerous. Such exhibit, if left with the examiner, may be disposed of at the discretion of the Office.

#### 37 CFR 1.93. Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

See MPEP Chapter 2400 regarding treatment of biotechnology deposits.

### 608.03(a) Handling of Models, Exhibits, and Specimens

All models and exhibits received in the U.S. Patent and Trademark Office should be taken to the Technology Center (TC) assigned the related application for examination. The receipt of all models and exhibits which are to be entered into the application file record must be properly recorded on the "Contents" portion of the application file wrapper.

A label indicating the application number, filing date, and attorney's name and address should be attached to the model or exhibit so that it is clearly identified and easily returned after prosecution of the application is closed, if return is requested and the model or exhibit is deemed not necessary for the examination of the application. See 37 CFR 1.94.



If the model or exhibit cannot be conveniently stored within the application file wrapper, it should not be accepted.

Models and exhibits may be presented for demonstration purposes during an interview. The models and exhibits should be taken away by applicant or his/her attorney or agent at the conclusion of the interview since models or exhibits are generally not permitted to be admitted as part of the application or patent unless the requirements of 37 CFR 1.91 are satisfied. See MPEP § 713.08. A full description of what was demonstrated or exhibited during the interview must be made of record. See 37 CFR 1.133. Any model or exhibit that is left with the examiner at the conclusion of the interview, which is not made part of the application or patent, may be disposed of at the discretion of the Office.

*37 CFR 1.94. Return of models, exhibits or specimens.*

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

Upon request by applicant for the return of a model or exhibit, the model or exhibit will be returned to applicant at applicant's expense if (1) the examiner determines that it is not necessary to preserve the model or exhibit in the Office, and (2) the model or exhibit has not been earlier disposed of by the Office. A letter should be written to applicant by the TC stating that the model or exhibit is being returned under separate cover, and the model or exhibit should be forwarded with a copy of the letter and an address label to the Mail Center for wrapping and return.

For disposition of exhibits which are part of the record, see MPEP § 715.07(d).

For plant specimens, see MPEP § 1607 and 37 CFR 1.166.

*37 CFR 1.95. Copies of exhibits.*

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an applica-

tion or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

## 608.04 New Matter

*37 CFR 1.121. Manner of making amendments in application.*

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(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

\*\*\*\*\*

In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. See MPEP § 608.01(l).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected under 35 U.S.C. 112, first paragraph.

When new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made to cancel the new matter. The subject matter which is considered to be new matter must be clearly identified by the examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed.

A "new matter" amendment of the drawing is ordinarily not entered; neither is an additional or substitute sheet containing "new matter" even though provisionally entered by the TC technical support staff. See MPEP § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable. See MPEP § 608.04(c).

For new matter in reissue application, see MPEP § 1411.02. For new matter in substitute specification, see MPEP § 608.01(q).

**Note:** No amendment is permitted in a provisional application after it receives a filing date.

### 608.04(a) Matter Not in Original Specification, Claims, or Drawings

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

For completeness of disclosure, see MPEP § 608.01(p). For trademarks and tradenames, see MPEP § 608.01(v).

### 608.04(b) New Matter by Preliminary Amendment

An amendment is sometimes filed along with the filing of the application. Where a 37 CFR 1.53(b) application is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. See MPEP § 714.09.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under former 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

### 608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

### 608.05 Sequence Listing Table, or Computer Program Listing Appendix Submitted on a Compact Disc

37 CFR 1.52. *Language, paper, writing, margins, compact disc specifications.*

\*\*\*\*\*

(e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

- (i) A computer program listing (see § 1.96);
- (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
- (iii) A table (see § 1.58) that has more than 50 pages of text.

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII).

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates

of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the "Sequence Listing" in computer readable form required by § 1.821(e). The compact disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled "Copy 1" for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§ 1.77(b)(4)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

- (i) The name of each inventor (if known);
- (ii) Title of the invention;
- (iii) The docket number, or application number if known, used by the person filing the application to identify the application; and
- (iv) A creation date of the compact disc.
- (v) If multiple compact discs are submitted, the label shall indicate their order (e.g. "1 of X").
- (vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

#### 37 CFR 1.77. Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings.
- (6) Executed oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see § 1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.

(5) Background of the invention.

(6) Brief summary of the invention.

(7) Brief description of the several views of the drawing.

(8) Detailed description of the invention.

(9) A claim or claims.

(10) Abstract of the disclosure.

(11) "Sequence Listing," if on paper (see §§ 1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

Special procedures for the presentation of large tables, computer program listings and certain biosequences on compact discs are set forth in 37 CFR 1.52(e). Use of compact discs is desirable in view of the lengthy data listings being submitted as part of the disclosure in some patent applications. Such listings are often several hundred pages or more in length. By filing and publishing such data listings on compact disc rather than on paper, substantial cost savings can result to the applicants, the public, and the U.S. Patent and Trademark Office.

## BACKGROUND

A compact disc submitted under 37 CFR 1.52(e) must either be a CD-ROM or a CD-R. A CD-ROM is made by a process of pressing the disc from a master template; the data cannot be erased or rewritten. A CD-R is a compact disc that has a recording medium only capable of writing once. CD-RW type media which are erasable and rewriteable are not acceptable. Limiting the media types to CD-ROM and CD-R media will ensure the longevity and integrity of the data submitted. The files stored on the compact disc must contain only ASCII characters. No non-ASCII characters or proprietary file formats are permitted. A text viewer is recommended for viewing ASCII files.

While virtually any word processor may be used to view an ASCII file, care must be taken since a word processor will often not distinguish ASCII and non-ASCII files when displayed. For example, a word processor normally does not display hidden proprietary non-ASCII characters used for formatting when viewing a non-ASCII word processor file.

Compact disc(s) filed on the date that the application was accorded a filing date are to be treated as part of the originally filed disclosure even if the requisite "incorporation by reference" statement (see 37 CFR 1.77(b)(4)) is omitted. Similarly, if a preliminary amendment that accompanies the application when it is filed in the Office is identified in the oath or declaration, and the preliminary amendment includes compact disc(s), the compact disc(s) will be treated as part of the original disclosure. The compact disc(s) is considered part of the original disclosure by virtue of its inclusion with the application on the date the application is accorded a filing date. The incorporation by reference statement of the material on the compact disc is required to be part of the specification to allow the Office the option of separately printing the material on compact disc. The examiner should require applicant(s) to insert this statement if it is omitted or the examiner may insert the statement by examiner's amendment at the time of allowance.

All compact discs submitted under 37 CFR 1.52(e) must be submitted in duplicate labeled as "copy 1" and "copy 2" respectively. If more than one compact disc is required to hold all of the information, each compact disc must be submitted in duplicate to form two sets of discs: one set labeled "copy 1" and a second set labeled "copy 2." Both disc copies should initially be routed to the Office of Initial Patent Examination (OIPE). The compact discs will be checked by OIPE for viruses, readability, the presence of non-ASCII files, and compliance with the file and disc labeling requirements. OIPE will retain one copy of the discs and place the other copy in a holder fastened into the application file jacket. In the event that there is not a complete set of files on both copies of the originally filed discs, OIPE will retain the originally filed discs and send a notice to the applicant to submit an additional complete copy. For provisional applications, OIPE will provide applicant notification and, where appropriate, require correction for virus infected compact discs, unreadable compact discs (or

unreadable files thereon), and missing duplicate discs. An amendment to the material on a compact disc must be done by submitting a replacement compact disc with the amended file(s). The amendment should include a corresponding amendment to the description of the compact disc and the files contained on the compact disc in the paper portion of the specification. A replacement compact disc containing the amended files must contain all of the files of the original compact disc that were not amended. This will insure that the Office, printer, and public can quickly access all of the current files in an application or patent by referencing only the latest set of compact discs.

Compact discs should be stored in the compact disc holder provided in each application file. The compact discs, especially the non-label side, should not be scratched, marked or otherwise altered or deformed. Compact discs and application files containing compact discs should not be stored in areas exposed to heat and humidity that might damage the discs.

If a compact disc becomes damaged or lost from the file wrapper, OIPE will make a duplicate replacement copy of the disc from the copy retained in OIPE. At time of allowance, if a replacement disc is required, the application file and replacement request should be forwarded to OIPE to provide the replacement disc.

Examiners may view the files on the application compact disc using virtually any text reader or the MS Word word processor software installed on their workstation. Special text viewing software will be provided on examiner workstations in Technology Centers that receive ASCII files that are not readily readable using the MS Word word processor software.

The following form paragraphs may be used to notify applicant of corrections needed with respect to compact disc submissions.

*¶ 6.60.01 CD-ROM/CD-R Requirements (No Statement that CDs are Identical)*

This application is objected to under 37 CFR 1.52(e)(4) because it does not contain a statement in the transmittal letter that the two compact discs are identical. Correction is required.

*¶ 6.60.02 CD-ROM/CD-R Requirements (No Listing in Transmittal Letter)*

This application is objected to because it contains a data file on CD-ROM/CD-R, however, the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any

other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e)(3). A statement listing the required information is required.

**¶ 6.61.01 Specification Lacking List of Compact Disc(s) and/or Associated Files**

Portions of this application are contained on compact disc(s). When portions of an application are contained on a compact disc, the paper portion of the specification must identify the compact disc(s) and list the files including name, file size, and creation date on each of the compact discs. See 37 CFR 1.52(e). Compact disc labeled [1] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the file name, file size, and file creation date.

**Examiner Note:**

In bracket 1, insert the name on the label of the compact disc.

**¶ 6.61.02 Specification Lacking An Incorporation By Reference Statement for the Compact Disc**

This application contains compact disc(s) as part of the originally filed subject matter, but does not contain an incorporation by reference statement for the compact discs. See 37 CFR 1.77(b)(4). Applicant(s) are required to insert in the specification an incorporation-by-reference of the material on the compact disc(s).

**¶ 6.62 Data File on CD-ROM/CD-R Not in ASCII File Format**

This application contains a data file on CD-ROM/CD-R that is not in an ASCII file format. See 37 CFR 1.52(e). File [1] is not in an ASCII format. Applicant is required to resubmit file(s) in ASCII format. No new matter may be introduced in presenting the file(s) in ASCII format.

**Examiner Note:**

1. This form paragraph must be used to indicate whenever a data file (table, computer program listing or Sequence Listing) is submitted in a non-ASCII file format. The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file may contain non-ASCII characters.
2. In bracket 1, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters.

The following form paragraphs should be used to respond to amendments which include amended or substituted compact discs.

**¶ 6.70.01 CD-ROM/CD-R Requirements (Amendment Does Not Include Statement that CDs are Identical)**

The amendment filed [1] is objected to under 37 CFR 1.52(e)(4) because it does not contain a statement in the transmittal letter that the two compact discs are identical. Correction is required.

**¶ 6.70.02 CD-ROM/CD-R Requirements (No Listing in Transmittal Letter Submitted With Amendment)**

The amendment filed [1] contains data on compact disc(s). Compact disc labeled [2] is not identified in the transmittal letter and/or the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e)(3). A statement listing the required information is required.

**Examiner Note:**

1. Use this form paragraph when the transmittal letter does not include a listing of the files and required information.
2. In bracket 1, insert the date of the amendment.
3. In bracket 2, insert the name on the label of the compact disc.

**¶ 6.71.01 Specification Lacking List of Compact Disc(s) and/or Associated Files (Amendment Filed With Compact Disc(s))**

The amendment filed [1] contains data on compact disc(s). Compact disc labeled [2] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the file name, file size, and file creation date. See 37 CFR 1.52(e).

**Examiner Note:**

1. In bracket 1, insert the date of the amendment.
2. In bracket 2, insert the name on the label of the compact disc.

**¶ 6.71.02 Specification Lacking An Incorporation By Reference Statement for the Compact Disc (Amendment Filed With Compact Disc)**

The amendment filed [1] amends or adds a compact disc(s). See 37 CFR 1.77(b)(4) and 1.52(e)(5). Applicant is required to update or insert an incorporation-by-reference of the material on the compact disc(s) in the specification.

**Examiner Note:**

1. Use this form paragraph when the CD-ROM/CD-R is filed with an amendment, but the required incorporation-by-reference statement is neither amended nor added to the specification.
2. In bracket 1, insert the date of the amendment.

**¶ 6.72.01 CD-ROM/CD-R Requirements (CDs Not Identical)**

The amendment filed [1] is objected to under 37 CFR 1.52(e)(4) because the two compact discs are not identical. Correction is required.

**Examiner Note:**

1. Use this form paragraph when the two compact discs are not identical.
2. See also form paragraph 6.70.01 where the transmittal letter does not include a statement that the two compact discs are identical.

**¶ 6.72.02 Data File, Submitted With Amendment, on CD-ROM/CD-R Not in ASCII File Format**

The amendment filed [1] contains a data file on CD-ROM/CD-R that is not in an ASCII file format. File [2] is not in an ASCII format. Applicant is required to resubmit file(s) in ASCII format as required by 37 CFR 1.52(e)(3). No new matter may be introduced in presenting the file(s) in ASCII format.

**Examiner Note:**

1. This form paragraph must be used whenever a data file (table, computer program listing or Sequence Listing) is submitted in a non-ASCII file format. The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file contains non-ASCII characters.
2. In bracket 1, insert the date of the amendment.
3. In bracket 2, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters.

**¶ 6.72.03 CD-ROM/CD-R Are Not Readable**

The amendment filed [1] contains a data file on CD-ROM/CD-R that is unreadable. Applicant is required to resubmit the file(s) in International Standards Organization (ISO) 9660 standard and American Standard Code for Information Interchange (ASCII) format as required by 37 CFR 1.52(e)(3). No new matter may be introduced in presenting the file in ISO 9660 and ASCII format.

**¶ 6.72.04 CD-ROM/CD-R Contains Viruses**

The amendment filed [1] is objected to because the compact disc contains at least one virus. Correction is required.

**¶ 6.72.05 CD-ROM/CD-R Requirements (Missing Files On Amended Compact Disc)**

The amendment to the application filed [1] is objected to because the newly submitted compact disc(s) do not contain all of the unamended data file(s) together with the amended data file(s) that were on the CD-ROM/CD-R. Since amendments to a compact disc can only be made by providing a replacement compact disc, the replacement disc must include all of the files, both amended and unamended, to be a complete replacement.

**Examiner Note:**

Use this form paragraph when a replacement compact disc is submitted that fails to include all of the files on the original compact disc(s) that have not been cancelled by amendment.

**608.05(a) Deposit of Computer Program Listings**

**37 CFR 1.96. Submission of computer program listings.**

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or

task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent* If the computer program listing is contained in 300 lines or fewer, with each line of 72 characters or fewer, it may be submitted either as drawings or as part of the specification.

(1) *Drawings.* If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.*

(i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52.

(ii) Any listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

(c) *As an appendix which will not be printed:* Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. The specification must include a reference to the "computer program listing appendix" at the location indicated in § 1.77(b)(4).

(1) Multiple computer program listings for a single application may be placed on a single compact disc. Multiple compact discs may be submitted for a single application if necessary. A separate compact disc is required for each application containing a computer program listing that must be submitted on a "computer program listing appendix."

(2) The "computer program listing appendix" must be submitted on a compact disc that complies with § 1.52(e) and the following specifications (no other format shall be allowed):

- (i) Computer Compatibility: IBM PC/XT/AT, or compatibles, or Apple Macintosh;
- (ii) Operating System Compatibility: MS-DOS, MS-Windows, Unix, or Macintosh;
- (iii) Line Terminator: ASCII Carriage Return plus ASCII Line Feed;
- (iv) Control Codes: the data must not be dependent on control characters or codes which are not defined in the ASCII character set; and
- (v) Compression: uncompressed data.

Special procedures for presentation of computer program listings in the form of compact disc files in U.S. national patent applications are set forth in 37 CFR 1.96. Use of compact disc files is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred

pages in length. By filing and publishing such computer program listings on compact discs rather than on paper, substantial cost savings can result to the applicants, the public, and the U.S. Patent and Trademark Office.

## BACKGROUND

A computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine-independent (object or source) programming language which will cause a computer to perform a desired task, such as solving a problem, regulating the flow of work in computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while the computer program listing may appear either directly or as a computer program listing on compact disc appendix to the specification and be incorporated into the specification by reference.

Copies of publicly available computer program listings are available from the U.S. Patent and Trademark Office on paper and on compact disc at the cost set forth in 37 CFR 1.19(a).

## DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The provisions of 37 CFR 1.52 and 37 CFR 1.84 for submitting specifications and drawings on paper have been found suitable for most patent applications. However, when lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome. The cost of printing long computer programs in patent documents is also very expensive to the U.S. Patent and Trademark Office. Under 37 CFR 1.96, several different methods for submitting computer program listings, including the use of compact discs, are set forth. A computer program listing contained on three hundred printout lines or less may be submitted either as drawings (in compliance with 37 CFR 1.84), as part of the written specification (in compliance with 37 CFR 1.52), or on compact disc (in compliance with 37 CFR 1.52(e)). A computer program listing contained on three hundred and one (301) printout lines or more must be submit-

ted as ASCII files on compact discs (in compliance with 37 CFR 1.96(c)).

Form paragraphs 6.64.01 through 6.64.03 may be used to notify the applicant of this requirement.

### ¶ 6.64.01 *Computer Program Listing Appendix on Compact Disc Requirement*

The description portion of this application contains a computer program listing consisting of more than three hundred (300) lines. In accordance with 37 CFR

#### **Examiner Note:**

1. This form paragraph must be used whenever an application filed on or after November 7, 2000 contains a computer program listing consisting of more than three hundred lines as part of the descriptive portion of the specification.
2. In bracket 1, insert the range of page numbers of the specification which include the computer program listing.

### ¶ 6.64.02 *Computer Program Listing as Printout Within the Specification (More Than 60 Lines And Not More Than Three Hundred Lines)*

This application contains a computer program listing of over sixty (60) lines and less than three hundred and one (301) lines within the written specification. In accordance with 37 CFR 1.96(b), a computer program listing contained on over sixty (60) lines and less than three hundred-one (301) lines, must, if submitted as part of the specification, be positioned at the end of the specification and before the claims. Accordingly, applicant is required to cancel the computer program listing and either incorporate such listing in a compact disc in compliance with 37 CFR 1.96, or insert the computer program listing after the detailed description of the invention but before the claims, in the form of direct printouts from a computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper.

#### **Examiner Note:**

This form paragraph must be used whenever the descriptive portion of the specification of an application filed on or after November 7, 2000 contains a computer program listing consisting of a paper printout of more than 60 lines and no more than three hundred lines.

### ¶ 6.64.03 *Computer Program Listing as Printout in Appendix (More Than Three Hundred Lines)*

This application contains an appendix consisting of a computer program listing of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than three hundred (300) lines, must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(b)(4)). Accordingly, applicant is required to cancel the computer program listing appearing in the current appendix to the specification, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c), and insert an appropriate reference to

the newly added computer program listing appendix on compact disc at the beginning of the specification.

**Examiner Note:**

This form paragraph must be used whenever an application filed on or after November 7, 2000 contains a computer program listing consisting of a paper printout appendix of more than three hundred lines.

**OTHER INFORMATION**

A computer program listing on compact disc filed with a patent application will be referred to as a Computer Program Listing Appendix on compact disc and will be identified as such on the front page of the patent but will not be part of the printed patent. "Computer Program Listing Appendix on compact disc" denotes the total computer program listing files contained on all compact discs. The face of the file wrapper will bear a label to denote that an appendix on compact disc is included in the application. A statement must be included in the specification to the effect that a computer program listing appendix on compact disc is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross-reference to related applications. 37 CFR 1.77 (b)(4). The patent front page and the *Official Gazette* entry will both contain information as to the names and sizes of files on compact discs of computer program listings appearing in the computer program listing appendix on compact disc. When an application containing compact discs is received in the Office of Initial Patent Examination (OIPE), a special envelope will be affixed to the right side of the file wrapper underneath all papers, and the compact discs inserted therein. The application file will then proceed on its normal course.

**TEMPORARY CONTINUATION OF MICROFICHE PRACTICE THROUGH FEBRUARY 2001**

The Office will provide for the continuation of prior microfiche appendix practice for computer listings until February 28, 2001. On or after March 1, 2001, all computer listings as part of the application disclosure that are in conformance with the microfiche appendix rules below may rely on the microfiche and need not submit a computer program listing appendix on compact disc; all computer listings as

part of the application disclosure not in conformance with the microfiche appendix rules below must conform to the requirements of 37 CFR 1.52 and 37 CFR 1.96 as set forth above.

The prior microfiche practice is continued through February 28, 2001 to accommodate applicants who incurred the time and expense of preparing microfiche. Those applicants with computer program listings in the disclosure who have not prepared microfiche will generally incur significantly less time and expense creating compact disc files than creating microfiche.

All computer listings submitted on microfiche through February 28, 2001, must conform to the requirements of former 37 CFR 1.96(c), as reproduced below:

*Former 37 CFR 1.96. Submission of computer program listings.*

\*\*\*\*\*

(c) As an appendix which will not be printed. If a computer program listing printout is eleven or more pages long, applicants must submit such listing in the form of microfiche, referred to in the specification (see § 1.77(a)(6)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" must be made at the beginning of the specification at the location indicated in § 1.77(a)(6). Any amendments thereto must be made by way of revised microfiche.

(1) Availability of appendix. Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) Submission requirements. Except as modified or clarified in this paragraph (c)(2), computer-generated information submitted as a "microfiche appendix" to an application shall be in accordance with the standards set forth in 36 CFR Part 1230 (Micrographics).

(i) Film submitted shall be a first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right-reading).

(iii) At least the left-most third (50 mm. x 12 mm.) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply an application number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the



microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(ii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a test target.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1, resolution of the original microfilm shall be at least 120 lines per mm. (5.0 target).

(F) An index, when included, should appear in the last frame (lower-right hand corner when data is right-reading) of each microfiche.

