(e) Maintenance fee payments and surcharge payments relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in § 1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See § 1.27(g).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§1.26 and 1.28(a).

37 CFR 1.366 establishes the guidelines and procedures for submission of maintenance fees, including any necessary surcharges. The patentee may pay maintenance fees and any necessary surcharges or any person or organization may pay maintenance fees and any necessary surcharges on behalf of the patentee without filing in the Office evidence of authorization by the patentee to pay maintenance fees. This will enable patentees to pay the maintenance fees and any necessary surcharges themselves or authorize some person or organization to pay maintenance fees and any necessary surcharges on their behalf. No verification of the authority to pay maintenance fees and any necessary surcharges in a particular patent will be made by the Office. While anyone may pay the maintenance fees and any necessary surcharges on a patent, if the payment is accepted by the Office, any Office notices relating to maintenance fees and any necessary surcharges will be mailed to the "fee address" set forth in 37 CFR 1.363. If the payment is not accepted by the Office, it will be returned to the person who submitted the payment if a return address is available. It is recommended that the payor should include a return address along with his or her telephone number since the Office may contact the payor in some instances when it is unclear to which patent the fees are to be applied. See MPEP § 2530.

A maintenance fee and any necessary surcharge for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid, and at the proper time, i.e., within the periods set forth in 37 CFR 1.362. If the amount of the maintenance fee is correct on the date it is paid and credited to the patent, a later change in the maintenance fees to reflect a new fee amount will not require a modification in the amount paid. However, in order for the maintenance fee to be considered paid, the payment must at least identify the patent number to which the fee is to be credited. If the payment does not include a patent number, the payment will be returned to the person who submitted the payment. See MPEP § 2530.

37 CFR 1.366(c) provides that a maintenance fee payment must include the patent number and the application number on which the maintenance fee is being paid. If the payment includes identification of only the patent number (i.e., does not identify the application number for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment. See MPEP § 2530. The application number required to be submitted is not that of a prior parent application, but rather the application number of the actual application that matured into the patent for which maintenance fees are to be paid. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the application number required is that of the reissue application.

If a patent expires because the maintenance fee and any necessary surcharge have not been paid in the manner required by 37 CFR 1.366, the patentee could proceed under 37 CFR 1.378 (see MPEP § 2590), if appropriate, or could file a petition under 37 CFR 1.377 (see MPEP § 2580) within the period set therein seeking to have the maintenance fee accepted as timely even though not all of the required identifying data was present prior to expiration of the grace period.

Under 37 CFR 1.366(d), the following information should also be submitted for each patent on which a maintenance fee or surcharge is paid (37 CFR 1.366(d)):

(A) the Fee Year (e.g., 3 1/2, 7 1/2, or 11 1/2 year fee);

(B) the amount of the maintenance fee and any surcharge being submitted;

(C) any assigned customer number; and

(D) whether small entity status is being changed or claimed with the payment.

Where the payment is a maintenance fee and any necessary surcharge on a reissue patent, in addition to the information requested for all payments, it is requested that the original patent number be furnished. Although the submission of the information requested under 37 CFR 1.366(d) is not mandatory, it would expedite the processing of maintenance fee payments.

The Maintenance Fee Transmittal Form, PTO/SB/45 should be used when submitting maintenance fees. This form is available, upon request, from the Status and Entity Division. It is also available from the USPTO website (http://www.uspto.gov).

The Office processes fees in the order in which they are presented. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all patents listed, and there is no authorization to charge a deposit account or a credit card, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

2520 Maintenance Fee Amounts

37 CFR 1.20(e)-(h) sets the fee amounts for the maintenance fees and the grace period surcharge. The maintenance fee amounts are subject to adjustment to reflect fluctuations occurring in the Consumer Price Index pursuant to 35 U.S.C. 41(f). The maintenance fee amounts (37 CFR 1.20(e)-(h)) are subject to a 50% reduction for small entities pursuant to 35 U.S.C. 41(h). The Status and Entity Division and the USPTO website (www.uspto.gov) may be contacted for the current maintenance fee amounts.

37 CFR 1.366(g) provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 1.28(a). A patentee cannot obtain a refund of a maintenance fee which was due and payable on the patent. Any duplicate payment will be refunded to the fee address.

2522 Methods of Payment

The method of payment for the maintenance fee and any necessary surcharge is set forth in 37 CFR 1.23. The payment shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank notes, or United States Postal Service money order as provided in 37 CFR 1.23(a). If the maintenance fee and any necessary surcharge is sent in any other form, the Office may delay or cancel the credit until collection is made. For example, a personal or other uncertified check drawn on a U.S. bank that is not immediately negotiable, e.g., because it lacks a signature or due to insufficient funds, will not constitute payment of a maintenance fee and/or surcharge.

The maintenance fee can be charged to a credit card as set forth in 37 CFR 1.23(b), but credit for the payment is subject to actual receipt of the fee by the Office. Credit Card Payment Form (PTO-2038) should be used for payment of fees by credit card. If credit card information is provided on a form or document other than the form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge. See MPEP § 509.

Any remittance from a foreign country must be payable and immediately negotiable in the United States for the full amount of the maintenance fee and/or surcharge required.

37 CFR 1.366(b) provides that maintenance fees and any necessary surcharge may be paid by authorization to charge a deposit account established pursuant to 37 CFR 1.25. The authorization to charge the deposit account must be submitted within an appropriate window or grace period and must be limited to maintenance fees and surcharges payable on the date of submission. The authorization to charge the deposit account cannot be submitted prior to the third, seventh, or eleventh year after grant of the patent. If an authorization to charge a deposit account were submitted to pay the maintenance due at 3 years and 6 months after grant, a new authorization to charge a deposit account or other form of payment will have to be submitted at the appropriate time for each of the maintenance fees due at 7 years and 6 months and 11 years and 6 months. Any payment or authorization filed at any time other than that set forth in 37 CFR 1.362(d), (e), or (f) will not serve as a payment of the maintenance fee, except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner pursuant to 37 CFR 1.378. See MPEP § 2590. A payment of less than the required amount, a payment in a manner other than that set forth in 37 CFR 1.23, or the filing of an authorization to charge a deposit account having insufficient funds, will not constitute payment of a maintenance fee on a patent. The authorization is required to permit the immediate

charging of the maintenance fee to the deposit account. An authorization would be improper if it only authorized the maintenance fee to be charged at a later date, e.g., on the last possible day of payment without surcharge. Such an authorization would not serve as payment of the maintenance fee. Any payment which fails to result in the entire proper amount of the maintenance fee being present on the due date will not constitute payment of the maintenance fee.

Maintenance fee payments and any surcharges relating thereto must be submitted separately from any other payments for fees or charges, whether submitted in the manner set forth in 37 CFR 1.23 or by authorization to charge a deposit account. 37 CFR 1.366(e). Maintenance fee payments and surcharge payments relating thereto that are commingled with payments for other fees or charges, e.g., application filing fees, issue fees, document supply fees, etc., will not be accepted. Maintenance fees require processing by a separate area of the Office and are not processed in the same manner as other fees and charges. Maintenance fees for a number of patents can be submitted together in one submission and one payment. 37 CFR 1.366(e) specifies that if maintenance fee payments for more than one patent are submitted together, they should be submitted on as few sheets as possible, listing the patent numbers in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and any surcharges for all the listed patents, the payment will be applied in the order the patents are listed. In such a circumstance the maintenance fee and any surcharge for one or more of the last listed patents will not be paid.

Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount required.

It is not suggested that cash be sent by mail. However, if cash is sent it will be at the risk of the sender and should be sent via registered mail.

2530 Informalities

PATENT NUMBER MISSING

If the maintenance fee payment does not include a patent number (e.g., includes only an application number), the payment will be returned to the person who submitted the payment.

APPLICATION NUMBER MISSING OR INCONSISTENT WITH PATENT NUMBER

The Office intends to treat maintenance fee payments that identify the patent number without its proper corresponding application number as follows:

(A) a reasonable attempt will be made to contact the person who submitted the payment (e.g., patentee or agent) to confirm the patent number and application number of the patent for which the maintenance fee is being paid;

(B) if such an attempt is not successful but the payment includes at least a patent number, the payment will be processed as a maintenance fee paid for the patent number provided, and a letter will be sent by the Office identifying the patent number and application number to which the maintenance fee was posted. The letter will set a period of time within which to file a petition under 37 CFR 1.377 along with the petition fee if the maintenance fee was not posted to the patent for which the payment was intended. The letter will be mailed to the "fee address for maintenance fee purposes" specified in 37 CFR 1.363.

PAYMENT LATE OR INSUFFICIENT

Examples of when a payment of maintenance fees and any necessary surcharges will be considered to be late or insufficient include instances when:

(A) Though a payment was received, additional funds are required due to surcharge or fee increase;

(B) Though a payment was received in an amount for small entity, the patented file records do not indicate that an assertion of small entity status was received; or

(C) The payment was received after the patent expired.

If the Office considers a payment to be late or insufficient, a notice will be sent to the "fee address for maintenance fee purposes" (see 37 CFR 1.363) provided the grace period provided by 37 CFR 1.362(e) has not expired. Reply to the notice is required prior to expiration of the grace period in

order to avoid the expiration of the patent. If a reply is not received prior to expiration of the patent, then an appropriate petition under 37 CFR 1.377 or 37 CFR 1.378 is required. See MPEP § 2580 and § 2590.

2540 Fee Address for Maintenance Fee Purposes

37 CFR 1.363. Fee address for maintenance fee purposes.

(a) All notices, receipts, refunds, and other communications relating to payment or refund of maintenance fees will be directed to the correspondence address used during prosecution of the application as indicated in § 1.33(a) unless:

(1) A "fee address" for purposes of payment of maintenance fees is set forth when submitting the issue fee, or

(2) A change in the correspondence address for all purposes is filed after payment of the issue fee, or

(3) A "fee address" or a change in the "fee address" is filed for purposes of receiving notices, receipts and other correspondence relating to the payment of maintenance fees after the payment of the issue fee, in which instance, the latest such address will be used.

(b) An assignment of a patent application or patent does not result in a change of the "correspondence address" or "fee address" for maintenance fee purposes.

All notices, receipts, refunds and other communications relating to the payment or refund of a maintenance fee will be directed to the correspondence address used during the prosecution of the application, unless a "fee address" for the purpose of payment of the maintenance fee has been designated or a change in the correspondence address has been made (see MPEP § 2542). 37 CFR 1.33(d) allows a correspondence address or change thereto to be filed during the enforceable life of the patent. Patentees should ensure that the Office is properly notified of the proper "fee address" to which all maintenance fee communications are to be directed.

Under the statutes and rules, the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fee is due. It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. The failure to receive the reminder notice will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. The Office will attempt to assist patentees through the mailing of a Maintenance Fee Reminder in the grace period. However, the failure to receive a Maintenance Fee Reminder will not relieve the patentee of the obligation to timely pay the appropriate maintenance fee to prevent expiration of the patent, nor will it constitute unavoidable delay if the patentee seeks to reinstate the patent under 37 CFR 1.378(b). See *In re Patent No. 4,409,763*, 7 USPQ2d 1798 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992). Maintenance fee correspondence will not be directed to more than one address.

The "Fee Address" Indication Form, PTO/SB/47, and the Request for Customer Number Form, PTO/SB/125, are suggested when requesting establishment of a "Fee Address" or the assignment of a "Customer Number." The "Fee Address" Indication Form, PTO/SB/47, is available, upon request, from the Status and Entity Division and from the USPTO website (www.uspto.gov). Requests for the establishment of a "Fee Address" should be submitted to the Status and Entity Division prior to or at the time of payment of maintenance fees in order to ensure that receipt of payment is directed to the fee address. See MPEP § 403 concerning requests for a Customer Number.

Additional patent numbers may be assigned to a "Customer Number" at any time, with a written request.

The "Customer Number" of the Fee Address should be referred to on all future maintenance fee payments in order to expedite the payment.

2542 Change of Correspondence Address

Unless a fee address has been designated, all notices, receipts, refunds, and other communications relating to the patent will be directed to the correspondence address (37 CFR 1.33) used during the prosecution of the application. Practitioners of record when the patent issues who do not wish to receive correspondence relating to maintenance fees must change the correspondence address in the patented file or provide a fee address to which such correspondence should be sent. It is not required that a practitioner file a request for permission to withdraw pursuant to 37 CFR 1.36 solely for the purpose of changing the correspondence address in a patented file.

The correspondence address should be updated or changed as necessary to ensure that all communications are received in a timely manner. A change of

correspondence address may be made as provided in 37 CFR 1.33(a). The correspondence address may be changed as provided in 37 CFR 1.33(a)(1) prior to the filing of an oath or declaration. After an oath or declaration has been executed and filed by at least one inventor, the correspondence address may be changed as provided in 37 CFR 1.33(a)(2).

Requests for a change of the correspondence address may be sent to the Office of Public Records, Document Services Division, Special Handling Branch during the enforceable life of the patent. To ensure accuracy and to expedite requests for change to the correspondence address, it is suggested that the request include both the patent number and the application number. Form PTO/SB/122 may be used to request a change of correspondence address in a patent application. Form PTO/SB/123 may be used to request a change of correspondence address for an issued patent.

2550 Small Entity Status

In order to establish small entity status for the purpose of paying a maintenance fee, a written assertion of entitlement to small entity status must be filed prior to or with the maintenance fee paid as a small entity. A written assertion is only required to be filed once and will remain effective until changed.

37 CFR 1.366(f) serves as a reminder to patentees of the necessity to check for the loss of small entity status prior to paying each maintenance fee on a patent. This is also a requirement of 37 CFR 1.27(g). The notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. If status as a small entity has been previously established by filing an assertion of small entity status and such status is checked and found to be proper, no notification is required. It is not necessary to file a new assertion establishing small entity status at this point if the status as a small entity has been established and is still proper even if rights have been transferred to a small entity after the assertion of small entity status. The requirement is to notify the Office of the loss of entitlement and to pay the maintenance fee in the proper amount for other than a small entity where appropriate. The refund provisions of 37 CFR 1.28(a) for later submitted small entity assertions do apply to maintenance fees.

2560 Revocation of Power of Attorney and Withdrawal of Attorney

The revocation or withdrawal of an attorney may be submitted at any time; however, it is recommended that it be done well prior to the date a maintenance fee is due.

When processing a revocation of a power of attorney, the Office of Public Records, Document Services Division, Special Handling Branch forwards copies of the completed action to the requester and the attorney being removed. Also, a copy is placed in the patent file wrapper.

When processing a withdrawal of an attorney, the Office of Public Records, Document Services Division, Special Handling Branch forwards copies of the completed action to the attorney and the patent owner. Also, a copy is placed in the patent file wrapper.

It should be noted that an assignment does not act as a revocation of power of attorney for authorization previously given. However, the assignee may revoke a previous power of attorney. See 37 CFR 3.71 and 3.73.

2570 Status Requests

The Status and Entity Division will respond to requests for the status of patents. Status can be requested by telephone or by facsimile. Telephone status requests are limited to two patent numbers per telephone call. Maintenance fee information for a patent can also be accessed through an automated voice response system. See MPEP § 1730 for the telephone and facsimile numbers.

The Status and Entity Division has a form available, for the user's convenience, when submitting requests in person or via facsimile.

2575 Notices

Under the statutes and the regulations, the Office has no duty to notify patentees when their maintenance fees are due. It is the responsibility of the patentee to ensure that the maintenance fees are paid to prevent expiration of the patent. The Office will, however, provide some notices as reminders that maintenance fees are due, but the notices, errors in the

notices or in their delivery, or the lack or tardiness of notices will in no way relieve a patentee from the responsibility to make timely payment of each maintenance fee to prevent the patent from expiring by operation of law. The notices provided by the Office are courtesies in nature and intended to aid patentees. The Office's provision of notices in no way shifts the burden of monitoring the time for paying maintenance fees on patents from the patentee to the Office.

PREPRINTED STANDARD NOTICES

The patent grant currently includes a reminder notice that maintenance fees may be due. The Notice of Allowance currently includes a reminder notice that maintenance fees may be due.

OFFICIAL GAZETTE NOTICE

A notice will appear in each issue of the *Official Gazette* which will indicate which patents have been granted 3, 7, and 11 years earlier, that the window period has opened, and that maintenance fee payments will now be accepted for those patents.

Another *Official Gazette* notice published after expiration of the grace period will indicate any patent which has expired due to nonpayment of maintenance fees and any patents which have been reinstated. An annual compilation of such expirations and reinstatements will also be published.

MAINTENANCE FEE REMINDERS

Since patentees are expected to maintain their own record and docketing systems and since it is expected that most patentees will pay their maintenance fees during the window period to avoid payment of a surcharge, the Office will not send any reminder notices to the patentee until after the grace period has begun. This will reduce and simplify the mailing of notices but still give patentees an opportunity to pay their maintenance fee with surcharge during the grace period before expiration of their patents. The Office will mail any Maintenance Fee Reminder to the fee address as set forth in 37 CFR 1.363. See MPEP § 2540.

RECEIPT NOTICES

The Office will issue a receipt for payment of maintenance fees after entry of the maintenance fee payment. Such a receipt will provide an opportunity for the patentee to check if the Office has properly credited the payment. The original document submitted by the patentee when paying the maintenance fee will also be appropriately marked and returned to the fee address as set forth in 37 CFR 1.363.

EXPIRATION NOTICES

The Office will mail a Notice of Patent Expiration to the fee address as set forth in 37 CFR 1.363 when Office records indicate that a patent has expired for failure to pay a required maintenance fee.

2580 Review of Decision Refusing to Accept and Record Payment of a Maintenance Fee Filed Prior to Expiration of Patent

37 CFR 1.377. Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Commissioner to accept and record the maintenance fee.

(b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(h). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

37 CFR 1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 CFR 1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Commissioner to accept and record the maintenance fee. This petition may be used, for example, in situations where an error is present in the identifying data required by 37 CFR 1.366(c) with the maintenance fee payment, i.e., either the patent number or the application number are incorrect. See MPEP § 2515 and § 2530. A petition under 37 CFR 1.377 would not be appropriate where

there is a complete failure to include at least one correct mandatory identifier as required by 37 CFR 1.366(c) for the patent since no evidence would be present as to the patent on which the maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would not credit the fee to the patent. A petition under 37 CFR 1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number. Likewise, a petition under 37 CFR 1.377 would not be appropriate where the entire maintenance fee payment, including any necessary surcharge, was not filed prior to expiration of the patent.

Any petition filed under 37 CFR 1.377 must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of. The petition must be accompanied by the proper petition fee. The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to have resulted from an error by the Office.

Any petition filed under 37 CFR 1.377 must comply with the requirements of 37 CFR 1.181(b) and must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes 37 CFR 1.377. If the petition is signed by a person not registered to practice before the Office, the petition must indicate whether the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324.

Any petition under 37 CFR 1.377 should be marked on the front page of the communication to the attention of the Office of Petitions and addressed as follows:

Assistant Commissioner for Patents

Box DAC

Washington, D.C. 20231

2590 Acceptance of Delayed Payment of Maintenance Fee in Expired Patent to Reinstate Patent

37 CFR 1.378. Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

(1) the required maintenance fee set forth in §1.20 (e)-(g);

(2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:

(1) the required maintenance fee set forth in § 1.20 (e)-(g);

(2) the surcharge set forth in § 1.20(i)(2); and

(3) a statement that the delay in payment of the maintenance fee was unintentional.

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded

unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

37 CFR 1.378(a) provides that the Commissioner may accept the payment of any maintenance fee due on a patent based on an expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable or unintentional. The appropriate surcharge set forth in § 1.20(i) must be paid as a condition of accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

Any petition under 37 CFR 1.378(b) or (c) should be marked on the front page of the communication to the attention of the Office of Petitions and addressed as follows:

Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

Any petition under 37 CFR 1.378 must be signed by an attorney or agent registered to practice before the U.S. Patent and Trademark Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes of 37 CFR 1.378. If the petition is signed by a person not registered to practice before the Office, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324.

37 CFR 1.378(e) provides a mechanism for obtaining reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a). This mechanism is a petition for reconsideration which may be filed within 2 months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. In contrast to petitions filed under paragraph (a), the petition for reconsideration requires the petition fee set forth in 37 CFR 1.17(h). After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. The maintenance fee and the surcharge submitted will be refunded if the delayed payment of the maintenance fee is not accepted. The refund will be made following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. The petition fee for filing a petition for reconsideration will not be refunded unless, on reconsideration, the refusal to accept and record the maintenance fee is determined to result from an error by the Office.

UNAVOIDABLE DELAY

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

(A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);

(B) the surcharge set forth in 37 CFR 1.20(i)(1); and

(C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133.

See *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the "unavoidable" delay standard.

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See *Patent No. 4,409,763*, *supra*. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the *Federal Register* at 49 *Fed. Reg.* 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 *Off. Gaz. Pat. Office* 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable. For example, an error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

UNINTENTIONAL DELAY

Public Law 102-444 amended 35 U.S.C. 41(c)(1) in 1992 to permit the Commissioner to accept late payment of any maintenance fee filed within 24 months after the 6-month grace period, if the delay in payment is shown to the satisfaction of the Commissioner to have been unintentional. See MPEP § 711.03(c) for a general discussion of the "unintentional" delay standard.

In addition to the timeliness deadline set forth in the preceding paragraph, a petition filed under the unintentional standard of 37 CFR 1.378(c) must include:

(A) the required maintenance fee set forth in 37 CFR 1.20 (e) through (g);

(B) the surcharge for an unintentionally expired patent as set forth in 37 CFR 1.20(i)(2); and

(C) a statement that the delay in payment of the maintenance fee was unintentional.

A person seeking reinstatement of an expired patent should not make a statement that the delay in payment of the maintenance fee was unintentional unless the entire delay was unintentional, including the period from discovery that the maintenance fee was not timely paid until payment of the maintenance fee. For example, a statement that the delay in payment of the maintenance fee was unintentional would not be proper when the patentee becomes aware of an unintentional failure to timely pay the maintenance fee and then intentionally delays filing a petition for reinstatement of the patent under 37 CFR 1.378.

2591 Intervening Rights in Reinstated Patents

Intervening rights in reinstated patents are provided by 35 U.S.C. 41(c)(2) which is reproduced in MPEP § 2501. No patent, the term of which has been maintained as a result of the acceptance of a late payment of a maintenance fee, shall abridge or affect the right of any person or his or her successors in business who made, purchased, imported, or used after the 6-month grace period but prior to the acceptance of the late maintenance fee anything protected by the patent, to continue the use or importation of, or to sell to others to be used or sold, the specific things made, purchased, imported, or used. A court before which such matter is in question may provide for the continued manufacture, use, importation, or sale of the thing made, purchased, imported, or used as specified, or for the manufacture, use, importation, or sale of which substantial preparation was made after the 6-month grace period but before the acceptance of the late maintenance fee, and it may also provide for the continued practice of any process, practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but prior to the acceptance of the late maintenance fee, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of the late maintenance fee.

2595 Forms

The following forms are suggested when submitting a maintenance fee or establishing a fee address for maintenance fee purposes. "Maintenance Fee Transmittal Form," Form PTO/SB 45; and "'Fee Address' Indication Form," Form PTO/SB/47.

PTO/SB/45 (01-01)
Approved for use through 12/31/2002. OMB 0651-0016
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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

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MAINTENANCE FEE TRANSMITTAL FORM

Address to:
Assistant Commissioner for Patents
Box M Fee
Washington, D.C. 20231

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 "Assistant Commissioner for Patents, Box M Fee, Washington D.C. 20231" on_____.

Signature_____.

Typed or printed name_____.

Enclosed herewith is the payment of the maintenance fee(s) for the listed patent(s).

1. ☐ A check for the amount of $_____for the full payment of the maintenance fee(s) and any necessary surcharge on the following patents is enclosed.
2. ☐ The Commissioner is hereby authorized to charge $_____to cover the payment of the fee(s) indicated below to Deposit Account No._____.
3. ☐ The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No._____.
4. ☐ Payment by credit card. Form PTO-2038 is attached.