(v) Microfiche generated by Computer Output Microfilm.

(A) The first frame of each microfiche submitted should contain a resolution test frame.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(E) An index, when included, should appear on the last frame (lower-right hand corner when data is right reading) of each microfiche.

\*\*\*\*\*

A microfiche filed with a patent application will be referred to as a "Microfiche Appendix," and will be identified as such on the front page of the patent but will not be part of the printed patent. "Microfiche Appendix" denotes the total microfiche, whether only one or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less. The face of the file wrapper will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross-reference to related applications. The patent front page and

the *Official Gazette* entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix. When an application containing microfiche is received in the Office of Initial Patent Examination (OIPE), a special envelope will be affixed to the right side of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course.

### 605.08(b) Compact Disc Submissions of Large Tables

37 CFR 1.58. *Chemical and mathematical formulae and tables.*

\*\*\*\*\*

(b) Tables that are submitted in electronic form (§§ 1.96(c) and 1.821(c)) must maintain the spatial relationships (e.g., columns and rows) of the table elements and preserve the information they convey. Chemical and mathematical formulae must be encoded to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning.

\*\*\*\*\*

The provisions of 37 CFR 1.52 and 37 CFR 1.58 for submitting specifications and tables on paper have been found suitable for most patent applications. However, when lengthy tables must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome. The cost of printing long tables in patent documents is also very expensive to the U.S. Patent and Trademark Office. In the past, all disclosures forming part of a patent application were presented on paper with the exception of microorganisms and computer program listings. Under 37 CFR 1.58, several different methods for submitting large tables, including the use of CD-ROM and CD-R, are set forth.

The files stored on the compact disc containing the table must contain only ASCII characters. No special formatting characters or proprietary file formats are permitted. Accordingly, great care must be taken so that the spatial arrangement of the data in rows and columns is maintained. This will allow the table to be viewed with virtually any text viewer. A single table contained on fifty pages or less must be submitted either as drawings (in compliance with 37 CFR 1.84)

or as part of the specification in paper (in compliance with 37 CFR 1.52).

A single table contained on 51 pages or more may be submitted on a CD-ROM or CD-R (in compliance with 37 CFR 1.52(e) and 37 CFR 1.58). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table on a compact disc unless the subdivided tables are presented as numerous files on the compact disc so as to lose their relationship to the overall large table.

Form paragraphs 6.63.01 and 6.63.02 may be used to notify applicant of corrections needed to comply with the requirements of 37 CFR 1.52(e) and 37 CFR 1.58(b) with respect to tables.

**¶ 6.63.01 CD-ROM/CD-R Requirements (Table Listing in Specification)**

The description portion of this application contains a table consisting of less than fifty one (51) pages only on a CD-ROM or CD-R. In accordance with 37 CFR 1.52(e), only a table of at least fifty one (51) pages may be submitted on a CD-ROM or CD-R. Accordingly, applicant is required to cancel the references to the CD-ROM/CD-R table appearing in the specification on pages [1], file a paper version of the table in compliance with 37 CFR 1.52 and change all appropriate references to the former CD-ROM/CD-R table to the newly added paper version of the table in the remainder of the specification

**Examiner Note:**

1. This form paragraph must be used whenever an application filed on or after November 7, 2000 contains a table on a CD-ROM or CD-R consisting of less than fifty one (51) pages as part of the descriptive portion of the specification.
2. In bracket 1, insert the range of page numbers of the specification which reference the table.

**¶ 6.63.02 Table on CD-ROM/CD-R Column/Row Relationship Not Maintained**

This application contains a table on CD-ROM/CD-R. Tables presented on CD-ROM/CD-R in compliance with 37 CFR 1.58 must maintain the spacial orientation of the cell entries. The table submitted does not maintain the data within each table cell in its proper row/column alignment. The data is misaligned in the table as follows: [1]. Applicant is required to submit a replacement compact disc with the table data properly aligned.

**Examiner Note:**

1. This form paragraph must be used whenever the data in a table cannot be accurately read because the data in the table cells do not maintain their row and column alignments.
2. In bracket 1, insert the area of the table that does not maintain the row and column alignments.

## 608.05(c) Compact Disc Submissions of Biosequences

Filing of biosequence information on compact disc is now permitted in lieu of filing on paper. See MPEP § 2420 and § 2422.03.

## 609 Information Disclosure Statement

### 37 CFR 1.97. Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(3) Before the mailing of a first Office action on the merits; or

(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in § 1.17(p).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making

reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a *bona fide* attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

(i) If an information disclosure statement does not comply with either this section or § 1.98, it will be placed in the file but will not be considered by the Office.

### 37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. patent application publication and U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed;

(iii) For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed; and

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or

published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

Information Disclosure Statements (IDSs) are not permitted in provisional applications filed under 35 U.S.C. 111(b). See 37 CFR 1.51(d). Since no substantive examination is given in provisional applications, a disclosure of information is unnecessary. Any such statement filed in a provisional application will be returned or destroyed at the option of the Office.

In applications filed under 35 U.S.C. 111(a), applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with the duty of disclosure provided in 37 CFR 1.56. Applicants and other individuals substantively involved with the preparation and/or prosecution of the patent application also may want the Office to consider information for a variety of other reasons; e.g., to make sure that the examiner has an opportunity to consider the same information that was considered by these individuals, or by another patent office in a counterpart or related patent application filed in another country.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner assigned to the application. The requirements for the content of a

statement have been simplified in the rules, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the Office so the examiner can evaluate its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the rules are designed to encourage individuals to submit information to the Office promptly and in a uniform manner. These rules provide certainty for the public by defining the requirements for submitting information disclosure statements to the Office so that the Office will consider information contained therein before a patent is granted.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP § 2129 regarding admissions by applicant.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement must be (1) in compliance with the content requirements of 37 CFR 1.98, and (2) filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in subsection III.A below. The requirements based on the time of filing the statement are discussed in subsection III.B below. Examiner handling of information disclosure statements is discussed in subsection III.C below.

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. Only where the relevancy of the information is

actually discussed in the application file (either by the examiner or by the applicant) or where the information is relied upon to reject a claim in the application, will the information deemed to have been "considered" (to the extent discussed) for the purposes of reexamination under the *Portola* guidelines. See MPEP § 2242 under the subsection "General Principles Governing Compliance With Portola Packaging. Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will not be considered by the Office but will be placed in the application file.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements of 37 CFR 1.97 and 37 CFR 1.98. Use of form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B, "Information Disclosure Statement," is encouraged as a means to provide the required list of information as set forth in 37 CFR 1.98(a)(1). Applicants are encouraged to use the USPTO forms when preparing an information disclosure statement. A copy of forms PTO-1449, "Information Disclosure Citation" and PTO/SB/08A and 08B are reproduced at the end of this section to indicate how the forms should be completed. The forms will enable applicants to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that the information has been considered.

## I. IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS

### A. *IDS That Has Been Considered (1) In The Parent Application, Or (2) Prior To The Filing Of A Request For Continued Examination (RCE)*

#### 1. **Continued Prosecution Applications (CPAs) Filed Under 37 CFR 1.53(d) Or File Wrapper Continuing (FWC) Applications Filed Under Former 37 CFR 1.62**

Information which has been considered by the Office in the parent application of a continued prosecution application (CPA) filed under 37 CFR 1.53(d), or a file wrapper continuing application (FWC) filed prior to December 1, 1997 under former 37 CFR 1.62,

will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent.

**2. Continuation Applications or Divisional Applications, Filed Under 37 CFR 1.53(b) Or Filed Under Former 37 CFR 1.60, Or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)**

The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application filed under 37 CFR 1.53(b). Such information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

**3. Requests For Continued Examination (RCE) Under 37 CFR 1.114**

Information which has been considered by the Office in the application before the filing of a RCE will be part of the file before the examiner and need not be resubmitted to have the information considered by the examiner and listed on the patent.

**B. IDS That Has Not Been Considered (1) In The Parent Application, Or (2) Prior To The Filing Of A Request For Continued Examination**

**1. Continued Prosecution Applications Filed Under 37 CFR 1.53(d)**

Information filed in the parent application that complies with the content requirements of 37 CFR 1.98 will be considered by the examiner in the CPA. No specific request from the applicant that the previously submitted information be considered by the examiner is required.

**2. File Wrapper Continuing Application Filed Under Former 37 CFR 1.62**

For FWC applications filed prior to December 1, 1997 under former 37 CFR 1.62, in order to ensure consideration of information complying with the content requirements of 37 CFR 1.98 previously submit-

ted, but not considered, in a parent application, applicant must either specifically request that the previously submitted information be considered in the FWC or resubmit the information in the FWC in compliance with 37 CFR 1.97 and 37 CFR 1.98.

**3. Continuation Applications or Divisional Applications, Filed Under 37 CFR 1.53(b) Or Filed Under Former 37 CFR 1.60, Or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)**

For these types of applications, in order to ensure consideration of information previously submitted, but not considered, in a parent application, applicant must resubmit the information in the continuing application in compliance with 37 CFR 1.97 and 37 CFR 1.98.

**4. Requests For Continued Examination Under 37 CFR 1.114**

Information filed in the application in compliance with the content requirements of 37 CFR 1.98 before the filing of a RCE will be considered by the examiner after the filing of the RCE. For example, an applicant filed an IDS in compliance with 37 CFR 1.98 after the mailing of a final Office action, but the IDS did not comply with the requirements of 37 CFR 1.97(d)(1) and (d)(2) and therefore, the IDS was not considered by the examiner. After applicant files a RCE, the examiner will consider the IDS filed prior to the filing of the RCE. For more details on RCE, see MPEP § 706.07(h).

**II. NATIONAL STAGE APPLICATIONS**

The examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO-892 form.

In a national stage application, the following form paragraphs may be used where appropriate to notify

applicant regarding references listed in the search report of the international application:

*¶ 6.53 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Prior to Allowance*

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 or PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

**Examiner Note:**

1. This form paragraph may be used for PCT National Stage applications submitted under 35 U.S.C. 371 where the examiner has obtained copies of the cited references. For applications filed from US, JPO or EPO search authorities, the copies of the references should be supplied by those offices under the trilateral agreement. However, if receipt of such copies is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply copies for consideration. See MPEP § 1893.03(g).
2. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.
3. This form paragraph should only be used prior to allowance when a statutory period for reply is being set in the Office action.
4. If the application is being allowed, form paragraph 6.54 should be used with the Notice of Allowability instead of this form paragraph.

*¶ 6.54 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Ready for Allowance*

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 or PTO/SB/08A and 08B form, must be filed within ONE MONTH of the mailing date of this communication. NO EXTENSION OF TIME WILL BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) to comply with this requirement.

**Examiner Note:**

1. See the Examiner Note for form paragraph 6.53.

*¶ 6.55 References Not Considered in 37 U.S.C. 371 Application Based Upon Search Report*

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each U.S. and foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any

drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609 A(1) states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement requirements of 37 CFR 1.97(e). See MPEP § 609 subsection III C(1).

**Examiner Note:**

1. This form paragraph may be used in National Stage applications submitted under 35 U.S.C. 371 where the international searching authority was not the US, EPO or JPO.

### III. MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT

#### A. Content

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection III.A(1), A(2), and A(3) below.

#### A (1) List of All Patents, Publications, U.S. Applications, or Other Information

Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by

the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

The list of information complying with the identification requirements of 37 CFR 1.98(b) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list (generated by the Office) will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of either form PTO-1449, Information Disclosure Citation, or PTO/SB/08A and 08B, Information Disclosure Statement, to list the documents is encouraged. See subsection C(2) below.

#### **A (2) Legible Copies**

In addition to the list of information, each information disclosure statement must also include a legible copy of:

(A) Each U.S. patent application publication, and U.S. and foreign patent;

(B) Each publication or that portion which caused it to be listed;

(C) For each cited pending U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(D) All other information or that portion which caused it to be listed.

37 CFR 1.98(a)(2)(iii) requires a copy of a pending U.S. application that is being cited in an IDS. If the pending U.S. application is only identified in the specification's background information rather than being part of an IDS submission, a copy need not be supplied. Pursuant to 37 CFR 1.98(a)(2)(iii), applicant may choose to cite only a portion of a pending application including any claims directed to that portion rather than the entire application.

There are exceptions to this requirement that a copy of the information must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (1) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under 35 U.S.C. 120; and (2) the IDS submitted in the earlier application complies with 37 CFR 1.98(a)-(c). If both of these conditions are met, the examiner will consider the information previously cited or submitted to the Office and considered by the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See subsection III.A(3) below.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. "A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references." (citations omitted).).

37 CFR 1.98(a)(3)(ii) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

### **A (3) Concise Explanation of Relevance for Non-English Language Information**

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in

37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein with the page(s) and lines of the specification where it is incorporated being noted in the IDS.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.



The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) (“[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.”).

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The untranslated portions of the Japanese reference “contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO.” 204 F.3d at 1376, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. “The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner’s attention from the reference’s relevant teaching.” 204 F.3d at 1378, 54 USPQ2d at 1008.

Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or

where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

### **B. Time for Filing**

The procedures and requirements under 37 CFR 1.97 for submitting an information disclosure statement are linked to four stages in the processing of a patent application:

(1)(a) for national applications (not including CPAs), within 3 months of filing, or before the mailing of a first Office action on the merits, whichever is later;

(b) for international applications, within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 or before the mailing of a first Office action on the merits in the national stage application, whichever is later;

(c) for continued examinations (i.e., RCEs filed under 37 CFR 1.114) and CPAs filed under 37 CFR 1.53(d), before the mailing of a first Office action on the merits;

(2) after the period in (1), but prior to the prosecution of the application closes, i.e., before the mailing of a final Office action, a Notice of Allowance, or an *Ex parte Quayle* action, whichever is earlier;

(3) after the period in (2) but on or before the date the issue fee is paid; and

(4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue under 37 CFR 1.313(c).

These procedures and requirements apply to applications filed under 35 U.S.C. 111(a) (utility), 161 (plants), 171 (designs), and 251 (reissue), as well as international applications entering the national stage under 35 U.S.C. 371.

The requirements based on the time when the information disclosure statement is filed are summarized as follows.

<u>Time when IDS is filed</u>	<u>37 CFR 1.97 Requirements</u>
(1)(a) for national applications (not including CPAs), within 3 months of filing or before first Office action on the merits, whichever is later; (b) for national stage applications, within 3 months of entry into national stage or before first Office action on the merits, whichever is later; (c) for RCEs and CPAs before the first Office action on the merits.	None (IDS will be considered).
(2) After (1) but before final action, notice of allowance, or <i>Quayle</i> action.	1.97(e) statement or 1.17(p) fee.
(3) After (2) and before (or with) payment of issue fee.	1.97(e) statement, and 1.17(p) fee.
(4) After payment of issue fee.	IDS will not be considered. (See petition under 37 CFR 1.313(c) to withdraw from issue.)

**B (1) Information Disclosure Statement Filed BEFORE First Action on the Merits or Within Three (3) Months of Actual Filing Date (37 CFR 1.97(b))**

An information disclosure statement will be considered by the examiner if filed within any one of the following time periods:

(A) for national applications (not including CPAs), within 3 months of the filing date of the national application or before the mailing date of a first Office action on the merits;

(B) for international applications, within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 or before the mailing date of a first Office action on the merits; or

(C) for RCEs and CPAs, before the mailing date of a first Office action on the merits.

An information disclosure statement filed within one of these periods requires neither a fee nor a statement under 37 CFR 1.97(e). An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions of "Express Mail" delivery under 37 CFR 1.10. An Office action is mailed on the date indicated in the Office action.

It would not be proper to make final a first Office action in a continuing application or in an application after the filing of a RCE if the information submitted in the IDS during the time period set forth in 37 CFR 1.97(b) is used in a new ground of rejection.

**(a) National or International Applications**

The term "national application" includes continuing applications (continuations, divisions, and continuations-in-part but not CPAs), so 3 months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application. For international applications, the 3 months will be measured from the date of entry of the national stage.

All information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within 3 months of the filing date, will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action, a notice of allowance, or an *Ex parte Quayle* action is mailed prior to a date which is 3 months from the filing date, any information contained in a complete information disclosure statement filed within that 3-month window will be considered by the examiner.

Likewise, an information disclosure statement will be considered if it is filed later than 3 months after the application filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 2 and the first Office action on the merits was not mailed until 6 months later on July 2, the examiner would be required to consider any proper information disclosure statement filed prior to July 2.

#### (b) RCE and CPA

The 3-month window as discussed above does not apply to a RCE filed under 37 CFR 1.114 or a CPA filed under 37 CFR 1.53(d). An IDS filed after the filing of a RCE will be considered if the IDS is filed before the mailing date of a first Office action on the merits. A RCE is not the filing of an application, but merely the continuation of prosecution in the current application. After the mailing of a RCE, such application is treated as an amended application by the examiner and is subject to a short turnover time. Therefore, applicants are encouraged to file any IDS with the filing of a RCE. See MPEP § 706.07(h) for details on RCEs.

Similarly, an IDS filed in a CPA will be considered if the IDS is filed before the mailing date of a first Office action on the merits. Applicants are encouraged to file any IDS in a CPA as early as possible, preferably at the time of filing of the CPA request.

If an IDS cannot be filed before the mailing of a first Office action on the merits (generally within 2 months from the filing of the RCE or CPA), applicants may request a 3-month suspension of action under 37 CFR 1.103(c) in an application at the time of filing of the RCE, or under 37 CFR 1.103(b) in a CPA, at the time of filing of the CPA. Where an IDS is mailed to the Office shortly before the expiration of a 3-month suspension under 37 CFR 1.103(b) or (c),

applicant is requested to make a courtesy call to notify the examiner as to the IDS submission.

#### **B (2) Information Disclosure Filed After B(1) but BEFORE Mailing of Final Action, Notice of Allowance, or an Ex parte Quayle Action (37 CFR 1.97(c))**

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection III.B(1) above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

- a final action under 37 CFR 1.113, e.g., final rejection;

- a notice of allowance under 37 CFR 1.311; or

- an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action,

whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p). If a final action, notice of allowance, or an *Ex parte Quayle* action is mailed in an application and later withdrawn, the application will be considered as not having had a final action, notice of allowance, or an *Ex parte Quayle* action mailed for purposes of considering an information disclosure statement.

An *Ex parte Quayle* action is an action that closes the prosecution in the application as referred to in 37 CFR 1.97(c). Therefore, an information disclosure statement filed after an *Ex parte Quayle* action, must comply with the provisions of 37 CFR 1.97(d).

#### (a) Information is Used in a New Ground of Rejection

##### i) Final Rejection is Not Appropriate

If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.

## ii) Final Rejection is Appropriate

The information submitted with a statement under 37 CFR 1.97(e) can be used in a new ground of rejection and the next Office action can be made final, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee as set forth in 37 CFR 1.17(p), the examiner may use the information submitted, 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 § 706.07(a).

### **B(3) Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97(d)**

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under 37 CFR 1.113; a notice of allowance under 37 CFR 1.311; or an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection B(5); and
- (B) the fee set forth in 37 CFR 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 CFR 1.17(p)) and submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

Form paragraph 6.52 may be used to inform the applicant that the information disclosure statement is being considered.

#### *¶ 6.52 Information Disclosure Statement Filed After Prosecution Has Been Closed*

The information disclosure statement (IDS) submitted on [1] was filed after the mailing date of the [2] on [3]. The submission is in compliance with the provisions of 37 CFR 1.97. Accord-

ingly, the information disclosure statement is being considered by the examiner.

#### **Examiner Note:**

1. In bracket 1, insert the date the IDS was filed.
2. In bracket 2, insert --final Office action--, --Notice of Allowance--, or an --*Ex parte Quayle* action-- as appropriate.

The requirements of 37 CFR 1.97 provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within 3 months after an individual designated in 37 CFR 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid.

If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), the applicant may file a RCE under 37 CFR 1.114, or a continuing application under 37 CFR 1.53(b) or (d) to have the information considered by the examiner. If the applicant files a continuing application under 37 CFR 1.53(b), the parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance. If the prior application is a design application, or a utility or plant application filed before May 29, 2000, the filing of a continued prosecution application under 37 CFR 1.53(d) automatically abandons the prior application. See the discussion in subsection I. above under the heading "IDS IN CONTINUED EXAMINATIONS AND CONTINUING APPLICATION."

### **B (4) Information Disclosure Statement Filed After Payment of Issue Fee**

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See subsection C below. The application may be withdrawn from issue at this point, pursuant to 37 CFR 1.313(c)(2) or 1.313(c)(3) so that the information can be considered in the application upon the filing of a RCE under 37 CFR 1.114 or in a continuing application filed under 37 CFR 1.53(b) or 1.53(d). In this situation, a RCE, or a CPA

(if the prior application is a design application, or a utility or plant application filed before May 29, 2000), or a continuing application filed under 37 CFR 1.53(b) could be filed even though the issue fee had already been paid. See MPEP § 1308. Applicants are encouraged to file the petition under 37 CFR 1.313(c)(2) with a RCE, or the petition under 37 CFR 1.313(c)(3) with a CPA or continuing application under 37 CFR 1.53(b), by facsimile transmission to the Office of Petitions (see MPEP § 1730 for the facsimile number). The Office cannot ensure that any petition under 37 CFR 1.313(c) will be acted upon prior to the date of patent grant. Applicants considering filing a petition under 37 CFR 1.313(c) are encouraged to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider and grant a petition under 37 CFR 1.313(c). The petition need not be accompanied by the information disclosure statement if the size of the statement makes its submission by facsimile impracticable, but the petition should indicate that an IDS will be filed in the application or in the continuing application if it does not accompany the petition under 37 CFR 1.313(c). The IDS should be filed before the mailing of a first Office action on the merits. If the IDS cannot be filed within this time period, applicants may request a three-month suspension of action under 37 CFR 1.103 at the time of filing of the RCE or CPA. See the discussion above in paragraph III.B(1)(b) above.