*Information required by 37 CFR 1.366(c) (columns 1 & 4). Information requested under 37 CFR 1.366(d) (columns 2, 3, 5, & 6)

Item	Patent Number*	Maintenance Fee Amount (37 CFR 1.20 (e)-(g))	Surcharge Amount (37 CFR 1.20 (h)-(i))	U.S. Application Number* [06/555,555]	Payment Year 5			Small Entity? **
					3.5 yrs	7.5 yrs	11.5 yrs	
	1	2	3	4				6
1								
2								
3								
4								
5								
6								
Subtotals Columns 2 & 3								
Total Payment								

☐ _____additional sheets attached for listing additional patents.

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.

Respectfully submitted***:

Customer's name:

Telephone:

Fax:

Customer's Signature:

Note. *All correspondence will be forwarded to the "Fee Address" or to the "Correspondence Address" if no "Fee Address" has been provided. 37 CFR 1.363.

**Payment of small entity fee is appropriate if small entity status still exists, see 37 CFR 1.27(g). To establish small entity status or to change status from small to large entity, note the requirements of 37 CFR 1.27 and 1.33(b).

***WHERE MAINTENANCE FEE PAYMENTS ARE TO BE MADE BY AUTHORIZATION TO CHARGE A DEPOSIT ACCOUNT, BOTH CUSTOMER'S NAME AND SIGNATURE ARE REQUIRED.

Burden Hour Statement: This collection of information is required by 37 CFR 1.366. This information is used by the public to submit (and by the USPTO to process) payment of patent maintenance fees. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 0.08 hours to complete, including gathering, preparing, and submitting the complete payment of maintenance fees. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/47 (10-00)
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"FEE ADDRESS" INDICATION FORM

Address to:
Assistant Commissioner for Patents
Box M. Fee
Washington, D.C. 20231

Please recognize as the "Fee Address" under the provisions of 37 CFR 1.363 the following address:

☐ Customer Number _____ → *Place Customer Number Bar Code Label here*
Type Customer Number here

OR

☐ Request for Customer Number (PTO/SB/125) attached hereto

OR

☐ Firm or Individual Name					
Address					
Address					
City		State		Zip	
Country					
Telephone		Fax			

in the following listed application(s) for which the Issue Fee has been paid or patent(s).

PATENT NUMBER (if known)	APPLICATION NUMBER

(check one)

☐ Applicant/Inventor

☐ Attorney or Agent of record _____ (Reg. No.)

☐ 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)

☐ Assignment recorded at Reel _____ Frame _____

_____ Signature

_____ Typed or printed name

_____ Customer's telephone number

_____ Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more that one signature is required, see below *.

☐ *Total of _____ forms are submitted.

Burden Hour Statement: This collection of information is required by 37 CFR 1.383. This information is used by the public to submit (and by the USPTO to process) payment of patent maintenance fees. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 0.08 minutes to complete, including gathering, preparing, and submitting the complete payment of maintenance fees. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Chapter 2700 Patent Terms and Extensions

2701 Patent Term

35 U.S.C. 154. Contents and term of patent; provisional rights.

(a) IN GENERAL.—

*****

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 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 or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

*****

(c) CONTINUATION.—

(1) DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) REMEDIES.—The remedies of sections 283, 284, and 285 of this title shall not apply to acts which —

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) REMUNERATION.—The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapter 28 and chapter 29 (other than those provisions excluded by paragraph (2)) of this title.

*****

For applications filed on or after June 8, 1995, Section 532(a)(1) of the Uruguay Round Agreements Act (Pub. L. 103-465, 108 Stat. 4809 (1994)) amended 35 U.S.C. 154 to provide that the term of a patent (other than a design patent) begins on the date the patent issues and ends on the date that is 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 or applications under 35 U.S.C. 120, 121, or 365(c), twenty years from the filing date of the earliest of such application(s). This patent term provision is referred to as the "twenty-year term." Design patents have a term of fourteen years from the date of patent grant. See 35 U.S.C 173 and MPEP § 1505.

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty-year term" or seventeen years from the patent grant. See 35 U.S.C. 154(c). A patent granted on an international application filed

before June 8, 1995, and which entered the national stage under 35 U.S.C. 371 before, on or after June 8, 1995, will have a term that is the greater of seventeen years from the date of grant or twenty years from the international filing date or any earlier filing date relied upon under 35 U.S.C. 120, 121 or 365(c). The terms of these patents are subject to reduction by any applicable terminal disclaimers (discussed below).

CONTINUING APPLICATIONS

A patent granted on a continuation, divisional, or continuation-in-part application that was filed on or after June 8, 1995, will have a term which ends twenty years from the filing date of earliest application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), regardless of whether the application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) was filed prior to June 8, 1995.

INTERNATIONAL APPLICATIONS

A patent granted on an international application filed on or after June 8, 1995 and which enters the national stage under 35 U.S.C. 371 will have a term which ends twenty years from the filing date of the international application. A continuation or a continuation-in-part application claiming benefit under 35 U.S.C. 365(c) of an international application filed under 35 U.S.C. 363 designating the United States will have a term which ends twenty years from the filing date of the parent international application.

FOREIGN PRIORITY

Foreign priority under 35 U.S.C. 119(a)-(d), 365(a), or 365(b) is not considered in determining the term of a patent. Accordingly, an application claiming priority under 35 U.S.C. 365(a) or 365(b) has a term which ends twenty years from the filing date of the application in the United States and not the prior international application.

DOMESTIC PRIORITY UNDER 35 U.S.C. 119(e)

Domestic priority under 35 U.S.C. 119(e) to one or more U.S. provisional applications is not considered in the calculation of the twenty-year term. See 35 U.S.C. 154(a)(3).

EXPIRATION DATE OF PATENTS WITH TERMINAL DISCLAIMERS

To determine the "original expiration date" of a patent subject to a terminal disclaimer, it is generally necessary to examine the language of the terminal disclaimer in the patent file history. If the disclaimer disclaims the terminal portion of the term of the patent which would extend beyond the expiration date of an earlier issued patent, then the expiration date of the earlier issued patent determines the expiration date of the patent subject to the terminal disclaimer. Before June 8, 1995, the terminal disclaimer date was printed on the face of the patent; the date was determined from the expected expiration date of the earlier issued patent based on a seventeen year term measured from grant. When 35 U.S.C. 154 was amended such that all patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty year term" or seventeen years from the patent grant, the terminal disclaimer date as printed on many patents became incorrect. If the terminal disclaimer of record in the patent file disclaims the terminal portion of the patent subsequent to the full statutory term of a referenced patent (without identifying a specific date), then the date printed on the face of the patent is incorrect when the full statutory term of the referenced patent is changed as a result of 35 U.S.C. 154(c). That is, the referenced patent's "twenty year term" is longer than the seventeen year term. In such a case, a patentee may request a Certificate of Correction under 37 CFR 1.323 to correct the information printed on the face of the patent. However, if the terminal disclaimer of record in the patent file disclaims the terminal portion of the patent subsequent to a specific date, without reference to the full statutory term of a referenced patent, then the expiration date is the date specified. Several decisions related to disclaimers are posted in the Freedom of Information Act (FOIA) section of the USPTO Internet site (www.uspto.gov).

PATENT TERM EXTENSIONS OR ADJUSTMENTS

See MPEP § 2710, *et seq.*, for patent term extensions or adjustments for delays within the USPTO under 35 U.S.C. 154 for utility and plant patents issuing on applications filed on or after June 8,

1995. Patents that issue from applications filed before June 8, 1995, are not eligible for term adjustment under 35 U.S.C. 154.

See MPEP § 2750 *et. seq.* for patent term extensions available under 35 U.S.C. 156 for premarket regulatory review. The patent term extension that may be available under 35 U.S.C. 156 for premarket regulatory review is separate from and will be added to any extension that may be available under former and current 35 U.S.C. 154. While patents that issue from applications filed before June 8, 1995, are not eligible for term adjustment under 35 U.S.C. 154, such patents may be extended under 35 U.S.C. 156.

2710 Term Extensions or Adjustments for Delays Within the USPTO Under 35 U.S.C. 154

Utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term adjustment (extension) provisions of former 35 U.S.C. 154(b) and 37 CFR 1.701. See MPEP § 2720. Utility and plant patents issuing on applications filed on or after May 29, 2000 are eligible for the patent term adjustment provisions of 35 U.S.C. 154(b)(amended, effective May 29, 2000) and 37 CFR 1.702-1.705. See MPEP § 2730.

Plant and utility patents issuing on applications filed before June 8, 1995 which have a term that is the greater of the "twenty-year term" (see MPEP § 2701) or seventeen years from patent grant are not eligible for term extension or adjustment due to delays in processing the patent application by the United States Patent and Trademark Office.

Since the term of a design patent is not affected by the length of time prosecution takes place, there are no patent term adjustment provisions for design patents.

2720 Applications Filed Between June 8, 1995, and May 28, 2000

Former 35 U.S.C. 154. Contents and term of patent.

*****

(b) TERM EXTENSION.—

(1) INTERFERENCE DELAY OR SECRECY ORDERS.—If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW. —If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.—The period of extension referred to in paragraph (2)—

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.—The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

*****

37 CFR 1.701. Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

The twenty-year term of a patent issuing from an application filed on or after June 8, 1995, and before May 29, 2000, may be extended for a maximum of five years for delays in the issuance of the patent due to interferences, secrecy orders and/or successful appeals to the Board of Patent Appeals and Interferences or the Federal courts in accordance with 37 CFR 1.701. See former 35 U.S.C. 154(b), as reproduced above. Extensions for successful appeals are limited in that the patent must not be subject to a terminal disclaimer. Further, the period of extension will be reduced by any time attributable to appellate review within three years of the filing date of the application, and the period of extension for appellate review will be reduced by any time during which the applicant did not act with due diligence. The patent term extension that may be available under 35 U.S.C. 156 for premarket regulatory review is separate from and will be added to any extension that may be available under former and current 35 U.S.C. 154. See MPEP § 2750 *et seq.* 35 U.S.C. 154(b) was amended, effective May 29, 2000, to provide for patent term adjustment for applications filed on or after May 29, 2000, but the provisions of former 35 U.S.C. 154(b), as reproduced above, continue to apply to applications filed between and including June 8, 1995 and May 28, 2000.

Examiners make no decisions regarding patent term extensions. Extensions under former 35 U.S.C. 154 will be calculated by PALM and will be printed on the Notice of Allowance and Issue Fee Due. Any patent term extension granted as a result of administrative delay pursuant to 37 CFR 1.701 will also be printed on the face of the patent in generally the same location as the terminal disclaimer information. The term of a patent will be readily discernible from the face of the patent (i.e., from the filing date, continuing data, issue date and any patent term extensions printed on the patent).

If applicant disagrees with the patent term extension or adjustment information printed on the Notice of Allowance and Issue Fee Due, applicant may request review by way of a petition under 37 CFR 1.181. To avoid loss of patent term, however, any such petitions filed during the pendency of the application will not be decided until after issuance of the patent. If the petition is granted, a Certificate of Correction pursuant to 37 CFR 1.322 will be issued. If an error is noted after the patent issues, patentee may seek correction of the patent term extension information by filing a request for a Certificate of Correction pursuant to 37 CFR 1.322.

Petitions and Certificates of Correction regarding patent term extension under former 35 U.S.C. 154(b) should be addressed to the Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

2730 Applications Filed on or After May 29, 2000; Grounds for Adjustment

35 U.S.C. 154. Contents and term of patent; provisional rights.

*****

(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(2) LIMITATIONS.—

(A) IN GENERAL.— To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM.— No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5, United States Code, shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

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37 CFR 1.702. Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, on or after May 29, 2000).

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

(b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference proceedings.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a).

(d) *Delays caused by secrecy order.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under 35 U.S.C. 181.

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability.

(f) The provisions of this section and §§1.703 through 1.705 apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

35 U.S.C. 154(b), as amended effective May 29, 2000, and 37 CFR 1.702-1.705 apply to utility and plant patent applications filed on or after May 29, 2000. All references to 35 U.S.C. 154(b) hereinafter are to 35 U.S.C. 154(b), as amended effective May 29, 2000.

37 CFR 1.702 sets forth the bases for patent term adjustment under 35 U.S.C. 154(b)(1).

37 CFR 1.702(a) indicates that a patent is entitled to patent term adjustment if the Office fails to perform certain acts of examination within specified time frames (35 U.S.C. 154(b)(1)(A)).

37 CFR 1.702(b) indicates that a patent is entitled to patent term adjustment if, subject to a number of limitations, the Office fails to issue a patent within three years of the actual filing date of the application (35 U.S.C. 154(b)(1)(B)). In the case of an international application, the phrase "actual filing date of the application in the United States" means the date the national stage commenced under 35 U.S.C. 371(b) or

(f). See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 *FR* 56366, 56382-84, (Sept. 18, 2000), 1239 *Off. Gaz. Pat. Office* 14, 28-30 (Oct. 3, 2000).

37 CFR 1.702(c) indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by an interference proceeding (35 U.S.C. 154(b)(1)(C)(i)). 37 CFR 1.702(d) indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by the application being placed under a secrecy order under 35 U.S.C. 181 (35 U.S.C. 154(b)(1)(C)(ii)). 37 CFR 1.702(e) indicates that a patent is entitled to patent term adjustment if the issuance of the patent was delayed by successful appellate review under 35 U.S.C. 134, 141, or 145 (35 U.S.C. 154(b)(1)(C)(iii)).

37 CFR 1.702(f) provides that the provisions of 37 CFR 1.702 through 1.705 apply only to original (i.e., non-reissue) applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications. Since a continued prosecution application (CPA) filed under 37 CFR 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000, is entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705. Since a request for continued examination (RCE) filed under 35 U.S.C. 132(b) and 37 CFR 1.114 is **not** a new application (it is a submission in a previously filed application), filing an RCE in an application filed before May 29, 2000, does **not** cause that application to be entitled to the benefits of the patent term adjustment provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 through 1.705.

37 CFR 1.703. Period of adjustment of patent term due to examination delay.

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was and ending on the date the patent was issued;

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was under 35 U.S.C. 134 and § 1.191 and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

(c) The period of adjustment under § 1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under § 1.702(d) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151.

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was under 35 U.S.C. 134 and § 1.191 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(f) The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of adjustment attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under § 1.702 and this section beyond the expiration date specified in the disclaimer.

37 CFR 1.704. Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(1) Suspension of action under § 1.103 at the applicant's request, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under § 1.103 was and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under § 1.314, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under § 1.314 was filed and ending on the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under 35 U.S.C. 111(b) to a nonprovisional application under 35 U.S.C. 111(a) pursuant to 35 U.S.C. 111(b)(5), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date the application was filed under 35 U.S.C. 111(b) and ending on the date a request in compliance with §1.53(c)(3) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months;

(7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Board of Patent Appeals and Interferences, other than a decision designated as containing a new ground of rejection under § 1.196(b) or statement under § 1.196(c), or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; and

(11) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

(e) Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

37 CFR 1.705. Patent term adjustment determination

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A)Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any application for patent term adjustment under this section that requests reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Commissioner that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) If the patent is issued on a date other than the projected date of issue and this change necessitates a revision of the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section.

(e) The periods set forth in this section are not extendable.

(f) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

2750 Patent Term Extension for Delays at other Agencies under 35 U.S.C. 156

The right to a patent term extension based upon regulatory review is the result of the Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585 (codified at 21 U.S.C. 355(b), (j), (l); 35 U.S.C. 156, 271, 282)(Hatch-Waxman Act). The act sought to eliminate two distortions to the normal "patent term produced by the requirement that certain products must receive premarket regulatory approval." *Eli Lilly & Co. v. Medtronic Inc.*, 496 U.S. 661, 669, 15 USPQ2d 1121, 1126 (1990). The first distortion was that the patent owner loses patent term during the early years of the patent because the product cannot be commercially marketed without approval from a regulatory agency. The second distortion occurred after the end of the patent term because competitors could not immediately enter the market upon expiration of the patent because they were not allowed to begin testing and other activities necessary to receive FDA approval before patent expiration.

The part of the act codified as 35 U.S.C. 156 was designed to create new incentives for research and development of certain products subject to premarket government approval by a regulatory agency. The statute enables the owners of patents on certain human drugs, food or color additives, medical devices, animal drugs, and veterinary biological products to restore to the terms of those patents some of the time lost while awaiting premarket government approval from a regulatory agency. The rights derived from extension of the patent term are limited to the approved product (as defined in 35 U.S.C. 156(a)(4) and (a)(5)). See 35 U.S.C. 156(b). Accordingly, if the patent claims other products in addition to the approved product, the exclusive patent rights to the additional products expire with the original expiration date of the patent.

In exchange for extension of the term of the patent, Congress legislatively overruled *Roche Products v. Bolar Pharmaceuticals*, 733 F.2d 858, 221 USPQ 937 (Fed. Cir. 1984) as to products covered by 35 U.S.C. 271(e) and provided that it shall not be an act of infringement, for example, to make and test a patented drug solely for the purpose of developing and submitting information for an Abbreviated New Drug Application (ANDA). 35 U.S.C. 271(e)(1). See Donald O. Beers, *Generic and Innovator Drugs: A Guide to FDA Approval Requirements*, Fifth Edition, Aspen Law & Business, 1999, 4.3[2] for a discussion of the Hatch-Waxman Act and infringement litigation. Furthermore, Congress provided that an ANDA cannot be filed until five years after the approval date of the product if the active ingredient or a salt or ester of the active ingredient had not been previously approved under section 505(b) of the Federal Food, Drug and Cosmetic Act. 21 U.S.C. 355(j)(4)(D)(ii). See also Lourie, *Patent Term Restoration: History, Summary, and Appraisal*, 40 Food, Drug and Cosmetic L. J. 351, 353-60 (1985). See also Lourie,

Patent Term Restoration, 66 J. Pat. Off. Soc'y 526 (1984).

On November 16, 1988, 35 U.S.C. 156 was amended by Public Law 100-670, essentially to add animal drugs and veterinary biologics to the list of products that can form the basis of patent term extension. Animal drug products which are primarily manufactured through biotechnology are excluded from the provisions of patent term extension.

On December 3, 1993, 35 U.S.C. 156 was further amended to provide for interim extension of a patent where a product claimed by the patent was expected to be approved, but not until after the original expiration date of the patent. Public Law 103-179, Section 5.

An application for the extension of the term of a patent under 35 U.S.C. 156 must be submitted by the owner of record of the patent or its agent within the sixty-day period beginning on the date the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. See 35 U.S.C. 156(d)(1). The USPTO initially determines whether the application is formally complete and whether the patent is eligible for extension. The statute requires the Commissioner of Patents and Trademarks to notify the Secretary of Agriculture or the Secretary of Health and Human Services of the submission of an application for extension of patent term which complies with 35 U.S.C. 156 within sixty days and to submit to the Secretary a copy of the application. Not later than thirty days after receipt of the application from the Commissioner, the Secretary will determine the length of the applicable regulatory review period and notify the Commissioner of the determination. If the Commissioner determines that the patent is eligible for extension, the Commissioner calculates the length of extension for which the patent is eligible under the appropriate statutory provision and issues an appropriate Certificate of Extension.

Patent term extensions provided by private relief legislation, public laws other than as enacted by 35 U.S.C. 156, such as 35 U.S.C. 155 and 155A, are not addressed herein.

2751 Eligibility Requirements

35 U.S.C. 156. Extension of patent term

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent, which shall include any patent term adjustment granted under section 154(b) if —

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended under subsection (e)(1) of this section;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

(4) the product has been subject to a regulatory review period before its commercial marketing or use;

(5)(A) except as provided in subparagraph (B) or (C), the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of the product under the provision of law under which such regulatory review period occurred;

(B) in the case of a patent which claims a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use of the product after such regulatory period is the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or

(C) for purposes of subparagraph (A), in the case of a patent which —

(i) claims a new animal drug or a veterinary biological product which (I) is not covered by the claims in any other patent which has been extended, and (II) has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and

(ii) was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the "approved product."

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(f) For purposes of this section:

(1) The term "product" means:

(A) A drug product.

(B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

(2) The term "drug product" means the active ingredient of—

(A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) or

(B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.

(3) The term "major health or environmental effects test" means a test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use. Periods of analysis or evaluation of test results are not to be included in determining if the conduct of a test required at least six months.

(4)(A)Any reference to section 351 is a reference to section 351 of the Public Health Service Act.

(B) Any reference to section 503, 505, 512, or 515 is a reference to section 503, 505, 512, or 515 of the Federal Food, Drug and Cosmetic Act.

(C) Any reference to the Virus-Serum-Toxin Act is a reference to the Act of March 4, 1913 (21 U.S.C. 151 - 158).

(5) The term "informal hearing" has the meaning prescribed for such term by section 201(y) of the Federal Food, Drug and Cosmetic Act.

(6) The term "patent" means a patent issued by the United States Patent and Trademark Office.

(7) The term "date of enactment" as used in this section means September 24, 1984, for human drug product, a medical device, food additive, or color additive.

(8) The term "date of enactment" as used in this section means the date of enactment of the Generic Animal Drug and Patent Term Restoration Act for an animal drug or a veterinary biological product.

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37 CFR 1.710. Patents subject to extension of the patent term

(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term *product* referred to in paragraph (a) of this section means —

(1) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

37 CFR 1.720. Conditions for extension of patent term

The term of a patent may be extended if:

(a) The patent claims a product or a method of using or manufacturing a product as defined in § 1.710;

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to §§ 1.701, 1.760, or 1.790;

(c) An application for extension is submitted in compliance with § 1.740;

(d) The product has been subject to a regulatory review period as defined in 35 U.S.C. 156(g) before its commercial marketing or use;

(e) The product has received permission for commercial marketing or use and —

(1) The permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(2) In the case of a patent other than one directed to subject matter within § 1.710(b)(2) claiming a method of manufacturing the product that primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent, or

(3) In the case of a patent claiming a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

(f) The application is submitted within the sixty-day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review period occurred; or in the case of a patent claiming a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or in the case of a patent that claims a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and said drug or product has received permission for the commercial marketing or use in non-food-producing animals, the

application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal;

(g) The term of the patent, including any interim extension issued pursuant to § 1.790, has not expired before the submission of an application in compliance with § 1.741; and

(h) No other patent term has been extended for the same regulatory review period for the product.

35 U.S.C. 156(a) sets forth what patents can be extended and the conditions under which they may be extended. 37 CFR 1.710 also addresses the patents that may be extended, and 37 CFR 1.720 describes the conditions under which a patent may be extended. As set forth in 35 U.S.C. 156 and 37 CFR 1.710, a patent which claims a human drug product, medical device, food or color additive first approved for marketing or use after September 24, 1984, or an animal drug or veterinary biological product (which was not primarily manufactured through biotechnology) first approved for marketing or use after November 16, 1988, may qualify for patent term extension. Furthermore, 35 U.S.C. 156(a)(1) - (5) require that the applicant establish that:

(1) the patent has not expired before an application under 35 U.S.C. 156(d) was filed (this may be an application for patent term extension under subsection (d)(1) or an application for interim extension under subsection (d)(5));

(2) the patent has never been extended under 35 U.S.C. 156(e)(1);

(3) the application for extension is submitted by the owner of record of the patent or its agent to the Office within 60 days of regulatory agency approval of the commercial marketing application and the application includes details relating to the patent, the approved product, and the regulatory review time spent in securing regulatory agency approval;

(4) the product has been subject to a regulatory review period within the meaning of 35 U.S.C. 156(g) before its commercial marketing or use;

(5) the approval is the first permitted commercial marketing or use of the product (35 U.S.C. 156(a)(5)(A)), except in the case of human drug products manufactured using recombinant DNA technology where the provisions of 35 U.S.C. 156(a)(5)(B) apply, or in the case of a new animal drug or a veterinary biological product where the provisions of 35 U.S.C. 156(a)(5)(C) apply.

35 U.S.C. 156(c)(4) also requires that no other patent term has been extended for the same regulatory review period for the product. See MPEP § 2761.

MEANING OF "PRODUCT" AS DEFINED IN 35 U.S.C. 156(f)

As required by 35 U.S.C. 156(a), patents eligible for extension of patent term are those which:

(A) claim a "product" as defined in 35 U.S.C. 156(f)(1), either alone or in combination with other ingredients, wherein the product reads on a composition (product) that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and

(B) meet all other conditions and requirements of the statute.

The term "claims a product" is not synonymous with "infringed by a product." A patent which claims a metabolite of an approved drug does not claim the approved drug. *Hoechst-Roussel Pharmaceuticals Inc. v. Lehman*, 109 F.3d 756, 759, 42 USPQ2d 1220, 1223 (Fed. Cir. 1997).

The term "product" means:

(A) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(B) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(C) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

See 21 CFR 60.3(b) for definitions of terms such as active ingredient, color additive, food additive, human drug product, and medical device.

Essentially, a "product" is a "drug product," medical device, food additive, or color additive requiring Food and Drug Administration or Department of Agriculture (Plant and Animal Inspection Service) approval of an order or regulation prior to commercial marketing or use. "Drug product" is the active ingredient of a human drug, animal drug (excluding those primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques), or biological product (as defined by the Federal Food, Drug and Cosmetics Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient. Animal biological products are approved by the Plant and Animal Inspection Service of the Department of Agriculture.

A "drug product" means the active ingredient found in the final dosage form prior to administration of the product to the patient, not the resultant form the drug may take after administration. In this regard, a drug in the ester form which is used for oral administration is a different drug product from the same active moiety in a salt form which is administered by injection, even though both the salt and the ester are used to treat the same disease condition. The ester form is a different active ingredient from the salt form. Both the ester and the salt active ingredient may each support an extension of patent term of different patents provided the acid itself has not previously been approved. See *Glaxo Operations UK Ltd. v. Quigg*, 706 F.Supp. 1224, 1232-33, 10 USPQ2d 1100, 1107 (E.D. Va. 1989); *aff'd.*, 894 F.2d 392, 13 USPQ2d 1628 (Fed. Cir. 1990).

Furthermore, a "drug product" is the active ingredient of a particular new drug, rather than the entire composition of the drug product approved by the Food and Drug Administration. See *Fisons plc v. Quigg*, 1988 U.S. Dist. LEXIS 10935; 8 USPQ2d 1491, 1495 (D.D.C. 1988); *aff'd.*, 876 F2d 99, 110; 10 USPQ2d 1869, 1870 (Fed. Cir. 1989). An active ingredient of a drug is the ingredient in the drug product that becomes therapeutically active when administered. *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 393, 13 USPQ2d 1628, 1629 (Fed. Cir. 1990); *but c.f., Abbott Laboratories v. Young*, 920 F.2d 984, 989 n.7 (D.C. Cir. 1990), *cert denied*, 112 S. Ct. 76 (1991) (The court rejected the approach of *Glaxo* in considering whether *Abbott* was entitled to exclusivity).

A patent is considered to claim the product at least in those situations where the patent claims the active ingredient per se, or claims a composition or formulation which contains the active ingredient(s) and reads on the composition or formulation approved for commercial marketing or use.

NO PREVIOUS EXTENSIONS (WITH LIMITED EXCEPTIONS)

37 CFR 1.720(b) explains that patent term extension pursuant to 35 U.S.C. 156 is available only if the term of the patent has never been previously extended, except for extensions issued pursuant to 37 CFR 1.701, 1.760, or 1.790. An extension issued pursuant to 37 CFR 1.701 is an extension of the patent due to administrative delay within the Office. Note that the term of a patent is "adjusted," not extended, pursuant to 37 CFR 1.702-1705. An extension issued pursuant to 37 CFR 1.760 is an interim extension under 35 U.S.C. 156(e)(2). An extension issued pursuant to 37 CFR 1.790 is an interim extension under 35 U.S.C. 156(d)(5).

REGULATORY REVIEW PERIOD

37 CFR 1.720(d) restates the statutory requirement set forth in 35 U.S.C. 156(a)(4). The regulatory review period must have been a regulatory review period defined by the statute. A regulatory review period under section 510(k) of the Federal Food, Drug and Cosmetic Act is not a regulatory review period which gives rise to eligibility for patent term extension under 35 U.S.C. 156. *In re Nitinol Medical Technologies Inc.*, 17 USPQ2d 1492, 1492-1493 (Comm'r Pat. & Tm. 1990). See also *Baxter Diagnostics v. AVL Scientific Corp.* 798 F. Supp. 612, 619-620; 25 USPQ2d 1428,1434 (CD CA 1992)(Congress intended only Class III medical devices to be eligible for patent term extension).

If the product is alleged to be a medical device, then regulatory review must have occurred under section 515, and not section 505, of the Federal Food, Drug and Cosmetic Act. Drug products are not reviewed under section 515.

If more than one application for patent term extension is filed based upon a single regulatory review period, election will be required of a single patent. See MPEP § 2761.

FIRST PERMITTED MARKETING OR USE

37 CFR 1.720(e) follows 35 U.S.C. 156(a)(5), and sets forth that the approval under the relevant provision of law must have been the first permitted marketing or use of the product under the provision of law, unless the product is for use in food producing animals as explained below. See *In re Patent Term Extension Application, U.S. Patent No. 3,849,549*, 226 USPQ 283, 284 (Pat. & Tm. Office 1985). If the product is a human drug product, then the approval of the active ingredient must be the first permitted commercial marketing or use of the active ingredient as a single entity or in combination with another active ingredient under the provision of law under which regulatory review occurred.

Where a product contains multiple active ingredients, if any one active ingredient has not been previously approved, it can form the basis of an extension of patent term provided the patent claims that ingredient. See *In re Alcon Laboratories Inc.*, 13 USPQ2d 1115, 1121 (Comm'r Pat. & Tm. 1989) for examples of products having different combinations of active ingredients. A different ratio of hormones is not a different active ingredient for purposes of 35 U.S.C. 156. Furthermore, an approved product having two active ingredients, which are not shown to have a synergistic effect or have pharmacological interaction, will not be considered to have a single active ingredient made of the two active ingredients.

As to 35 U.S.C. 156(a)(5)(C), which is addressed in 37 CFR 1.720(e)(3), the term of a patent directed to a new animal drug or veterinary biological product may be extended based on a second or subsequent approval of the active ingredient provided all the following conditions exist:

(A) the patent claims the drug or product;

(B) the drug or product is not covered by the claims in any other patent that has been extended;

(C) the patent term was not extended on the basis of the regulatory review period for use in non-food producing animals; and

(D) the second or subsequent approval was the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal. In this case, the application must be filed within sixty days of the first approval for administration to a food-producing animal.

For animal drugs or products, prior approval for use in a non-food producing animal will not make a patent ineligible for patent term extension based upon a later approval of the drug or product for use in food producing animals, if the later approval is the first approval of the drug or product for use in food producing animals.

2752 Patent Term Extension Applicant

35 U.S.C. 156. Extension of patent term

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(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain —

(A) the identity of the approved product and the Federal statute under which regulatory review occurred;

(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent;

(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);

(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities; and

(E) such patent or other information as the Director may require.

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37 CFR 1.730. Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of § 1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with § 3.73(b) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (*e.g.*, a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

35 U.S.C. 156(d)(1) requires that the application for extension of the patent term must be submitted by the owner of record of the patent or its agent. If the application is filed by an assignee, the application papers should refer to the reel and frame number of the recorded assignment. A power of attorney from the patent owner to any patent attorney or agent submitting the patent term extension application papers should be filed, if the attorney or agent is not already of record in the patent (see 37 CFR 1.34(b)).

If the applicant for patent term extension was not the marketing applicant before the regulatory agency, then there must be an agency relationship between the patent owner and the marketing applicant during the regulatory review period. To show that such an applicant is authorized to rely upon the activities of the marketing applicant before the Food and Drug Administration or the Department of Agriculture, it is advisable for the applicant for patent term extension to obtain a letter from the marketing applicant specifically authorizing such reliance.

2753 Application Contents

37 CFR 1.740. Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Commissioner. A formal application for the extension of patent term must include:

(1) A complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) A complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) An identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) In the case of a drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients), the use for which it was approved, and the provision of law under which it was approved.

(5) A statement that the application is being submitted within the sixty day period permitted for submission pursuant to § 1.720(f) and an identification of the date of the last day on which the application could be submitted;

(6) A complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) A copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) A copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a *Federal Register* notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

(11) A brief description beginning on a new page of the significant activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) A statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) A statement that applicant acknowledges a duty to disclose to the Commissioner of Patents and Trademarks and the Secretary of Health and Human Services or the Secretary of Agriculture any information which is material to the determination of entitlement to the extension sought (see § 1.765);

(14) The prescribed fee for receiving and acting upon the application for extension (see § 1.20(j)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application (for a total of three copies).

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

37 CFR 1.740 sets forth the requirements for a formal application for extension of patent term. See MPEP § 2752 for a discussion of who may apply for a patent term extension. See 37 CFR 1.741 and MPEP § 2754 for a description of the information that must be submitted in the patent term extension application in order to be accorded a filing date.

37 CFR 1.740(a)(1) requires a complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics so as to enable the Commissioner to make a determination of whether the patent claims the approved product, or a method of using or manufacturing the approved product.

37 CFR 1.740(a)(2) requires a complete identification of the federal statute including the applicable provision of law under which the regulatory review occurred. When the regulatory review of the product took place under more than one Federal statute, each appropriate statute should be listed. This could apply to a situation where a human biological product is tested under an investigational new drug (IND) application pursuant to the Federal Food, Drug, and Cosmetic Act, but is approved under the Public Health Service Act; or to a situation where approval is sought for use of a particular medical device with a specific drug product which may require approval under more than a single provision of law. The product that forms the basis of an application for patent term extension must be either a medical device or a drug product; it cannot be a combination of those separate products. See the file history of U.S. Patent No. 4,428,744 for an example of the application of this principle.

The date that a product receives permission for commercial marketing or use (which must be identified pursuant to 37 CFR 1.740(a)(3)) is generally the mailing date of the letter from the regulatory agency indicating regulatory approval. For a food additive, the approval date is generally the effective date stated in the regulation and the date the regulation is published.

37 CFR 1.740(a)(4) provides that for drug products, each active ingredient must be identified and there must be an indication of the use for which the product was approved. For each active ingredient, a statement must be made that either the active ingredient was not previously approved for commercial marketing or use under the Federal Food, Drug and Cosmetic Act, or that the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients) and the provision of law under which it was approved. The information is

especially necessary for a determination of eligibility where, for example, the application is based on a second or subsequent approval of an active ingredient, but the first approval for administration to a food-producing animal.

In accordance with 37 CFR 1.740(a)(5), the application must be submitted within the sixty day period permitted for submission pursuant to 37 CFR 1.720(f). If the sixty day period ends on a Saturday, Sunday or Federal holiday, then the last day on which the application could be submitted will be considered to be the next business day following the Saturday, Sunday or Federal holiday. See 37 CFR 1.7. However, applicants are cautioned to avoid filing an application for patent term extension on the last day for filing to avoid the application being denied because the filing deadline was inadvertently missed.

The expiration date of the patent for which an extension is sought as identified pursuant to 37 CFR 1.740(a)(6) should be the expiration date according to the law (35 U.S.C. 154) at the time of filing of the application for patent term extension, and should include any patent term adjustment under 35 U.S.C. 154(b).

Pursuant to 37 CFR 1.740(a)(9), the application for patent term extension need only explain how one product claim of the patent claims the approved product, if there is a claim to the product. In addition, the application need only explain how one method of use claim of the patent claims the method of use of the approved product, if there is a claim to the method of use of the product. Lastly, the application need only explain how one claim of the patent claims the method of manufacturing the approved product, if there is a claim to the method of manufacturing the approved product. At most, a showing explaining three claims is required. However, each claim that claims the approved product, the method of use of the approved product, or the method of manufacturing the approved product must be listed. See 35 U.S.C. 156(d)(1)(B).

The showing should clearly explain how each listed claim reads on the approved product. For example, where a generic chemical structure is used in the claim to define the claimed invention, a listing of variables and substituents which correspond to the approved product is appropriate. Where a claim uses the "means for" language permitted by 35 U.S.C. 112, paragraph 6, reference to the column and line number of the patent text and any drawing reference numbers, as well as a description of any relevant equivalents, is also appropriate.

Pursuant to 37 CFR 1.740(a)(10), the patent term extension applicant must provide a statement to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory period. In cases where there is no regulatory event to reflect the commencement of the testing or approval phase of the regulatory review period, applicants should include in the application the dates that they claim initiate either the approval or the testing phases and an explanation of their reasonable bases for why they conclude that these dates are the relevant dates. For instance, when the clinical trials are conducted outside of the United States, the testing phase for a medical device begins on the date the clinical investigation involving the device began. An applicant should include an explanation as to why the date claimed is the date on which such clinical investigations had commenced. If the applicant has any means of substantiating that date, that information should be included in the application.

37 CFR 1.740(a)(11) requires a brief description of the activities of the marketing applicant before the regulatory agency. This description should include an identification of significant communications of substance with the regulatory agency and the dates related to such communications. For example, these activities would include the dates of the submissions of new data to the FDA, communications between FDA and the applicant with respect to the appropriate protocols for testing the product, and communications between FDA and the applicant that are attempts to define the particular requirements for premarketing approval for this particular product. The applicant is not required to establish the existence of due diligence during the regulatory review period in order to have a complete application.

As stated above, the marketing applicant must have been an agent of the patent owner, if not the same entity as the patent owner. Accordingly, the Office will not assist the patent owner in obtaining information required in an application for patent term extension from the marketing applicant. It is sufficient that the description of the activities briefly identify those significant activities undertaken by the marketing

applicant directed toward regulatory approval, and a submission of insignificant details or identification of non-substantive communications is not required.

37 CFR 1.740(a)(12) requires that the extension applicant state the length of extension claimed and show how the length of extension was calculated, including whether the 14-year limit of 35 U.S.C. 156(c)(3) or the two or three limit of 35 U.S.C. 156(g)(6)(C) applies.

37 CFR 1.740(a)(15) requires the patent term extension applicant to provide a correspondence address. A fax number should also be provided. Normally only communications regarding the application for patent term extension will be sent to the address specified in the patent term extension application. If the address is changed after filing the application for patent term extension, the change of address should be sent to Box Patent Extension, since changing the address for the patent file will not cause the address for the patent term extension application to also be changed.

In order to change the address of all correspondence, including maintenance fee reminders, a change of address should also be filed. A change of address must be signed by the patent applicant, the assignee of the entire interest, or an attorney or agent of record. 37 CFR 1.33(a). Accordingly, if the patent term extension application is signed by the marketing applicant, as an agent of the patent owner, a power of attorney from the patent owner to any attorney for the marketing applicant would be necessary for the attorney for the marketing applicant to be able to sign a change of address for the patent file.

Pursuant to 37 CFR 1.740(b), two additional copies of the application for patent term extension must be filed with the application. In addition, applicants are requested to file an additional two copies of the application, for a total of five copies. The original copy is placed into the patent application file after the Notice of Final Determination is mailed. Two copies of the application are forwarded to the regulatory agency, one copy is made available for public inspection in the Office of Patent Legal Administration, and the fifth copy is used by the Legal Advisor.

2754 Filing Date

37 CFR 1.741. Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in §1.8 or § 1.10. A complete application must include:

(1) An identification of the approved product;

(2) An identification of each Federal statute under which regulatory review occurred;

(3) An identification of the patent for which an extension is being sought;

(4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;

(5) Sufficient information to enable the Commissioner to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Commissioner and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

(6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

FILING DATE ACCORDED

An application for patent term extension under 35 U.S.C. 156 may be filed by mail addressed to the Assistant Commissioner for Patents, Box **Patent Ext.**, Washington, D.C. 20231 or may be hand carried to the Office of Patent Legal Administration. Applicants are encouraged to use the post card receipt practice described in MPEP § 502.

As set forth in 37 CFR 1.741(a), the filing date of an application for patent term extension is the date on which a complete application is received in the USPTO or filed pursuant to the certificate of mailing provisions of 37 CFR 1.8 (see MPEP § 512 for suggested formats for a certificate of mailing) or the Express Mail provisions of 37 CFR 1.10. Patent term extension applications should not be filed

by facsimile, however correspondence setting forth a change of address and other papers relating to a patent term extension may be sent by facsimile to the Office of Patent Legal Administration.

COMPLETE APPLICATION

The term "complete application" is defined in 37 CFR 1.741(a) and is an application meeting the requirements set forth in 35 U.S.C. 156(d)(1). For the establishment of a filing date, the distinction between the requirements of 37 CFR 1.740 and the requirements of 37 CFR 1.741 are important. While the requirements of 37 CFR 1.740 may be satisfied outside the 60 day filing period, the requirements of 37 CFR 1.741 are mandated by 35 U.S.C. 156 and must be satisfied within the 60 day filing period for the establishment of the filing date. The Office will consider each of these statutory requirements to be satisfied in an application which provides sufficient information, directed to each requirement, to act on the application, even though further information may be desired by the USPTO or the regulatory agency before a final determination of eligibility and length of patent term extension is made.

INFORMAL APPLICATION

37 CFR 1.740. Formal requirements for application for extension of patent term; correction of informalities.

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(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

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If the application does not meet all the formal requirements of 37 CFR 1.740(a) (see MPEP § 2753), the applicant will be notified of the informalities and may seek to have that holding reviewed under 37 CFR 1.740(c) or to correct the informality. The time periods set forth therein are subject to the provisions of 37 CFR 1.136, unless otherwise stated in the notice.

Note that if the application satisfies the requirements of 37 CFR 1.741, the application filing date will have been established even if the application is held to be informal under 37 CFR 1.740.

2754.01 Deadline for Filing an Application Under 35 U.S.C. 156(d)(1)

An application for patent term extension under 35 U.S.C. 156(d)(1) may only be filed within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The statutory time period is not extendable and cannot be waived or excused. See U.S. Patent No. 4,486,425 (application for patent term extension filed after the end of the 60-day period and was therefore denied). The sixty-day period begins on the regulatory agency approval date which marks the end of the regulatory review period. The statute takes into account only the regulatory review carried out by the Food and Drug Administration or the Department of Agriculture and no other government obstacles to marketing or use. See *Unimed, Inc. v. Quigg*, 888 F2d 826, 828; 12 USPQ2d 1644, 1646 (Fed. Cir. 1989). For drug products the approval date is the date of a letter by the Food and Drug Administration indicating that the application has been approved, even if the letter requires further action before the drug can be marketed. *Mead Johnson Pharmaceutical Group v. Bowen*, 838 F2d 1332, 1336; 6 USPQ2d 1565, 1568 (D.C. Cir. 1988). For food or color additives, the relevant date is the effective date of the regulation or order, which is set forth in the regulation or order, and which is generally the date that the regulation or order is published, e.g., in the Federal Register. See 21 U.S.C. 348(e). This date will generally be later than the date the approval is communicated to the marketing applicant.

2754.02 Filing Window for an Application Under 35 U.S.C. 156(d)(5)

A first application for interim extension under 35 U.S.C. 156(d)(5) (to extend the patent term before product approval) must be filed within the period beginning six months and ending fifteen days before the patent is due to expire. Each subsequent application for interim extension must be filed during the period beginning sixty days before and ending thirty

days before the expiration of the preceding interim extension. 35 U.S.C. 156(d)(5)(C). An interim extension granted under 35 U.S.C. 156(d)(5) terminates sixty days after permission for commercial marketing or use of the product is granted, except, if within the sixty-day period any additional information needed for an application for patent term extension under 35 U.S.C. 156(d)(1) is submitted, the patent may be further extended. 35 U.S.C. 156(d)(5)(E). The additional information required to be submitted includes the fee for an application for patent term extension under 35 U.S.C. 156(d)(1) and identification of the date the product received permission for commercial marketing or use and a statement that the application is being submitted within sixty days of such date and identification of the last date that the application could be submitted. See 37 CFR 1.740(a)(3) and (5). However, if the product is not approved within the period of interim extension, a new request for interim extension must be filed and another interim extension granted to keep the patent in force. An applicant is generally limited to four one-year interim extensions.

See MPEP § 2755.02 for additional information pertaining to the interim extension of patent term under 35 U.S.C. 156(d)(5).

2754.03 Filing of a Request for an Extension Under 35 U.S.C. 156(e)(2)

A request for an interim extension under 35 U.S.C. 156(e)(2) (to extend the patent term during the processing of the patent term extension application) should be made at least three months before the patent is due to expire. See MPEP § 2755.01 for information pertaining to the interim extension of patent term under 35 U.S.C. 156(e)(2).

2755 Eligibility Determination

37 CFR 1.750. Determination of eligibility for extension of patent term

A determination as to whether a patent is eligible for extension may be made by the Commissioner solely on the basis of the representations contained in the application for extension filed in compliance with § 1.740 or § 1.790. This determination may be delegated to appropriate Patent and Trademark Office officials and may be made at any time before the certificate of extension is issued. The Commissioner or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. In an application for extension filed in compliance with § 1.740, a notice will be mailed to applicant containing the determination as to the eligibility of the patent for extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of § 1.136.

The determination as to whether a patent is eligible for an extension will normally be made solely from the representations contained in the application for patent term extension. However, further information may be required or inquiry made of applicant before a final determination is made on whether a patent is eligible for extension. In circumstances where further information is required by the Office, the applicant will be given a time period within which to respond. The failure to provide a response within the time period provided may result in a final determination adverse to the granting of an extension of patent term unless the response period is extended. An extension of time to respond may be requested under the provisions of 37 CFR 1.136. Under appropriate circumstances, e.g., if time is of the essence for a particular reason, a request for information may contain a statement that the provisions of 37 CFR 1.136(a) are not available. The intentional failure to provide the information requested may result in an adverse final determination.

A final determination may be made at any time after an application is filed. A single request for reconsideration of a final determination may be filed within one month or within such other time period set in the final determination. A notice will be mailed to applicant containing the determination as to eligibility of the patent for extension and the period of time of the extension of the term, if any. This notice shall constitute the final determination as to eligibility and any period of extension of the patent term. If no request for reconsideration is filed within the time period set in the notice of final determination, the certificate of patent term extension will be issued in due course. See MPEP § 2758.

2755.01 Interim Extension of Patent Term During the Processing of the Application

35 U.S.C. 156. Extension of patent term.

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(2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

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37 CFR 1.760. Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with § 1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to § 1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Commissioner may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

If the original term of the patent for which extension is sought will expire before a final decision to issue a certificate of extension can be made, and a determination is made that the patent is eligible for extension, 35 U.S.C. 156 provides that the Commissioner may issue an interim extension of the patent term for up to one year pending a final decision on the application for extension. Should additional time be necessary, additional interim extensions of up to one year may be granted by the Commissioner. The length of any interim extension is discretionary with the Commissioner so long as it is for one year or less. Its length should be set to provide time for completion of any outstanding requirements. See *In re Reckitt & Colman Products Ltd.*, 230 USPQ 369, 372 (Comm'r Pat. & Tm. 1986). The Commissioner may issue an interim extension under 35 U.S.C. 156(e)(2) with or without a request from the applicant.

Where a determination is made that the patent is not eligible for patent term extension, an interim extension of the patent term is not warranted under 35 U.S.C. 156(e)(2). See *In re Alcon Laboratories Inc.*, 13 USPQ2d 1115, 1123 (Comm'r. Pat.& Tm. 1989).

Where an interim extension has been granted and it is subsequently determined that the patent is not eligible for patent term extension, the interim extension may be vacated *ab initio* as ineligible under 35 U.S.C. 156(e)(2). See *In re Reckitt*, 230 USPQ at 370.

While 37 CFR 1.760 provides that a request for an interim extension by the applicant "should" be filed three months prior to the expiration of the patent, this time frame is not mandatory. Any request filed within a shorter period of time will be considered, upon a proper showing, where it is not possible to make an earlier request. However, for an interim extension to be granted, the application for extension, in compliance with 37 CFR 1.741, must have been filed prior to the expiration date of the patent. In no event will an interim extension be granted for a period of patent term extension longer than the period of extension to which the patent would be eligible.

A notice of each interim extension granted will be issued to the applicant for patent term extension. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the interim extension will be published in the Official Gazette of the Patent and Trademark Office.