Alternatively, for example, a petition pursuant to 37 CFR 1.313(c)(1) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 CFR 1.313(c)(1). Form paragraph 13.09 may be used.

¶ 13.09 *Information Disclosure Statement, Issue Fee Paid*

Applicant's information disclosure statement of [1] was filed after the issue fee was paid. Information disclosure statements filed after payment of the issue fee will not be considered, but will be placed in the file. However, the application may be withdrawn from issue in order to file a request for continued examination (RCE) under 37 CFR 1.114 upon the grant of a petition under 37 CFR 1.313(c)(2), or a continuing application under 37 CFR 1.53(b) (or a continued prosecution application (CPA) under 37 CFR 1.53(d) if the prior application is a design application, or a

utility or plant application filed before May 29, 2000) upon the grant of a petition filed under the provisions of 37 CFR 1.313(c)(3). Alternatively, the other provisions of 37 CFR 1.313 may apply, e.g., a petition to withdraw the application from issue under the provisions of 37 CFR 1.313(c)(1) may be filed together with an unequivocal statement by the applicant that one or more claims are unpatentable over the information contained in the statement. The information disclosure statement would then be considered upon withdrawal of the application from issue under 37 CFR 1.313(c)(1).

**Examiner Note:**

1. For information disclosure statements submitted after the issue fee has been paid, use this form paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the filing date of the IDS.

If an application has been withdrawn from issue under one of the provisions of 37 CFR 1.313(c)(1)-(3), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under 37 CFR 1.313(c) should be directed to the Office of Petitions in the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP § 1308.

**B(5) Statement Under 37 CFR 1.97(e)**

A statement under 37 CFR 1.97(e) must state either

(1) that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.

A statement under 37 CFR 1.97(e) can contain either of two statements. One statement is that each item of information in an information disclosure statement was first cited in any communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than 3 months prior to the filing date of the statement.

Applicant would not be able to make a statement under 37 CFR 1.97(e) where an item of information was first cited by a foreign patent office, for example, a year before the filing of the IDS, in a communication from that foreign patent office, and the same item of information is once again cited by another foreign patent office within three months prior to the filing of the IDS in the Office. Similarly, applicant would not be able to make a statement under 37 CFR 1.97(e) where an item of information was cited in an examination report and the same item of information was previously cited more than three months prior to the filing of the IDS in the Office, in a search report from the same foreign patent office. Under this statement, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report.

The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 CFR 1.10.

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application).

Communications from foreign patent offices in foreign applications sometimes include a list of the family of patents corresponding to a particular patent being cited in the communication. The family of patents may include a United States patent or other patent in the English language. Some applicants submit

information disclosure statements to the PTO which list and include copies of both the particular patent cited in the foreign patent office communication and the related United States or other English language patent from the family list. Since this is to be encouraged, the United States or other English language patent will be construed as being cited by the foreign patent office for purposes of a statement under 37 CFR 1.97(e)(1). The examiner should consider the United States or other English language patent if 37 CFR 1.97 and 37 CFR 1.98 are complied with.

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement.

The phrase "after making reasonable inquiry" makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being stated. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than 3 months, however, cannot make the statement under 37 CFR 1.97(e)(2) without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The statement can

be based on present, good faith knowledge about when information became known without a search of files being made.

A statement under 37 CFR 1.97(e) need not be in the form of an oath or a declaration under 37 CFR 1.68. A statement under 37 CFR 1.97(e) by a registered practitioner or any other individual that the statement was filed within the 3-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a statement under 37 CFR 1.97(e) could read as follows:

I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of this statement,

or

I hereby state that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than 3 months prior to the filing of this Information Disclosure Statement.

An information disclosure statement may include two lists and two statements, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than 3 months prior to filing the statement and some was not, but was not known more than 3 months prior to filing the statement.

A copy of the foreign search report need not be submitted with the statement under 37 CFR 1.97(e), but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information was known to any individual designated in 37 CFR 1.56(c) is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date

certain for determining if a statement under 37 CFR 1.97(e) can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith. Questions about the adequacy of any statement received in writing by the Office should be directed to the Office of Patent Legal Administration.

#### **B(6) Extensions of Time (37 CFR 1.97(f))**

No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136(a) or (b). If a bona fide attempt is made to comply with the content requirements of 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

#### ***C. Examiner Handling of Information Disclosure Statements***

Information disclosure statements will be reviewed for compliance with the requirements of 37 CFR 1.97 and 37 CFR 1.98 as discussed in subsection III.A and B above. Applicant will be notified of compliance and noncompliance with the rules as discussed below.

#### **C(1) Noncomplying Information Disclosure Statements**

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in subsection III.B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the

requirements based on the time of filing of the IDS (37 CFR 1.97).

The examiner should write "not considered" on an information disclosure statement where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.09. If the improper citation appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered.

If an item of information in an IDS fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98, that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner.

If information listed in the specification rather than in a separate paper, or if the other content requirements as discussed in subsection III.A above are not complied with, the information need not be considered by the examiner, in which case, the examiner should notify applicant in the next Office action that the information has not been considered.

#### (a) Form Paragraphs

##### ¶ 6.49 Information Disclosure Statement Not Considered

The information disclosure statement filed [1] fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all requirements for statements under 37 CFR 1.97(e). See MPEP § 609 subsection III, C(1).

#### Examiner Note:

See MPEP § 609 for situations where the use of this form paragraph would be appropriate.

##### ¶ 6.49.01 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.02 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.03 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.05 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

##### ¶ 6.49.06 Information Disclosure Statement Not Considered, References Listed in Specification

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and MPEP § 609 subsection III A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

##### ¶ 6.49.07 Information Disclosure Statement Not Considered, No Copy of References

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; for each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion and all other information or that portion which caused it to be listed. It



has been placed in the application file, but the information referred to therein has not been considered.

¶ **6.49.08 Information Disclosure Statement Not Considered, No List of References**

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, applications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

¶ **6.49.09 Information Disclosure Statement Not Considered, No Explanation of Relevance of Non-English Language Information**

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(3)(i) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

¶ **6.51 Time for Completing Information Disclosure Statement**

The information disclosure statement filed on [1] does not fully comply with the requirements of 37 CFR 1.98 because: [2]. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above-mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above-mentioned information disclosure statement being placed in the application file with the non-complying information **not** being considered. See 37 CFR 1.97(i).

**Examiner Note:**

Use this form paragraph if an IDS complies with the timing requirements of 37 CFR 1.97 but part of the content requirements of 37 CFR 1.98 has been inadvertently omitted.

This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in 37 CFR 1.97, have not been complied with.

**C(2) Complying Information Disclosure Statements**

The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in

Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. Only where the relevancy of the information is actually discussed in the application file (either by the examiner or by the applicant) or where the information is relied upon to reject a claim in the application, will the information deemed to be "considered" (to the extent discussed) for the purposes of reexamination under the *Portola* guidelines. See MPEP § 2242 under the subsection "General Principles Governing Compliance With Portola Packaging."

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 or PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form. If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list, form PTO-1449, or PTO/SB/08A and 08B, as reviewed by the examiner, will be returned to the applicant with the next communication. Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto. The original copy of the list, form PTO-1449, or PTO/SB/08A and 08B will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication as to which references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO-1449 or PTO/SB/08A and 08B .

Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (subsection III.A(3) above) and

insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent. See *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1377-78, 54 USPQ2d 1001, 1008 (Fed. Cir. 2000) (“[A]s MPEP Section 609C(2) reveals, the examiner’s understanding of a foreign reference is generally limited to that which he or she can glean from the applicant’s concise statement...Consequently, while the examiner’s initials require that we presume that he or she considered the [foreign] reference, this presumption extends only to the examiner’s consideration of the brief translated portion and the concise statement.”).

Since information is required to be submitted in a separate paper listing the citations rather than in the specification, there is no need to mark “All checked” or “Checked” in the margin of a specification containing citations.

If an item of information in an IDS fails to comply with requirements of 37 CFR 1.97 and 37 CFR 1.98, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner and will be appropriately initialed.

### **C (3) Documents Submitted As Part of Applicant’s Reply to Office Action**

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (e.g., PTO-892, PTO-1449, or PTO/SB/08A and 08B) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in reply to the first Office action and also lists those patents on a PTO-1449 or PTO/SB/08A and 08B along with two journal articles, but does not file a statement under 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p), it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO-1449 or PTO/SB/08A and 08B and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

### **D. Information Printed on Patent**

A citation listed on form PTO-1449 or PTO/SB/08A and 08B and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449 or PTO/SB/08A and 08B, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, and the list includes a column for the examiner’s initials to

indicate that the information was considered. For patents printed after January 1, 2001, citations from information disclosure statements that are printed on the face of the patent will be distinguished from citations cited by the examiner on a form PTO-892. The citations cited by the examiner on a form PTO-892 will be marked with an asterisk. If an item of information is cited more than once in an IDS and on a form PTO-892, the citation of the item will be listed only once on the patent as a citation cited by the examiner.

If the applicant does not provide classification information for a citation, or if the examiner lines through incorrect classification data, the citation will be printed on the face of the patent without the classi-

fication information. If a U.S. patent application number is listed on a PTO-1449 or PTO/SB/08A and 08B form or its equivalent and the examiner considers the information and initials the form, the application number will be printed on the patent. Applicants may wish to list U.S. patent application numbers on other than a form PTO-1449 or PTO/SB/08A and 08B format to avoid the application numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact as noted in subsection III.C(2) above.

Form PTO-1449		Docket Number (Optional) 32210	Application Number 07/123,456				
INFORMATION DISCLOSURE CITATION IN AN APPLICATION							
<i>(Use several sheets if necessary)</i>							
Applicant C. Benson, et al							
Filing Date 1-2-91			Group Art Unit 3401				
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	
JD.	3 7 0 3 4 4 5	11-72	Tew	418	61		
JD.	3 9 9 4 0 0 0	6-75	Reitter	418	61		
JD.	3 6 9 4 5 0 9	1-71	Sarich	418	61		
JD.	4 3 2 5 7 7 7	5-90	Wolfe	418	63		
FOREIGN PATENT DOCUMENTS							
	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	Translation	
						YES	NO
	3 3 3 5 4 0	06-75	France				
JD.	1 1 3 7 7 2 9	06-65	Federal Republic of Germany	418	63	X	
JD.	9 1 4 1	08-79	European Patent Office				
JD.	W08401871	09-80	PCT International				
JD.	5 0 - 3 1 0 6	11-79	Japan	260	424		X
OTHER DOCUMENTS <small>(Including Author, Title, Date, Pertinent Pages, Etc.)</small>							
JD.	Kovach, et al "Simple Precision RC Oscillator," IBM Tech. Disclosure Bulletin Vol. 16, No. 10.						
	3/74, p.p. 3174-3175						
	Tiers, J. Am. Chem. Soc. 825513 (1960)						
EXAMINER	J. De		DATE CONSIDERED		Sept. 30, 1991		
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.							

Please type a plus sign (+) inside this box →

PTO/SB/08A (10-96)  
 Approved for use through 10/31/99. 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 contains a valid OMB control number.

Substitute for form 1448A/PTO <b>INFORMATION DISCLOSURE                  STATEMENT BY APPLICANT</b> (use as many sheets as necessary)		<b>Complete if Known</b>	
Application Number	07/123,456		
Filing Date	1-2-91		
First Named Inventor	C. Benson		
Group Art Unit	3615		
Examiner Name	John Doe		
Attorney Docket Number	32210		
Sheet		of	

U.S. PATENT DOCUMENTS						
Examiner Initials <sup>2</sup>	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>3</sup> (if known)			
J.D.		3703445		Tew	11-72	
J.D.		3994000		Reitter	06-75	
J.D.		3694509		Sarich	01-71	
J.D.		4325777		Wolfe	05-90	

FOREIGN PATENT DOCUMENTS								
Examiner Initials <sup>2</sup>	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
		FR	338540			06-75		
J.D.		DE	1137729			06-65		X
J.D.		EP	9141			08-79		
J.D.		WO	80/01871			09-80		
J.D.		JP	50-3106			11-79		

Examiner Signature	John. Doe	Date Considered	Sept. 30, 1991
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.  
<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language translation is attached.  
 Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

MANUAL OF PATENT EXAMINING PROCEDURE

Please type a plus sign (+) inside this box →

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 Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE  
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Substitute for form 1449B/PTO		<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(use as many sheets as necessary)</i>		Application Number	07/123,456
		Filing Date	1-2-91
		First Named Inventor	C. Benson
		Group Art Unit	3615
		Examiner Name	John Doe
		Attorney Docket Number	32210
Sheet		of	

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS			
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
JD		KOVACH, "Simple Precision RC Oscillator," IBM Tech. Disclosure Bulletin,	
↓		Vol. 16, No. 10., 3/12/1990, pgs. 3174- 3175.	
		<del>TIERS, J. Am. Chem. Soc. 825513 (1960)</del>	

Examiner Signature	John Doe	Date Considered	Sept. 30, 1991
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<sup>1</sup> EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## 610 Third Party Submission of Patents or Publications in a Published Application

37 CFR 1.99. *Third-party submission in published application*

(a) A submission by a member of the public of patents or publications relevant to a pending published application may be entered in the application file if the submission complies with the requirements of this section and the application is still pending when the submission and application file are brought before the examiner.

(b) A submission under this section must identify the application to which it is directed by application number and include:

(1) The fee set forth in § 1.17(p);

(2) A list of the patents or publications submitted for consideration by the Office, including the date of publication of each patent or publication;

(3) A copy of each listed patent or publication in written form or at least the pertinent portions; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent or publication in written form relied upon.

(c) The submission under this section must be served upon the applicant in accordance with § 1.248.

(d) A submission under this section shall not include any explanation of the patents or publications, or any other information. The Office will dispose of such explanation or information if included in a submission under this section. A submission under this section is also limited to ten total patents or publications.

(e) A submission under this section must be filed within two months from the date of publication of the application (§ 1.215(a)) or prior to the mailing of a notice of allowance (§ 1.311), whichever is earlier. Any submission under this section not filed within this period is permitted only when the patents or publications could not have been submitted to the Office earlier, and must also be accompanied by the processing fee set forth in § 1.17(i). A submission by a member of the public to a pending published application that does not comply with the requirements of this section will be returned or discarded.

(f) A member of the public may include a self-addressed postcard with a submission to receive an acknowledgment by the Office that the submission has been received. A member of the public filing a submission under this section will not receive any communications from the Office relating to the submission other than the return of a self-addressed postcard. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a submission under this section.

Once an application has been published under 35 U.S.C. 122(b), a member of the public (i.e., a third party to the prosecution proceeding of the application) may submit patents and publications relevant to the published application pursuant to 37 CFR 1.99. The patents and publications may be entered in the appli-

cation file if the submission complies with the requirements of 37 CFR 1.99 and the application is still pending when the submission and application file are brought before the examiner. The submission must be served upon the applicant in accordance with 37 CFR 1.248 prior to the filing of the submission in the Office.

The purpose for permitting a third party to submit relevant patents or publications in a published application is to enhance the quality of examination of the application. This objective is accomplished by informing the examiner that such relevant patents or publications are in existence and should be considered when evaluating the patentability of the claims.

To ensure that a third-party submission under 37 CFR 1.99 does not amount to a protest or pre-grant opposition without express consent of the applicants, 37 CFR 1.99 does not permit the third party to have the right to insist that the examiner consider any of the patents or publications submitted.

If the submission is not in compliance with 37 CFR 1.99, information filed in the submission may be removed prior to the examiner receiving the submission and application file. The Office will screen third-party submissions to determine whether they are limited to patents and publication, and to remove any explanations or information (other than patents and publications) from the submission before the submission is placed in the application file and forwarded to the examiner. If the explanations cannot be separated from the patents or publications, such patents or publications will be discarded. By the time the examiner receives the application file and submission, some or all patents or publications in the submission may have been discarded.

The entry of a submission under 37 CFR 1.99 does not mean that the patents or publications contained in the submission will be necessarily considered and cited by the examiner. Unless the examiner clearly cites a patent or publication on form PTO-892, "Notice of References Cited" and such patent or publication is used in a rejection or its relevance is actually discussed during prosecution, the patent or publication will not be deemed to have been "considered" for purposes of reexamination under the *Portola* guidelines. See MPEP § 2242 under the subsection "General Principles Governing Compliance With *Portola* Packaging."

If the applicant wants to ensure that the information in a third-party submission is considered by the examiner, the applicant should submit such information in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98. Since the third party is required to serve the applicant a copy of the submission, applicant may file the IDS prior to the Office receiving or acting on the submission. Furthermore, an individual who has a duty to disclose under 37 CFR 1.56 should submit any material information contained in a third-party submission to the Office in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98 to ensure such material information is properly disclosed to the examiner.

### I. WHEN MUST A THIRD-PARTY SUBMISSION BE FILED

37 CFR 1.99(e) specifies that a submission under 37 CFR 1.99 must be filed within two months from the date of publication of the application (37 CFR 1.215(a)), or prior to the mailing of a notice of allowance (37 CFR 1.311), whichever is earlier. Republication of an application under 37 CFR 1.211 does not restart the two-month period specified in 37 CFR 1.99(e).

Any submission not filed within the periods specified in 37 CFR 1.99(e) is permitted only when the patents or publications could not have been submitted to the Office earlier (e.g., an amendment submitted in the application after publication changes the scope of the claims to an extent that could not reasonably have been anticipated by a person reviewing the published application during the period specified in 37 CFR 1.99(e)). Submissions after the periods specified in 37 CFR 1.99(e) must be accompanied by (1) a statement that the patents or publications being submitted in the submission could not have been submitted to the Office earlier, and (2) the processing fee as set forth in 37 CFR 1.17(i).

### II. CONTENTS REQUIREMENTS FOR A THIRD-PARTY SUBMISSION

Prior to filing a submission under 37 CFR 1.99, the patents or publications being submitted must be served upon the applicant pursuant to 37 CFR 1.248. A submission under 37 CFR 1.99 must identify the application to which it is directed by the application number and must include:

(A) a certification that the third party has served the information being submitted upon the applicant in compliance with 37 CFR 1.248(b).

(B) a listing of the patents or publications submitted for consideration by the Office (including the date of publication of each patent or publication);

(C) a copy of each listed patent or publication in written form or at least the pertinent portions thereof;

(D) an English language translation of all pertinent parts of any non-English language patent or publication in written form; and

(E) a certification that the third party has served the information being submitted upon the applicant in compliance with 37 CFR 1.248(b).

Pursuant to 37 CFR 1.99(d), a submission **cannot** include any of the following:

(A) more than ten total references (patents or publications);

(B) explanations of the patents or publications;

(C) documents other than patents or publications (e.g., the submission cannot include any affidavits or declarations); or

(D) markings or highlights on the patents or publications.

The third party may, however, submit redacted versions of a patent or publication containing only the most relevant portions of the patent or publication. The Office will review submissions to determine whether they are limited to patents and publications and remove any explanations or documents other than patents and publications from the submission before the submission is placed in the file of the application and forwarded to the examiner. The Office will dispose of such explanations or documents if included in a submission. Furthermore, if the explanation cannot be readily removed from the patents or publications (e.g., highlights), the patents or publications will be discarded.

### III. NO THIRD-PARTY PARTICIPATION

The involvement of a third party in filing a submission under 37 CFR 1.99 ends with the filing of the submission. A third party may include a self-addressed postcard with a submission filed under 37 CFR 1.99 to receive an acknowledgment by the Office that the submission has been received. The third party filing the submission will not receive any



communications from the Office relating to the submission other than the return of the self-addressed postcard.

#### **IV. TREATMENT OF A THIRD-PARTY SUBMISSION**

##### **A. *Procedures for Technical Support Staff***

Technical support staff in the TC will initially process third party submissions under 37 CFR 1.99. Once the technical support personnel recognizes a prior art submission as a third party submission under 37 CFR 1.99, he or she will enter the third party submission into PALM and into the application file. The technical support personnel will verify that the fee for a submission under 37 CFR 1.99 (i.e., the fee set forth in 37 CFR 1.17(p)) has been paid and, if appropriate, collect the fee(s) that may have been authorized in the third party submission. If the fee has not been paid (and there is no authorization to charge the fee contained in the third party submission), technical support personnel are **not** to charge applicant's deposit account for the requisite fee since the submission is being submitted by a third party rather than the applicant. The technical support personnel will review the listing of patents and publications to verify that it is clearly identified as a submission under 37 CFR 1.99. If the listing is not identified as a submission under 37 CFR 1.99, the technical support personnel will write on the listing "Submission under 37 CFR 1.99" followed by his or her initials and the date of entry. The technical support personnel will then forward the submission and the application file to the Supervisory Patent Examiner (SPE) or Special Program Examiner (SPRE) responsible for screening submissions under 37 CFR 1.99.

##### **B. *Procedures for Screeners***

Once the third party submission and application file have been forwarded to the SPE or SPRE who is responsible for screening submissions under 37 CFR 1.99, the SPE or SPRE will screen the third party submission to determine whether the submission is in compliance with the timeliness requirements noted in subsection I. above and the content requirements noted in subsection II. above. Submissions under 37 CFR 1.99 that do not comply with the timeliness or content requirements will be discarded. Only those

submissions that comply with 37 CFR 1.99 will be forwarded to the examiner along with the application file for consideration.

If the entire submission or parts of the submission need to be discarded, the screener should retain the cover letter or the first page of the submission (transmittal) and parts of the submission that are in compliance with the requirements of 37 CFR 1.99 and discard the rest of the submission. The screener should write on the transmittal that "the third party submission (or the list of items) has been discarded," and include the reason(s) why the submission or the items have been discarded (e.g., the submission was not timely filed or copies of items 1, 2, & 3 are not provided). The screener should also include his or her initials, and the date of entry.