2755.02 Interim Extension of Patent Term Before Product Approval

35 U.S.C. 156. Extension of patent term.

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(5)(A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days before such term is due to expire. The application shall contain—

(i) the identity of the product subject to regulating review and the Federal statute under which such review is occurring;

(ii) the identity of the patent for which interim extension is being sought and the identity of each claim of such patent which claims the product under regulatory review or a method of using or manufacturing the product;

(iii) information to enable the Director to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

(iv) a brief description of the activities undertaken by the applicant during the applicable regulatory review period to date with respect to the product under review and the significant dates applicable to such activities; and

(v) such patent or other information as the Director may require.

(B) If the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the Director shall publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

(C) The owner of record of a patent, or its agent, for which an interim extension has been granted under subparagraph (B), may apply for not more than 4 subsequent interim extensions under this paragraph, except that, in the case of a patent subject to subsection (g)(6)(C), the owner of record of the patent, or its agent, may apply for only 1 subsequent interim extension under this paragraph. Each such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

(D) Each certificate of interim extension under this paragraph shall be recorded in the official file of the patent and shall be considered part of the original patent.

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the day on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period, the applicant notifies the Director of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) for not to exceed 5 years from the date of expiration of the original patent term; or

(ii) if the patent is subject to subsection (g)(6)(C), from the date on which the product involved receives approval for commercial marketing or use.

(F) The rights derived from any patent the term of which is extended under this paragraph shall, during the period of interim extension—

(i) in the case of a patent which claims a product, be limited to any use then under regulatory review;

(ii) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent then under regulatory review; and

(iii) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the product then under regulatory review.

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37 CFR 1.790. Interim extension of patent term under 35 U.S.C. 156(d)(5).

(a) An owner of record of a patent or its agent who reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect may submit one or more applications for interim extensions for periods of up to one year each. The initial application for interim extension must be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire. Each subsequent application for interim extension must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension. In no event will the interim extensions granted under this section be longer than the maximum period of extension to which the applicant would be entitled under 35 U.S.C. 156(c).

(b) A complete application for interim extension under this section shall include all of the information required for a formal application under § 1.740 and a complete application under § 1.741. Sections (a)(1), (a)(2), (a)(4), and (a)(6) - (a)(17) of § 1.740 and § 1.741 shall be read in the context of a product currently undergoing regulatory review. Sections (a)(3) and (a)(5) of § 1.740 are not applicable to an application for interim extension under this section.

(c) The content of each subsequent interim extension application may be limited to a request for a subsequent interim extension along with a statement that the regulatory review period has not been completed along with any materials or information required under §§ 1.740 and 1.741 that are not present in the preceding interim extension application.

37 CFR 1.791. Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use.

Any interim extension granted under 35 U.S.C. 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files an application for extension under §§ 1.740 and 1.741 including any additional information required under 35 U.S.C. 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. 156.

If a patent that claims a product which is undergoing the approval phase of regulatory review as defined by 35 U.S.C. 156(g)(1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), and (5)(B)(ii) is expected to expire before approval is granted, interim patent term extension is available under 35 U.S.C. 156(d)(5). The application

for patent term extension that must be submitted is generally the same as would be filed had the product been approved, except that the approval date is not required to be set forth. Once the product is approved, the application must be converted to an application for patent term extension under 35 U.S.C. 156(d)(1) to obtain patent term extension under that subsection.

Processing of an application for interim patent term extension under 35 U.S.C. 156(d)(5) is performed in the Office of Patent Legal Administration and is similar to other applications for patent term extension, except that the Office is not required to seek the advice of the relevant regulatory agency. The relevant agency, however, is normally consulted before an interim extension is granted or before the application is denied. The fee for an application for patent term extension under 35 U.S.C. 156(d)(5) is set forth in 37 CFR 1.20(j)(2), and the fee for a subsequent application is set forth in 37 CFR 1.20(j)(3). Copies of an application for interim extension are maintained in the same manner as applications for patent term extension. As required by 35 U.S.C. 156(d)(5)(B), a determination that a patent is eligible for extension under 35 U.S.C. 156, but for regulatory approval, is published in the Federal Register. A sample order granting a second interim extension follows:

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re___

Request for Patent Term Extension
U.S. Patent No.___

ORDER GRANTING
INTERIM EXTENSION

On __, patent owner __, filed an application under 35 U.S.C. 156(d)(5) for interim extension of the term of U.S. Patent No. __. The patent claims the active ingredient __ in the human drug product "___." The application indicates that the product is currently undergoing a regulatory review before the Food and Drug Administration for permission to market or use the product commercially. The original term of the patent expired on ___ On ___, the patent was granted an first interim extension under 35 U.S.C. 156(d)(5) for a period of one year.

Review of the application indicates that except for receipt of permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. 156. Since it is apparent that the regulatory review period may extend beyond the date of expiration of the patent, as extended by the first interim extension, a second interim extension of the patent term under 35 U.S.C. 156(d)(5) is appropriate.

An interim extension under 35 U.S.C. 156(d)(5) of the term of U.S. Patent No. __ is granted for a period of one year from the extended expiration date of the patent.

As seen from the example given, a series of one-year interim extensions may be granted if requested in a timely manner (in the window of time between thirty and sixty days before the extended expiration date).

An interim extension granted under 35 U.S.C. 156(d)(5) terminates sixty days after permission for commercial marketing or use of the product is granted, except, if within the sixty day period any additional information needed for an application for patent term extension under 35 U.S.C. 156(d)(1) is submitted, the patent may be further extended. 35 U.S.C. 156(d)(5)(E).

2756 Correspondence Between the USPTO and the Regulatory Agency

It is the Commissioner's responsibility to decide whether an applicant has satisfied the requirements of the statute and whether the patent qualifies for patent term extension. The regulatory agency possesses expertise and records regarding some of the statutory requirements and has certain direct responsibilities under 35 U.S.C. 156 for determining the length of the regulatory review period. Consequently, to facilitate eligibility decisions and permit the regulatory agency and the Office to carry out their responsibilities under 35 U.S.C. 156, both the Food and Drug Administration and the Department of Agriculture have entered into an "agreement" of cooperation with the Office. *Memorandum of Understanding Between the Patent and Trademark Office and the Food and Drug Administration*, 52 Fed. Reg. 17830 (May 12, 1987); *Memorandum of Understanding Between the Patent and Trademark Office and the Animal and Plant Health Inspection Service*, 54 Fed. Reg. 26399 (June 23, 1989); 1104 OG 18 (July 11, 1989). The agreements establish the procedures whereby the regulatory agency assists the Office in determining a patent's eligibility for patent term restoration under 35 U.S.C. 156. It also establishes procedures for exchanging information between the regulatory agency and the Office regarding regulatory review

period determinations, due diligence petitions and informal regulatory agency hearings under the law. The patent term extension applicant receives a copy of all correspondence between the Office and the regulatory agency.

The Animal and Health Inspection Service of the Department of Agriculture is responsible for assisting the Office in determining the eligibility of patent claiming a veterinary biological product that has been subject to the Virus-Serum-Toxin Act (21 U.S.C. 151-59) and for determining the regulatory review period of the veterinary biological product. The Secretary of Health and Human Services of the Food and Drug Administration is responsible for assisting the Office in determining the eligibility of patents claiming any other product for which regulatory review gives rise to eligibility for patent term extension. 21 CFR 60.10.

INFORMATION REGARDING ELIGIBILITY FOR EXTENSION

If the Office has no clear reason to deny eligibility for patent term extension (even if there are questions concerning eligibility), or if the applicant has been notified of any informalities and it is anticipated that the informalities will be corrected or explained, a first letter is sent to the regulatory agency requesting information regarding eligibility. The letter is accompanied by a copy of the patent term extension application. This letter does **not** request the determination of the applicable regulatory review period.

The regulatory agency reply is usually in the form of a written response:

(A) verifying whether the product has undergone a regulatory review period within the meaning of 35 U.S.C. 156(g) prior to commercial marketing or use;

(B) stating whether the marketing permission was for the first permitted commercial marketing or use of that product, or, in the case of recombinant DNA technology, whether such commercial marketing or use was the first permitted under the process claimed in the patent;

(C) informing the Office whether the patent term extension application was submitted within sixty days after the product was approved for marketing or use; and

(D) providing the Office with any other information relevant to the Office determination of whether a patent related to a product is eligible for patent term extension.

While the Office has primary responsibility for the eligibility determination, the regulatory agency often possesses information which is not readily available to the Office. The assistance on the part of the regulatory agency enables both the Office and the agency to process applications efficiently and to conserve resources.

PRELIMINARY ELIGIBILITY DECISION

Upon receipt of a reply from the regulatory agency to the first letter from the Office requesting assistance on determining eligibility, a preliminary eligibility decision (not the final decision) is made as to whether the patent is eligible for an extension of its term. As noted above, the reply from the regulatory agency will usually inform the Office as to whether the permission for commercial marketing and use of the product on which the application for patent term extension is based is the first such approval for that product. Furthermore, the regulatory agency usually provides information regarding the date of product approval to permit a determination as to whether the application was filed within the sixty-day statutory period. The information provided by the regulatory agency is then compared with the related information from the application. If no major discrepancies are found and the patent is determined to be eligible for patent term extension, a second letter requesting a determination of the length of the regulatory review period of the product is mailed to the regulatory agency not later than sixty (60) days after the Office receipt date of the reply from the regulatory agency. In the interest of efficiency, if the patent is determined to be ineligible for patent term extension, the Office will dismiss the application rather than request a determination of the regulatory review period. *In re Allen & Hansbury, Ltd.*, 227 USPQ 955, 960 n. 9 (Comm'r Pat. & Tm. 1985). A certified copy of the application for patent term extension is sent to the regulatory agency along with the second letter. The second letter states that, subject to final review, the patent is considered eligible for patent term extension and requests a determination of the applicable regulatory review period.

2757 Regulatory Agency Determination of the Length of the Regulatory Review Period

Under 35 U.S.C. 156, the regulatory agency is responsible for the determination of the length of the regulatory review period for the approved product on which the application for patent term extension is based. The determination by the regulatory agency is made based on the application as well as the official regulatory agency records for the approved product. See, e.g., 21 CFR Ch. 1, Subpart C. The determination of the length of the regulatory review period is solely the responsibility of the regulatory agency. *Aktiebolaget Astra v. Lehman*, 71 F.3d 1578, 1580-81, 37 USPQ2d 1212, 1214-15 (Fed. Cir. 1995); U.S. Patent No. 4,215,113.

Once the determination has been made, the regulatory agency publishes the information in the Federal Register and forwards a letter to the Office with the same information. Included in both the Federal Register Notice and the letter to the Office are the total length of the regulatory review period and the relevant dates on which the determination is based. Both the letter to the Office and the Federal Register Notice separate the total regulatory period into the initial or testing phase and the final approval phase. This provides the Office with the information necessary to determine the actual length of extension for which the patent may be eligible. The Federal Register Notice also sets a date, 180 days after publication of the notice, as a deadline for filing written comments concerning any of the information set forth in the notice or a petition for a determination regarding whether the marketing applicant has acted with due diligence during the regulatory review period. The letter to the Office makes clear that the determination does not take into account the issue date of the patent nor does it exclude one-half of the testing phase.

The regulatory review period determination is not final until due diligence petitions and informal hearings, if any, have been resolved. A certificate for extension of the term of a patent may not issue from the Office until the regulatory review period determination is final unless an interim extension appears warranted under 35 U.S.C. 156(d)(5) and (e)(2).

2757.01 Due Diligence Determination

If a due diligence petition is filed during the 180-day period following publication of the regulatory agency determination of the regulatory review period, the regulatory agency (e.g., FDA) makes the determination under 35 U.S.C. 156(d)(2)(B) whether the applicant for patent term extension acted with due diligence during the regulatory review proceedings. The term "due diligence" is defined in 35 U.S.C. 156(d)(3) as "that degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period." After affirming or revising the determination of the regulatory review period, the regulatory agency notifies the Office and publishes the results in the Federal Register. If no comment or petition is filed in the time period provided, the regulatory agency notifies the Office that the period for filing a due diligence petition pursuant to the notice has expired and that the regulatory agency therefore considers its determination of the regulatory review period for the product to be final. Following notification from the regulatory agency, the Office proceeds with the final eligibility determination. See 21 CFR Ch. 1, Subparts D and E.

2758 Notice of Final Determination - Calculation of Patent Term Extension

35 U.S.C. 156. Extension of patent term.

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(c) The term of a patent eligible for extension under subsection (a) shall be extended by the time equal to the regulatory review period for the approved product which period occurs after the date the patent is issued, except that—

(1) each period of the regulatory review period shall be reduced by any period determined under subsection (d)(2)(B) during which the applicant for the patent extension did not act with due diligence during such period of the regulatory review period;

(2) after any reduction required by paragraph (1), the period of extension shall include only one-half of the time remaining in the periods described in paragraphs (1)(B)(i), (2)(B)(i), (3)(B)(i), (4)(B)(i), and (5)(B)(i) of subsection (g);

(3) if the period remaining in the term of a patent after the date of the approval of the approved product under the provision of law under which such regulatory review occurred when added to the regulatory review period as revised under paragraphs (1) and (2) exceeds fourteen years, the period of extension shall be

reduced so that the total of both such periods does not exceed fourteen years, and

(4) in no event shall more than one patent be extended under subsection (e)(i) for the same regulatory review period for any product.

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(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) If the patent involved was issued after the date of the enactment of this section, the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(B) If the patent involved was issued before the date of the enactment of this section and —

(i) no request for an exemption described in paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted,

(ii) no major health or environment effects test described in paragraph (2)(B) or (4)(B) was initiated and no petition for a regulation or application for registration described in such paragraph was submitted, or

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was submitted, before such date for the approved product the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(C) If the patent involved was issued before the date of the enactment of this section and if an action described in subparagraph (B) was taken before the date of enactment of this section with respect to the approved product and the commercial marketing or use of the product has not been approved before such date, the period of extension determined on the basis of the regulatory review period determined under such paragraph may not exceed two years or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years.

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After reviewing the information provided by the regulatory agency, if the Office determines the patent to be eligible for extension, the calculation is made of the length of extension for which the patent is eligible under the appropriate statutory provisions (35 U.S.C. 156(c); 37 CFR 1.750). The length of extension is subject to the limitations of 35 U.S.C. 156(c)(3) and 35 U.S.C. 156(g)(6). A Notice of Final Determination is mailed to applicant which states the length of extension for which the application has been determined to be eligible and the calculations used to determine the length of extension. Recently mailed Notices of Final Determination are posted in the Freedom of Information (FOIA) section of the USPTO web site (www.uspto.gov) with other Decisions of the Commisssioner. The notice provides a period, usually one month, in which the applicant can request reconsideration of any aspect of the Office determination as to eligibility or the length of extension for which the application has been found eligible.

If the application has been determined to be ineligible for patent term extension, an appropriate Notice of Final Determination is mailed to applicant which denies the application and sets forth the basis for the denial. The applicant is given a period, usually one month, in which to seek reconsideration of the determination.

If the patent is found to be eligible for extension, the Notice of Final Determination may include text similar to the following:

A determination has been made that U.S. Patent No. ___, which claims the human drug ___, is eligible for patent term extension under 35 U.S.C. 156. The period of extension has been determined to be ___.

A single request for reconsideration of this final determination as to the length of extension of the term of the patent may be made if filed within one month of the date of this notice. Extensions of time under 37 CFR 1.136(a) are not applicable to this time period. In the absence of such request for reconsideration, the Commissioner will issue a certificate of extension, under seal, for a period of ___ days.

The period of extension has been calculated using the FDA determination of the length of the regulatory review period published in the Federal Register of ___. Under 35 U.S.C. 156(c).

Period of Extension = 1/2 (Testing Phase) + Approval Phase

= 1/2 (___ -___) + ___

= ___ days

Since the regulatory review period began __, before the patent issued ___, only that portion of the regulatory review period occurring after the date the patent issued has been considered in the above determination of the length of the extension period 35 U.S.C. 156(c). (From __ to ___) is___ days; this period is subtracted for the number of days occurring in the testing phase according to the FDA determination of the length of the regulatory review period.) No determination of a lack of due diligence under 35 U.S.C. 156(c)(1) was made.

The 14 year exception of 35 U.S.C. 156(c)(3) operates to limit the term of the extension in the present situation because it provides that the period remaining in the term of the patent measured from the date of approval of the approved product (___) when added to the period of extension calculated above (___ days) cannot exceed fourteen years. The period of extension is thus limited to ___, by operation of 35 U.S.C. 156(c)(3). Since the patent term (35 U.S.C. 154) would expire on ___, the period of extension is the number of days to extend the term of the patent from its expiration date to and including ___, or ___ days.

The limitations of 35 U.S.C. 156(g)(6) do not operate to further reduce the period of extension determined above.

See MPEP § 2759 for further information pertaining to the issuance of a certificate of extension.

A patent term extension generally extends the patent from its "original expiration date," as defined by 35 U.S.C. 154 to include extension under 35 U.S.C. 154(b). Patents "in force on June 8, 1995 only because of a Hatch-Waxman extension are not entitled to re-apply a restoration extension to a 20-year from filing term." *Merck & Co. v. Kessler*, 80 F.3d 1543, 1553, 38 USPQ2d 1347, 1354 (Fed. Cir. 1996). However, if the patent received an interim extension under 35 U.S.C. 156(d)(5) and the patent is eligible for either a two- or a three-year extension, the extension would run from the approval date of the product, not the original expiration date of the patent. See 35 U.S.C. 156(d)(5)(E)(ii).

No certificate or extension will be issued if the term of a patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations the final determination would issue indicating that no certificate will issue.

CALCULATION OF PATENT TERM EXTENSION

The procedure for calculating the length of the patent term extension is set forth for human drugs, antibiotic drugs, and human biological products in 37 FR 1.775; for food or color additives in 37 CFR 1.776; for medical devices in 37 CFR 1.777; for animal drug products in 37 CFR 1.778; and for veterinary biological products in 37 CFR 1.779. The length of patent term extension is the length of the regulatory review period as determined by the Secretary of Health and Human Services or the Secretary of Agriculture, but reduced, where appropriate, by the time periods provided in 37 CFR 1.775 - 1.779. The Office will rely on the Secretary's determination of the length of the regulatory review period when calculating the length of the extension period under 37 CFR 1.775 - 1.779.

Any part of the regulatory review period which occurs before the patent was granted will not be counted toward patent term extension. Any period in which the marketing applicant failed to exercise due diligence, thereby unnecessarily adding to the length of the regulatory review period after the patent issued, will not be considered in determining the length of the extension period. In making the calculation of the extension period, half days will be ignored and thus will not be subtracted from the regulatory review period.

For products other than animal drug or veterinary biological products, the calculated extension period cannot exceed any of the following statutory maximum periods of extension:

(A) If the period remaining in the term of the patent after the date of approval of the approved product when added to the calculated regulatory review period exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years;

(B) If the patent involved was issued after September 24, 1984, (the date of enactment of the statute), the calculated period of extension may not exceed five years;

(C) If the patent involved was issued before September 24, 1984, (the date of enactment of the statute), and the regulatory review period proceeding started after this date, the calculated period of extension may not exceed five years; and

(D) If the patent involved was issued before September 24, 1984, (the date of enactment of the statute), and the regulatory review period proceeding started before this date, and the commercial marketing or use of the product has been approved after such date, the calculated period of extension may not exceed two years.

For animal drug or veterinary biological products, the calculated extension period cannot exceed any of the following statutory maximum periods of extension:

(A) If the period remaining in the term of the patent after the date of approval of the approved product when added to the calculated regulatory review period exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years;

(B) If the patent involved was issued after November 16, 1988, the calculated period of extension may not exceed five years;

(C) If the patent involved was issued before November 16, 1988, and the regulatory review period proceeding started after this date, the calculated period of extension may not exceed five years; and

(D) If the patent involved was issued before November 16, 1988, and the regulatory review period proceeding started before this date, and the commercial marketing or use of the product has been approved after such date, the calculated period of extension may not exceed three years.

The patent term extension of a patent that issued before September 24, 1984, where the regulatory review period began and ended before September 24, 1984, would only be a function of the regulatory review period and the fourteen-year limit, and may be extended for more than five years. *Hoechst Aktiengesellschaft v. Quigg*, 916 F2d 522, 525, 16 USPQ2d 1549, 1551 (Fed. Cir. 1990).

2759 Certificate of Extension of Patent Term

35 U.S.C. 156. Extension of patent term.

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(e)(1) A determination that a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for the extension. If the Director determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the Director shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

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37 CFR 1.780. Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark* Office and in the *Federal Register*. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750 will indicate that no certificate or order will issue.

Once a determination is made pursuant to 37 CFR 1.750 that a patent is eligible for extension of its term, a certificate of extension, under seal, will be issued to the patent owner at the correspondence address specified in the application for patent term extension. Following the one-month period provided in the Notice of Final Determination, and where an extension is appropriate, the Certificate of Extension is signed by the Commissioner. The original certificate is mailed or delivered to the applicant and a copy is sent to the regulatory agency. A copy of the certificate is placed in the two files (official file/patent file and public file) maintained for the patent term extension application.

Upon issuance of the certificate of extension, a notice is published in the *Official Gazette*. A sample *Official Gazette* Notice Follows:

PATENT TERM EXTENDED UNDER 35 U.S.C. 156

A Certificate extending the term of the following patent was issued on __.

U.S. Patent No.: __ Granted: __; Applicant: __; Owner of Record: __; Title: ___; Classification: __ Product Trade Name: __; Original Expiration Date: __; Term Extended: ____; Extended Expiration Date: __.

All original papers from the application for patent term extension in the official file are transferred to the official patent file of the subject patent and become a part of the permanent record. A copy of the certificate

of extension of patent term is added to the patent electronic database as part of the patent record in the same manner as is a certificate of correction or a terminal disclaimer. The patent is also added to the list of patents extended under 35 U.S.C. 156, a copy of which is posted on the USPTO web site (www.uspto.gov) and which is also available in the Reading Room of the Public Search Room and from the Office of Patent Legal Administration. The public file for the application for patent term extension is stored in the Office of Patent Legal Administration.

2760 Trade Secret, Confidential, and Protective Order Material

There is no provision in the statute or the rules for withholding from the public any information that is submitted to the Office or the regulatory agency relating to an application for patent term extension. While one submitting such materials to the Office in relation to a pending application for patent term extension must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes imposes. Proprietary or trade secret information should be submitted generally in accordance with the procedures set forth in MPEP § 724.02. Identification of the propriety or trade secret material should be made by page, line, and word, as necessary. The Office will not in the first instance undertake the task of determining the precise material in the application which is proprietary or trade secret information. Only the applicant is in a position to make this determination. See *In re Schering-Plough Corp.*, 1 USPQ2d 1926, 1926 (Comm'r Pat. & Tm. 1986).

The information will not be made public as part of the patent file before a certificate of patent extension is issued. Should the Office receive a Freedom of Information Act (FOIA) request for the material, the applicant will be provided notice and an opportunity to substantiate its claim that the material is proprietary before the Office determines whether disclosure of the material is required under the FOIA. If such information was material to a determination of eligibility or any other Office responsibility under 35 U.S.C. 156, it will be made public at the time the certificate of extension is issued. Otherwise, if a suitable petition to expunge is filed before the issuance of the certificate, the trade secret or confidential information will be expunged from the file and returned to the patent term extension applicant. If a petition to expunge is not filed prior to the issuance of the certificate, all of the information will be open to public inspection.

2761 Multiple Applications for Extension of Term of the Same Patent or of Different Patents for the Same Regulatory Review Period for a Product

35 U.S.C. 156. Extension of patent term.

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(c)(4) in no event shall more than one patent be extended under subsection (e)(i) for the same regulatory review period for any product.

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37 CFR 1.785. Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

(a) Only one patent may be extended for a regulatory review period for any product § 1.720 (h). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the patents are otherwise eligible for extension pursuant to the requirements of this subpart, in the absence of an election by the applicant, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent term having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if the patent owner or its agent is the holder of the regulatory approval granted with respect to the regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such infor-

mation within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant to § 1.750 and shall be regarded as part of that determination.