If a patent or publication has been discarded (e.g., because it contained highlighted portions), there is nothing to preclude the screener from separately obtaining a clean copy of the patent or publication. After the submission has been reviewed for compliance with all the requirements of 37 CFR 1.99, the submission and the application file will be forwarded to the examiner for consideration.

##### **C. *Procedures for Examiners***

Once the third-party submission and the application file have been forwarded to the examiner, the examiner should act on the submission immediately. If an Office action is outstanding, the examiner may treat the submission when preparing the Office action. If an Office action is not outstanding, the examiner should treat the submission immediately on a separate Office communication (i.e., a PTOL-90).

The examiner should not initial any patents or publication on the listing of patents or publications submitted in a third-party submission. The examiner may request for applicant's comments of any patent or publication in the submission.

The examiner should notify applicant of the Office treatment of the third-party submission using form paragraph 6.56. If any patent or publication in the submission under 37 CFR 1.99 has been determined by the examiner to be relevant to the patentability of the claims in the published application, the examiner should list the patent or publication on form PTO-892 and provide an explanation of its relevance unless the patent or publication has been used in a rejection. If

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the examiner considers it desirable, or necessary, to obtain applicant's comments on the patents or publications submitted before further action, the examiner will offer applicant an opportunity to file comments. If the examiner has specific questions or requests for information from the applicant regarding any of the patents or publications, the examiner may make a requirement of information under 37 CFR 1.105. See MPEP §704.

¶ 6.56 Notify Applicant of Office Treatment of a Third-Party Submission

A third-party submission has been filed under 37 CFR 1.99 on [1] in the published application.

To ensure that a third-party submission does not amount to a protest or pre-grant opposition, 37 CFR 1.99 does not permit the third party to have the right to insist that the examiner considers any of the patents or publications submitted. Furthermore, if the submission is not in compliance with 37 CFR 1.99, some or all of the information submitted may have been discarded prior to the examiner receives the submission. Therefore, unless the examiner clearly cites a patent or publication on form PTO-892, Notice of References Cited and such reference is used in a rejection or its relevance is actually discussed during prosecution, consideration by the examiner of any patent or publication submitted in a third-party submission cannot be presumed.

If the applicant wants to ensure that the information in a third-party submission is considered by the examiner, the applicant should submit the information in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98. An individual who has a duty to disclose under 37 CFR 1.56 should also submit any material infor-

mation contained in a third-party submission to the Office in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98 to ensure such material information is properly disclosed to the examiner.

Examiner Note:

- 1. In bracket 1, insert the date that the Office received the submission.

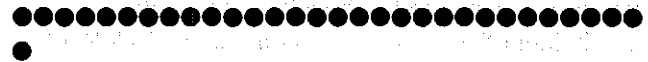
Form paragraph 6.57 may be used to offer applicant an opportunity to file comments on a third-party submission.

¶ 6.57 Requesting Applicant's Comments on a Third-Party Submission

A third-party submission has been filed under 37 CFR 1.99 on [1] in the published application. Applicant is offered an opportunity to file any comments regarding the patents or publications submitted in the third-party submission. Any comments should be filed within the later of the time period set forth in the prior Office action or one month from the mailing of this Office communication.

Examiner Note:

- 1. While the examiner normally should not need further information from applicant, this form paragraph may be used to request applicant's comment.
2. In bracket 1, insert the date that the Office received the submission.



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  - 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
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    - 707.05(c) Order of Listing

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710.02(b)	Shortened Statutory Period: Situations In Which Used	714.01(d)	Amendment Signed by Applicant But Not by Attorney or Agent of Record
710.02(c)	Specified Time Limits: Situations In Which Used	714.01(e)	Amendments Before First Office Action
710.02(d)	Difference Between Shortened Statutory Periods for Reply and Specified Time Limits	714.02	Must Be Fully Responsive
710.02(e)	Extension of Time		
710.04	Two Periods Running		
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710.05	Period Ending on Saturday, Sunday, or a Federal Holiday		

## EXAMINATION OF APPLICATIONS

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714.04	Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty	715.02	How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims
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## 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

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 before the application is placed in the storage racks to await the first action.

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

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 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 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 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

### 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.

(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) Any reply that states 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 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.

### **704.11 What Information May Be Required**

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.

### **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

37 CFR 1.105(a)(1)(i)-(vii) 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).

### 704.11(b) When May A Requirement For Information Be Made

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.

#### 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.

#### **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.

#### **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**

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.

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

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.

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.

### 704.12(c) Treatment of An Incomplete Reply

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 paragraph 7.91.

An incomplete reply to a 37 CFR 1.105 requirement in an abandoned application will only result in termination of the proceedings since the application is already abandoned. Similarly, an incomplete reply to a 37 CFR 1.105 requirement in an issued patent during a request for inventorship change will only result in termination of the proceedings, not lapse of the patent.

### 704.13 Time Periods for Reply

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

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.

### 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

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.

**¶ 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.

**¶ 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 any of the applicants 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 will 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**

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.

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.

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. 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**

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 (paragraph B(2)) and MPEP § 706.07(a) following a submission of an Information Disclosure Statement under 37 CFR 1.97 and 1.98.

## 705 Patentability Reports

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.

The report, if legibly written, need not be typed.

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

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 --."

### 705.01(a) Nature of P.R., Its Use and Disposal

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 written or typed on a 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. 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.

### DISAGREEMENT AS TO CLASSIFICATION

Conflict of opinion as to classification may be referred to a patent classifier 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.

### **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.

### **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. 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**

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. That this has been done may be indicated by a pencil notation on the file wrapper.

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**

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.

### 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

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.

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#### (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(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.

(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.

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## 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.

## 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.

## 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.

## 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 (§ 1.191) 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 or a patent under reexamination after reply by the applicant or the patent owner. If claims are rejected, or objections or requirements made, applicant or patent owner will be notified in the same manner as after the first examination. Applicant or patent owner may reply to such Office action in the same manner provided in 37 CFR 1.111 or 37 CFR 1.945, with or without amendment, unless such Office action indicates that it is made final (37 CFR 1.113), or an appeal under 37 CFR 1.191 has been taken (37 CFR 1.116), or 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, any amendment 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.

## 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

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 Commissioner.

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

*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, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; 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 a patent shall not be deemed filed

in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); 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 negated 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) 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 invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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).

### 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.

### REEXAMINATION

For scope of rejections in reexamination proceedings see MPEP § 2258.

### 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.

### 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 and if the requirements of 35 U.S.C. 120 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, 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), 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 is entitled to priority under 35 U.S.C. 119(e) from a provisional application, the effective filing date is the filing date of the provisional application.

See MPEP § 1893.03(b) for determining the effective filing date of an application filed under 35 U.S.C. 371. See MPEP § 201.11(a) and § 1895 for 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 35 U.S.C. 371.

### **706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent**

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.

#### **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.

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

##### **I. 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).

##### **II. 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).

#### **Determine Whether the Examined Application is a PRE-PG PUB Application or a PG-PUB Application**

The American Inventors Protection Act (AIPA), Pub. L. 106-113, 113 Stat. 1501 (1999), amended 35 U.S.C. 102(e) to provide that U.S. patents, U.S. application publications, and certain international application publications can be used as prior art under 35 U.S.C. 102(e) based on their earliest effective filing date against applications filed on or after November 29, 2000; and applications filed prior to November 29, 2000 which have been voluntarily published. Applications that were filed on or after November 29, 2000, and applications that were filed prior to November 29, 2000 which have been voluntarily published are referred to as PG-PUB applications. When examining any PG-PUB application, the application is subject to the current version of 35 U.S.C. 102 (e) as set forth below.

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

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(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, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; 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 a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

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Applications that were filed prior to November 29, 2000 which have not been voluntarily published are referred to as pre PG-PUB applications. This includes international applications filed before November 29, 2000 which entered the national stage as to the U.S. on or after November 29, 2000. When examining any pre PG-PUB application, the application is subject to the former 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-

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(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.

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#### ***When Examining Pre PG-PUB Applications***

When examining any application filed prior to November 29, 2000 which has not been voluntarily published (pre PG-PUB application), for 35 U.S.C. 102(e) to apply:

(A) The reference must be a U.S. Patent (or SIR) with a filing date earlier than the effective filing date of the application. See MPEP § 2136.03. Note that, for purposes of 35 U.S.C. 102(e), the filing date of the reference patent which has issued on an application entitled to priority from a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application, except for a patent granted on an

international application (PCT) in which applicant has fulfilled the requirements of paragraphs (1), (2) and (4) of 35 U.S.C. 371. The prior art date of a patent granted on such a 35 U.S.C. 371 application is the date on which paragraphs (1), (2) and (4) of 35 U.S.C. 371 have been fulfilled; and

(B) The inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor need 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 common inventors.

#### ***When Examining PG-PUB Applications***

When examining applications filed on or after November 29, 2000 or applications filed prior to November 29, 2000 which have been voluntarily published (PG-PUB applications), for 35 U.S.C. 102(e) to apply:

(A) The reference must be a U.S. patent (or SIR), a U.S. patent application publication, or an international application publication with a filing date earlier than the effective filing date of the application being examined. An international application is prior art under 35 U.S.C. 102(e) only if (1) the international application designated the United States, (2) the international application was published under PCT Article 21(2)(a) in English, (3) the international application was filed on or after November 29, 2000, and (4) the international application entered the national stage as to the United States. See MPEP § 2136.03. The 35 U.S.C. 102(e) critical reference date of U.S. patents, U.S. application publications and certain international application publications, entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e), is the filing date of the provisional application with certain exceptions. When examining a PG-PUB application, a U.S. patent granted on a 35 U.S.C. 371 application has no reference date under 35 U.S.C. 102(e). A U.S. application publication resulting from a 35 U.S.C. 371 application entitled to the benefit of the filing date of the provisional application will have a reference date as of the filing date of the provisional application under 35 U.S.C. 119(e) only if the international application was published in English pursuant to PCT Article 21(2)(a). Similarly, an international application publication entitled to the filing date of a provisional application will have a reference



date as of the filing date of the provisional application, but only if the international application designated the United States, the international application was published under PCT Article 21(2)(a) in English, the international application was filed on or after November 29, 2000, and the international application entered the national stage as to the United States; and

(B) The inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor need 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 common inventors.

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

If 35 U.S.C. 102(e) does not apply, then the examiner should consider 35 U.S.C. 102(a). 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

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; or

(C) Perfecting priority under 35 U.S.C. 119(e) or 120 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).

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 application in the case of a provisional rejection) claiming the same patentable invention as defined in 37 CFR 1.601(n). See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference 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). 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 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).

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. See MPEP § 715 for information on the requirements of 37 CFR 1.131 affidavits.

(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 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).

### **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)

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 a decade.

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) Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application

If a copending U.S. patent application discloses subject matter which would anticipate the claims in another pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional 35 U.S.C. 102(e) rejection can be made.

#### 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 neither application is published at the time of the provisional rejection, the rejection must be 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 or 7.15.04 should be used as appropriate 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, Application Being Examined Filed before 11/29/00 and Not Voluntarily Published Under 35 U.S.C. 122(b)*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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 patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future 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. The copending application must have either a common assignee or at least one common inventor.
2. If the application being examined was filed before November 29, 1999 and has not been voluntarily published, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
3. If the application being examined was filed on or after November 29, 1999 and has not been voluntarily published, and there is no evidence of common ownership of record, and 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.

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

*Application Being Examined Filed On or After 11/29/00 or Filed Before 11/29/00 and Voluntarily Published Under 35 U.S.C. 122(b)*

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 should be used when the application being examined was either filed on or after November 29, 2000 or voluntarily published pursuant to 35 U.S.C. 122(b).
2. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
3. If the application being examined was filed before November 29, 1999, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
4. If the application being examined was filed on or after November 29, 1999 and there is no evidence of common ownership of record, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
5. In bracket 3, insert either --assignee-- or --inventor--.
6. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.
7. 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.
8. 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 application 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**

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.

**¶ 7.12 102(e), Patent to Another with Earlier Filing Date, Application Being Examined Filed Before 11/29/00 and Not Published under 35 U.S.C. 122(b)**

(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) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined 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 application being examined was **filed before November 29, 2000**, and was not voluntarily published as a patent application publication under 35 U.S.C. 122(b).
2. If the application being examined is a continued prosecution application (CPA), and the actual filing date of this CPA is on or after November 29, 2000, then form paragraph 7.12.01 must be used instead.
3. The filing of a request for continued examination (RCE) does not change the filing date of the application being examined. Therefore, if an RCE is filed on or after November 29, 2000 in an application filed (1) before November 29, 2000 and (2) not voluntarily published under 35 U.S.C. 122(b), pre-AIPA 35 U.S.C. 102(e) applies.
4. This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.07 to 7.11.

**¶ 7.12.01 102(e), Application for Patent or Patent to Another with Earlier Filing Date, Application Being Examined Filed on or After 11/29/00 or Filed Before 11/29/00 and Voluntarily Published under 35 U.S.C. 122(b)**

(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, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; 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 a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an

international application filed under the treaty defined in section 351(a).

**Examiner Note:**

1. This paragraph should only be used if the application (including first-filed applications, continuing applications filed under 37 CFR 1.53(b), CPAs and reissues) being examined was **filed on or after November 29, 2000 or was filed prior to November 29, 2000 but was voluntarily published as a patent application publication under 35 U.S.C. 122(b)**.
2. This paragraph should also be used if the application being examined is an international application complying with the national stage requirements (35 U.S.C. 371(c)) having an international filing date on or after November 29, 2000.
3. If the application being examined has not been published and contains a request for continued examination (RCE) in an application filed before November 29, 2000, form paragraph 7.12 must be used instead of this form paragraph.
4. If post-AIPA 35 U.S.C. 102(e) is relied upon in the examination of the application it is important to note that a patent issued from an international application complying with the national stage requirements (35 U.S.C. 371(c)) is **not** to be relied upon in making a prior art rejection under 35 U.S.C. 102(e)(2) since such a patent has no prior art date under post-AIPA 35 U.S.C. 102(e)(2). The patent would continue to have its issue date as a prior art date under 35 U.S.C. 102(a) and (b).
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, Application Being Examined Filed before 11/29/00 and Not Voluntarily Published Under 35 U.S.C. 122(b)

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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 patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future 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. The copending application must have either a common assignee or at least one common inventor.
2. If the application being examined was filed before November 29, 1999 and has not been voluntarily published, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
3. If the application being examined was filed on or after November 29, 1999 and has not been voluntarily published, and there is no evidence of common ownership of record, and 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.

¶ 7.15.04 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor, Application Being Examined Filed On or After 11/29/00 or Filed Before 11/29/00 and Voluntarily Published Under 35 U.S.C. 122(b)

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 should be used when the application being examined was either filed on or after November 29, 2000 or voluntarily published pursuant to 35 U.S.C. 122(b).
2. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
3. If the application being examined was filed before November 29, 1999, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
4. If the application being examined was filed on or after November 29, 1999 and there is no evidence of common ownership of record, and the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
5. In bracket 3, insert either --assignee-- or --inventor--.

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

7. 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.

8. 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. In bracket 3, insert either --assignee-- or --inventor--.
3. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.
4. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.01.

*¶ 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 must have neither a common assignee nor a common inventor.
2. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 3, insert the prior art relied upon.

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

5. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.01.

*¶ 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 references 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(1) - § 706.02(1)(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

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now 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 change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c)

does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application. See MPEP § 706.02(l)(1) for additional information regarding disqualified prior art under 35 U.S.C. 102(e)/103.

Where two applications of different inventive entities are copending and the filing dates differ, a provisional rejection under 35 U.S.C. 102(e)/103 should be made in the later filed application if the applications have a common assignee or a common inventor, unless the later application was filed on or after November 29, 1999 and the applications were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made. See MPEP § 706.02(l)(3) for examination procedure with respect to 35 U.S.C. 103(c). Otherwise the confidential status of applications 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, 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 filed on or after November 29, 1999, showing that 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.

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 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:

**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.
3. A and B file continuing application claiming priority to 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 filed on or after November 29, 1999:

**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, filed on or after November 29, 1999, 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 made.
3. B's patent issues.	A's claims 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, filed on or after November 29, 1999, 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 made; no 35 U.S.C. 102(e)/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.

#### 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 applications 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(I) Rejections Under 35 U.S.C. 102(f)/103 and 35 U.S.C. 102(g)/103; 35 U.S.C. 103(c)**

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

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(c) 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 invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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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(I)(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, 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.") If the subject matter qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a), 35 U.S.C. 102(b), or 35 U.S.C. 102(e)) it will not be disqualified as prior art under 35 U.S.C. 103(c).

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 qualifies as prior art under 35 U.S.C. 102. A patent applicant urging that subject matter is disqualified has the burden of establishing that it was commonly owned at the time the claimed invention was made. Absent proper evidence of common ownership at the time the later invention was made, the appropriate rejection under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) as it applies through 35 U.S.C. 103 should be made. See MPEP § 706.02(I)(2) for information pertaining to establishing common ownership.

Information learned from or transmitted to persons outside the organization is not disqualified as prior art. 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. See MPEP § 706.02(I)(2).

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) benefit based upon the foreign filed applications is appropriate and 35 U.S.C. 119(a)-(d) benefit can be accorded based upon each of the foreign filed applications.

### **706.02(1)(1) Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103(c)**

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

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(c) 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 invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now 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 change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application.

The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application. For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. The recapture doctrine prevents the presentation of claims in 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 commonly owned or assigned at the time the invention was made.

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, including 35 U.S.C. 102(e), is not affected, and may still be used to reject claims as being anticipated.

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.

See MPEP § 706.02(1)(2) for information regarding establishing common ownership. See MPEP § (1)(3) for examination procedure with respect to 35 U.S.C. 103(c). Non-statutory and statutory 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 MPEP § 804.

### **706.02(1)(2) Establishing Common Ownership**

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 at the time the claimed invention was made. See MPEP § 706.02(1) 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). See MPEP § 706.02(1)(1) for 35 U.S.C. 102(e)/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) 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) 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, 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) 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(f) or 35 U.S.C. 102(g), or, for applications filed on or after November

29, 1999, 35 U.S.C. 102(e), 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 Commissioner has reinstated 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.

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*, 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.

### **706.02(1)(3) Examination Procedure With Respect to 35 U.S.C. 103(c)**

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 common ownership by, or an obligation of assignment to, the same person at the time the invention was made. Such a commonly owned reference is only disqualified when

(A) proper evidence is filed,

(B) the reference *only* qualifies as prior art under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999, (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).

See MPEP § 706.02(1)(2) for additional information pertaining to establishing common ownership.

### **EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES WHERE COMMON OWNERSHIP HAS NOT BEEN ESTABLISHED**

If the application file being examined does not establish that it and the reference patent(s) or application(s) are owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, the examiner will:

(A) assume the application(s) and patent(s) are not commonly owned;

(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 a statement is made that the application(s) and patent(s) were commonly owned, at the time the invention was made. When applying any 35 U.S.C. 102(e)/103 references against the claims in applications filed on or after November 29, 1999, the examiner should anticipate that a statement of common ownership may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). See MPEP § 706.02(1)(1). 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.

**EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES FILED ON OR AFTER NOVEMBER 29, 1999 WHERE COMMON OWNERSHIP HAS BEEN ESTABLISHED**

If the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made, 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.

**EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES FILED PRIOR TO NOVEMBER 29, 1999 WHERE COMMON OWNERSHIP HAS BEEN ESTABLISHED**

In applications filed prior to November 29, 1999, the disclosure of an earlier filed patent application which issues as a patent continues to be prior art under 35 U.S.C. 102(e) against a later invented and filed application of another inventor even though the patent and the later invention were owned by, or subject to, an obligation of assignment to the same person at the time the later invention was made. See MPEP § 706.02(1)(1).

If the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made, the examiner will:

(A) examine the applications as to all grounds except 35 U.S.C. 102(f) and (g) as they apply through 35 U.S.C. 103;

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

(C) examine the later filed application under 35 U.S.C. 102(e) as it applies through 35 U.S.C. 103 and make a provisional rejection under 35 U.S.C. 102(e)/35 U.S.C. 103 in the later filed application, if appropriate; and

(D) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate, and permit the applicant of the later filed application to file an affidavit or declaration under 37 CFR 1.131, or a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 if the same patentable invention is being claimed and the commonly owned application has issued as a patent (see MPEP § 715.05 and § 718), or an affidavit or declaration under 37 CFR 1.132 showing the invention is not "by another," to overcome the provisional or actual 35 U.S.C. 102(e)/35 U.S.C. 103 rejection, if appropriate. An affidavit or declaration under 37 CFR 1.130 cannot be used to overcome a provisional 35 U.S.C. 102(e)/103 rejection. See MPEP § 718.

**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. 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 guidance 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. See MPEP § 804 and § 804.02.

## 706.02(m) Form Paragraphs for Use in Rejections Under 35 U.S.C. 103

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 negated 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 For Applications filed Prior to November 29, 1999, 103(a) Rejection Using Art Disqualified Under 102 (f) or (g)

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. Accordingly, [2] is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

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(f) or (g), but which qualifies under another section of 35 U.S.C. 102.

2. In brackets 1 and 2, identify the commonly owned applied art (patent or co-pending application).
3. Use this form paragraph only in applications filed prior to November 29, 1999. For applications filed on or after November 29, 1999, use form paragraph 7.20.03.

### ¶ 7.20.03 For Applications Filed On Or After November 29, 1999, 103(a) Rejection Using Art Disqualified Under 102(e), (f) or (g)

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. Accordingly, [2] is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

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 rejection 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 commonly owned applied art (patent or co-pending application).
3. Use this form paragraph only in applications filed on or after November 29, 1999. For applications filed prior to November 29, 1999, use form paragraph 7.20.01.

### ¶ 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).

### ¶ 7.21 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 this rejection relies upon art that is disqualified under 35 U.S.C. 102(f) or (g) based upon the common ownership of the invention, paragraph 7.20.01 must follow this paragraph.