Only one patent may be extended for a regulatory review period for any product. If more than one application for extension is filed for a single patent by different applicants, the certificate of extension of the term of the patent, if appropriate, would be issued based upon the first filed application for extension of patent term. If a single applicant files more than one application for patent term extension for a single patent based upon the regulatory review period of different products, then the final determination under 37 CFR 1.750 will provide a period of time (usually one month) for the patent owner to elect the product for which extension is desired. An express withdrawal of the applications for extension of the nonelected products should accompany the election. The final determination will indicate that if the patent owner fails to elect a single product within the set time period, the Office will issue a certificate of extension for the patent for a specified one of the products.

If more than one application for extension is filed by a single applicant for the extension of the terms of different patents based upon the same regulatory review period for a product, the certificate of extension will be issued on the application for extension of the patent having the earliest date of issuance of those for which extension is sought unless all but one application for extension is voluntarily withdrawn by the applicant. When plural patents are found to be eligible for patent term extension based on the same regulatory review of a product, the final determination under 37 CFR 1.750 will provide a period of time (usually one month) for the patent owner to elect the patent for which extension is desired. An express withdrawal of the application(s) for extension of the nonelected patent(s) should accompany the election. A failure to elect within the set time period will result in issuance of a certificate of extension for the patent having the earliest date of issue.

If applications for extension are filed by different applicants for the extension of the terms of different patents based upon the same regulatory review period of a product, the certificate of extension will be issued on the application of the holder of the regulatory approval (marketing applicant). If the marketing applicant is not an applicant for extension, the certificate of extension will issue to the applicant for extension which holds an express authorization from the marketing applicant to rely upon the regulatory review period as the basis for the application for extension. See also 37 CFR 1.785(d).

2762 Duty of Disclosure in Patent Term Extension Proceedings

37 CFR 1.765. Duty of disclosure in patent term extension proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf of the patent owner or its agent for the patent term extension proceeding or through a patent owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross

negligence in connection with the patent term extension proceeding, a final determination will be made pursuant to § 1.750 that the patent is not eligible for extension.

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A duty of candor and good faith toward the USPTO, the Secretary of Health and Human Services, and the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner, and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding, must bring such information to the attention of the Office or the Secretary, as appropriate, as soon as it is practicable to do so after the individual becomes aware of the information. Information is "material" when there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding. Any such material information should be submitted to the Commissioner of Patents and Trademarks, the Secretary of Health and Human Services, or the Secretary of Agriculture, as appropriate, accompanied by a copy of each written document being disclosed. The information may be submitted through a patent attorney or agent.

A determination of eligibility for an extension or the issuance of a certificate will not be made if clear and convincing evidence of fraud or attempted fraud on the Office or a Secretary is determined to be present, or the duty of disclosure is determined to have been violated through bad faith or gross negligence in connection with the patent term extension proceeding. Since the determination as to whether a patent is eligible for extension may be made solely on the basis of the representations made in the application for extension, a final determination to refuse a patent term extension because of fraud or a violation of the duty of disclosure is expected to be rare. See MPEP § 2010.

2763 Limitation of Third Party Participation

37 CFR 1.765. Duty of disclosure in patent term extension proceedings.

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(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

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Although the statute specifically provides for public input into the determination of the regulatory review period, i.e., the filing of a due diligence petition before the regulatory agency, no such provision was made for proceedings before the Office. Since applicant already has a duty of disclosure to both the Office and the regulatory agency, and Congress expected that it would be an administratively simple proceeding, no input from third parties is permitted. Absent an invitation from the Commissioner, any such submission would be inappropriate. Accordingly, 37 CFR 1.765(d) precludes submissions to the Office by or on behalf of third parties, thereby making patent term extension proceedings in the Office an *ex parte* matter between the patent owner or its agent and the Office. Submissions by third parties not requested by the Office will be returned, or otherwise disposed of, without consideration. See *In re Dubno*, 12 USPQ2d 1153, 1154 (Comm'r Pat. & Tm. 1989).

2764 Express Withdrawal of Application for Extension of Patent Term

37 CFR 1.770. Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to § 1.750 by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for reply to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the

Office does not entitle applicant to a refund of the filing fee (§ 1.20(j)) or any portion thereof.

Any request for withdrawal of an application for extension of patent term after a determination has been made pursuant to 37 CFR 1.750 must be submitted on or before the date permitted for reply to the final determination, and be accompanied by a petition under 37 CFR 1.182 with the appropriate petition filing fee.

Appendix I Partial List of Trademarks

The following is a partial list of trademarks which may appear from time to time in patent applications. Proper usage of trademarks requires that they be capitalized at all times. See MPEP § 608.01(v).

Any questions by the examiners as to whether an apparent trademark is in fact a registered trademark or to what particular goods a registered trademark applies should be referred to the Trademark Search Library (308-9800) for determination.

Trademark	*Particular goods on or in connection with which the trademark is used*
ACE	Elastic bandages, adhesive bandages, adherent compounds for attaching surgical dressings or bandages to the skin, and bandage fastening clips
ACTIONWEAR	Men's, women's, children's, and infants' garments - namely coats, sweaters, blouses, shirts, underwear, and sleepwear
ADRENALIN	Hemostatic, astringent, blood-pressure raising and stimulating preparations for medicinal or surgical purposes
AEROJET	Thrust motors whose general purpose is to provide thrust by means of a combustion process, and includes all the component parts of such motors
AEROSOL	Wetting agents for use in reducing the interfacial tension between liquids and solids or between two immiscible liquids
AIRVEYOR	Conveyors for conveying and handling materials
ANCHOR	Metallic fencing and related components
ARNEL	Yarns; textile fibers, including staple fibers and continuous filaments
BARBIE	Doll; accessories for doll
BEEF STICK	Summer sausage
BIRKENSTOCK	Footwear-namely, sandals, shoes, and shoe insoles
BLUSH	Wines
BOOGIE	Surfboards
BUSS	Electric fuses, fuse holders, fuse wire, and protectors for electric circuits that include fuse links and thermal cutouts and that respond to heavy overloads or short circuits to open the circuits
BUTTERFLY	Medical infusion sets for administration of fluids
CALGON	Water softening and water conditioning for industrial, laundry, and semi-industrial use
CALROD	Electrical resistance heaters; electrical resistance heating elements for cooling devices
CARBORUNDUM	Electrical devices comprising detectors for radio apparatus, resistance rods, lightning arrestors, resistors, and resistor units
CARBORUNDUM	Crystalline substance used as an abradant and for other purposes
CAROUSEL	Photographic projectors
CAT	Machinery for earth moving, earth conditioning, and material handling, namely, loaders and engines therefor, and parts for the foregoing; vehicles and internal combustion engines for earth and material hauling and handling, namely tractors and engines therefor, and parts for the foregoing
CATERPILLAR	Tractors, engines, treads, etc.
CHAP STICK	Medicinal preparation for chapped skin, sunburn, and hangnails
CLOROX	Household cleanser compositions, laundry detergent

Trademark	*Particular goods on or in connection with which the trademark is used*
COCA-COLA	Beverages and syrups for the manufacture of such beverages (carbonated soft drink)
COCOA-PUFFS	Ready to eat breakfast cereal
COKE	Nonalcoholic, maltless beverages and the syrups for making such beverages
COREX	Thermosetting plastic in the nature of a paint converted by heat into an insoluble, unfusible film
CRAWLER	Children's play clothes, namely, overalls, shirts, rompers, and sunsuits
CYCLONE	Seeders and planters
DACRON	Yarns of synthetic fibers; synthetic polyester fibers for generalized use in the industrial arts
DORITOS	Corn chips, potato chips, tortilla chips, pretzels, and nut meats
FEDEX	Shipping containers in the nature of document envelopes, boxes and tubes; pick-up, transportation, storage, and delivery of documents, packages and freight by land and air
FIBERGLAS	Inorganic material in a fibrous condition or in the form of a loose mass of filaments or fibers
FLEXWOOD	Fabric-backed wood veneer
FLYING SAUCER	Toys, namely model airplanes and aerodynamic flying discs
FOAMICIDE	Chemical composition for addition to foaming liquids present in bottle and container washing processes and in industrial chemistry processes, to prevent the formation of foam therein
FOOTLETS	Anklets, knee-hi socks, hosiery, and footsocks
FORMICA	Laminates and solid surfacing materials in the form of slabs made predominantly of plastic for use in the manufacture of countertops, vanity tops, tabletops, sinkbowls, bath tubs, wall paneling, flooring, and furniture
GLAD	Plastic bag holders
GLAD LOCK	Plastic bags for packaging, such as food storage and freezer bags
HACKY SACK	Footbags used in a kicking game; conducting kicking game tournaments and kicking game instructional clinics
HI-LITER	Marking pens
INTERNET	Communication services, namely providing electronic data transmission services in the electronic banking field and retail marketing field
INTERNET	Carpeting installation information exchange and consulting services rendered by computer
INTERNET TELEVISION	Distribution and production of broadcast and nonbroadcast television programs, videotaped programs and audio tapes
IRONCLAD	Storage-battery plates
JARLSBERG	Cheese
JEEP	Automobiles and structural parts thereof
JELL-O	A compound used in the preparation of (jellies) desserts (pastries and ice-cream); gelatin dessert
JELLO-LIGHT	Pudding
JET SKI	Boats, recreational watercraft, floor mats, clothing, paint for machinery, tarpaulins, used to hold down boat covers; straps, namely boat covers and boat towing lines, motor oil, duffle bags

PARTIAL LIST OF TRADEMARKS

Trademark	*Particular goods on or in connection with which the trademark is used*
KARMELKORN	Popcorn candy, seasoned popcorn, cheese-covered popcorn, and popcorn balls each of which is made from popped popcorn; and also unpopped popcorn, candy, candied apple, nuts, and ice cream
KEVLAR	Man-made fibers for generalized use in the industrial arts
KITTY LITTER	Ground clay used for litters for small animals, i.e., cats, rats, mice, hamsters
KLEENEX	Absorbent tissue suitable for cleaning, hygienic, and cosmetic purposes, and paper towels
KOOSH	Tossing balls
LIFE SAVERS	Chewing-gum, candy, sweetmeats, and confections
LINOTYPE	Typesetting machines and parts thereof; accessories and equipment for use with typeset machines and systems - namely, line printers, video terminals, keyboards, tape perforators, tape readers, graphic scanners, optical character readers and computer programs
LIQUID PAPER	Office supply products, namely correction fluid, error correction tapes
LISTSERV	Computer software for managing electronic mailing lists
LOAFERS	Ladies', men's, and boys' shoes made of leather, rubber, fabric, and various combinations of such materials
LUCITE	Enamel and paint
LYCRA	Synthetic fibers and filaments for generalized use in the industrial arts
MINI BAR	Small-sized pry bars
MONOTYPE	Type casting and composing machines, including keyboards and casting-machines and repair parts and supplies therefor; paper ribbons or controllers for type casting and composing machines; photo typesetting machines utilizing cameras and laser beam, and structural parts thereof, typefaces, typefonts and type designs of alphanumeric characters and/or typographical symbols recorded as visible images in printer's type
MUSIC BY MUZAK	Planned music service for transmitting specially programmed background music to stores, restaurants, homes, hotels, banks, railroads, airlines, boats, transportation terminals, factories and other industrial and commercial establishments throughout the U.S.
MYLAR	Flexible film for packaging purposes; polyester film
OILGEAR	Valves for use in and in connection with the hydraulic transmission of power
ORLON	Synthetic fiber-forming polymers and copolymers of acrylic acid or its derivatives produced in the form of fibers for further use in the industrial arts
PAMPERS	Disposable diapers
PARA-SAIL	Parachutes
PERF-A-TAPE	Paper tape for sealing composition board joints
PERMALLOY	Metal hardening agent sold as a component part of machine parts; namely, sheaves, drill steels, barrel rollers, and pins for mining machinery such as drag line conveyors and drills

Trademark	*Particular goods on or in connection with which the trademark is used*
PIZZA ROLLS	Pasta snacks, namely hamburger flavor pasta snacks, cheeseburger flavor pasta snacks, pepperoni and cheese flavor pasta snacks, sausage, and cheese flavor pasta snacks, and shrimp and cheese flavor pasta snacks
POPSICLE	Frozen confections on sticks and liquid flavoring concentrates for making said confections
POST-IT	Stationary notes containing adhesive on one side for attachment to surfaces
PYREX	Beakers, flasks, test tubes, etc.; glass
QUICKEN	Computer software programs and user documentation supplied therewith
Q-TIPS	Absorbent swabs and balls for toiletry, medical, and cosmetic uses; swabs consisting of small sticks of wood or paper having wads of cotton twisted about one or both ends, intended for use primarily as a cosmetic aid
RICE KRISPIES	Cereal breakfast food
RIPPLE	Wines
ROLLERBLADE	Boots equipped with longitudinally aligned rollers used for skating and skiing
ROQUEFORT	Cheese
SANKA	Coffees and teas, coffee and tea extracts, both dry and liquid, and tea and coffee substitutes
SCOTCH	Masking tape, cellophane tape, acetate fiber tape and other pressure-sensitive adhesive tapes; liquid adhesive, adhesive sheet material, an adhesive coated sheet material in sheet or strip form; adhesive tape
SNAP-ON	Sharpening stones, nail clipper; calibrated rulers, magnetic paper clips, magnetic tape holders, drill bit gauges, tape measurers; tools and machinery
SNOOZ-ALARM	Electronic repeat alarm timer sold as a component of alarm clocks; clocks
SPEED NUT	Nuts
SPERRY TOP-SIDER	Boating coats, boating hats, boating suits, boating jackets, boating shirts and boating trousers, footwear
STELLITE	Metal alloys
STELLITE	Rivet setting tools
SWOOSH	Footwear
TABASCO	Pepper sauce
TALON	Thread
TEFLON	Synthetic resinous fluorine-containing polymers in form of molding and extruding compositions, fabricated shapes-namely, sheets, [rods] tubes, tape and filaments [-solutions,] and emulsions; polytetrafluoroethylene coatings in the nature of paints and varnishes
TELEMARKETING INC.	Telephone marketing consulting services; conducting telephone sales campaigns for business clients
TELETYPE	Printing-telegraph apparatus
TELEX	Equipment and apparatus for electronic treatment of sound-namely, sound recorders-reproducers, phonographs, tape decks, tape recorders, tape cartridge players, tape duplicators, tapes for sound recording and reproduction, combination tape recorders and radios, and combination phonographs-tape decks, and components and parts for all of said equipment
THERMOS	Temperature-retaining vessels; double-walled glass vessels with vacuum between the walls
TOLL HOUSE	Prepared edible chocolate

Trademark	*Particular goods on or in connection with which the trademark is used*
TOUCH-TONE	Musical instruments, mainly timpani and other drums, malletsfor playing drums, and other percussion instruments and parts thereof
TRAV-O-LATER	Endless conveyors
TRIGGER	Indicating tripping fuses
TROUT CHOW	Feed for fish
TWIST-LOCK	Electrical wiring apparatus, namely electric flush receptacles, attachment plug, caps, cord-coupling, caps, couplings, connectors, motor couplings, attachment plugs, and motor plugs
TYVEK	Fabrics of man-made fibers and filaments suitable for making into household furnishings and apparel and for industrial uses
VASELINE	Emollient and medicinal preparation for external and internal use; petroleum jelly, oil petrol, white mineral oil; moisturizing lotion and cream
VELCRO	Notion - namely, a synthetic material sold in ribbon, sheet, or piece goods form, said material having complemental parts which adhere to each other when pressed together and adapted for use as a closure fastener, or button for closing garments, curtains, or the like; separable fasteners-namely, hook and loop-type fasteners and components thereof
VICTROLA	Prerecorded audio cassettes; records for talking-machines
VIDEOFILE	Document storage systems designed to automate the storage andretrieval of document images, and components thereof
VIENNA BEEF	Tongue, corned beef, frankfurters, wieners, knockwurst, polish sausage, pastrami, salami, and bologna
VISE-GRIP	Hand tools and instruments, namely pliers and workholding clamps with or without a cutting edge, wrenches, wrenches with a wire cutter and welding clamps, and sheet metal bending tool
VOTATOR	Machinery for processing and handling materials in fluid, plastic, or particulate form including food products
WEATHER-OMETER	Apparatus for testing the effect of weather upon the surface of objects
WEED EATER	Machinery for edging and trimming vegetation; weed and grass cutting machinery for edging and trimming lawns
WIFFLE	Simulated or auxiliary pliable plastic baseballs and a game played therewith
WINDBREAKER	Men's, young men's, boys', women's, misses' and girl's apparel for sportswear, dress wear, work wear, and uniforms; namely jackets, vests, trousers, suits, shirts, blouses
WINDOWS	Cartridges containing software for operating or enhancing the operation of laser printers, which cartridges are to be inserted into the printers, and accompanying software for installation in computers which communicate with the printers; computer programs and manuals sold as a unit; namely graphical operating environment programs for microcomputers
WINDSURFER	Sailboats having a free sail system
WITE-OUT	Typing and drawing correction fluid (erasing liquid)

Trademark	*Particular goods on or in connection with which the trademark is used*
XEROX	Electrophotographic copying machines (and equipment for recording x-ray images - namely, processors for electrostatically charging xeroradiographic plates and conditioners for producing positive or negative prints)
ZIPLOC	Plastic bags

Appendix II List of Decisions Cited

Appendix L Patent Laws

United States Code Title 35 - Patents

PART I — UNITED STATES PATENT AND TRADEMARK OFFICE

CHAPTER 1 — ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

CHAPTER 2 — PROCEEDINGS IN THE PATENTS AND TRADEMARK OFFICE

CHAPTER 3 — PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

CHAPTER 4 — PATENT FEES; FUNDING; SEARCH SYSTEMS

PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

CHAPTER 11 — APPLICATION FOR PATENT

CHAPTER 12 — EXAMINATION OF APPLICATION

CHAPTER 13 — REVIEW OF PATENT AND TRADEMARK OFFICE DECISION

CHAPTER 14 — ISSUE OF PATENT

CHAPTER 15 — PLANT PATENTS

CHAPTER 16 — DESIGNS

CHAPTER 17 — SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRIES

CHAPTER 18 — PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE

PART III — PATENTS AND PROTECTION OF PATENT RIGHTS

CHAPTER 25 — AMENDMENT AND CORRECTION OF PATENTS

CHAPTER 26 — OWNERSHIP AND ASSIGNMENT

CHAPTER 27 — GOVERNMENT INTERESTS IN PATENTS

CHAPTER 28 — INFRINGEMENT OF PATENTS

CHAPTER 29 — REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

CHAPTER 30 — PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS

CHAPTER 31 — OPTIONAL INTER PARTES REEXAMINATION PROCEDURES

PART IV — PATENT COOPERATION TREATY

CHAPTER 35 — DEFINITIONS

CHAPTER 36 — INTERNATIONAL STAGE

CHAPTER 37 — NATIONAL STAGE

PART I — UNITED STATES PATENT AND TRADEMARK OFFICE

CHAPTER 1 — ESTABLISHMENT, OFFICERS AND EMPLOYEES, FUNCTIONS

35 U.S.C. 1 Establishment.

(a) ESTABLISHMENT.— The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

(b) OFFICES.— The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

(c) REFERENCE.— For purposes of this title, the United States Patent and Trademark Office shall also be referred to as the "Office" and the "Patent and Trademark Office".

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-572 (S. 1948 sec. 4711).)

35 U.S.C. 2 Powers and duties.

(a) IN GENERAL.— The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

(1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and

(2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) SPECIFIC POWERS.— The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5, United States Code;

(C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1) of this title; and

(F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness;

(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)(A) may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of the Federal Property and Administrative Services Act of

1949 (40 U.S.C. 471 et seq.), the Public Buildings Act (40 U.S.C. 601 et seq.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.); and

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44, United States Code;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world;

(12)(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed $100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

(c) CLARIFICATION OF SPECIFIC POWERS.—

(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

(d) CONSTRUCTION.— Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-572 (S. 1948 sec. 4712); subsection (4)(A) amended Oct. 30, 2000, Public Law 106-400, sec. 2, 114 Stat. 1675.)

35 U.S.C. 3 Officers and employees.

(a) UNDER SECRETARY AND DIRECTOR.—

(1) IN GENERAL.— The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) IN GENERAL.— The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES.— The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, United States Code, as the case may be.

(3) OATH.— The Director shall, before taking office, take an oath to discharge faithfully the duties of the Office.

(4) REMOVAL.— The Director may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

(1) DEPUTY UNDER SECRETARY AND DEPUTY DIRECTOR.— The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

(2) COMMISSIONERS.—

(A) APPOINTMENT AND DUTIES.— The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5, United States Code. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) SALARY AND PERFORMANCE AGREEMENT.— The Commissioners shall be paid an annual rate of basic pay not to exceed the maxi-

mum rate of basic pay for the Senior Executive Service established under section 5382 of title 5, United States Code, including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5, United States Code. The compensation of the Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, United States Code, to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18, United States Code. In addition, the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the Director, of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the Commissioners only to the extent that such payment does not cause the Commissioners' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3, United States Code.

(C) REMOVAL.— The Commissioners may be removed from office by the Secretary for misconduct or nonsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5, United States Code. The Secretary shall provide notification of any such removal to both Houses of Congress.

(3) OTHER OFFICERS AND EMPLOYEES.— The Director shall—

(A) appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office; and

(B) define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the Director may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no positions or personnel of the Office shall be taken into account for purposes of applying any such limitation

(4) TRAINING OF EXAMINERS.— The Office shall submit to the Congress a proposal to provide an incentive program to retain as employees patent and trademark examiners of the primary examiner grade or higher who are eligible for retirement, for the sole purpose of training patent and trademark examiners.

(5) NATIONAL SECURITY POSITIONS.— The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

(c) CONTINUED APPLICABILITY OF TITLE 5, UNITED STATES CODE.— Officers and employees of the Office shall be subject to the provisions of title 5, United States Code, relating to Federal employees.

(d) ADOPTION OF EXISTING LABOR AGREEMENTS.— The Office shall adopt all labor agreements which are in effect, as of the day before the effective date of the Patent and Trademark Office Efficiency Act, with respect to such Office (as then in effect).

(e) CARRYOVER OF PERSONNEL.—

(1) FROM PTO.— Effective as of the effective date of the Patent and Trademark Office Efficiency Act, all officers and employees of the Patent and Trademark Office on the day before such effective date shall become officers and employees of the Office, without a break in service.

(2) OTHER PERSONNEL.— Any individual who, on the day before the effective date of the Patent and Trademark Office Efficiency Act, is an officer or employee of the Department of Commerce (other than an officer or employee under paragraph (1)) shall be transferred to the Office, as necessary to carry out the purposes of this Act, if—

(A) such individual serves in a position for which a major function is the performance of work reimbursed by the Patent and Trademark Office, as determined by the Secretary of Commerce;

(B) such individual serves in a position that performed work in support of the Patent and Trademark Office during at least half of the incumbent's work time, as determined by the Secretary of Commerce; or

(C) such transfer would be in the interest of the Office, as determined by the Secretary of Commerce in consultation with the Director.

Any transfer under this paragraph shall be effective as of the same effective date as referred to in paragraph (1), and shall be made without a break in service.

(f) TRANSITION PROVISIONS.—

(1) INTERIM APPOINTMENT OF DIRECTOR.— On or after the effective date of the Patent and Trademark Office Efficiency Act, the President shall appoint an individual to serve as the Director until the date on which a Director qualifies under subsection (a). The President shall not make more than one such appointment under this subsection.

(2) CONTINUATION IN OFFICE OF CERTAIN OFFICERS.—

(A) The individual serving as the Assistant Commissioner for Patents on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Patents until the date on which a Commissioner for Patents is appointed under subsection (b).

(B) The individual serving as the Assistant Commissioner for Trademarks on the day before the effective date of the Patent and Trademark Office Efficiency Act may serve as the Commissioner for Trademarks until the date on which a Commissioner for Trademarks is appointed under subsection (b).

(Amended Sept. 6, 1958, Public Law 85-933, sec. 1, 72 Stat. 1793; Sept. 23, 1959, Public Law 86-370, sec. 1(a), 73 Stat. 650; Aug. 14, 1964, Public Law 88-426, sec. 305(26), 78 Stat. 425; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Jan. 2, 1975, Public Law 93-601, sec. 1, 88 Stat. 1956; Aug. 27, 1982, Public Law 97-247, sec. 4, 96 Stat. 319; Oct. 25, 1982, Public Law 97-366, sec. 4, 96 Stat. 1760; Nov. 8, 1984, Public Law 98-622, sec. 405, 98 Stat. 3392; Oct. 28, 1998, Public Law 105-304, sec. 401(a)(1), 112 Stat. 2887; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-575 (S. 1948 sec. 4713).)

35 U.S.C. 4 Restrictions on officers and employees as to interest in patents.

Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 5 Patent and Trademark Office Public Advisory Committees.

(a) ESTABLISHMENT OF PUBLIC ADVISORY COMMITTEES.—

(1) APPOINTMENT.— The United States Patent and Trademark Office shall have a Patent Public Advisory Committee and a Trademark Public Advisory Committee, each of which shall have nine voting members who shall be appointed by the Secretary of Commerce and serve at the pleasure of the Secretary of Commerce. Members of each Public Advisory Committee shall be appointed for a term of 3 years, except that of the members first appointed, three shall be appointed for a term of 1 year, and three shall be appointed for a term of 2 years. In making appointments to each Committee, the Secretary of Commerce shall consider the risk of loss of competitive advantage in international commerce or other harm to United States companies as a result of such appointments.

(2) CHAIR.— The Secretary shall designate a chair of each Advisory Committee, whose term as chair shall be for 3 years.

(3) TIMING OF APPOINTMENTS.— Initial appointments to each Advisory Committee shall be made within 3 months after the effective date of the Patent and Trademark Office Efficiency Act. Vacancies shall be filled within 3 months after they occur.

(b) BASIS FOR APPOINTMENTS.— Members of each Advisory Committee—

(1) shall be citizens of the United States who shall be chosen so as to represent the interests of diverse users of the United States Patent and Trademark Office with respect to patents, in the case of the

Patent Public Advisory Committee, and with respect to trademarks, in the case of the Trademark Public Advisory Committee;

(2) shall include members who represent small and large entity applicants located in the United States in proportion to the number of applications filed by such applicants, but in no case shall members who represent small entity patent applicants, including small business concerns, independent inventors, and nonprofit organizations, constitute less than 25 percent of the members of the Patent Public Advisory Committee, and such members shall include at least one independent inventor; and

(3) shall include individuals with substantial background and achievement in finance, management, labor relations, science, technology, and office automation. In addition to the voting members, each Advisory Committee shall include a representative of each labor organization recognized by the United States Patent and Trademark Office. Such representatives shall be nonvoting members of the Advisory Committee to which they are appointed.

(c) MEETINGS.— Each Advisory Committee shall meet at the call of the chair to consider an agenda set by the chair.

(d) DUTIES.— Each Advisory Committee shall—

(1) review the policies, goals, performance, budget, and user fees of the United States Patent and Trademark Office with respect to patents, in the case of the Patent Public Advisory Committee, and with respect to Trademarks, in the case of the Trademark Public Advisory Committee, and advise the Director on these matters;

(2) within 60 days after the end of each fiscal year—

(A) prepare an annual report on the matters referred to in paragraph (1);

(B) transmit the report to the Secretary of Commerce, the President, and the Committees on the Judiciary of the Senate and the House of Representatives; and

(C) publish the report in the Official Gazette of the United States Patent and Trademark Office.

(e) COMPENSATION.— Each member of each Advisory Committee shall be compensated for each day (including travel time) during which such member is attending meetings or conferences of that Advisory Committee or otherwise engaged in the business of that Advisory Committee, at the rate which is the daily equivalent of the annual rate of basic pay in effect for level III of the Executive Schedule under section 5314 of title 5, United States Code. While away from such member's home or regular place of business such member shall be allowed travel expenses, including per diem in lieu of subsistence, as authorized by section 5703 of title 5, United States Code.

(f) ACCESS TO INFORMATION.— Members of each Advisory Committee shall be provided access to records and information in the United States Patent and Trademark Office, except for personnel or other privileged information and information concerning patent applications required to be kept in confidence by section 122.

(g) APPLICABILITY OF CERTAIN ETHICS LAWS.— Members of each Advisory Committee shall be special Government employees within the meaning of section 202 of title 18, United States Code.

(h) INAPPLICABILITY OF FEDERAL ADVISORY COMMITTEE ACT.— The Federal Advisory Committee Act (5 U.S.C. App.) shall not apply to each Advisory Committee.

(i) OPEN MEETINGS.— The meetings of each Advisory Committee shall be open to the public, except that each Advisory Committee may by majority vote meet in executive session when considering personnel or other confidential information

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-578 (S. 1948 sec. 4714).)

35 U.S.C. 6 Board of Patent Appeals and Interferences.

(a) ESTABLISHMENT AND COMPOSITION.— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.

(b) DUTIES.— The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon

applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

(Repealed by Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4715(a).)

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(2)).)

35 U.S.C. 7 Library.

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

(Repealed Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 8 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 8 Classification of patents.

The Director may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

(Transferred to 35 U.S.C. 7 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 9 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 9 Certified copies of records.

The Director may furnish certified copies of specifications and drawings of patents issued by the Patent and Trademark Office, and of other records available either to the public or to the person applying therefor.

(Transferred to 35 U.S.C. 8 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 10 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 10 Publications.

(a) The Director may publish in printed, typewritten, or electronic form, the following:

(1) Patents and published applications for patents, including specifications and drawings, together with copies of the same. The Patent and Trademark Office may print the headings of the drawings for patents for the purpose of photolithography.

(2) Certificates of trademark registrations, including statements and drawings, together with copies of the same.

(3) The Official Gazette of the United States Patent and Trademark Office.

(4) Annual indexes of patents and patentees, and of trademarks and registrants.

(5) Annual volumes of decisions in patent and trademark cases.

(6) Pamphlet copies of the patent laws and rules of practice, laws and rules relating to trademarks, and circulars or other publications relating to the business of the Office.

(b) The Director may exchange any of the publications specified in items 3, 4, 5, and 6 of subsection (a) of this section for publications desirable for the use of the Patent and Trademark Office.

(Transferred to 35 U.S.C. 9 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 11 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4804(b)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 582 (S. 1948 secs. 4507(1) and 4732(a)(10)(A)).)

35 U.S.C. 11 Exchange of copies of patents and applications with foreign countries.

The Director may exchange copies of specifications and drawings of United States patents and published applications for patents for those of foreign countries.

The Director shall not enter into an agreement to provide such copies of specifications and drawings of United States patents and applications to a foreign country, other than a NAFTA country or a WTO member country, without the express authorization of the Secretary of Commerce. For purposes of this section, the terms "NAFTA country" and "WTO member country" have the meanings given those terms in section 104(b).

(Transferred to 35 U.S.C. 10 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 12 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4808).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 582 (S. 1948 secs. 4507(2)(A), 4507(2)(B), and 4732(a)(10)(A)).)

35 U.S.C. 12 Copies of patents and applications for public libraries.

The Director may supply copies of specifications and drawings of patents and published applications for patents in printed or electronic form to public libraries in the United States which shall maintain such copies for the use of the public, at the rate for each year's issue established for this purpose in section 41(d) of this title.

(Transferred to 35 U.S.C. 11 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 13 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)); amended Aug. 27, 1982, Public Law 97-247, sec. 15, 96 Stat. 321; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4804(c)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 566, 582 (S. 1948 secs. 4507(3)(A), 4507(3)(B), 4507(4), and 4732(a)(10)(A)).)

35 U.S.C. 13 Annual report to Congress.

The Director shall report to the Congress, not later than 180 days after the end of each fiscal year, the moneys received and expended by the Office, the purposes for which the moneys were spent, the quality and quantity of the work of the Office, the nature of training provided to examiners, the evaluation of the Commissioner of Patents and the Commissioner of Trademarks by the Secretary of Commerce, the compensation of the Commissioners, and other information relating to the Office.

(Transferred to 35 U.S.C. 12 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Transferred from 35 U.S.C. 14 Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S 1948 sec. 4717(1)).)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565, 581 (S. 1948 secs. 4507(2), 4718).)

CHAPTER 2 — PROCEEDINGS IN THE PATENTS AND TRADEMARK OFFICE

Sec.

35 U.S.C. 21 Filing date and day for taking action.

(a) The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

(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 fee paid, on the next succeeding secular or business day.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Aug. 27, 1982, Public Law 97-247, sec. 12, 96 Stat. 321; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 22 Printing of papers filed.

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 589 (S. 1948 secs. 4732(a)(10)(A), 4804(a)).)

35 U.S.C. 23 Testimony in Patent and Trademark Office cases.

The Director may establish rules for taking affidavits and depositions required in cases in the Patent and Trademark Office. Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 24 Subpoenas, witnesses.

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 25 Declaration in lieu of oath.

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

(Added Mar. 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 26 Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Director despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

(Added Mar. 26, 1964, Public Law 88-292, sec. 1, 78 Stat. 171; amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 3 — PRACTICE BEFORE PATENT AND TRADEMARK OFFICE

Sec.

31 [Repealed]

35 U.S.C. 31 [Repealed].

(Repealed Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580 (S. 1948 sec. 4715(b)).)

35 U.S.C. 32 Suspension or exclusion from practice.

The Director may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of this title, or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The Director shall have the discretion to designate any attorney who is an officer or employee of the United States Patent and Trademark Office to conduct the hearing required by this section. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Director upon the petition of the person so refused recognition or so suspended or excluded.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat.1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-580, 581, 582 (S. 1948 secs. 4715(c), 4719, 4732(a)(10)(A)).)

35 U.S.C. 33 Unauthorized representation as practitioner.

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

CHAPTER 4 — PATENT FEES; FUNDING; SEARCH SYSTEMS

35 U.S.C. 41 Patent fees; patent and trademark search systems.

(a) The Director shall charge the following fees:

(1)(A) On filing each application for an original patent, except in design or plant cases, $690.

(B) In addition, on filing or on presentation at any other time, $78 for each claim in independent form which is in excess of 3, $18 for each claim (whether independent or dependent) which is in excess of 20, and $260 for each application containing a multiple dependent claim.

(C) On filing each provisional application for an original patent, $150.

(2) For issuing each original or reissue patent, except in design or plant cases, $1,210.

(3) In design and plant cases-

(A) on filing each design application, $310;

(B) on filing each plant application, $480;

(C) on issuing each design patent, $430; and

(D) on issuing each plant patent, $580.

(4)(A)On filing each application for the reissue of a patent, $690.

(B) In addition, on filing or on presentation at any other time, $78 for each claim in independent form which is in excess of the number of independent claims of the original patent, and $18 for each claim (whether independent or dependent) which is in excess of 20 and also in excess of the number of claims of the original patent.

(5) On filing each disclaimer, $110.

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, $300.

(B) In addition, on filing a brief in support of the appeal, $300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, $260.

(7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $110.

(8) For petitions for 1-month extensions of time to take actions required by the Director in an application-

(A) on filing a first petition, $110;

(B) on filing a second petition, $270; and

(C) on filing a third or subsequent petition, $490.

(9) Basic national fee for an international application where the Patent and Trademark Office was the International Preliminary Examining Authority and the International Searching Authority, $670.

(10) Basic national fee for an international application where the Patent and Trademark Office was the International Searching Authority but not the International Preliminary Examining Authority, $690.

(11) Basic national fee for an international application where the Patent and Trademark Office was neither the International Searching Authority nor the International Preliminary Examining Authority, $970.

(12) Basic national fee for an international application where the international preliminary examination has been paid to the Patent and Trademark Office, and the international preliminary examination report states that the provisions of Article 33 (2), (3), and (4) of the Patent Cooperation Treaty have been satisfied for all claims in the application entering the national stage, $96.

(13) For filing or later presentation of each independent claim in the national stage of an international application in excess of 3, $78.

(14) For filing or later presentation of each claim (whether independent or dependent) in a national stage of an international application in excess of 20, $18.

(15) For each national stage of an international application containing a multiple dependent claim, $260.

For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Director.

(b) The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

(1) 3 years and 6 months after grant, $830.

(2) 7 years and 6 months after grant, $1,900.

(3) 11 years and 6 months after grant, $2,910.

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee. No fee may be established for maintaining a design or plant patent in force.

(c)(1) The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

(2) A patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall not abridge or affect the right of any person or that person's successors in business who made, purchased, offered to sell, or used anything protected by the patent within the United States, or imported anything protected by the patent into the United States after the 6-month grace period but prior to the acceptance of a maintenance fee under this subsection, to continue the use of, to offer for sale, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported. The

court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, or used within the United States, or imported into the United States, as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, and the court may also provide for the continued practice of any process that is practiced, or for the practice of which substantial preparation was made, after the 6-month grace period but before the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the 6-month grace period but before the acceptance of a maintenance fee under this subsection.

(d) The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services:

(1) For recording a document affecting title, $40 per property.

(2) For each photocopy, $.25 per page.

(3) For each black and white copy of a patent, $3.

The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents issued in that year shall be $50.

(e) The Director may waive the payment of any fee for any service or material related to patents in connection with an occasional or incidental request made by a department or agency of the Government, or any officer thereof. The Director may provide any applicant issued a notice under section 132 of this title with a copy of the specifications and drawings for all patents referred to in that notice without charge.

(f) The fees established in subsections (a) and (b) of this section may be adjusted by the Director on October 1, 1992, and every year thereafter, to reflect any fluctuations occurring during the previous 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.

(g) No fee established by the Director under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the *Official Gazette* of the Patent and Trademark Office.

(h)(1) Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

(2) With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher than the surcharge or fee required of any other entity under the same or substantially similar circumstances.

(i)(1) The Director shall maintain, for use by the public, paper, microform or electronic collections of United States patents, foreign patent documents, and United States trademark registrations arranged to permit search for and retrieval of information. The Director may not impose fees directly for the use of such collections, or for the use of the public patent and trademark search rooms or libraries.

(2) The Director shall provide for the full deployment of the automated search systems of the Patent and Trademark Office so that such systems are available for use by the public, and shall assure full access by the public to, and dissemination of, patent and trademark information, using a variety of automated methods, including electronic bulletin boards and remote access by users to mass storage and retrieval systems.

(3) The Director may establish reasonable fees for access by the public to the automated search systems of the Patent and Trademark Office. If such fees are established, a limited amount of free access shall be made available to users of the systems for purposes of education and training. The Director may waive the payment by an individual of fees authorized by this subsection upon a showing of need or hardship, and if such waiver is in the public interest.

(4) The Director shall submit to the Congress an annual report on the automated search systems of the Patent and Trademark Office and the access by the public to such systems. The Director shall also pub-

lish such report in the Federal Register. The Director shall provide an opportunity for the submission of comments by interested persons on each such report.

(Amended July 24, 1965, Public Law 89-83, sec. 1, 2, 79 Stat. 259; Jan. 2, 1975, Public Law 93-596, sec. 1, Jan. 2, 1975, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 3, 89 Stat. 690.)

(Subsection (g) amended Dec. 12, 1980, Public Law 96-517, sec. 2, 94 Stat. 3017; Aug. 27, 1982, Public Law 97-247, sec. 3(a)-(e), 96 Stat. 317.)

(Subsections (a)-(d) amended Sept. 8, 1982, Public Law 97-256, sec. 101, 96 Stat. 816.)

(Subsection (a)(6) amended Nov. 8, 1984, Public Law 98-622, sec. 204(a), 98 Stat. 3388.)

(Subsection (h) added Nov. 6, 1986, Public Law 99-607, sec. 1(b)(2), 100 Stat. 3470.)

(Subsections (a), (b), (d), (f), and (g) amended Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1637.)

(Subsections (a)(9) - (15) and (i) added Dec. 10, 1991, Public Law 102-204, sec. 5, 105 Stat. 1637.)

(Subsection (c)(1) amended Oct. 23, 1992, Public Law 102-444, sec. 1, 106 Stat. 2245.)

(Subsection (a)(1)(C) added Dec. 8, 1994, Public Law 103-465, sec. 532(b)(2), 108 Stat. 4986.)

(Subsection (c)(2) amended, Dec. 8, 1994, Public Law 103-465, sec. 533(b)(1), 108 Stat. 4988.)

(Subsections (a)-(b) revised Nov. 10, 1998, Public Law 105-358, sec. 3, 112 Stat. 3272.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-554, 570, 582, 589 (S. 1948 secs. 4202, 4605(a), 4732(a)(5), 4732(a)(10)(A)) and 4804(d)).)

35 U.S.C. 42 Patent and Trademark Office funding.

(a) All fees for services performed by or materials furnished by the Patent and Trademark Office will be payable to the Director.

(b) All fees paid to the Director and all appropriations for defraying the costs of the activities of the Patent and Trademark Office will be credited to the Patent and Trademark Office Appropriation Account in the Treasury of the United States.

(c) To the extent and in the amounts provided in advance in appropriations Acts, fees authorized in this title or any other Act to be charged or established by the Director shall be collected by and shall be available to the Director to carry out the activities of the Patent and Trademark Office. All fees available to the Director under section 31 of the Trademark Act of 1946 shall be used only for the processing of trademark registrations and for other activities, services and materials relating to trademarks and to cover a proportionate share of the administrative costs of the Patent and Trademark Office.

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

(e) The Secretary of Commerce shall, on the day each year on which the President submits the annual budget to the Congress, provide to the Committees on the Judiciary of the Senate and the House of Representatives:

(1) a list of patent and trademark fee collections by the Patent and Trademark Office during the preceding fiscal year;

(2) a list of activities of the Patent and Trademark Office during the preceding fiscal year which were supported by patent fee expenditures, trademark fee expenditures, and appropriations;

(3) budget plans for significant programs, projects, and activities of the Office, including out-year funding estimates;

(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89 Stat. 690; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018; Aug. 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319; Sept. 13, 1982, Public Law 97-258, sec. 3(i), 96 Stat. 1065.)

(Subsection (c) amended Dec. 10, 1991, Public Law 102-204, sec. 5(e), 105 Stat. 1640.)

(Subsection (e) added Dec. 10, 1991, Public Law 102-204, sec. 4, 105 Stat. 1637.)

(Subsection (c) revised Nov. 10, 1998, Public Law 105-358, sec. 4, 112 Stat. 3274.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555, 582 (S. 1948 secs. 4205 and 4732(a)(10)(A)).)

PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

CHAPTER 10 — PATENTABILITY OF INVENTIONS

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.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603).)

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.

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.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691.)

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505).)

(Subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806).)

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

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

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

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

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

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

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

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

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

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

(i) express an exogenous nucleotide sequence,

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

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

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

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

(c) 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.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec.1, 109 Stat. 3511.)

(Subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807).)

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.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 14, 1975, Public Law 94-131, sec. 6, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1993, Public Law 103-182, sec. 331, 107 Stat. 2113; Dec. 8, 1994, Public Law 103-465, sec. 531(a), 108 Stat. 4982; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 105 Inventions in outer space.

(a) Any invention made, used, or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used, or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used, or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

(Added Nov. 15, 1990, Public Law 101-580, sec. 1(a), 104 Stat. 2863.)

CHAPTER 11 — APPLICATION FOR PATENT

35 U.S.C. 111 Application.

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) ABANDONMENT.—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) OTHER BASIS FOR PROVISIONAL APPLICATION.—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) APPLICABLE PROVISIONS.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 5, 96 Stat. 319; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(3), 108 Stat. 4986; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 588 (S. 1948 secs. 4732(a)(10)(A), 4801(a)).)

35 U.S.C. 112 Specification.

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.

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.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

(Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; Nov. 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691.)

35 U.S.C. 113 Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 8, 89 Stat. 691; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 115 Oath of applicant.

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. Such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

(Amended Aug. 27, 1982, Public Law 97-247, sec. 14(a), 96 Stat. 321; Oct. 21, 1998, Pub. L. 105-277, sec. 2222(d), 112 Stat. 2681-818.)

35 U.S.C. 116 Inventors.

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 6(a), 96 Stat. 320; Nov. 8, 1984, Public Law 98-622, sec. 104(a), 98 Stat. 3384; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 117 Death or incapacity of inventor.

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

35 U.S.C. 118 Filing by other than inventor.

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)(1)No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim.The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e)(1)An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term "WTO member country" has the same meaning as the term is defined in section 104(b)(2) of this title; and

(2) the term "UPOV Contracting Party" means a member of the International Convention for the Protection of New Varieties of Plants.

(Amended Oct. 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748; July 28, 1972, Public Law 92-358, sec. 1, 86 Stat. 501; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(1), 108 Stat. 4985.)

(Subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec.4503(a)).)

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564, 588, 589 (S. 1948 secs. 4503(b)(2), 4801 and 4802).)

(Subsections (f) and (g) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4802).)

35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)

35 U.S.C. 121 Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 122 Confidential status of applications; publication of patent applications.

(a) CONFIDENTIALITY.— Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

(b) PUBLICATION.—

(1) IN GENERAL.—

(A) Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

(B) No information concerning published patent applications shall be made available to the public except as the Director determines.

(C) Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

(2) EXCEPTIONS.—

(A) An application shall not be published if that application is—

(i) no longer pending;

(ii) subject to a secrecy order under section 181 of this title;

(iii) a provisional application filed under section 111(b) of this title; or

(iv) an application for a design patent filed under chapter 16 of this title.

(B)(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) An applicant may rescind a request made under clause (i) at any time.

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

(v) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of section 154(d) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

(c) PROTEST AND PRE-ISSUANCE OPPOSITION.— The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

(d) NATIONAL SECURITY.— No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17 of this title.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)

CHAPTER 12 — EXAMINATION OF APPLICATION

Sec.

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

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.

(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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-560, 582 (S. 1948 secs. 4403 and 4732(a)(10)(A)).)

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 134 Appeal to the Board of Patent Appeals and Interferences.

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the administrative patent judge favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal. The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 204(b)(1), 98 Stat. 3388; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4605(b)).)

35 U.S.C. 135 Interferences.

(a) Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

(b)(1)A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is

made before 1 year after the date on which the application is published.

(c) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Director may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Director shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Director gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Director by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining patentability of the invention involved in the interference.

(Subsection (c) added Oct. 15, 1962, Public Law 87-831, 76 Stat. 958.)

(Subsections (a) and (c) amended, Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

(Subsection (a) amended Nov. 8, 1984, Public Law 98-622, sec. 202, 98 Stat. 3386.)

(Subsection (d) added Nov. 8, 1984, Public Law 98-622, sec. 105, 98 Stat. 3385.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566, 582 (S. 1948 secs. 4507(11) and 4732(a)(10)(A)).)

CHAPTER 13 — REVIEW OF PATENT AND TRADEMARK OFFICE DECISION

Sec.

35 U.S.C. 141 Appeal to the Court of Appeals for the Federal Circuit.

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with

the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), (b)(2), 96 Stat. 49, 50; Nov. 8, 1984, Public Law 98-622, sec. 203(a), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(c) and 4732(a)(10)(A)).)

35 U.S.C. 142 Notice of appeal.

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 143 Proceedings on appeal.

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(d) and 4732(a)(10)(A)).)

35 U.S.C. 144 Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-620, sec. 414(a), 98 Stat. 3363; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 145 Civil action to obtain patent.

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-622, sec. 203(b), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-571, 582 (S. 1948 secs. 4605(e) and 4732(a)(10)(A).)

35 U.S.C. 146 Civil action in case of interference.

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided.

In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Apr. 2, 1982, Public Law 97-164, sec. 163(a)(7), 96 Stat. 49; Nov. 8, 1984, Public Law 98-622, sec. 203(c), 98 Stat. 3387; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 14 — ISSUE OF PATENT

35 U.S.C. 151 Issue of patent.

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

(Amended July 24, 1965, Public Law 89-83, sec. 4, 79 Stat. 260; Jan. 2, 1975, Public Law 93-601, sec. 3, 88 Stat. 1956; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 152 Issue of patent to assignee.

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 153 How issued.

Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Director, and shall be recorded in the Patent and Trademark Office.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec.

1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 154 Contents and term of patent; provisional rights.

(a) IN GENERAL.—

(1) CONTENTS.—Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

(2) TERM.—Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 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 or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY.—Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

(4) SPECIFICATION AND DRAWING.—A copy of the specification and drawing shall be annexed to the patent and be a part of such patent.