4. 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, use 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 patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future 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. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference 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. See MPEP § 706.02(1)(1) and § 706.02(1)(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 filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made. See MPEP § 706.02(1)(3).

2. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.

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

4. In bracket 4, insert explanation of obviousness.

5. 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.

6. 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 based upon common ownership, 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). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference 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. See MPEP § 706.02(1)(1) and § 706.02(1)(2). [4]

**Examiner Note:**

1. This paragraph is used to reject over a patent with an earlier filing date that discloses the claimed invention. The patent must have either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made. See MPEP § (1)(3).

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

3. 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.

*¶ 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 Schumann*, 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. 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)

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****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:

**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).

**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).

**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).

**Utility**

A rejection on the ground of lack of utility includes the more specific grounds of inoperativeness,

involving perpetual motion, frivolous, fraudulent, and against public policy. 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:**

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.

1. In each case, 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. A utility that is inoperative should be treated as being not credible since a utility that is inoperative cannot be credible.

**706.03(b) Barred by Atomic Energy Act**

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(f), 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(f), in order for the Commissioner 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**

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 containing 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 containing 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 along with an explanation as to why the specification is not enabling. 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 problem along with an explanation as to why the specification is not enabling. 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**

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 Paper No. [3] filed [4]. In that paper, applicant has stated [5], and this statement indicates that the invention is different from what is defined in the claim(s) because [6].

**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 brackets 3 and 4, 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 Paper No. and the date the paper was filed in the USPTO.
4. In bracket 5, set forth what applicant has stated in the submission to indicate a different invention.
5. In bracket 6, 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 - 7.34.06, 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*

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "[1]" in claim [2] is used by the claim to mean "[3]", while the accepted meaning is "[4]."

**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 form paragraph must be preceded by form paragraph 7.34.01.

#### ¶ 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. 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 3<sup>rd</sup> 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:

1. 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:

1. 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:

1. 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 conducting," 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

#### 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 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(1).

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 because it introduces new matter into the disclosure. 35 U.S.C. 132 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 not 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 statement 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

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 1.605 (See MPEP § 2305.02),

(B) copy a claim from a patent when suggested by the examiner (MPEP § 2305.02), or

(C) respond or appeal, within the time limit fixed, to the examiner's rejection of claims copied from a patent (see MPEP § 2307.02).

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 § 2306.

#### ¶ 7.49 Rejection, Disclaimer, Failure To Appeal

Claim [1] stand finally disposed of for failure to reply to or appeal from the examiner's rejection of such claim(s) presented for interference within the specified time. See 37 CFR 1.661 and 1.663.

### 706.03(v) After Interference or Public Use Proceeding

For rejections following an interference, see MPEP § 2363.03.

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

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, 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

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.

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

See MPEP § 2307.02.

### 706.07 Final Rejection

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 applicants, 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 (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner 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 suc-

cessive 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, whichever is longer, 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 , 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

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 paragraph (B)(2). 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.

When applying any 35 U.S.C. 102(e)/103 references against the claims of an application filed on or after November 29, 1999, 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(1)(3).

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(B)(2)(i). 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.

**706.07(b) Final Rejection, When Proper on First Action**

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.

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**

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. In no event can the statutory period for reply expire later than 6 months from the date of the final rejection.

(B) If the form paragraph setting a variable reply period is inadvertently not included in the final Office action, the SSP for reply will end 3 months from the date of the final Office action and cannot be extended other than by making a petition and paying a fee pursuant to 37 CFR 1.136(a). However, if an advisory action is mailed in such a case where the reply to the final action has been filed within 2 months, the examiner should vacate the original SSP and reset the period for reply to correspond with the Office policy set forth in the Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," 1027 O.G. 71 (Feb. 8, 1983). See paragraph (F) below.

(C) 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.

### ADVISORY ACTIONS

(D) 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 the appropriate box at the top portion of the Advisory Action form, PTOL-303.

If PTOL-303 is not used, then use Form Paragraph 7.67.01 on all advisory actions where a first complete reply has been filed within 2 months of the date of the final Office action.

#### ¶ 7.67.01 *Advisory After Final, Heading, 1st Reply Filed Within 2 Months*

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, 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.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

#### **Examiner Note:**

1. This form paragraph should be used in all advisory actions if:
  - a. it was the FIRST reply to the to the final rejection, and
  - b. it was filed within two months of the date of the final rejection.

2. If a notice of appeal has been filed, also use form paragraph 7.68.
3. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(E) 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 use form paragraph 7.67.

(F) Where the final Office action does not set a variable reply period as set forth in paragraph (A) above AND applicant does file a complete first reply to the final Office action within 2 months, and if an advisory action is necessary and cannot be mailed within 3 months of the final Office action, the examiner should vacate the original SSP and reset the reply period to expire on the mailing date of the advisory action by using form paragraph 7.67.02. In no case can the statutory period for reply expire later than 6 months from the date of the final Office action. Note that form paragraph 7.67.02 can be used with the advisory action (preferable) or after the advisory action is mailed to correct the error of not setting a variable reply period.

#### ¶ 7.67.02 *Advisory After Final, Heading, No Variable SSP Set in Final*

Since the first reply to the final Office action was filed within TWO MONTHS of the mailing date of that action and the advisory action was not mailed within THREE MONTHS of that date, the THREE-MONTH shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the *Official Gazette* at 1027 O.G. 71, February 8, 1983. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

#### **Examiner Note:**

1. This form paragraph should be used in all advisory actions where:
  - a. the reply is a first reply to the final action;
  - b. the reply was filed within two months of the mailing date of the final; and
  - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.

2. If the final action set a variable SSP, do not use this form paragraph, use form paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use form paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(G) When an advisory action properly contains either form paragraph 7.67.01 or 7.67.02, 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.

#### EXAMINER'S AMENDMENTS

(H) 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.

(I) 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.

(J) 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 or trademark 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 Commissioner 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), item (J) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

**PRACTICE AFTER FINAL**

(K) Replies after final should be processed and considered promptly by all Office personnel.

(L) 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.

(M) 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.

(N) 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.

(O) 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**

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.

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(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

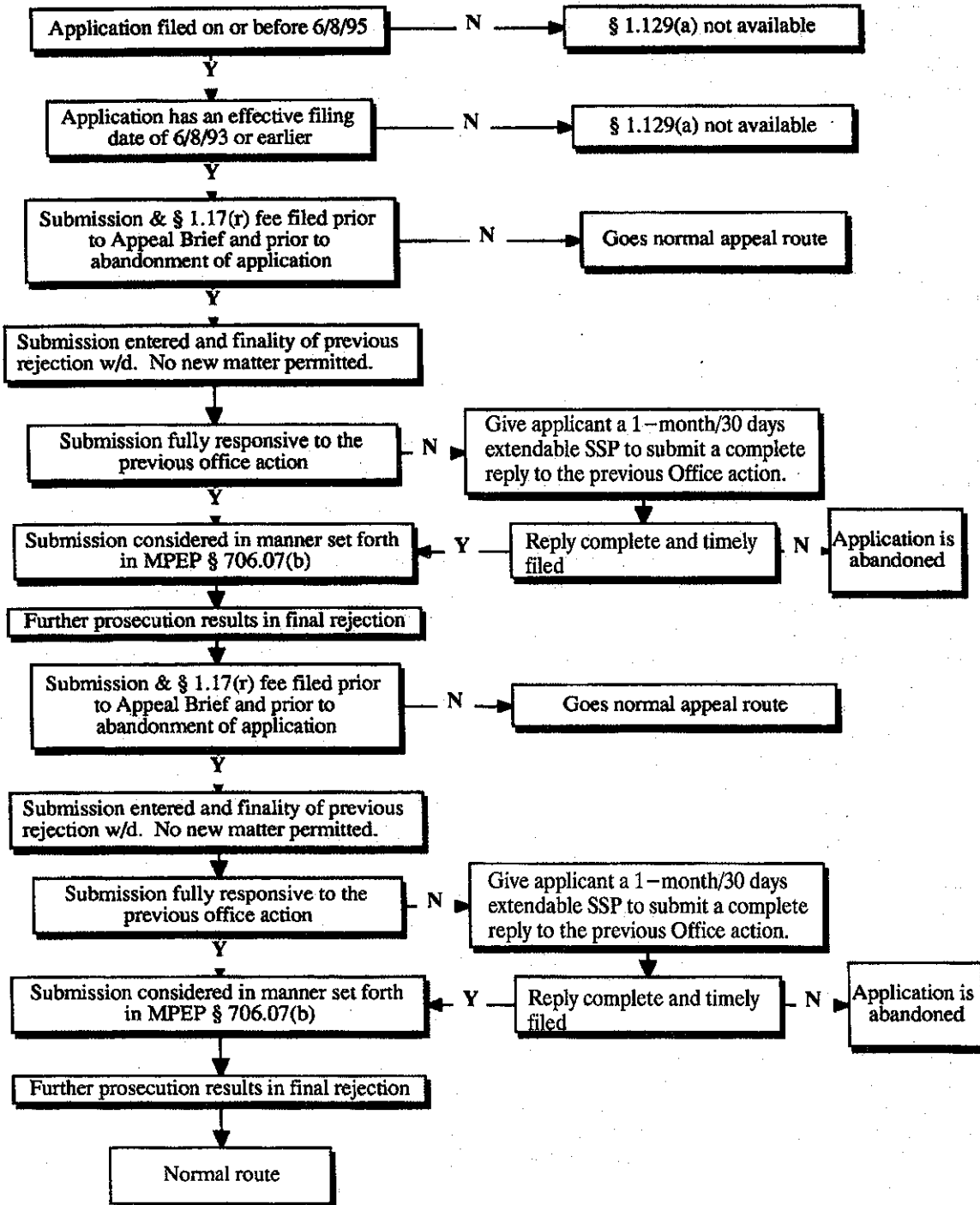
In order to facilitate the completion of prosecution of applications pending in the USPTO as of June 8, 1995 and to ease the transition between a 17-year patent term and a 20-year patent term, Public Law 103-465 provided for the further limited reexamination of an application pending for 2 years or longer 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 reopen prosecution of 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 1.192 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 1.192. 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 1.17(e) 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, 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 information disclosure statement 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.

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 PTO 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, submissions filed with the 37 CFR 1.17(r) fee, and any submissions filed prior to the mailing of the next Office action will be entered. Any conflicting amendments should be clarified for entry by the applicant upon payment of the 37 CFR 1.17(r) fee. Absent specific instructions for entry, all submissions filed as of the date of the withdrawal of the finality of the previous final action will be entered in the order in which they were filed. 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 1.17(e) 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.

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).

*¶ 7.42.03 Action Is Final, First Action Following Submission Under 37 CFR 1.129(a)*

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 1.192. Upon the timely filing of a second 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 1.17(e) 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.

**706.07(h) Request for Continued Examination (RCE) Practice**

*35 CFR 132(b). Notice of rejection; reexamination.*

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(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 under § 1.192 or a reply brief under § 1.193(b), 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) or a continued prosecution application (CPA) under 37 CFR 1.53(d). 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.

## 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 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 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
- (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*, 1935 Comm'r Dec. 11 (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). The definition for a "submission" in 37 CFR 1.114 is the same as the definition in 37 CFR 1.129(a). See MPEP § 706.07(g) for transitional after-final practice under 37 CFR 1.129(a). 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. An appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR 1.114(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.

## 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*, 1935 Comm'r Dec. 11 (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 eligible for either a CPA or an

RCE (i.e., a plant or utility application filed on or after June 8, 1995, but before May 29, 2000), that ambiguity will be resolved in favor of treating the transmittal paper as a request for a CPA under 37 CFR 1.53(d). 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.

#### **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 RCE. Any previously filed unentered amendments, amendments filed with the RCE, and any amendments filed prior to the mailing of the next Office action (after the RCE) will normally be entered. Absent specific instructions for entry, all amendments filed as of the date the RCE is filed are entered in the order in which they were filed. 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. Unlike a CPA, 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)(i) has been amended to provide that CPA practice under 37 CFR 1.53(d) does **not** apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000. Thus, an application (except for a design application) must have an actual filing date **before** May 29, 2000 for the applicant to be able to file a CPA of that application. While the Office uses the filing date (and application number) of the prior application of a CPA for identification purposes, the filing date of a CPA under 37 CFR 1.53(d) is the date the request for a CPA is filed. See 37 CFR 1.53(d)(2). Thus, if a CPA of an application (other than for a design patent) is filed on or after May 29, 2000, 37 CFR 1.53(d)(1)(i) does not permit the filing of a further CPA, regardless of the filing date of the prior application as to the first CPA (*i.e.*, the filing date used for identification purposes for the CPA).

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), 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 still be treated as an RCE (albeit 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.

If an applicant files a request for a CPA of an application to which CPA practice no longer applies and the CPA satisfies the requirements of 37 CFR 1.114 to be a proper RCE, but the applicant does not want the request for a CPA to be treated as a RCE under 37 CFR 1.114 (*e.g.*, the CPA is a divisional CPA), the applicant may file a petition under 37 CFR 1.53(e)

requesting that the improper CPA be converted to an application under 37 CFR 1.53(b). A petition under 37 CFR 1.53(e) to accept and treat an improper application filed under 37 CFR 1.53(d) as a proper application under 37 CFR 1.53(b) must include:

(A) the \$130.00 petition fee;

(B) a true copy of the complete nonprovisional application, as filed, designated as the prior nonprovisional application in the application papers filed under 37 CFR 1.53(d);

(C) any amendments entered in the prior nonprovisional application;

(D) any amendments submitted but not entered in the prior nonprovisional application and directed to be entered in the application papers filed under 37 CFR 1.53(d); and

(E) an executed oath or declaration under 37 CFR 1.63, if one has not already been submitted with the application papers filed under 37 CFR 1.53(d).

The Office will not grant such a petition unless the petition is before an appropriate deciding official before an Office action has been mailed in response to the RCE under 37 CFR 1.114 (as the improper CPA is being treated). If an Office action has been mailed in response to the RCE, the applicant should then simply file a new application under 37 CFR 1.53(b) within the period for reply to such Office action.

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 the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. See *Changes to Application Examination and Provisional Application Practice*, final rule, 65 *Fed. Reg.* 50092 (Aug. 16, 2000), 1238 *Off. Gaz. Pat. Office* 13 (Sept. 5, 2000). 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, 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). If the application is under final rejection, a 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.

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 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.

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 applicant indicating that the request was not accompanied by a submission as required by 37 CFR 1.114. 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 reply to a final Office action is outstanding and the submission only includes an information disclosure statement (IDS), the submission (*i.e.*, the IDS) 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.

### ¶ 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 supercedes 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. In addition, as 35 U.S.C. 132(b) and 37 CFR 1.114 provide continued examination of an application (and not examination of a continuing application), the applicant 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).

## 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*, 1935 Comm'r Dec. 11 (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 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, the applicant does not have to pay the issue fee again if the application is thereafter allowed. If the issue fee has been paid and prosecution is reopened, the applicant may **not** obtain a refund of the issue fee. If, however, the application is subsequently allowed, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee required by the new notice of allowance.

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, but prior to a deci-

sion on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. See 37 CFR 1.114(d). Thus, the filing of an RCE under 37 CFR 1.114 in an application on appeal awaiting a decision by the Board on the appeal will be treated as a withdrawal of the appeal by the applicant, regardless of whether the request for continued examination under 37 CFR 1.114 includes the appropriate fee (37 CFR 1.17(e)) or a submission (37 CFR 1.114(c)). Applicants should advise the Board of Patent Appeals and Interferences 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.

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.

If an RCE is filed in an application after appeal to the Board of Patent Appeals and Interferences 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 withdraw the appeal pursuant to 37 CFR 1.114. The proceedings as to the rejected claims are considered terminated. Therefore, if no claim is allowed, the application is abandoned. 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 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 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. 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 application 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. COMPARISON CHART AND FORMS

### A. *Comparison With The Transitional Procedure Set Forth In 37 CFR 1.129(a) And The CPA Procedure Set Forth In 37 CFR 1.53(d)*

The RCE procedure in 37 CFR 1.114 should not be confused with the transitional procedure for the further limited examination of patent applications set forth in 37 CFR 1.129(a) or the CPA procedure set forth in 37 CFR 1.53(d). The following chart provides a comparison of the three different procedures.

### B. *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.

	<b>Continued prosecution application (CPA) under 37 CFR 1.53(d)</b>	<b>URAA transitional practice under 37 CFR 1.129(a)</b>	<b>Request for continued examination (RCE) under 37 CFR 1.114</b>
1	CPA practice is not applicable to provisional applications or during reexamination Note: CPA practice has been made inapplicable to any utility or original plant applications filed on or after May 29, 2000 (including reissue)	37 CFR 1.129(a) practice is applicable only to original utility or original plant applications filed before or on June 8, 1995, and which have been pending for at least two years as of June 8, 1995 (date-wise virtual mutual exclusivity with RCE practice)	RCE practice is not applicable to provisional applications, design applications, applications filed before June 8, 1995, or during reexamination
2	A CPA may be filed before the prosecution in an application is closed	A submission under 37 CFR 1.129(a) must be filed after final rejection and before an appeal brief is filed	After August 16, 2000, a RCE must be filed after the prosecution in an application is closed
3	Statutory authority: 35 U.S.C. §§ 111(a), 120, and 121	Statutory authority: Section 532(a)(2)(A) of Pub. L. 103-465 (uncodified)	Statutory authority: 35 U.S.C. § 132(b)



	<b>Continued prosecution application (CPA) under 37 CFR 1.53(d)</b>	<b>URAA transitional practice under 37 CFR 1.129(a)</b>	<b>Request for continued examination (RCE) under 37 CFR 1.114</b>
4	The Office treats a CPA as continued examination of the same application, but it is technically/legally a new application	Further examination under 37 CFR 1.129(a) is in fact continued examination of the same application	A RCE is in fact continued examination of the same application
5	The applicant may defer paying the filing fee for a CPA under 37 CFR 1.53(g)	The applicant may not defer paying the fee for a submission under 37 CFR 1.129(a)	The applicant may not defer paying the fee for a RCE
6	The fee for a CPA must be the statutory filing fee: basic filing fee plus any applicable excess claims fees (even if previously paid in the prior application)	The Office sets the fee (fee need not include excess claims fee for claims previously paid for): the fee is set at an amount equal to the basic filing fee of a utility application (small entity reduction is available)	The Office sets the fee for a RCE (RCE fee need not include excess claims fee for claims previously paid for): the RCE fee is set at an amount equal to the basic filing fee of a utility application (small entity reduction is available)
7	A patent issuing on a CPA filed on or after May 29, 2000, is entitled to the patent term adjustment provisions of the AIPA, regardless of the filing date of any prior application of the CPA. A patent issuing on a CPA is <b>not</b> entitled to any patent term adjustment accumulated during prosecution of any prior application of the CPA.	An application that is eligible for the transitional practice of 37 CFR 1.129(a) is <b>not</b> entitled to the patent term adjustment provisions of the AIPA.	Filing a RCE on or after May 29, 2000, will <b>not</b> cause an application to be entitled to the patent term adjustment provisions of the AIPA. If an application is entitled to the patent term adjustment provisions of the AIPA ( <i>i.e.</i> , was itself filed on or after May 29, 2000), filing a RCE cuts-off the applicants ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment.
8	No limit on the number of times an applicant may file a CPA to obtain continued examination	An applicant may have only two (2) submissions entered as a matter of right under 37 CFR 1.129(a)	No limit on the number of times an applicant may file a RCE to obtain continued examination
9	A CPA is not entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8	A submission under 37 CFR 1.129(a) is entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8	A RCE is entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8

	<b>Continued prosecution application (CPA) under 37 CFR 1.53(d)</b>	<b>URAA transitional practice under 37 CFR 1.129(a)</b>	<b>Request for continued examination (RCE) under 37 CFR 1.114</b>
10	Applicants may file a continuation or divisional CPA, but not a CIP CPA.	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)
11	A CPA abandons the (previously) pending application: appeals to the BPAI or courts in the prior application become moot automatically	A submission under 37 CFR 1.129(a) does not abandon the (previously and currently) pending application: no appeal issues because Office requires such submission to be filed before an appeal (to BPAI) brief is filed	A RCE does not abandon the (previously and currently) pending application: appeals to the BPAI are dismissed by operation of 37 CFR 1.114 but any pending court action must be dismissed to restore jurisdiction over the application to the Office
12	Inventorship carries over unless the applicant provides a statement deleting inventors	Inventorship carries/continues: any change must be via 37 CFR 1.48	Inventorship carries/continues: any change must be via 37 CFR 1.48
13	Small entity status does not carry (but can be claimed by reference to status in prior application or payment of small entity filing fee)	Small entity status carries/continues	Small entity status carries/continues
14	A CPA accompanied by an amendment (preliminary) cancelling all claims makes the CPA improper (not entitled to a filing date)	Submission under 37 CFR 1.129(a) accompanied by an amendment cancelling all claims is simply a non-responsive amendment	RCE accompanied by an amendment cancelling all claims is simply a non-responsive amendment
15	Submission need not include a reply that is a <i>bona fide</i> attempt to advance the application	Submission must include a reply that is a <i>bona fide</i> attempt to advance the application (37 CFR 1.111)	Submission must include a reply that is a <i>bona fide</i> attempt to advance the application (37 CFR 1.111) if a reply to an Office action is outstanding

	<b>Continued prosecution application (CPA) under 37 CFR 1.53(d)</b>	<b>URAA transitional practice under 37 CFR 1.129(a)</b>	<b>Request for continued examination (RCE) under 37 CFR 1.114</b>
16	A CPA filed on or after November 29, 2000, will be subject to the eighteen-month publication provisions of the AIPA, and the changes to 35 U.S.C. § 102(e)	Submission on or after November 29, 2000, does not subject application to the eighteen-month publication provisions of the AIPA or the changes to 35 U.S.C. § 102(e); voluntary publication may be requested	Submission on or after November 29, 2000, does not subject application to the eighteen-month publication provisions of the AIPA or the changes to 35 U.S.C. § 102(e); voluntary publication may be requested
17	A CPA based on the national stage of an international application is an application filed under 35 U.S.C. § 111(a) and thus it is subject to restriction practice in accordance with 37 CFR 1.141-1.146	If a submission is filed in a national stage application under 35 U.S.C. § 371, the application is still subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499	If a submission is filed in a national stage application under 35 U.S.C. § 371, the application is still subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499

PTO/SB/30 (06-00)

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<h2 style="margin: 0;">REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL</h2> <p style="font-size: small; margin-top: 10px;">Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995. See The American Inventors Protection Act of 1999 (AIPA).</p>	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr><td style="padding: 2px;">Application Number</td><td style="width: 100px;"></td></tr> <tr><td style="padding: 2px;">Filing Date</td><td></td></tr> <tr><td style="padding: 2px;">First Named Inventor</td><td></td></tr> <tr><td style="padding: 2px;">Group Art Unit</td><td></td></tr> <tr><td style="padding: 2px;">Examiner Name</td><td></td></tr> <tr><td style="padding: 2px;">Attorney Docket Number</td><td></td></tr> </table>	Application Number		Filing Date		First Named Inventor		Group Art Unit		Examiner Name		Attorney Docket Number	
Application Number													
Filing Date													
First Named Inventor													
Group Art Unit													
Examiner Name													
Attorney Docket Number													

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**NOTE:** 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. § 1.114**

a.  Previously submitted

i.  Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on \_\_\_\_\_  
(Any unentered amendment(s) referred to above will be entered).

ii.  Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_

iii.  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 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)

b.  Other \_\_\_\_\_

3. **Fees** The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

a.  The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. \_\_\_\_\_

i.  RCE fee required under 37 C.F.R. § 1.17(e)

ii.  Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)

iii.  Other \_\_\_\_\_

b.  Check in the amount of \$ \_\_\_\_\_ enclosed

c.  Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED			
Name (Print/Type)		Registration No. (Attorney/Agent)	
Signature		Date	

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: Commissioner For Patents, Box RCE, Washington, DC 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on:			
Name (Print/Type)		Date	
Signature		Date	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Assistant Commissioner for Patents, Box RCE, Washington, DC 20231.



Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
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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).
- 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) or a CPA under 37 CFR 1.53(d).
- 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:** If a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) has been filed in the utility or plant application (including a previously filed CPA) that was filed on or after May 29, 2000, **the request for a CPA has been treated as a RCE** because the CPA practice no longer applies to such application. The constructive RCE, however, is improper for reason(s) indicated above.

***A copy of this notice MUST be returned with any reply.***

Direct the reply and any questions about this notice to:

\_\_\_\_\_, Examining Group \_\_\_\_\_

(703) 30 \_\_\_\_\_  
FORM PTO-2051 (Rev. 3/2001)

## 707 Examiner's Letter or Action

### 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.

(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 (703) [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 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 (703) [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 (703) [7]. The fax phone number for the organization where this application or proceeding is assigned is (703) [8].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [9].

#### Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual 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 phone number.
7. In bracket 8, insert the appropriate fax number for your organization.
8. In bracket 9, insert the telephone number for your receptionist.

*¶ 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 (703) [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 (703) [8]. The fax phone number for the organization where this application or proceeding is assigned is (703) [9].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [10].

**Examiner Note:**

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual 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 phone number.
8. In bracket 9, insert the appropriate fax number for your organization.
9. In bracket 10, insert the telephone number for your receptionist.

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.



<b>Office Action Summary</b>	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) 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 the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- 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).

11)  The proposed drawing correction filed on \_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  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.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other:

### 707.01 Primary Examiner Indicates Action for New Assistant

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 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

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 official 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 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

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. 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. See MPEP § 1302.12. In a continued prosecution application filed under 37 CFR 1.53(d) or a file wrapper continuing application filed under former 37 CFR 1.62, 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' attorney 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; or

(E) are U.S. Patents which are cited at allowance (MPEP § 1302.04).

### 707.05(a) Copies of Cited References

Copies of cited 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 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. 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 continuation 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 references, the examiner should:

(A) Write the citation of the references on form PTO-892, "Notice of References Cited";

(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 and which have been obtained from the classified search file;

(D) Make two copies of each reference which is to be supplied and which has been located in a place

other than the classified search file (e.g., textbooks, bound magazines, personal search material, etc.). Using red ink identify one copy as "File Copy" and the other copy as "Applicant's Copy". Both copies should be placed in the application file wrapper;

(E) 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.

In the case of design applications, procedures are the same as set forth in MPEP § 707.05 (a)-(g) except that less than the entire disclosure of a cited U.S. utility patent may be supplied with the action by the Design Group. Copies of all sheets of drawings relied on and of the first page of the specification are furnished without charge. Any other subject matter, including additional pages of specification relied on by the examiner will be provided without charge. Where an applicant desires a complete copy of a cited U.S. patent, it may be obtained through Patent and Trademark Copy Sales at the usual charge.

<b>Notice of References Cited</b>	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.

### 707.05(b) Citation of Related Art and Information by Applicants

#### CITATION OF RELATED ART BY APPLICANTS

MPEP § 609 sets forth positive 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 pertinent prior art of which they may be aware, whether or not such art is cited by the applicant.

Prior art submitted by applicant in the manner provided in MPEP § 609 will not be supplied with an Office action.

#### 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 pertinent prior art of which they may be aware, whether or not such art is cited by the applicant.

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

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 PTO-1449 or PTP/SB/08 that has been initialled by the examiner.

### 707.05(e) Data Used in Citing References

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).

#### 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.

#### FOREIGN PATENTS AND 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."

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.

## PUBLICATIONS

See MPEP § 711.06(a) for citation of abstracts, abbreviations and defensive publications. 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. T117653.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.

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.

## 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+Seventh+Revised+Edi>>



tion%2C+1996&dload=0&path=/ext5/  
extra&name=054265%2Erdo&docid=00805F50F  
E7b%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

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.

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 paragraph must be followed by one or more of 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 paragraph must follow paragraph 7.81.
3. If a copy of the PTO-892 is being provided without correction, use paragraph 7.83 instead of this 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 reference copies being supplied must be listed following this paragraph.
2. This paragraph must be preceded by paragraph 7.81 and may also be used with 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 paragraph should follow paragraph 7.81 and may follow 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

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 Commissioner'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

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. 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 paragraph would be appropriate when changes must be made prior to allowance. For example, when there is a requirement for drawing corrections that have to be submitted for approval or when corrections to the specification have to 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

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 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 7.38 may be used where applicant's arguments are not persuasive or are moot.

#### ¶ 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.

¶ 7.37.01 *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. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

**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, § 806.02, § 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**

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 his-

tory through successive actions is thus easily traceable. Each action should conclude with a summary of all claims presented for examination.

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 § 821.03 and § 809.02(c).

See MPEP § 2363.03 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.

#### **707.07(j) State When Claims Are Allowable**

##### **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.

##### **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.

### 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

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 only when the noted independent claim(s) 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) 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

Claim [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

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 (703) [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 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 (703) [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 (703) [7]. The fax phone number for the organization where this application or proceeding is assigned is (703) [8].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [9].

#### Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual 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 phone number.
7. In bracket 8, insert the appropriate fax number for your organization.
8. In bracket 9, insert the telephone number for your receptionist.

### ¶ 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 (703) [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 (703) [8]. The fax phone number for the organization where this application or proceeding is assigned is (703) [9].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [10].

#### Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual 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 phone number.
8. In bracket 9, insert the appropriate fax number for your organization.
9. In bracket 10, insert the telephone number for your receptionist.

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

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."

### 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

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.

### 707.13 Returned Office Action

Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. The examiner should use every reasonable means to ascertain the correct address and forward the action again, after stamping it "remailed" with the date thereof and redirecting it if there is any reason to believe that the action would reach applicant at such new address. If the Office action was addressed to an attorney, 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. If the period dating from the remailing

elapses with no communication from applicant, the application is abandoned.

## 708 Order of Examination

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 applicant 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 Commissioner.

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) and to reexamination proceedings involved in litigation (MPEP § 2261), 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

#### *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 Commissioner 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 Commissioner, 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 Commissioner 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 Commissioner or an Assistant 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.

See also MPEP § 714.13, § 1207 and § 1309.

## 708.02 Petition To Make Special

*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 Commissioner 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 Commissioner, 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).

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.

### 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).

### 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).

### 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. Such petitions should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the inventions contribute to the restoration or maintenance

of one of these life-sustaining elements. No fee is required for such a petition. See 37 CFR 1.102(c).

### 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), 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. Such petitions should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how 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).

### 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. A search made by a foreign patent office satisfies this requirement;

(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 relating to counter-terrorism inventions.

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.

Applicants who desire that an application relating to inventions for countering terrorism be made special should file a petition with the petition 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 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).

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**

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.

## 709 Suspension of Action

### 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(h), 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 examination 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 § 1.494 or § 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 Commissioner 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 Subpart E of this part.

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).

## 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(h)	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(h),
- (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) or a request for continued examination (RCE) under 37 CFR 1.114. 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.

**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), 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. The period of suspension will start on the date that the Office grants the filing date for the CPA, or recognizes the proper RCE.

**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 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).

**Missing Parts for the CPA (Filing Date Granted)**

If the Office assigns a filing date to the CPA, the request for suspension will be processed, even if the

CPA was not accompanied by the CPA filing 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 filing fee and the surcharge set forth in 37 CFR 1.16(e). Applicant must pay the CPA filing 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.

**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 Filing Under 37 CFR 1.53(d) or a Notice of Improper Request for Continued Examination 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.

**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:

### 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).

### 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 1.494 or 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); or if the application is filed before November 29, 2000, the applicant must submit:

(1) a request for voluntary publication under 37 CFR 1.221 (see the first check box on the form PTO/SB/37),

(2) the fee for the voluntary publication set forth in 37 CFR 1.17(i),

(3) a copy of the application in compliance with the Office's electronic filing system (EFS) requirements, and

(4) the confirmation number;

(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.

### 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--.

### 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.

### AT THE INITIATIVE OF THE OFFICE

37 CFR 1.103(e) provides that the Office will notify applicant if the Office suspends action in an application on its own initiative. An examiner may grant an initial suspension of Office action on his or her own initiative, as in MPEP § 709.01 and § 2315.01, for a maximum period of 6 months. Any second or subsequent suspension of action in patent applications under 37 CFR 1.103(e) are decided by the TC Director. See MPEP § 1003.

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.

### ¶ 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 6 months.
2. The TC Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. The TC Director's approval must appear on the letter granting any second or subsequent suspension.

PTO/SB/37 (01-01)  
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 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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### Request for Deferral of Examination 37 CFR 1.103(d)

Application Number		Group Art Unit	
Filing Date		Examiner Name	
First Named Inventor		Attorney Docket Number	

Address to: Assistant Commissioner for Patents  
 Washington, D.C. 20231

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 the application is filed prior to November 29, 2000:

I hereby request voluntary publication of the above-identified application under 37 CFR 1.221. A copy of the application in compliance with the Office's electronic filing system requirements has been submitted and the confirmation number is \_\_\_\_\_.

*Note:* A request for voluntary publication under 37 CFR 1.221 requires a copy of the application in compliance with the Office's electronic filing system requirements (EFS) as set forth in the USPTO Electronic Business Center Web Page at [www.uspto.gov/ebc](http://www.uspto.gov/ebc), the publication fee set forth in 37 CFR 1.18(d), and the processing fee for the voluntary publication set forth in 37 CFR 1.17(i).

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 Commissioner is hereby authorized to charge the following fees, or credit any overpayment, to Deposit Account No. \_\_\_\_\_
  - 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).

*Note:* The publication fee set forth in 37 CFR 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 of Applicant, Attorney, or Agent in Compliance with 37 CFR 1.33(b) Required			
Name (Print/Type)		Registration Number (Attorney/Agent)	
Signature		Date	
<p><i>Note:</i> Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms for more than one signature, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Assistant Commissioner for Patents, Washington, DC 20231.

### 709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee

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.

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

### 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 that another consequence, such as disclaimer, will take place.

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(b), (c), or (d)), 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

### 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 § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or

(v) The application is involved in an interference declared pursuant to § 1.611.

(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 § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 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 § 1.645 for extensions of time in interference proceedings.

(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; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings; and § 1.956 for extensions of time in *inter partes* reexamination proceedings.

(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 Commissioner 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 reexamination proceedings.

### **710.02(b) Shortened Statutory Period: Situations In Which Used**

Under the authority given him or her by 35 U.S.C. 133, the Commissioner 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 § 2363.02.

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**

Incorrect citation by examiner — regardless of time remaining in original period .... MPEP § 710.06.

### **710.02(c) Specified Time Limits: Situations In Which Used**

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(e) 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.

(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 nonelected 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 § 809.02(c) and § 821.01.

(D) A portion of 37 CFR 1.605(a) provides that in suggesting claims for interference:

The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim.

The failure to timely present the suggested claim will not result in abandonment of the application, but will be treated as a disclaimer by the applicant of the invention defined by the suggested claim. See MPEP § 2305.02.

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**

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 1.192(a)) and the 1-month time period for filing a new appeal brief to correct the deficiencies in a defective appeal brief (37 CFR 1.192(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 1.192(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 issue 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

#### 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 § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or
- (v) The application is involved in an interference declared pursuant to § 1.611.

(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 § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 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 § 1.645 for extensions of time in interference proceedings.

(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; § 1.645 for extensions of time in interference proceedings; § 1.550(c) for extensions of time in *ex parte* reexamination proceedings; and

§ 1.956 for extensions of time in *inter partes* reexamination proceedings.

(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 1.645.

It should be very carefully noted that neither the primary examiner nor the Commissioner 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. 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 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);

(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 are set forth in 37 CFR 1.17(a) and are subject 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)(1) 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)(1) 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 a mere sentence such as

The applicant herewith petitions the Commissioner of Patents and Trademarks 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. Utilization of this proce-

cedure 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.

For purposes of convenience, a request for an extension of time may be personally delivered and left with the appropriate area to become an official paper in the file without routing through the Mail Center. The person who accepts the request for an extension of time will have it date stamped.

If duplicate copies of a request for an extension of time under 37 CFR 1.136(b) are hand delivered to a TC, both copies are dated, either stamped approved or indicated as being approved in part or denied, and signed. The duplicate copy is returned to the delivering person regardless of whether the request was signed by a registered attorney or agent, either of record or acting in a representative capacity, the applicant or the assignee of record of the entire interest.

If the request for extension under 37 CFR 1.136(b) is not presented in duplicate, the applicant should be advised promptly regarding action taken on the request 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 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 (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.

**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.

See also MPEP § 706.07(f).

**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. *In re Affidavit Filed After Final Rejection*, 152 USPQ 292 (Comm'r Pat. 1966).

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.

#### **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 must be paid within the 3-month period.

#### **710.04 Two Periods Running**

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 § 2305.03.

#### **710.04(a) Copying Patent Claims**

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 § 2305.02.

#### **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

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. 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 reamain any action (MPEP § 707.13), the action should be correspondingly redated, as it is the reamaining 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).

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).

#### **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.

#### **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 correspondence 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

*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 including an associate attorney or agent appointed by the principal attorney or agent and whose power is 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.

### 711.01 Express or Formal Abandonment

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 different 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.

Action in recognition of an express abandonment may take the form of an acknowledgment by the examiner or 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 examiner 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) or a file wrapper continuing application under former 37 CFR 1.62(g) is considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application.

Form paragraph 7.88 may be used to acknowledge proper express abandonments.

#### ¶ 7.88 Acknowledge Express Abandonment

This application is abandoned in view of the letter of express abandonment complying with 37 CFR 1.138 filed on [1].

#### Examiner Note:

1. With the exception of express abandonments resulting from the filing of a continued prosecution application under 37 CFR 1.53(d) or a file wrapper continuation application under former 37 CFR 1.62 or when filed with a continuing application, all express abandonments must be signed by all of the inventors, the owners of the entire interest, or an attorney or agent of record.
2. The provisions of 37 CFR 1.34 do **not** apply to express abandonments unless filed with a continuing application.

If the letter expressly abandoning the application does comply with 37 CFR 1.138, the examiner should respond by using a "Notice of Abandonment" form PTO-1432, and by checking the appropriate box(es). The examiner's signature should appear at the bottom of the form. If such a letter does not comply with the requirements of 37 CFR 1.138, a fully explanatory letter should be sent.

Form paragraph 7.89 may be used to acknowledge improper express abandonments.

#### ¶ 7.89 Letter of Express Abandonment, Improper

The letter filed on [1] does not comply with the requirements of 37 CFR 1.138, and therefore is not a proper letter of express abandonment.

#### Examiner Note:

The reasons why the letter fails to comply with 37 CFR 1.138 must be fully explained, e.g., the individual signing the express abandonment is not of record. See the "Examiner Note" of form paragraph 7.88.

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 endorsed on the file wrapper and placed in the application file but not formally entered.

The application should be pulled for abandonment after expiration of the minimum 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 Lass-cell*, 1884 C.D. 66, 29 O.G. 861 (Comm'r Pat. 1884), an amendment filed after the filing date of an application canceling all of the claims, even though said amendment is signed by the applicant himself/herself and the assignee, is not an express abandonment. Such an amendment is regarded as nonresponsive and should not be entered, and 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 withdrawal would result in abandonment of the application. In such instances the withdrawal of appeal is in fact an express abandonment.

## AFTER NOTICE OF ALLOWANCE

If a letter of express abandonment is being submitted in an allowed application, the express abandonment should be accompanied by a petition to withdraw from issue under 37 CFR 1.313 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 act before the date of issue. 37 CFR 1.313 provides that an allowed application will not be withdrawn from issue except by approval of the Commissioner, and that after the issue fee has been paid, it 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 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.

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.

#### **TO AVOID PUBLICATION OF APPLICATION**

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) should be addressed to Box PGPUB-ABN. 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. 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).

#### **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.

#### **FORM FOR FILING EXPRESS ABANDONMENT**

A copy of an appropriate form for use in filing an express abandonment under 37 CFR 1.138 in favor of a continuing application or to avoid publication of the application is reproduced below.

PTO/SB/24 (10-00)  
 Approved for use through 09/30/2000. 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.

<b>EXPRESS ABANDONMENT UNDER 37 CFR 1.138</b>	Docket Number (Optional)								
<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 2px;">In re Application of</td> </tr> <tr> <td style="width: 60%; padding: 2px;">Application Number</td> <td style="padding: 2px;">Filed</td> </tr> <tr> <td colspan="2" style="padding: 2px;">For</td> </tr> <tr> <td style="width: 40%; padding: 2px;">Group Art Unit</td> <td style="padding: 2px;">Examiner</td> </tr> </table>		In re Application of		Application Number	Filed	For		Group Art Unit	Examiner
In re Application of									
Application Number	Filed								
For									
Group Art Unit	Examiner								
<p>To:</p> <p>Assistant Commissioner for Patents                  Washington, DC 20231</p> <p>I request that the above-identified application be expressly abandoned as of the filing date of this paper unless a box below is checked.</p> <p>1. <input type="checkbox"/> I hereby petition to expressly abandon the above-identified application to avoid publication. (Petition fee under 37 CFR 1.17(h) included).</p> <p>2. <input type="checkbox"/> I request that the above-identified application be expressly abandoned as of the filing date accorded the continuing application filed herewith.</p> <p>NOTE: A paper requesting express abandonment of an application is not effective unless and until an appropriate Office official recognizes the paper. See MPEP 711.01</p> <p>I am the</p> <p><input type="checkbox"/> applicant.</p> <p><input type="checkbox"/> 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).</p> <p><input type="checkbox"/> attorney or agent of record.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a) (May act only if the box 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(a).</p> <p>_____                  (Attorney or agent registration number)</p> <p>_____                  Signature</p> <p>_____                  Date</p> <p>_____                  Typed or printed name</p> <p>Note: Signatures of all the inventors or assignees of record of the entire interest or their representatives(s) are required. Submit multiple forms if more than one signature is required. See below*.</p> <p>* <input type="checkbox"/> Total of _____ forms are submitted.</p>									

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



## 711.02 Failure To Take Required Action During Statutory Period

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 endorsed on 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 Commissioner 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(c); 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(c) 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(c) (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 Commissioner 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:

Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX:

(703) 308-6916  
Attn: Office of Petitions

By hand:

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Telephone inquiries with respect to this matter should be directed to the Office of Petitions Staff at (703) 305-9282. 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 paragraph; instead use form paragraph 7.95.

### 711.02(b) Special Situations Involving Abandonment

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 § 2305.

(E) Where an FWC application under former 37 CFR 1.62 was filed. See MPEP § 201.06(b) and § 711.01.

(F) Where a continued prosecution application (CPA) under 37 CFR 1.53(d) is filed. See MPEP § 201.06(d) and § 711.01.

(G) Prior to a decision by the Board, an application on appeal that has no allowed claims may become abandoned when an 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.

(H) 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.

(I) 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 reconsidera-

tion 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

*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 Commissioner 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 Commissioner 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 dis-

claimer 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, 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 Commissioner.**

(a) Petition may be taken to the Commissioner:

(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 Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

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(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.

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## 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.

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 treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is

accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), **subject to such other requirements as may be imposed**). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(d) because abandonment of an application is a *per se* failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a *per se* failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned.

In any event, 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. 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. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

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).

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 upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

## III. 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 Commissioner 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 Commissioner 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.

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 non-provisional 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 utility or plant application filed before May 29, 2000, or 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 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 a request for continued examination (RCE) (accompanied by a submission 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 utility or plant application filed before May 29, 2000, or 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 1.192 for filing the appeal brief will be set by the Commissioner 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." 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.

### (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 1.192(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 utility or plant application filed before May 29, 2000, or 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; and

(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). An applicant who has made a nonpublication request but who subsequently files an application directed to the invention disclosed in the application filed in the Office in a foreign country, or under a multilateral international agreement, that requires eighteen-month publication, must notify the Office of such filing within forty-five days after the date of such filing. The failure to timely provide such a notice to the Office will result in the abandonment of the application. See 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.

### **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 or PTO/SB/64PCT).

EXAMINATION OF APPLICATIONS

711.03(c)

PTO/SB/64 (10-00)

Approved for use through 10/31/2002. 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.

<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)</b>	Docket Number (Optional)
<p>First named inventor:</p> <p>Application No.: _____ Group Art Unit: _____</p> <p>Filed: _____ Examiner: _____</p> <p>Title: _____</p> <p>Attention: Office of Petitions Assistant Commissioner for Patents Box DAC Washington, D.C. 20231</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact Petitions information at (703) 305-9282.</p> <p>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.</p> <p style="text-align: center;"><b>APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</b></p> <p>NOTE: A grantable petition requires the following items:</p> <ol style="list-style-type: none"> <li>(1) Petition fee;</li> <li>(2) Reply and/or issue fee;</li> <li>(3) Terminal disclaimer with disclaimer fee --required for all utility and plant applications filed before June 8, 1995; and for all design applications; and</li> <li>(4) Statement that the entire delay was unintentional.</li> </ol> <p>1. Petition fee</p> <p><input type="checkbox"/> Small entity-fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Other than small entity - fee \$ _____ (37 CFR 1.17(m))</p> <p>2. Reply and/or fee</p> <p>A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):</p> <p><input type="checkbox"/> has been filed previously on _____.</p> <p><input type="checkbox"/> is enclosed herewith.</p> <p>B. The issue fee of \$ _____.</p> <p><input type="checkbox"/> has been paid previously on _____.</p> <p><input type="checkbox"/> is enclosed herewith.</p>	

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 1.0 hour to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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)(III)(C) and (D))].

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_____	_____
Date	Signature
Telephone Number: (____) _____	_____
	Typed or printed name
	_____
	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: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.
- transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

_____	_____
Date	Signature
	_____
	Type or printed name of person signing certificate

## 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 may be used to file a petition for revival of an unavoidably abandoned application.



EXAMINATION OF APPLICATIONS

711.03(c)

PTO/SB/61 (10-00)

Approved for use through 10/31/2002. 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.

<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)</b>	Docket Number (Optional)
<p>First named inventor: _____ Group Art Unit: _____</p> <p>Application Number: _____ Examiner: _____</p> <p>Filed: _____</p> <p>Title: _____</p> <p>Attention: Office of Petitions Assistant Commissioner for Patents Box DAC Washington, D.C. 20231</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.</p> <p>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 any extensions of time actually obtained.</p> <p style="text-align: center;"><b>APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</b> NOTE: A grantable petition requires the following items:</p> <ol style="list-style-type: none"> <li>(1) Petition fee;</li> <li>(2) Reply and/or issue fee;</li> <li>(3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995, and for all design applications; and</li> <li>(4) Adequate showing of the cause of unavoidable delay</li> </ol> <p>1. Petition fee</p> <p><input type="checkbox"/> small entity - fee \$ _____ (37 CFR 1.17(l)). Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> other than small entity - fee \$ _____ (37 CFR 1.17(l)).</p> <p>2. Reply and/or fee</p> <p>A. The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):</p> <p><input type="checkbox"/> has been filed previously on _____</p> <p><input type="checkbox"/> is enclosed herewith.</p> <p>B. The issue fee of \$ _____</p> <p><input type="checkbox"/> has been paid previously on _____</p> <p><input type="checkbox"/> is enclosed herewith.</p>	

[Page 1 of 3]

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PTO/SB/61 (10-00)

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**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 of \$\_\_\_\_\_ 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.

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\_\_\_\_\_ Date \_\_\_\_\_ Signature

Telephone \_\_\_\_\_  
Number: (\_\_\_\_) \_\_\_\_\_ Typed or printed name

\_\_\_\_\_ Address

- Enclosures:  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: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.
- transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

\_\_\_\_\_ Date \_\_\_\_\_ Signature

\_\_\_\_\_ Typed or printed name of person signing certificate

PTO/SB/61 (10-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**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.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Signature

\_\_\_\_\_  
Typed or printed name

(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 necessary)*

**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 Commissioner 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 Commissioner 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 filed before June 8, 1995; or

(C) a nonprovisional plant application filed before June 8, 1995.

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 applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, or to lapsed patents.

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 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031  
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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<b>TERMINAL DISCLAIMER TO ACCOMPANY PETITION</b> (Period Specified)	Docket Number (Optional)						
<p>In re Application of:</p> <p>Name:</p> <p>Application Number:</p> <p>Filed:</p> <p>For:</p> <p>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.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> 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.</p> <p>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 the 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.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: center; margin-top: 20px;"> <table style="width: 100%; border: none;"> <tr> <td style="border-top: 1px solid black; width: 60%;"></td> <td style="border-top: 1px solid black; width: 40%;"></td> </tr> <tr> <td style="text-align: center;">Signature</td> <td style="text-align: center;">Date</td> </tr> <tr> <td colspan="2" style="border-top: 1px solid black; text-align: center; padding-top: 5px;">                     Typed or printed name                 </td> </tr> </table> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p><b>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.</b></p> <p>* 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.</p>				Signature	Date	Typed or printed name	
Signature	Date						
Typed or printed name							

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/63 (10-00)

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U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE

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TERMINAL DISCLAIMER TO ACCOMPANY PETITION	Docket Number (Optional)
<p>In re Application of:  Name:  Application Number:  Filed:  For:</p>	
<p>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.</p>	
<p>Check either box 1 or 2 below, if appropriate.</p>	
<p>1. <input type="checkbox"/> 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.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p>	
<p>_____  Signature Date</p>	
<p>_____  Typed or printed name</p>	
<p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p>	
<p><b>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.</b></p>	
<p>* 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.</p>	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



## 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) pro-

vides 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

37 CFR 1.181 states that the examiner “may be directed by the Commissioner 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

Access to an abandoned application may be provided to any person, subject to 37 CFR 1.14(i), if a written request for access is submitted and if the abandoned application is not within the file wrapper of a

pending continued prosecution application (CPA) under 37 CFR 1.53(d) and is referred to:

(A) in a U.S. patent application publication or patent;

(B) in another U.S. application which is open to public inspection either pursuant to 37 CFR 1.11(b) or 37 CFR 1.14(e)(2)(i); or

(C) in an international application which designates the U.S. and is published in accordance with PCT Article 21(2).

See 37 CFR 1.14(e)(2). A copy of the specification, drawings, and papers relating to the file of an abandoned published application may also be provided to any person upon written request, including the fee set forth in 37 CFR 1.19(b)(2). See 37 CFR 1.14(c)(2). See also MPEP § 103. Form PTO/SB/68 may be used to request access of an application under 37 CFR 1.14(e).

#### **711.04(a) Pulling and Forwarding Abandoned Applications**

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**

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).

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.

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.

### **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, Abbreviations, and Defensive Publications**

#### **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.

#### **ABBREVIATURES**

Abbreviations were prepared and published in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviation 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 abbreviations was discontinued in 1965.

#### **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.

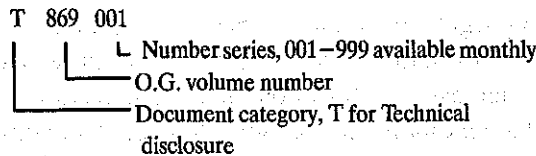
If a first continuing application was filed within 30 months from the earliest U.S. effective filing date of the application published under the Defensive Publication Program, later copending continuing applications (such as divisions if restriction is required during the prosecution of the first continuing 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).

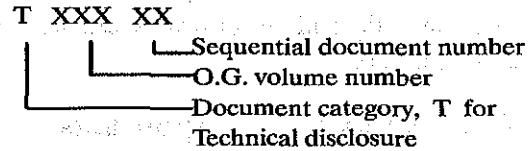
**Defensive Publication Number**

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, Abbreviations, and Defensive Publications as References**

It is important that abstracts, abbreviations, 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 *In re Osmond*, 191 USPQ 340 (Bd. App. 1976). See also MPEP § 2136.

An application or portion thereof from which an abstract, abbreviation or defensive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 U.S.C. 102(a), effective from the actual date of filing in the United States.

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 Abbreviations are listed under "Other References" in the citation thereof as follows:

(A) Abstracts and Abbreviations

Brown, (abstract or abbreviation) of Serial No. ...., filed ....., published in O.G. ...., on ..... (list classification).

(B) Applications or designated portions thereof,

abstracts, abbreviations, 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

#### *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 Commissioner.

(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 on any working day except during periods of overtime work.

### 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 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.

## 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 Patent Academy 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 or trademark examining attorney and identify two alternative dates and times for a video conference. The patent examiner or trademark examining attorney will then contact Patent Academy personnel who will, in turn, make all the arrangements. The customer will be notified as to the date and time of the video conference.

### 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. 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 FTS (Federal Telecommunications 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 notify their receptionist, immediately prior to an interview, to not complete 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 said 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.

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.

### **VIEWING OF VIDEO TAPES DURING INTERVIEWS**

The U.S. Patent and Trademark Office has video tape equipment available in the facilities of the Patent Academy 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 Training Manager to avoid any conflict with the Patent Academy.

Requests to use video tape viewing equipment for an interview should be made at least 1 week in advance to allow the Patent Academy 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 Patent Academy facilities located in Crystal Square Four, Suite 700, 1745 Jefferson Davis Highway, Arlington, VA 22202. Attorneys or applicants should not contact the Patent Academy 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.

### **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.

### **713.02 Interviews Prior to First Official Action**

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 counsellor 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

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

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(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, unless the examiner indicates he or she will do so. 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. 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. In a personal interview, the duplicate copy of the Interview Summary form 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 both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Interview Summary form or in an attachment to the form, the examiner will check a box at the bottom of the form informing the applicant that he or she need not supplement the form by submitting a separate record of the substance of the interview.

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 unless already described in the Interview Summary form completed by the examiner; 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.

### 713.05 Interviews Prohibited or Granted, Special Situations

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 or do not have in their possession a copy of the application file. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

However, interviews may be granted to registered individuals who are known to be the local representatives of the attorney in the application, even though a power of attorney to them is not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. See MPEP § 408.

If a registered individual seeking an interview has in his or her possession a copy of the application file, the examiner may accept his or her statement that he or she is authorized to represent the applicant under 37 CFR 1.34 or is the person named as the attorney or agent of record.

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

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney which complies with 37 CFR 1.91 and which is made part of the application record must be properly recorded on the "Contents" portion of the application file wrapper. See MPEP § 608.03 and § 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. If the model or exhibit is merely used for demonstration purpose and is not 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 accom-

plished 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

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 other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825).—*

(1) *Amendment by instruction to delete, replace, or add a paragraph.* Amendments to the specification, other than the

claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(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 to delete that section of the specification and to replace such deleted section with a replacement section;

(ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification;

(ii) A substitute specification in compliance with § 1.125(b); and

(iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification. The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) *Reinstatement.* Deleted matter may be reinstated only by a subsequent amendment presenting the previously deleted matter.

(c) *Claims.* —

(1) *Amendment by rewriting, directions to cancel or add.* Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., “amended,” “twice amended,” or “new”).

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., “amended,” “twice amended,” etc. The parenthetical expression “amended,” “twice amended,” etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled 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.

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

(d) *Drawings.* Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(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)(1) of this section is not required.

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(i) *Amendments in reexamination proceedings:* Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both *ex parte* reexaminations filed under § 1.510 and *inter partes* reexaminations filed under § 1.913 must be made in accordance with § 1.530(d)-(j).

(j) *Amendments in provisional applications:* 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 this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

## 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; and

(C) 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.

## MANNER OF MAKING AMENDMENTS

After March 1, 2001, all amendments to the specification, including the claims, must be made by replacement paragraph/section/claim in clean form (without underlining and bracketing) in order to eliminate (1) the need for the Office to enter changes to the text of application portions by handwriting in red ink, and (2) the presence of hard to scan brackets and underlining to improve the patent publishing process. This practice requires the applicant to provide a clean copy of an amended paragraph/section/claim together with a marked up version using applicant's choice of a marking system showing the changes being made which will aid the examiner. The marked up version must be based on the immediate previous version and indicate (by markings) how the previous version has been modified to produce the clean replacement paragraph(s), section(s), specification or claim(s) submitted in the current amendment. "Previous version" is defined as the version of record in the application as originally filed or from a previously entered amendment.

## *Amendments to the 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 the replacement paragraph(s) in clean form.

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 replacement or added paragraph(s) be in clean form. This means that the added or replacement paragraph(s) must not include any markings to indicate the changes that have been made. 37 CFR 1.121(b)(1)(iii) requires that a separate version of the replacement paragraph(s) accompany the amendment. The separate version must include each replacement paragraph with markings to show the changes relative to the previous version as an aid to the examiner. A marked up version, however, does not have to be supplied for any added paragraph(s) or any deleted paragraph(s), as it is sufficient to merely indicate or identify any paragraph that has been added or deleted.

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 in clean form, that is, without any markings to show the changes that have been made. A separate marked up version showing the changes in the section relative to the previous

version must accompany the actual amendment as an aid to the examiner.

Applicants are also permitted to amend the specification by submitting a substitute specification, provided the requirements of 37 CFR 1.125(b) are met. An accompanying separate marked up version showing the changes in the specification relative to the previous version is also required.

Any subject matter deleted by amendment 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.

### *Amendments to the Claims*

All amendments to a claim must be presented in the form of a rewritten claim. Any rewriting of a claim will be construed as a direction to cancel the previous version of the claim. See *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956)(amendment of a claim by inclusion of an additional limitation had exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation). Any rewritten or newly added claim must be submitted in clean form, that is, with no markings to indicate the changes that have been made, and must be accompanied by a marked up version separate from the amendment using applicant's choice of marking system to indicate the changes being made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added, e.g., "amended," "twice amended," or "new," in both the clean version and the marked up version. A marked up version does not have to be supplied for any added claims or any canceled claims. If a marked up version is supplied to show changes made to amended claims, however, applicant should identify (in the marked up version) any added or canceled claims with a statement, such as, "Claim 6 has been canceled." A canceled claim can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Applicants may submit a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants may wish to consolidate all previous versions of pending claims from a series of

separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not appear in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended. See MPEP § 714.13 for submitting a clean set of claims under 37 CFR 1.116 and MPEP § 714.16 for submitting a clean set under 37 CFR 1.312. See also MPEP § 714.22(a).

It is recommended that the following format be used by applicants in complying with the revised amendment practice requirements. The amendment paper should include, in the following order:

- (A) a clean version of the amended (replacement) paragraph(s)/claim(s);
- (B) a remarks section (beginning on a separate sheet); and
- (C) a marked-up version (also beginning on a separate sheet) showing changes and clearly identified as **"Version with markings to show changes made."**

The submission of a clean version of all pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining and bracketing, a marked up version should not be submitted.

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. See MPEP § 1302.04.

## AMENDMENT IN REEXAMINATION PROCEEDINGS

In patent-owner-filed reexaminations, the patent owner may amend at the time of the request for reexamination in accordance with 37 CFR 1.510(e). In any reexamination proceeding, no amendment or response can be filed between the date of the request for reexamination and the order for reexamination. See 37 CFR 1.530(a). Following the order for reexamination under 37 CFR 1.525 and prior to the examination phase of a 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 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 reexamination proceedings see MPEP § 2250 and § 2266.

### 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

37 CFR 1.33. *Correspondence respecting patent applications, reexamination proceedings, and other proceedings*

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(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 attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(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.

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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.

If copies of papers which require an original signature as set forth in 37 CFR 1.4(e) are filed, the signature must be applied after the copies are made. MPEP § 714.07.

When an unsigned or improperly signed amendment is received the amendment will be listed on the file wrapper, 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**

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). 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.

A preliminary amendment not filed along with the original application does not enjoy the status of part of the original disclosure. See MPEP § 608.04(b). Where an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. Any

copy of the application as filed must include a copy of the amendment as well, particularly where certified copies for priority purposes are requested.

Preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date. See MPEP § 502.

Any amendment canceling claims in order to reduce the filing fee should be filed with the application. Since only amendments canceling claims are entered before the filing fee is calculated, any other changes to the claims and/or specification should be part of a separate amendment. See MPEP § 506.

If a preliminary amendment 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 no corrective action is taken by the applicant, examination of the application may commence without entry of the proposed non-compliant preliminary amendment. See MPEP § 714.03.

A preliminary amendment will be entered unless it is disapproved by the Commissioner. A preliminary amendment may be disapproved by the Commissioner if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b). See MPEP § 714.03(a).

## **714.02 Must Be Fully Responsive**

*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) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.



(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 to 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. 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) and (c) may be held not fully responsive if both a clean version and a marked up version showing changes to the respective parts of the specification/claims are not provided. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

### 714.03 Amendments Not Fully Responsive, Action To Be Taken

37 CFR 1.135. Abandonment for failure to reply within time period.

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(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.

If an amendment submitted after March 1, 2001, fails to comply with 37 CFR 1.121 (as revised on September 8, 2000), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule. If the amendment that fails to comply with the requirements of the rule is a preliminary amendment, the Legal Instruments Examiner (LIE) will send the Notice which sets a time limit 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. If the amendment which fails to comply with the requirements of the rule is an amendment after a non-final Office action, the LIE will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply (37 CFR 1.135). Extensions of time are permitted (37 CFR 1.136(a)). Failure to reply to this Notice will result in abandonment of the application. See MPEP § 714.22 for treatment of non-compliant amendments after final rejection.

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. 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 or appeal (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 on form PTOL-319. 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 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 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) Amendment Unduly Interferes with the Preparation of an Office Action**

### **I. PRELIMINARY AMENDMENT**

#### *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.

(b)(1) A preliminary amendment will be entered unless disapproved by the Commissioner. 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.

(2) A preliminary amendment will not be disapproved 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.

(c) The time periods specified in paragraph (b)(2) of this section are not extendable.

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 with the application or as soon as possible thereafter. Entry of a preliminary amendment will not be disapproved 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); 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). These time periods are not extendable. See 37 CFR 1.115(c).

If a preliminary amendment is filed after these time periods and the conditions set forth in paragraph III (below) are met, entry of the preliminary amendment may be denied subject to the approval of the supervisory patent examiner (MPEP § 1002.02(d)).

See MPEP § 714.01(e) for additional information pertaining to amendments before first Office action.

### **II. SECOND (OR) SUBSEQUENT SUPPLEMENTAL AMENDMENT**

#### *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) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

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Generally, a second (or subsequent) supplemental reply (i.e., the third (or subsequent) reply) will be

entered unless it unduly interferes with an Office action being prepared in response to a previous reply. For example, after the mailing of a first Office action, the applicant filed an amendment (the first reply) on 1/8/01, a supplemental amendment (the second reply) on 2/8/01, and a second supplemental reply (the third reply) on 2/28/01. If the examiner has updated the search and almost completed the Office action before the Office receives the third reply, and the third reply adds numerous claims that would require the examiner to update the search, then the examiner with the SPE's approval may deny the entry of the third reply.

Applicants are encouraged to include a complete reply to an outstanding Office action in the first reply to prevent the need for supplemental replies. If the conditions set forth in paragraph III (below) are met, the entry of a second (or subsequent) supplemental amendment may be denied subject to the approval of the supervisory patent examiner (MPEP § 1002.02(d)).

### III. WHEN DISAPPROVAL IS APPROPRIATE

The factors that will be considered for denying entry of preliminary amendments under 37 CFR 1.115 and second (or subsequent) supplemental replies under 37 CFR 1.111 are the same. The factors 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 or the second (or subsequent) supplemental reply by the Office; and

(B) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment or the second (or subsequent) supplemental reply.

The entry of a preliminary amendment or a second (or subsequent) supplemental reply would unduly interfere with the preparation of an Office action and 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 or reply is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment or reply); and

(B) the entry of the amendment or reply 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 or a second (or subsequent) supplemental reply is received by the Office, the first condition is satisfied. Entry of the amendment or reply 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,

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 or second (or subsequent) supplemental reply 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 or reply may be denied.

### IV. WHEN DISAPPROVAL IS INAPPROPRIATE

Denying entry of a preliminary amendment under 37 CFR 1.115 or a second (or subsequent) supplemental reply under 37 CFR 1.111(a)(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 or reply is received in the Office (i.e., the 37 CFR 1.6 receipt date of the amendment or reply); or

(B) the entry of the amendment or reply would NOT require significant additional time in the preparation of the Office action.

Thus, the amendment or reply 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 or the second (or subsequent) supplemental reply 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 or second (or subsequent) supplemental reply.

Furthermore, even if the examiner has devoted a significant amount of time to prepare an Office action prior to the date the preliminary amendment or the second (or subsequent) supplemental reply is received in the Office, it is not appropriate to disapprove the entry of such an amendment or reply 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.

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.

### **Form Paragraphs**

Form paragraphs 7.46 and 7.47 should be used to notify applicant that the entry of a preliminary amendment or a second (or subsequent) supplemental reply (i.e., the third (or subsequent) reply) is denied because the amendment or reply 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). The exam-

iner 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--.

#### **¶ 7.47 Second (or Subsequent) Supplemental Reply Unduly Interferes with the Preparation of an Office Action**

The second (or subsequent) supplemental reply filed on [1] was not entered because entry of the reply would unduly interfere with the preparation of the Office action. See 37 CFR 1.111(a)(2). The examiner spent a significant amount of time on the preparation of an Office action before the reply was received. On the date of receipt of the reply, the examiner had completed [2].

Furthermore, entry of the reply would require significant additional time in the preparation of the Office action. Specifically, entry of the reply 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 reply along with a responsive reply under 37 CFR 1.111 to ensure proper entry of the reply.