(b) ADJUSTMENT OF PATENT TERM.—

(1) PATENT TERM GUARANTEES.—

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including—

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

(ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or

(iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to—

(i) a proceeding under section 135(a);

(ii) the imposition of an order under section 181; or

(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court

in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

(2) LIMITATIONS.—

(A) IN GENERAL.— To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM.— No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) REDUCTION OF PERIOD OF ADJUSTMENT.—

(i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.

(ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.

(iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

(3) PROCEDURES FOR PATENT TERM ADJUSTMENT DETERMINATION.—

(A) The Director shall prescribe regulations establishing procedures for the application for and determination of patent term adjustments under this subsection.

(B) Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

(C) The Director shall reinstate all or part of the cumulative period of time of an adjustment under paragraph (2)(C) if the applicant, prior to the issuance of the patent, makes a showing that, in spite of all due care, the applicant was unable to respond within the 3-month period, but in no case shall more than three additional months for each such response beyond the original 3-month period be reinstated.

(D) The Director shall proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection, notwithstanding any appeal taken by the applicant of such determination.

(4) APPEAL OF PATENT TERM ADJUSTMENT DETERMINATION.—

(A) An applicant dissatisfied with a determination made by the Director under paragraph (3) shall have remedy by a civil action against the Director filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent. Chapter 7 of title 5, United States Code, shall apply to such action. Any final judgment resulting in a change to the period of adjustment of the patent term shall be served on the Director, and the Director shall thereafter alter the term of the patent to reflect such change.

(B) The determination of a patent term adjustment under this subsection shall not be subject to appeal or challenge by a third party prior to the grant of the patent.

(c) CONTINUATION.—

(1) DETERMINATION.—The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

(2) REMEDIES.—The remedies of sections 283, 284, and 285 of this title shall not apply to acts which —

(A) were commenced or for which substantial investment was made before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act; and

(B) became infringing by reason of paragraph (1).

(3) REMUNERATION.—The acts referred to in paragraph (2) may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapter 28 and chapter 29 (other than those provisions excluded by paragraph (2)) of this title.

(d) PROVISIONAL RIGHTS.—

(1) IN GENERAL.— In addition to other rights provided by this section, a patent shall include the right to obtain a reasonable royalty from any person who, during the period beginning on the date of publication of the application for such patent under section 122(b), or in the case of an international application filed under the treaty defined in section 351(a) designating the United States under Article 21(2)(a) of such treaty, the date of publication of the application, and ending on the date the patent is issued—

(A) (i) makes, uses, offers for sale, or sells in the United States the invention as claimed in the published patent application or imports such an invention into the United States; or

(ii) if the invention as claimed in the published patent application is a process, uses, offers for sale, or sells in the United States or imports into the United States products made by that process as claimed in the published patent application; and

(B) had actual notice of the published patent application and, in a case in which the right arising under this paragraph is based upon an international application designating the United States that is published in a language other than English, had a translation of the international application into the English language.

(2) RIGHT BASED ON SUBSTANTIALLY IDENTICAL INVENTIONS.— The right under paragraph (1) to obtain a reasonable royalty shall not be available under this subsection unless the invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.

(3) TIME LIMITATION ON OBTAINING A REASONABLE ROYALTY.— The right under paragraph (1) to obtain a reasonable royalty shall be available only in an action brought not later than 6 years after the patent is issued. The right under paragraph (1) to obtain a reasonable royalty shall not be affected by the duration of the period described in paragraph (1).

(4) REQUIREMENTS FOR INTERNATIONAL APPLICATIONS—

(A) EFFECTIVE DATE.— The right under paragraph (1) to obtain a reasonable royalty based upon the publication under the treaty defined in section 351(a) of an international application designating the United States shall commence on the date on which the Patent and Trademark Office receives a copy of the publication under the treaty of the international application, or, if the publication under the treaty of the international application is in a language other than English, on the date on which the Patent and Trademark Office receives a translation of the international application in the English language.

(B) COPIES.— The Director may require the applicant to provide a copy of the international application and a translation thereof.

(Amended July 24, 1965, Public Law 89-83, sec. 5, 79 Stat. 261; Dec. 12, 1980, Public Law 96-517, sec. 4, 94 Stat. 3018; Aug. 23, 1988, Public Law 100-418, sec. 9002, 102 Stat. 1563; Dec. 8, 1994, Public Law 103-465, sec. 532 (a)(1), 108 Stat. 4983; Oct. 11, 1996, Public Law 104-295, sec. 20(e)(1), 110 Stat. 3529.)

(Subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-557 (S. 1948 sec. 4402(a)).)

(Subsection (d) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564 (S. 1948 sec. 4504).)

35 U.S.C. 155 Patent term extension.

Notwithstanding the provisions of section 154, the term of a patent which encompasses within its scope a composition of matter or a process for using such composition shall be extended if such composition or process has been subjected to a regulatory review by the Federal Food and Drug Administration pursuant to the Federal Food, Drug and Cosmetic Act leading to the publication of regulation permitting the interstate distribution and sale of such composition or process and for which there has thereafter been a stay of regulation of approval imposed pursuant to section 409 of the Federal Food, Drug and Cosmetic Act,

which stay was in effect on January 1, 1981, by a length of time to be measured from the date such stay of regulation of approval was imposed until such proceedings are finally resolved and commercial marketing permitted. The patentee, his heirs, successors, or assigns shall notify the Director within 90 days of the date of enactment of this section or the date the stay of regulation of approval has been removed, whichever is later, of the number of the patent to be extended and the date the stay was imposed and the date commercial marketing was permitted. On receipt of such notice, the Director shall promptly issue to the owner of record of the patent a certificate of extension, under seal, stating the fact and length of the extension and identifying the composition of matter or process for using such composition to which such extension is applicable. Such certificate shall be recorded in the official file of each patent extended and such certificate shall be considered as part of the original patent, and an appropriate notice shall be published in the Official Gazette of the Patent and Trademark Office.

(Added Jan. 4, 1983, Public Law 97-414, sec. 11(a), 96 Stat. 2065; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 secs. 4732(a)(6) and 4732(a)(10)(A)).)

35 U.S.C. 155A Patent term restoration.

(a) Notwithstanding section 154 of this title, the term of each of the following patents shall be extended in accordance with this section:

(1) Any patent which encompasses within its scope a composition of matter which is a new drug product, if during the regulatory review of the product by the Federal Food and Drug Administration —

(A) the Federal Food and Drug Administration notified the patentee, by letter dated February 20, 1976, that such product's new drug application was not approvable under section 505(b)(1) of the Federal Food, Drug and Cosmetic Act;

(B) in 1977 the patentee submitted to the Federal Food and Drug Administration the results of a health effects test to evaluate the carcinogenic potential of such product;

(C) the Federal Food and Drug Administration approved, by letter dated December 18, 1979, the new drug application for such application; and

(D) the Federal Food and Drug Administration approved, by letter dated May 26, 1981, a supplementary application covering the facility for the production of such product.

(2) Any patent which encompasses within its scope a process for using the composition described in paragraph (1).

(b) The term of any patent described in subsection (a) shall be extended for a period equal to the period beginning February 20, 1976, and ending May 26, 1981, and such patent shall have the effect as if originally issued with such extended term.

(c) The patentee of any patent described in subsection (a) of this section shall, within ninety days after the date of enactment of this section, notify the Director of the number of any patent so extended. On receipt of such notice, the Director shall confirm such extension by placing a notice thereof in the official file of such patent and publishing an appropriate notice of such extension in the *Official Gazette* of the Patent and Trademark Office.

(Added Oct. 13, 1983, Public Law 98-127, sec. 4(a), 97 Stat. 832; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 secs. 4732(a)(7) and 4732(a)(10)(A)).)

35 U.S.C. 156 Extension of patent term.

(a) The term of a patent which claims a product, a method of using a product, or a method of manufacturing a product shall be extended in accordance with this section from the original expiration date of the patent, which shall include any patent term adjustment granted under section 154(b) if —

(1) the term of the patent has not expired before an application is submitted under subsection (d)(1) for its extension;

(2) the term of the patent has never been extended under subsection (e)(1) of this section;

(3) an application for extension is submitted by the owner of record of the patent or its agent and in accordance with the requirements of paragraphs (1) through (4) of subsection (d);

(4) the product has been subject to a regulatory review period before its commercial marketing or use;

(5)(A) except as provided in subparagraph (B) or (C), the permission for the commercial marketing or use of the product after such regulatory review period is the first permitted commercial marketing or use of the product under the provision of law under which such regulatory review period occurred;

(B) in the case of a patent which claims a method of manufacturing the product which primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use of the product after such regulatory period is the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or

(C) for purposes of subparagraph (A), in the case of a patent which —

(i) claims a new animal drug or a veterinary biological product which (I) is not covered by the claims in any other patent which has been extended, and (II) has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and

(ii) was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

The product referred to in paragraphs (4) and (5) is hereinafter in this section referred to as the "approved product."

(b) Except as provided in subsection (d)(5)(F), the rights derived from any patent the term of which is extended under this section shall during the period during which the term of the patent is extended —

(1) in the case of a patent which claims a product, be limited to any use approved for the product —

(A) before the expiration of the term of the patent —

(i) under the provision of law under which the applicable regulatory review occurred, or

(ii) under the provision of law under which any regulatory review described in paragraph (1), (4), or (5) of subsection (g) occurred, and

(B) on or after the expiration of the regulatory review period upon which the extension of the patent was based;

(2) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent and approved for the product —

(A) before the expiration of the term of the patent —

(i) under any provision of law under which an applicable regulatory review occurred, and

(ii) under the provision of law under which any regulatory review described in paragraph (1), (4), or (5) of subsection (g) occurred, and

(B) on or after the expiration of the regulatory review period upon which the extension of the patent was based; and

(3) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make —

(A) the approved product, or

(B) the product if it has been subject to a regulatory review period described in paragraphs (1), (4), or (5) of subsection (g).

As used in this subsection, the term "product" includes an approved product.

(c) The term of a patent eligible for extension under subsection (a) shall be extended by the time equal to the regulatory review period for the approved product which period occurs after the date the patent is issued, except that—

(1) each period of the regulatory review period shall be reduced by any period determined under subsection (d)(2)(B) during which the applicant for the patent extension did not act with due diligence during such period of the regulatory review period;

(2) after any reduction required by paragraph (1), the period of extension shall include only one-half of the time remaining in the periods described in paragraphs (1)(B)(i), (2)(B)(i), (3)(B)(i), (4)(B)(i), and (5)(B)(i) of subsection (g);

(3) if the period remaining in the term of a patent after the date of the approval of the approved product under the provision of law under which such regulatory review occurred when added to the regulatory review period as revised under paragraphs (1) and (2) exceeds fourteen years, the period of extension shall be reduced so that the total of both such periods does not exceed fourteen years, and

(4) in no event shall more than one patent be extended under subsection (e)(i) for the same regulatory review period for any product.

(d)(1) To obtain an extension of the term of a patent under this section, the owner of record of the patent or its agent shall submit an application to the

Director. Except as provided in paragraph (5), such an application may only be submitted within the sixty-day period beginning on the date the product received permission under the provision of law under which the applicable regulatory review period occurred for commercial marketing or use. The application shall contain —

(A) the identity of the approved product and the Federal statute under which regulatory review occurred;

(B) the identity of the patent for which an extension is being sought and the identity of each claim of such patent;

(C) information to enable the Director to determine under subsections (a) and (b) the eligibility of a patent for extension and the rights that will be derived from the extension and information to enable the Director and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the period of the extension under subsection (g);

(D) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities; and

(E) such patent or other information as the Director may require.

(2)(A) Within 60 days of the submittal of an application for extension of the term of a patent under paragraph (1), the Director shall notify —

(i) the Secretary of Agriculture if the patent claims a drug product or a method of using or manufacturing a drug product and the drug product is subject to the Virus-Serum-Toxin Act, and

(ii) the Secretary of Health and Human Services if the patent claims any other drug product, a medical device, or a food additive or color additive or a method of using or manufacturing such a product, device, or additive and if the product, device, and additive are subject to the Federal Food, Drug and Cosmetic Act, of the extension application and shall submit to the Secretary who is so notified a copy of the application. Not later than 30 days after the receipt of an application from the Director, the Secretary reviewing the application shall review the dates contained in the application pursuant to paragraph (1)(C) and determine the applicable regulatory review period, shall notify the Director of the determination, and shall publish in the Federal Register a notice of such determination.

(B)(i) If a petition is submitted to the Secretary making the determination under subparagraph (A), not later than 180 days after the publication of the determination under subparagraph (A), upon which it may reasonably be determined that the applicant did not act with due diligence during the applicable regulatory review period, the Secretary making the determination shall, in accordance with regulations promulgated by the Secretary, determine if the applicant acted with due diligence during the applicable regulatory review period. The Secretary making the determination shall make such determination not later than 90 days after the receipt of such a petition. For a drug product, device, or additive subject to the Federal Food, Drug, and Cosmetic Act or the Public Health Service Act, the Secretary may not delegate the authority to make the determination prescribed by this clause to an office below the Office of the Commissioner of Food and Drugs. For a product subject to the Virus-Serum-Toxin Act, the Secretary of Agriculture may not delegate the authority to make the determination prescribed by this clause to an office below the office of the Assistant Secretary for Marketing and Inspection Services.

(ii) The Secretary making a determination under clause (i) shall notify the Director of the determination and shall publish in the Federal Register a notice of such determination together with the factual and legal basis for such determination. Any interested person may request, within the 60-day period beginning on the publication of a determination, the Secretary making the determination to hold an informal hearing on the determination. If such a request is made within such period, such Secretary shall hold such hearing not later than 30 days after the date of the request, or at the request of the person making the request, not later than 60 days after such date. The Secretary who is holding the hearing shall provide notice of the hearing to the owner of the patent involved and to any interested person and provide the owner and any interested person an opportunity to participate in the hearing. Within 30 days after the completion of the hearing, such Secretary shall affirm or revise the determination which was the subject of the hearing and notify the Director

of any revision of the determination and shall publish any such revision in the Federal Register.

(3) For the purposes of paragraph (2)(B), the term "due diligence" means that degree of attention, continuous directed effort, and timeliness as may reasonably be expected from, and are ordinarily exercised by, a person during a regulatory review period.

(4) An application for the extension of the term of a patent is subject to the disclosure requirements prescribed by the Director.

(5)(A) If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days before such term is due to expire. The application shall contain—

(i) the identity of the product subject to regulating review and the Federal statute under which such review is occurring;

(ii) the identity of the patent for which interim extension is being sought and the identity of each claim of such patent which claims the product under regulatory review or a method of using or manufacturing the product;

(iii) information to enable the Director to determine under subsection (a)(1), (2), and (3) the eligibility of a patent for extension;

(iv) a brief description of the activities undertaken by the applicant during the applicable regulatory review period to date with respect to the product under review and the significant dates applicable to such activities; and

(v) such patent or other information as the Director may require.

(B) If the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for an extension of the patent term under this section, the Director shall publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year.

(C) The owner of record of a patent, or its agent, for which an interim extension has been granted under subparagraph (B), may apply for not more than 4 subsequent interim extensions under this paragraph, except that, in the case of a patent subject to subsection (g)(6)(C), the owner of record of the patent, or its agent, may apply for only 1 subsequent interim extension under this paragraph. Each such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

(D) Each certificate of interim extension under this paragraph shall be recorded in the official file of the patent and shall be considered part of the original patent.

(E) Any interim extension granted under this paragraph shall terminate at the end of the 60-day period beginning on the day on which the product involved receives permission for commercial marketing or use, except that, if within that 60-day period, the applicant notifies the Director of such permission and submits any additional information under paragraph (1) of this subsection not previously contained in the application for interim extension, the patent shall be further extended, in accordance with the provisions of this section—

(i) for not to exceed 5 years from the date of expiration of the original patent term; or

(ii) if the patent is subject to subsection (g)(6)(C), from the date on which the product involved receives approval for commercial marketing or use.

(F) The rights derived from any patent the term of which is extended under this paragraph shall, during the period of interim extension—

(i) in the case of a patent which claims a product, be limited to any use then under regulatory review;

(ii) in the case of a patent which claims a method of using a product, be limited to any use claimed by the patent then under regulatory review; and

(iii) in the case of a patent which claims a method of manufacturing a product, be limited to the method of manufacturing as used to make the product then under regulatory review.

(e)(1) A determination that a patent is eligible for extension may be made by the Director solely on the basis of the representations contained in the application for the extension. If the Director determines that a patent is eligible for extension under subsection (a) and that the requirements of paragraphs (1) through (4) of subsection (d) have been complied with, the Director shall issue to the applicant for the extension of the term of the patent a certificate of extension, under seal, for the period prescribed by subsection (c). Such certificate shall be recorded in the official file of the patent and shall be considered as part of the original patent.

(2) If the term of a patent for which an application has been submitted under subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

(f) For purposes of this section:

(1) The term "product" means:

(A) A drug product.

(B) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

(2) The term "drug product" means the active ingredient of—

(A) a new drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) or

(B) a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient.

(3) The term "major health or environmental effects test" means a test which is reasonably related to the evaluation of the health or environmental effects of a product, which requires at least six months to conduct, and the data from which is submitted to receive permission for commercial marketing or use. Periods of analysis or evaluation of test results are not to be included in determining if the conduct of a test required at least six months.

(4)(A) Any reference to section 351 is a reference to section 351 of the Public Health Service Act.

(B) Any reference to section 503, 505, 512, or 515 is a reference to section 503, 505, 512, or 515 of the Federal Food, Drug and Cosmetic Act.

(C) Any reference to the Virus-Serum-Toxin Act is a reference to the Act of March 4, 1913 (21 U.S.C. 151 - 158).

(5) The term "informal hearing" has the meaning prescribed for such term by section 201(y) of the Federal Food, Drug and Cosmetic Act.

(6) The term "patent" means a patent issued by the United States Patent and Trademark Office.

(7) The term "date of enactment" as used in this section means September 24, 1984, for human drug product, a medical device, food additive, or color additive.

(8) The term "date of enactment" as used in this section means the date of enactment of the Generic Animal Drug and Patent Term Restoration Act for an animal drug or a veterinary biological product.

(g) For purposes of this section, the term "regulatory review period" has the following meanings:

(1)(A)In the case of a product which is a new drug, antibiotic drug, or human biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new drug, antibiotic drug, or human biological product is the sum of —

(i) the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 became effective for the approved product and ending on the date an application was initially submitted for such drug product under section 351, 505, or 507, and

(ii) the period beginning on the date the application was initially submitted for the approved product under section 351, subsection (b) of section 505, or section 507 and ending on the date such application was approved under such section.

(2)(A) In the case of a product which is a food additive or color additive, the term means the period

described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a food or color additive is the sum of —

(i) the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and

(ii) the period beginning on the date a petition was initially submitted with respect to the product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(3)(A) In the case of a product which is a medical device, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a medical device is the sum of —

(i) the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515, and

(ii) the period beginning on the date an application was initially submitted with respect to the device under section 515 and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) and ending on the date the protocol was declared completed under section 515(f)(6).

(4)(A) In the case of a product which is a new animal drug, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory review period for a new animal drug product is the sum of —

(i) the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the date an exemption under subsection (j) of section 512 became effective for the approved new animal drug product and ending on the date an application was initially submitted for such animal drug product under section 512, and

(ii) the period beginning on the date the application was initially submitted for the approved animal drug product under subsection (b) of section 512 and ending on the date such application was approved under such section.

(5)(A) In the case of a product which is a veterinary biological product, the term means the period described in subparagraph (B) to which the limitation described in paragraph (6) applies.

(B) The regulatory period for a veterinary biological product is the sum of —

(i) the period beginning on the date the authority to prepare an experimental biological product under the Virus- Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act, and

(ii) the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(6) A period determined under any of the preceding paragraphs is subject to the following limitations:

(A) If the patent involved was issued after the date of the enactment of this section, the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(B) If the patent involved was issued before the date of the enactment of this section and —

(i) no request for an exemption described in paragraph (1)(B) or (4)(B) was submitted and no request for the authority described in paragraph (5)(B) was submitted,

(ii) no major health or environment effects test described in paragraph (2)(B) or (4)(B) was initiated and no petition for a regulation or application for registration described in such paragraph was submitted, or

(iii) no clinical investigation described in paragraph (3) was begun or product development protocol described in such paragraph was submitted, before such date for the approved product the period of extension determined on the basis of the regulatory review period determined under any such paragraph may not exceed five years.

(C) If the patent involved was issued before the date of the enactment of this section and if an action described in subparagraph (B) was taken before the date of enactment of this section with respect to the approved product and the commercial marketing or use of the product has not been approved before such date, the period of extension determined on the basis of the regulatory review period determined under such paragraph may not exceed two years or in the case of an approved product which is a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act or the Virus-Serum-Toxin Act), three years.

(h) The Director may establish such fees as the Director determines appropriate to cover the costs to the Office of receiving and acting upon applications under this section.

(Added Sept. 24, 1984, Public Law 98-417, sec. 201(a), 98 Stat. 1598; amended Nov. 16, 1988, Public Law 100-670, sec. 201(a)-(h), 102 Stat. 3984; Dec. 3, 1993, Public Law 103-179, secs. 5, 6, 107 Stat. 2040, 2042; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(1), 108 Stat. 4987.)

(Subsection (f) amended Nov. 21, 1997, Public Law 105-115, sec. 125(b)(2)(P), 111 Stat. 2326.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-560, 582 (S. 1948 secs. 4404 and 4732(a)(10)(A)).)

35 U.S.C. 157 Statutory invention registration.

(a) Notwithstanding any other provision of this title, the Director is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant —

(1) meets the requirements of section 112 of this title;

(2) has complied with the requirements for printing, as set forth in regulations of the Director;

(3) waives the right to receive a patent on the invention within such period as may be prescribed by the Director; and

(4) pays application, publication, and other processing fees established by the Director.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Director shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The Director shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the uses of such procedures.

(Added Nov. 8, 1984, Public Law 98-622, sec. 102(a), 98 Stat. 3383; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 583 (S. 1948 secs. 4732(a)(10)(A) and 4732(a)(11)).)

CHAPTER 15 — PLANT PATENTS

35 U.S.C. 161 Patents for plants.

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

(Amended Sept. 3, 1954, 68 Stat. 1190.)

35 U.S.C. 162 Description, claim.

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

35 U.S.C. 163 Grant.

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

(Amended Oct. 27, 1998, Public Law 105-289, sec. 3, 112 Stat. 2781.)

35 U.S.C. 164 Assistance of the Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Director, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Director officers and employees of the Department.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 16 — DESIGNS

Sec.

35 U.S.C. 171 Patents for designs.

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. 172 Right of priority.

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 532(c)(2), 108 Stat. 4987.)

35 U.S.C. 173 Term of design patent.

Patents for designs shall be granted for the term of fourteen years from the date of grant.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 16, 96 Stat. 321; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(3), 108 Stat. 4987.)

CHAPTER 17 — SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRIES

Sec.

35 U.S.C. 181 Secrecy of certain inventions and withholding of patent.

Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the inter-

ested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner of Patents, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

Each individual to whom the application is disclosed shall sign a dated acknowledgment thereof, which acknowledgment shall be entered in the file of the application. If, in the opinion of the Atomic Energy Commission, the Secretary of a Defense Department, or the chief officer of another department or agency so designated, the publication or disclosure of the invention by the publication of an application or by the granting of a patent therefor would be detrimental to the national security, the Atomic Energy Commission, the Secretary of a Defense Department, or such other chief officer shall notify the Commissioner of Patents and the Commissioner of Patents shall order that the invention be kept secret and shall withhold the publication of the application or the grant of a patent for such period as the national interest requires, and notify the applicant thereof. Upon proper showing by the head of the department or agency who caused the secrecy order to be issued that the examination of the application might jeopardize the national interest, the Commissioner of Patents shall thereupon maintain the application in a sealed condition and notify the applicant thereof. The owner of an application which has been placed under a secrecy order shall have a right to appeal from the order to the Secretary of Commerce under rules prescribed by him.