### **Examiner Note:**

1. In bracket 1, provide the date that the Office received the second (or subsequent) supplemental reply (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 reply. For example, where appropriate insert --the prior art search and analysis of all the arguments presented in the prior replies-- 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 reply 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 new issues raised and new claims added in the 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**

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.

(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 § 2305).

(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 § 508.01, § 804.02, § 804.03, and § 1490).

(K) If any matter involving security has been added (MPEP § 115).

### **ACTION CROSSES AMENDMENT**

A supplemental action is usually 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**

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). Although a good copy is acceptable, signatures must be applied after the copy is made if the papers require an original signature as set forth in 37 CFR 1.4(e).

See MPEP § 608.01 for more discussion on acceptable copies.

### 714.08 Telegraphic Amendment

When a telegraphic amendment is received, the telegram is placed in the file but not entered. Applicant will be notified that the telegram is not accepted as a reply to the previous Office action and is not entered. The time period for reply to the Office action continues to run and is extendable under 37 CFR 1.136.

### 714.10 Claims Added in Excess of Filing Fee

The patent statute provides for the presentation of claims added in excess of the filing fee. On payment of an additional fee (see MPEP § 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action.

### 714.11 Amendment Filed During Interference Proceedings

See MPEP § 2364.01.

### 714.12 Amendments After Final Rejection or Action

*37 CFR 1.116. Amendments after final action or appeal.*

(a) An amendment after final action or appeal 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, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. 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 patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.

(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

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 complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1207.

*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 After Final Rejection or Action, Procedure Followed**

#### **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.

#### **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(c) is expected in all amendments after final rejection. 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 appropriate. See MPEP § 201.06(d). CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000. See MPEP § 706.07(h), paragraphs I and IV.

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 § 1207 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).

Applicant may submit an amendment under 37 CFR 1.116 by presenting a clean set of all pending claims in one paper. 37 CFR 1.121(c)(3) provides for the optional submission by applicant of a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant. When rewriting a claim in the clean set, the parenthetical expression, if any, identifying the version of the previous amendment of the claim to be rewritten, should not be repeated in the clean set. If no changes are being made in the amendment presenting the clean set, the paper should be entered. If, however, the amendment includes claims being amended (and is accompanied by a marked-up version showing the changes), the examiner may choose not to enter the

amendment in view of matters relating to the provisions of 37 CFR 1.116.

### ACTION BY EXAMINER

See also MPEP § 706.07(f).

In the event that the 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. 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 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 Interview Summary PTOL-413 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 § 1207 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 paragraphs 7.67-7.80 are to be used when issuing advisory actions after a final rejection.

**¶ 7.67 Advisory After Final, Heading, Before Appeal**

The period for reply [1] to run [2] MONTHS from the mailing date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. 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. A reply within the meaning of 37 CFR 1.113 must be timely filed to avoid abandonment of this application.

**Examiner Note:**

1. This paragraph should appear as a heading in all advisory actions prior to appeal. After appeal, use paragraph 7.68.
2. In bracket 1, insert --continues-- if applicant has not submitted a petition for an extension of time along with the appropriate fee under 37 CFR 1.136. If a proper extension has been requested under 37 CFR 1.136, insert --is extended-- in bracket 1.
3. In bracket 2, insert the full statutory period resulting from any extensions of time which have been granted, e.g., --FOUR-- months.
4. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
5. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

**¶ 7.67.01 Advisory After Final, Heading, 1st Reply Filed Within 2 Months**

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, 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.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

**Examiner Note:**

1. This form paragraph should be used in all advisory actions if:
  - a. it was the FIRST reply to the to the final rejection, and
  - b. it was filed within two months of the date of the final rejection.
2. If a notice of appeal has been filed, also use form paragraph 7.68.
3. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

**¶ 7.67.02 Advisory After Final, Heading, No Variable SSP Set in Final**

Since the first reply to the final Office action was filed within TWO MONTHS of the mailing date of that action and the advisory action was not mailed within THREE MONTHS of that date, the THREE-MONTH shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the *Official Gazette* at 1027 O.G. 71, February 8, 1983. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

**Examiner Note:**

1. This form paragraph should be used in all advisory actions where:
  - a. the reply is a first reply to the final action;
  - b. the reply was filed within two months of the mailing date of the final; and
  - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.
2. If the final action set a variable SSP, do not use this form paragraph, use form paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use form paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

**¶ 7.68 Advisory After Final, Heading, After Appeal**

An appeal under 37 CFR 1.191 was filed in this application on [1]. Appellant's brief is due on [2] in accordance with 37 CFR 1.192(a).

**Examiner Note:**

1. This paragraph must precede paragraph 7.70 if the amendment is entered.
2. This paragraph must precede paragraph 7.71 if the amendment is not entered.

**¶ 7.69 Advisory After Final, Before Appeal, Amendment To Be Entered**

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Allowed claim(s):** [2]

**Rejected claim(s):** [3]

**Claim(s) objected to:** [4]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02.
2. In brackets 2-4 indicate the status of all claims.

3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.69.01 for each group of claims subject to the same rejection.

**¶ 7.69.01 Advisory Action, Proposed Rejection of Claims, Before Appeal**

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon appeal and entry of the amendment:

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. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

**¶ 7.70 Advisory After Final, After Appeal, Amendment Entered**

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

**Allowed claim(s):** [2]

**Rejected claim(s):** [3]

**Claim(s) objected to:** [4]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.68.
2. In brackets 2-4 indicate the status of all pending claims.
3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.70.01 for each group of claims subject to the same rejection.
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

*¶ 7.70.01 Advisory Action, Proposed Rejection of Claims, After Appeal*

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on 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. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

*¶ 7.71 Advisory After Final, Amendment Not Entered*

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02 if an appeal has not been taken, or by paragraph 7.68 if an appeal has been taken.
2. If it is not known whether a notice of appeal has been filed and the full six month period has expired, do not use paragraphs 7.67, 7.67.01, 7.67.02 or 7.68; use instead the following: "If an appeal under 37 CFR 1.191 has not been properly filed, this application is abandoned."
3. One or more of the appropriate paragraphs 7.72 to 7.76 must directly follow this paragraph.

*¶ 7.71.01 Advisory After Final, Rewritten Claims Not Entered*

The amendment filed [1] under 37 CFR 1.116 will not be entered. Applicant's consolidation of all the claims in the application into a single paper would be entered if not presented with claim [2]. Although 37 CFR 1.121(c)(3) permits applicant to submit a clean copy of all of the claims in the application in a single paper, the inclusion of claim [3] raises new issues under 37 CFR 1.116. Thus, the entire paper is denied entry.

**Examiner Note:**

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert date of receipt of amendment.
3. In brackets 2 and 3, insert number of any claim which raise new issues. An explanation should follow bracket 2.

*¶ 7.72 Advisory After Final, Lacks Showing, Why Necessary and Not Earlier Presented*

There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

**Examiner Note:**

1. Paragraph 7.71 must precede this paragraph.
2. Do not use this paragraph as the sole reason for refusing entry of the amendment unless the situation is aggravated, in which case a full explanation is necessary.
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

*¶ 7.73 Advisory After Final, Raises New Issues*

The proposed amendment raises new issues that would require further consideration and/or search.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. The new issues including questions of new matter must be clearly identified following this form paragraph. (Examples are sufficient if the new issues are extensive.)
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

*¶ 7.75 Advisory After Final, Form for Appeal Not Improved*

The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.76 Advisory After Final, Additional Claims Presented*

The proposed amendment presents additional claims without canceling a corresponding number of finally rejected claims.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.78 Advisory After Final, Proposed New Claims Would Be Allowable*

Claim [1] as proposed would be allowable if submitted in a separately filed amendment canceling all non-allowed claims.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.

2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.79 Advisory After Final, Affidavit, Exhibit, or Request for Reconsideration Considered*

The [1] has been entered and considered but does not overcome the rejection because [2].

**Examiner Note:**

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should be provided in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.80 Advisory After Final, Affidavit or Exhibit Not Considered*

The [1] will not be considered because good and sufficient reasons why it was not earlier presented have not been shown. [2]

**Examiner Note:**

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should follow in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

## HAND DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to a Technology Center (TC). However, the TC will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), application number, filing date, and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the TC date stamp. The receipt will be handed back to the person hand delivering the

paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the TC via the Mail Center.

The TC will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account or a credit card. See MPEP § 509. However, in such an instance, the paper will be hand carried by TC personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand-carried to the Customer Service window, Crystal Plaza Building 2, Room 1B01.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Customer Service window by 3:00 p.m. the following work day. Upon return to the TC, the papers will be entered in the application file wrappers.

## 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 "Box 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 "Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231." Instead of mailing the envelope to "Box AF" as noted above, the reply may be hand-carried to the particular TC or other area of the Office in which the application is pending and marked on the outside envelope "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 “Box AF,” the envelope will be specially processed by the Mail Center and forwarded promptly to the examining TC, via the Office of Finance if any fees have to be charged or otherwise processed. 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 mailed by technical support staff 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

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.

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

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, however, the amendment is filed in the Office prior to the mailing out of the notice of allowance, but is received by the examiner after the mailing of the

notice of allowance, it has the same standing in the application as though the notice had not been mailed. Where the application has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under 37 CFR 1.312.

As above implied, 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

#### *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 Commissioner, 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, 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.

The Commissioner 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.

After the Notice of Allowance has been mailed, applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When rewriting a claim in the clean set, the parenthetical expression, if any, from the claim to be rewritten should not be repeated in the clean set. Thus, the only time a parenthetical expression should appear in the clean set is when a claim is being amended.

Entry of an entire clean claim set is subject to the provisions of 37 CFR 1.312. For example, after receipt of a notice of allowance, applicant may wish to submit an entire clean set of claims, making no changes, to make publication of the patent as accurate as possible. This type of amendment will be entered. Where, however, an amendment is submitted which contains an entire clean set of claims, some of which are amended, the examiner may choose not to enter the amendment pursuant to the provisions of 37 CFR 1.312.

The submission of a clean version of all the pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version would only be needed for claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining or bracketing, a marked up version should not be submitted. The examiner has no responsibility or burden to ensure the accuracy of applicant's claim rewriting.

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.

### **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.

### **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**

See MPEP § 2305.04 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 1.633**

Where an amendment filed with a motion under 37 CFR 1.633(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**

#### **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 the proposed amendment, file, and drawing (if any) to the Technology Center (TC) which allowed the application. If an amendment under 37 CFR 1.312 has been filed directly with the TC, the paper should be forwarded to the Publishing Division to be flagged in

PALM. The paper and file will be matched and returned to the TC for processing.

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.

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:**

1. Use this form both for amendments 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 (requires signature of supervisory patent examiner).
2. Entry of amendments filed after the Notice of Allowance not affecting the scope of the claims require the approval of a primary examiner and entry of amendments under 37 CFR 1.312(a) require approval by the supervisory patent examiner on recommendation of the primary 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.

If the 37 CFR 1.312 amendment includes proposed drawing changes which are acceptable, the Office response should include form paragraph 6.48.

*¶ 6.48 Drawing Changes in 37 CFR 1.312 Amendment*

Applicant is hereby given **ONE MONTH** from the mailing date of this letter or until the expiration of the period set in the "Notice of Allowance" (PTOL-85) or "Notice of Allowability" (PTOL-37 or PTO-37), whichever is longer, to file corrected drawings.

**Examiner Note:**

Use with the 37 CFR 1.312 amendment notice where there is a drawing correction proposal or request.

**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.

See MPEP § 714.16 for treatment of an amendment that consolidates all of the claims in the application in a single paper in accordance with 37 CFR 1.121(c)(3).

**714.16(e) Amendments Under 37 CFR 1.312, Entry in Part**

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 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.

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**

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 endorsed on the file wrapper 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

Amendments 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.

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.

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 § 714.03 for the treatment of preliminary amendments and non-final amendments that are not in compliance with 37 CFR 1.121. See MPEP § 714.22 for treatment of non-compliant amendments after final rejection.

### 714.19 List of Amendments, Entry Denied

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 Commissioner. See MPEP § 2305.03.

(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 § 2307.03.

(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 filed after the filing date of an application canceling all of the claims and presenting no substitute claim or claims. See MPEP § 711.01.

(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 Commissioner. 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 for return to applicant. 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 return 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.

(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, i.e., one which does not include replacement paragraphs/claims. See MPEP § 714.22.

(P) A preliminary amendment that unduly interferes with the preparation of a first Office action. Factors to be considered in denying entry of the preliminary amendment are set forth in 37 CFR 1.115(b). See MPEP § 714.03(a).

(Q) A second (or subsequent) supplemental reply that unduly interferes with an Office action being prepared in response to the previous reply. Factors to be considered in denying entry of the reply are set forth in 37 CFR 1.111(a)(2). See 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

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, 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.

(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.

(E) An amendment filed after March 1, 2001, that amends the specification in a manner that is not in compliance with 37 CFR 1.121, and that presents rewritten or new claims should be entered in part, rather than refused entry in toto. The proposed amendments to the specification should be denied entry and so marked, while the rest of the proposed amendment complying with 37 CFR 1.121 should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the amendments to the specification have not been entered. See 37 CFR 1.121 and MPEP § 714 for information regarding amendments to the specification and their format.

**NOTE.** The examiner writes "Enter" in red ink and his or her initials in the left margin opposite the enterable portions.

### 714.21 Amendments Inadvertently Entered, No Legal Effect

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."

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 returned.

### 714.22 Entry of Amendments, Directions for

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 other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825).—

(1) *Amendment by instruction to delete, replace, or add a paragraph.* Amendments to the specification, other than the claims and listings provided for elsewhere (§§ 1.96 and 1.825), may be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a deleted paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) Any replacement or added paragraph(s) in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of any replacement paragraph(s), on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of the paragraph(s). The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added paragraph or a deleted paragraph as it is sufficient to state that a particular paragraph has been added, or deleted.

(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 to delete that section of the specification and to replace such deleted section with a replacement section;

(ii) A replacement section in clean form, that is, without markings to indicate the changes that have been made; and

(iii) Another version of the replacement section, on one or more pages separate from the amendment, marked up to show all changes relative to the previous version of the section. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system.

(3) *Amendment by substitute specification.* The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification;

(ii) A substitute specification in compliance with § 1.125(b); and

(iii) Another version of the substitute specification, separate from the substitute specification, marked up to show all changes relative to the previous version of the specification. The changes may be shown by brackets (for deleted matter), or underlining (for added matter), or by any equivalent marking system.

(4) Reinstatement: Deleted matter may be reinstated only by a subsequent amendment presenting the previously deleted matter.

(c) *Claims.* —

(1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., “amended,” “twice amended,” or “new”).

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., “amended,” “twice amended,” etc. The parenthetical expression “amended,” “twice amended,” etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled 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.

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

(d) Drawings. Application drawings are amended in the following manner: Any change to the application drawings must be submitted on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the changes must be filed.

(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)(1) of this section is not required.

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(i) Amendments in reexamination proceedings: Any proposed amendment to the description and claims in patents involved in reexamination proceedings in both ex parte reexaminations filed under § 1.510 and inter partes reexaminations filed under § 1.913 must be made in accordance with § 1.530(d)-(j).

(j) Amendments in provisional applications: 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 this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

The term “brackets” set forth in 37 CFR 1.121 means square brackets, thus: [ ]. It does not encompass and is to be distinguished from parentheses ( ).

#### TREATMENT OF NON-COMPLIANT AMENDMENTS:

Preliminary amendments and non-final amendments which are not in compliance with 37 CFR 1.121 are handled by the technical support staff. The technical support staff notifies applicant of the defects by mailing a Notice of Non-Compliant Amendment. See MPEP § 714.03.

Amendments submitted after a final rejection are to be forwarded in unentered status to the examiners, who should address any non-compliance issues in an advisory action. If an amendment after final rejection fails to place the application in condition for allowance by removing all rejections and/or objections applied in the final rejection, applicant will be so notified by the examiner in an advisory action. If the amendment fails to comply with the requirements of 37 CFR 1.121, and the amendment is considered to be informal, the examiner should provide reasons for the non-compliance and require applicant to re-submit the amendment within any remaining period of time (set in the final rejection). No further extensions of time or new time periods which might serve to extend the six-month statutory period will be set in the advisory action. If time remains in the period set in the final rejection, applicants may re-submit the amendment, or request an extension of time (with appropriate fee) in which to do so, but will not be able to obtain an

extension beyond the six-month statutory deadline. Submission of any amendment at or near the end of the statutory period should be accompanied by the filing of a Notice of Appeal, in order to eliminate the risk of abandonment prior to the examiner acting on the amendment.

It is suggested that examiners explain in an advisory action the reasons why the amendment after final fails to comply with 37 CFR 1.121, in force as of March 1, 2001.

### 714.22(a) Amendments Consolidating All Claims

37 CFR 1.121. *Manner of making amendments in application.*

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(c) *Claims.* —

(3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

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37 CFR 1.121(c)(3) provides for the optional submission of a clean version (with no markings) of all of the pending claims in one amendment paper. Applicants have the opportunity to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. Providing this consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. When submitting a rewritten claim in the clean set, the parenthetical expression identifying the particular version, if any, from the claim to be rewritten should not be rewritten in the clean set. The claims, if merely rewritten in clean form, should retain the same claim number they had in the earlier version, and be submitted in proper numerical order, except for any canceled claims which would not appear in the rewritten amendment.

The submission of a clean version of all the pending claims shall be construed as directing the cancellation of all previous versions of any pending claims. A marked-up version would only be needed for

claims being changed by the current amendment (see 37 CFR 1.121(c)(1)(ii)). Any claim not accompanied by a marked-up version will constitute an assertion that it has not been modified relative to the immediate prior version. Thus, if applicant is not making any amendments to the claims, but is merely presenting all pending claims in clean form, without any underlining or bracketing, a marked-up version should not be provided.

The examiner has no responsibility or burden to ensure the accuracy of applicant's claim rewriting. See "Changes to Implement the Patent Business Goals" Final Rule, 65 F.R. 54604, 54639 (Sept. 8, 2000).

### 714.23 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 responsibility 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.

### 714.24 Amendment of Amendments

When a replacement paragraph or section to the specification is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. 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.



## 714.25 Discourtesy of Applicant or Attorney

*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 Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by the Commissioner's direct order. 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 with a view toward it being returned. See MPEP § 1003. If the TC Director determines that the remarks are in violation of 37 CFR 1.3, the TC Director will return the paper.

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

*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 § 1.601(n); 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 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.

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 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.

### 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.

(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).

### 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 § 2306. 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 is not 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.

## 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 and U.S. Patent Application Publication

See MPEP § 706.02(a) and § 2136 through § 2136.03 for a detailed discussion of the effective date of a U.S. patent or U.S. patent application publication as a reference.

U.S. patent application publications are available as prior art under 35 U.S.C. 102(e) against utility and plant patent applications (including reissues) that were filed on or after November 29, 2000, or that were voluntarily published, and for reexaminations of patents based on such applications. In other words, utility and plant patent applications (including reissues) filed prior to November 29, 2000, that have not voluntarily published, design applications and reexaminations of patents based on such applications are subject to rejections based on U.S. patent application publications under 35 U.S.C. 102(a), but not 35 U.S.C. 102(e).

Should it be established that the portion of the patent, or patent application publication, disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit or declaration is the date of amendment. *In re Willien*, 74 F.2d 550, 24 USPQ 210 (CCPA 1935). 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) 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 § 2306. 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 patent 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 ref-

erences 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(I)(1) through § 706.02(I)(3).

**715.01(a) Reference Is a Joint Patent or  
Published Application to  
Applicant and Another**

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 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**

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.

### **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).

### **DERIVATION**

When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection 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

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 appli-

cant 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.).

## 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.

### 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

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.

### 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).

### 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.2d 509, 190 USPQ 324 (CCPA 1976).

## 715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

### 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) A party qualified under 37 CFR 1.42, 1.43, or 1.47 in situation where some or all of the inventors are not available or not capable of joining in the filing of the application.

(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).

### 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

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 1.608 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 §§ 2306-2308. If the reference is claiming the same invention as the application and its publication date is 1 year or more 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) 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.).

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 Not Copied Within One Year of Patent Issue Date

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to 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 Not Copied Within One Year of Application Publication Date

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to 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," defined by 37 CFR 1.601(n) as follows:

Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A."

As provided in 37 CFR 1.601(i), an interference may be declared whenever an examiner is of the opinion that an application and a reference contain claims for the "same patentable invention." 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 1.601(n)), 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. Kluever*, 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

### 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.").

### 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.

### 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) 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.*, 94-1249 (Fed. Cir. 1995) (Citing *Newkirk v. Lulegian*, 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. Pho-

tographs, 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

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; or

(C) after final rejection and submitted

(1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or

(2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or

(3) under 37 CFR 1.129(a).

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 1.195 and MPEP § 1211.02.

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 respon-

sive 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

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, or
- (3) after final rejection and submitted
  - (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
  - (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
  - (iii) under 37 CFR 1.129(a).

**(B) Consideration of evidence.**

Evidence traversing rejections 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**

#### **OBJECTIVE EVIDENCE MUST BE CONSIDERED WHENEVER PRESENT**

Affidavits or declarations 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**

#### **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).

### 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.

### 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

#### IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING *PRIMA FACIE* CASE

When an applicant 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 over-

come 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

#### 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.).

#### 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).

#### 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.

#### 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

#### BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied up 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).

#### 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).

#### 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 indi-

rect 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

#### 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.).

#### **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**

Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of non-obviousness 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 100°C). Appellant demonstrated unexpected results via comparative tests with the prior art ion exchange resin at 110°C and 130°C. The court affirmed the rejection of claims 1-7 and 9-10 because the term "elevated temperatures" encompassed temperatures as low as 60°C where the prior art ion exchange resin was known to perform well. The rejection of claim 8, directed to a temperature in excess of 100°C, was reversed.). See also *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.).

#### **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