An invention shall not be ordered kept secret and the publication of an application or the grant of a patent withheld for a period of more than one year. The Commissioner of Patents shall renew the order at the end thereof, or at the end of any renewal period, for additional periods of one year upon notification by the head of the department or the chief officer of the agency who caused the order to be issued that an affirmative determination has been made that the national interest continues to so require. An order in effect, or issued, during a time when the United States is at war, shall remain in effect for the duration of hostilities and one year following cessation of hostilities. An order in effect, or issued, during a national emergency declared by the President shall remain in effect for the duration of the national emergency and six months thereafter. The Commissioner of Patents may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the publication or disclosure of the invention is no longer deemed detrimental to the national security.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566, 582 (S. 1948 secs. 4507(7) and 4732(a)(10)(B)).)

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(B)).)

35 U.S.C. 183 Right to compensation.

An applicant, his successors, assigns, or legal representatives, whose patent is withheld as herein provided, shall have the right, beginning at the date the applicant is notified that, except for such order, his application is otherwise in condition for allowance, or February 1, 1952, whichever is later, and ending six years after a patent is issued thereon, to apply to the head of any department or agency who caused the order to be issued for compensation for the damage caused by the order of secrecy and/or for the use of the invention by the Government, resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. The head of the department or agency is authorized, upon the presentation of a claim, to enter into an agreement with the applicant, his successors, assigns, or legal representatives, in full settlement for the damage and/or use. This settlement agreement shall be conclusive for all purposes notwithstanding any other provision of law to the contrary. If full settlement of the claim cannot be effected, the head of the department or agency may award and pay to such applicant, his successors, assigns, or legal representatives, a sum not exceeding 75 per centum of the sum which the head of the department or agency considers just compensation for the damage and/or use. A claimant may bring suit against the United States in the United States Court of Federal Claims or in the District Court of the United States for the district in which such claimant is a resident for an amount which when added to the award shall constitute just compensation for the damage and/or use of the invention by the Government. The owner of any patent issued upon an application that was subject to a secrecy order issued pursuant to section 181 of this title, who did not apply for compensation as above provided, shall have the right, after the date of issuance of such patent, to bring suit in the United States Court of Federal Claims for just compensation for the damage caused by reason of the order of secrecy and/or use by the Government of the invention resulting from his disclosure. The right to compensation for use shall begin on the date of the first use of the invention by the Government. In a suit under the provisions of this section the United States may avail itself of all defenses it may plead in an action under section 1498 of title 28. This section shall not confer a right of action on anyone or his successors, assigns, or legal representatives who, while in the full-time employment or service of the United States, discovered, invented, or developed the invention on which the claim is based.

(Amended Apr. 2, 1982, Public Law 97-164, sec. 160(a)(12), 96 Stat. 48; Oct. 29, 1992, Public Law 102-572, sec. 902 (b)(1), 106 Stat. 4516.)

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.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(1), 102 Stat. 1567; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(B)).)

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.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(2), 102 Stat. 1568.)

35 U.S.C. 186 Penalty.

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever willfully, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States, shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

(Amended Aug. 23, 1988, Public Law 100-418, sec. 9101(b)(3), 102 Stat. 1568.)

35 U.S.C. 187 Nonapplicability to certain persons.

The prohibitions and penalties of this chapter shall not apply to any officer or agent of the United States acting within the scope of his authority, nor to any person acting upon his written instructions or permission.

35 U.S.C. 188 Rules and regulations, delegation of power.

The Atomic Energy Commission, the Secretary of a defense department, the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States, and the Secretary of Commerce, may separately issue rules and regulations to enable the respective department or agency to carry out the provisions of this chapter, and may delegate any power conferred by this chapter.

CHAPTER 18 — PATENT RIGHTS IN INVENTIONS MADE WITH FEDERAL ASSISTANCE

Sec.

35 U.S.C. 200 Policy and objective.

It is the policy and objective of the Congress to use the patent system to promote the utilization of inventions arising from federally supported research or development; to encourage maximum participation of small business firms in federally supported research and development efforts; to promote collaboration between commercial concerns and nonprofit organizations, including universities; to ensure that inventions made by nonprofit organizations and small

business firms are used in a manner to promote free competition and enterprise without unduly encumbering future research and discovery; to promote the commercialization and public availability of inventions made in the United States by United States industry and labor; to ensure that the Government obtains sufficient rights in federally supported inventions to meet the needs of the Government and protect the public against nonuse or unreasonable use of inventions; and to minimize the costs of administering policies in this area.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3018; amended Nov. 1, 2000, Public Law 106-404, sec. 5, 114 Stat. 1745.)

35 U.S.C. 201 Definitions.

As used in this chapter —

(a) The term "Federal agency" means any executive agency as defined in section 105 of title 5, United States Code, and the military departments as defined by section 102 of title 5, United States Code.

(b) The term "funding agreement" means any contract, grant, or cooperative agreement entered into between any Federal agency, other than the Tennessee Valley Authority, and any contractor for the performance of experimental, developmental, or research work funded in whole or in part by the Federal Government. Such term includes any assignment, substitution of parties, or subcontract of any type entered into for the performance of experimental, developmental, or research work under a funding agreement as herein defined.

(c) The term "contractor" means any person, small business firm, or nonprofit organization that is a party to a funding agreement.

(d) The term "invention" means any invention or discovery which is or may be patentable or otherwise protectable under this title or any novel variety of plant which is or may be protectable under the Plant Variety Protection Act (7 U.S.C. 2321, et seq.).

(e) The term "subject invention" means any invention of the contractor conceived or first actually reduced to practice in the performance of work under a funding agreement: *Provided,* That in the case of a variety of plant, the date of determination (as defined in section 41(d) of the Plant Variety Protection Act (7 U.S.C. 2401(d)) must also occur during the period of contract performance.

(f) The term "practical application" means to manufacture in the case of a composition or product, to practice in the case of a process or method, or to operate in the case of a machine or system; and, in each case, under such conditions as to establish that the invention is being utilized and that its benefits are to the extent permitted by law or Government regulations available to the public on reasonable terms.

(g) The term "made" when used in relation to any invention means the conception or first actual reduction to practice of such invention.

(h) The term "small business firm" means a small business concern as defined at section 2 of Public Law 85-536 (15 U.S.C. 632) and implementing regulations of the Administrator of the Small Business Administration.

(i) The term "nonprofit organization" means universities and other institutions of higher education or an organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a)) or any nonprofit scientific or educational organization qualified under a State nonprofit organization statute.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3019.)

(Subsection (d) amended Nov. 8, 1984, Public Law 98-620, sec. 501(1), 98 Stat. 3364.)

(Subsection (e) amended Nov. 8, 1984, Public Law 98-620, sec. 501(2), 98 Stat. 3364.)

(Subsection (i) amended Oct. 22, 1986, Public Law 99-514, sec. 2, 100 Stat. 2095.)

35 U.S.C. 202 Disposition of rights.

(a) Each nonprofit organization or small business firm may, within a reasonable time after disclosure as required by paragraph (c)(1) of this section, elect to retain title to any subject invention: *Provided, however,* That a funding agreement may provide otherwise (i) when the contractor is not located in the United States or does not have a place of business located in the United States or is subject to the control of a foreign government, (ii) in exceptional circumstances when it is determined by the agency that restriction or elimination of the right to retain title to any subject invention will better promote the policy and objectives of this chapter, (iii) when it is deter-

mined by a Government authority which is authorized by statute or Executive order to conduct foreign intelligence or counterintelligence activities that the restriction or elimination of the right to retain title to any subject invention is necessary to protect the security of such activities, or (iv) when the funding agreement includes the operation of a Government-owned, contractor-operated facility of the Department of Energy primarily dedicated to that Department's naval nuclear propulsion or weapons related programs and all funding agreement limitations under this subparagraph on the contractor's right to elect title to a subject invention are limited to inventions occurring under the above two programs of the Department of Energy. The rights of the nonprofit organization or small business firm shall be subject to the provisions of paragraph (c) of this section and the other provisions of this chapter.

(b)(1) The rights of the Government under subsection (a) shall not be exercised by a Federal agency unless it first determines that at least one of the conditions identified in clauses (i) through (iii) of subsection (a) exists. Except in the case of subsection (a)(iii), the agency shall file with the Secretary of Commerce, within thirty days after the award of the applicable funding agreement, a copy of such determination. In the case of a determination under subsection (a)(ii), the statement shall include an analysis justifying the determination. In the case of determinations applicable to funding agreements with small business firms, copies shall also be sent to the Chief Counsel for Advocacy of the Small Business Administration. If the Secretary of Commerce believes that any individual determination or pattern of determinations is contrary to the policies and objectives of this chapter or otherwise not in conformance with this chapter, the Secretary shall so advise the head of the agency concerned and the Administrator of the Office of Federal Procurement Policy, and recommend corrective actions.

(2) Whenever the Administrator of the Office of Federal Procurement Policy has determined that one or more Federal agencies are utilizing the authority of clause (i) or (ii) of subsection (a) of this section in a manner that is contrary to the policies and objectives of this chapter the Administrator is authorized to issue regulations describing classes of situations in which agencies may not exercise the authorities of those clauses.

(3) At least once every 5 years, the Comptroller General shall transmit a report to the Committees on the Judiciary of the Senate and House of Representatives on the manner in which this chapter is being implemented by the agencies and on such other aspects of Government patent policies and practices with respect to federally funded inventions as the Comptroller General believes appropriate.

(4) If the contractor believes that a determination is contrary to the policies and objectives of this chapter or constitutes an abuse of discretion by the agency, the determination shall be subject to the last paragraph of section 203(2).

(c) Each funding agreement with a small business firm or nonprofit organization shall contain appropriate provisions to effectuate the following:

(1) That the contractor disclose each subject invention to the Federal agency within a reasonable time after it becomes known to contractor personnel responsible for the administration of patent matters, and that the Federal Government may receive title to any subject invention not disclosed to it within such time.

(2) That the contractor make a written election within two years after disclosure to the Federal agency (or such additional time as may be approved by the Federal agency) whether the contractor will retain title to a subject invention: *Provided*, That in any case where publication, on sale, or public use, has initiated the one year statutory period in which valid patent protection can still be obtained in the United States, the period for election may be shortened by the Federal agency to a date that is not more than sixty days prior to the end of the statutory period: And *provided further*, That the Federal Government may receive title to any subject invention in which the contractor does not elect to retain rights or fails to elect rights within such times.

(3) That a contractor electing rights in a subject invention agrees to file a patent application prior to any statutory bar date that may occur under this title due to publication, on sale, or public use, and shall thereafter file corresponding patent applications in other countries in which it wishes to retain title within reasonable times, and that the Federal Government may receive title to any subject inventions in the

United States or other countries in which the contractor has not filed patent applications on the subject invention within such times.

(4) With respect to any invention in which the contractor elects rights, the Federal agency shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world: *Provided,*That the funding agreement may provide for such additional rights; including the right to assign or have assigned foreign patent rights in the subject invention, as are determined by the agency as necessary for meeting the obligations of the United States under any treaty, international agreement, arrangement of cooperation, memorandum of understanding, or similar arrangement, including military agreements relating to weapons development and production.

(5) The right of the Federal agency to require periodic reporting on the utilization or efforts at obtaining utilization that are being made by the contractor or his licensees or assignees: *Provided*, That any such information, as well as any information on utilization or efforts at obtaining utilization obtained as part of a proceeding under section 203 of this chapter shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 of the United States Code.

(6) An obligation on the part of the contractor, in the event a United States patent application is filed by or on its behalf or by any assignee of the contractor, to include within the specification of such application and any patent issuing thereon, a statement specifying that the invention was made with Government support and that the Government has certain rights in the invention.

(7) In the case of a nonprofit organization, (A) a prohibition upon the assignment of rights to a subject invention in the United States without the approval of the Federal agency, except where such assignment is made to an organization which has as one of its primary functions the management of inventions (provided that such assignee shall be subject to the same provisions as the contractor); (B) a requirement that the contractor share royalties with the inventor; (C) except with respect to a funding agreement for the operation of a Government-owned-contractor-operated facility, a requirement that the balance of any royalties or income earned by the contractor with respect to subject inventions, after payment of expenses (including payments to inventors) incidental to the administration of subject inventions, be utilized for the support of scientific research, or education; (D) a requirement that, except where it proves infeasible after a reasonable inquiry, in the licensing of subject inventions shall be given to small business firms; and (E) with respect to a funding agreement for the operation of a Government-owned-contractor-operator facility, requirements (i) that after payment of patenting costs, licensing costs, payments to inventors, and other expenses incidental to the administration of subject inventions, 100 percent of the balance of any royalties or income earned and retained by the contractor during any fiscal year, up to an amount equal to 5 percent of the annual budget of the facility, shall be used by the contractor for scientific research, development, and education consistent with the research and development mission and objectives of the facility, including activities that increase the licensing potential of other inventions of the facility provided that if said balance exceeds 5 percent of the annual budget of the facility, that 75 percent of such excess shall be paid to the Treasury of the United States and the remaining 25 percent shall be used for the same purposes as described above in this clause (D); and (ii) that, to the extent it provides the most effective technology transfer, the licensing of subject inventions shall be administered by contractor employees on location at the facility.

(8) The requirements of sections 203 and 204 of this chapter.

(d) If a contractor does not elect to retain title to a subject invention in cases subject to this section, the Federal agency may consider and after consultation with the contractor grant requests for retention of rights by the inventor subject to the provisions of this Act and regulations promulgated hereunder.

(e) In any case when a Federal employee is a coinventor of any invention made with a nonprofit organization, a small business firm, or a non-Federal inventor, the Federal agency employing such coinventor may, for the purpose of consolidating rights in the invention and if it finds that it would expedite the development of the invention—

(1) license or assign whatever rights it may acquire in the subject invention to the nonprofit organization, small business firm, or non-Federal inventor in accordance with the provisions of this chapter; or

(2) acquire any rights in the subject invention from the nonprofit organization, small business firm, or non-Federal inventor, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction and no other transaction under this chapter is conditioned on such acquisition.

(f)(1) No funding agreement with a small business firm or nonprofit organization shall contain a provision allowing a Federal agency to require the licensing to third parties of inventions owned by the contractor that are not subject inventions unless such provision has been approved by the head of the agency and a written justification has been signed by the head of the agency. Any such provision shall clearly state whether the licensing may be required in connection with the practice of a subject invention, a specifically identified work object, or both. The head of the agency may not delegate the authority to approve provisions or sign justifications required by this paragraph.

(2) A Federal agency shall not require the licensing of third parties under any such provision unless the head of the agency determines that the use of the invention by others is necessary for the practice of a subject invention or for the use of a work object of the funding agreement and that such action is necessary to achieve the practical application of the subject invention or work object. Any such determination shall be on the record after an opportunity for an agency hearing. Any action commenced for judicial review of such determination shall be brought within sixty days after notification of such determination.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3020; subsection (b)(4) added and subsections (a), (b)(1), (b)(2), (c)(4), (c)(5), and (c)(7) amended Nov. 8, 1984, Public Law 98-620, sec. 501, 98 Stat. 3364; subsection (b)(3) amended Dec. 10, 1991, Public Law 102-204, sec. 10, 105 Stat. 1641; subsection (a) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-583 (S. 1948 sec. 4732(a)(12)); subsection (e) amended Nov. 1, 2000, Public Law 106-404, sec. 6(1), 114 Stat. 1745.)

35 U.S.C. 203 March-in rights.

(1) With respect to any subject invention in which a small business firm or nonprofit organization has acquired title under this chapter, the Federal agency under whose funding agreement the subject invention was made shall have the right, in accordance with such procedures as are provided in regulations promulgated hereunder, to require the contractor, an assignee, or exclusive licensee of a subject invention to grant a nonexclusive, partially exclusive, or exclusive license in any field of use to a responsible applicant or applicants, upon terms that are reasonable under the circumstances, and if the contractor, assignee, or exclusive licensee refuses such request, to grant such a license itself, if the Federal agency determines that such —

(a) action is necessary because the contractor or assignee has not taken, or is not expected to take within a reasonable time, effective steps to achieve practical application of the subject invention in such field of use;

(b) action is necessary to alleviate health or safety needs which are not reasonably satisfied by the contractor, assignee, or their licensees;

(c) action is necessary to meet requirements for public use specified by Federal regulations and such requirements are not reasonably satisfied by the contractor, assignee, or licensees; or

(d) action is necessary because the agreement required by section 204 has not been obtained or waived or because a licensee of the exclusive right to use or sell any subject invention in the United States is in breach of its agreement obtained pursuant to section 204.

(2) A determination pursuant to this section or section 202(b)(4) shall not be subject to the Contract Disputes Act (41 U.S.C. § 601 et seq.). An administrative appeals procedure shall be established by regulations promulgated in accordance with section 206. Additionally, any contractor, inventor, assignee, or exclusive licensee adversely affected by a determination under this section may, at any time within sixty days after the determination is issued, file a petition in the United States Court of Federal Claims, which shall have jurisdiction to determine the appeal on the record and to affirm, reverse, remand or modify, as appropriate, the determination of the Federal agency. In cases described in paragraphs (a) and (c), the

agency's determination shall be held in abeyance pending the exhaustion of appeals or petitions filed under the preceding sentence.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3022; amended Nov. 8, 1984, Public Law 98-620, sec. 501(9), 98 Stat. 3367; Oct. 29, 1992, Public Law 102-572, sec. 902(b)(1), 106 Stat. 4516.)

35 U.S.C. 204 Preference for United States industry.

Notwithstanding any other provision of this chapter, no small business firm or nonprofit organization which receives title to any subject invention and no assignee of any such small business firm or nonprofit organization shall grant to any person the exclusive right to use or sell any subject invention in the United States unless such person agrees that any products embodying the subject invention or produced through the use of the subject invention will be manufactured substantially in the United States. However, in individual cases, the requirement for such an agreement may be waived by the Federal agency under whose funding agreement the invention was made upon a showing by the small business firm, nonprofit organization, or assignee that reasonable but unsuccessful efforts have been made to grant licenses on similar terms to potential licensees that would be likely to manufacture substantially in the United States or that under the circumstances domestic manufacture is not commercially feasible.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023.)

35 U.S.C. 205 Confidentiality.

Federal agencies are authorized to withhold from disclosure to the public information disclosing any invention in which the Federal Government owns or may own a right, title, or interest (including a nonexclusive license) for a reasonable time in order for a patent application to be filed. Furthermore, Federal agencies shall not be required to release copies of any document which is part of an application for patent filed with the United States Patent and Trademark Office or with any foreign patent office.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023.)

35 U.S.C. 206 Uniform clauses and regulations.

The Secretary of Commerce may issue regulations which may be made applicable to Federal agencies implementing the provisions of sections 202 through 204 of this chapter and shall establish standard funding agreement provisions required under this chapter. The regulations and the standard funding agreement shall be subject to public comment before their issuance.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023; amended Nov. 8, 1984, Public Law 98-620, sec. 501(10), 98 Stat. 3367.)

35 U.S.C. 207 Domestic and foreign protection of federally owned inventions.

(a) Each Federal agency is authorized to —

(1) apply for, obtain, and maintain patents or other forms of protection in the United States and in foreign countries on inventions in which the Federal Government owns a right, title, or interest;

(2) grant nonexclusive, exclusive, or partially exclusive licenses under federally owned inventions, royalty-free or for royalties or other consideration, and on such terms and conditions, including the grant to the licensee of the right of enforcement pursuant to the provisions of chapter 29 of this title as determined appropriate in the public interest;

(3) undertake all other suitable and necessary steps to protect and administer rights to federally owned inventions on behalf of the Federal Government either directly or through contract, including acquiring rights for and administering royalties to the Federal Government in any invention, but only to the extent the party from whom the rights are acquired voluntarily enters into the transaction, to facilitate the licensing of a federally owned invention; and

(4) transfer custody and administration, in whole or in part, to another Federal agency, of the right, title, or interest in any federally owned invention.

(b) For the purpose of assuring the effective management of Government-owned inventions, the Secretary of Commerce authorized to -

(1) assist Federal agency efforts to promote the licensing and utilization of Government-owned inventions;

(2) assist Federal agencies in seeking protection and maintaining inventions in foreign countries, including the payment of fees and costs connected therewith; and

(3) consult with and advise Federal agencies as to areas of science and technology research and development with potential for commercial utilization.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3023; amended Nov. 8, 1984, Public Law 98-620, sec. 501(11), 98 Stat. 3367; subsections (a)(2) and (a)(3) amended Nov. 1, 2000, Public Law 106-404, sec. 6(2), 114 Stat. 1745.)

35 U.S.C. 208 Regulations governing Federal licensing.

The Secretary of Commerce is authorized to promulgate regulations specifying the terms and conditions upon which any federally owned invention, other than inventions owned by the Tennessee Valley Authority, may be licensed on a nonexclusive, partially exclusive, or exclusive basis.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3024; amended Nov. 8, 1984, Public Law 98-620, sec. 501(12), 98 Stat. 3367.)

35 U.S.C. 209 Licensing federally owned inventions.

(a) AUTHORITY.—A Federal agency may grant an exclusive or partially exclusive license on a federally owned invention under section 207(a)(2) only if—

(1) granting the license is a reasonable and necessary incentive to—

(A) call forth the investment capital and expenditures needed to bring the invention to practical application; or

(B) otherwise promote the invention's utilization by the public;

(2) the Federal agency finds that the public will be served by the granting of the license, as indicated by the applicant's intentions, plans, and ability to bring the invention to practical application or otherwise promote the invention's utilization by the public, and that the proposed scope of exclusivity is not greater than reasonably necessary to provide the incentive for bringing the invention to practical application, as proposed by the applicant, or otherwise to promote the invention's utilization by the public;

(3) the applicant makes a commitment to achieve practical application of the invention within a reasonable time, which time may be extended by the agency upon the applicant's request and the applicant's demonstration that the refusal of such extension would be unreasonable;

(4) granting the license will not tend to substantially lessen competition or create or maintain a violation of the Federal antitrust laws; and

(5) in the case of an invention covered by a foreign patent application or patent, the interests of the Federal Government or United States industry in foreign commerce will be enhanced.

(b) MANUFACTURE IN UNITED STATES.—A Federal agency shall normally grant a license under section 207(a)(2) to use or sell any federally owned invention in the United States only to a licensee who agrees that any products embodying the invention or produced through the use of the invention will be manufactured substantially in the United States.

(c) SMALL BUSINESS.—First preference for the granting of any exclusive or partially exclusive licenses under section 207(a)(2) shall be given to small business firms having equal or greater likelihood as other applicants to bring the invention to practical application within a reasonable time.

(d) TERMS AND CONDITIONS.—Any licenses granted under section 207(a)(2) shall contain such terms and conditions as the granting agency considers appropriate, and shall include provisions—

(1) retaining a nontransferrable, irrevocable, paid-up license for any Federal agency to practice the invention or have the invention practiced throughout the world by or on behalf of the Government of the United States;

(2) requiring periodic reporting on utilization of the invention, and utilization efforts, by the licensee, but only to the extent necessary to enable the Federal agency to determine whether the terms of the license are being complied with, except that any such report shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 of the United States Code; and

(3) empowering the Federal agency to terminate the license in whole or in part if the agency determines that—

(A) the licensee is not executing its commitment to achieve practical application of the invention, including commitments contained in any plan

submitted in support of its request for a license, and the licensee cannot otherwise demonstrate to the satisfaction of the Federal agency that it has taken, or can be expected to take within a reasonable time, effective steps to achieve practical application of the invention;

(B) the licensee is in breach of an agreement described in subsection (b);

(C) termination is necessary to meet requirements for public use specified by Federal regulations issued after the date of the license, and such requirements are not reasonably satisfied by the licensee; or

(D) the licensee has been found by a court of competent jurisdiction to have violated the Federal antitrust laws in connection with its performance under the license agreement.

(e) PUBLIC NOTICE.—No exclusive or partially exclusive license may be granted under section 207(a)(2) unless public notice of the intention to grant an exclusive or partially exclusive license on a federally owned invention has been provided in an appropriate manner at least 15 days before the license is granted, and the Federal agency has considered all comments received before the end of the comment period in response to that public notice. This subsection shall not apply to the licensing of inventions made under a cooperative research and development agreement entered into under section 12 of the Stevenson-Wydler Technology Innovation Act of 1980 (15 U.S.C. 3710a).

(f) PLAN.—No Federal agency shall grant any license under a patent or patent application on a federally owned invention unless the person requesting the license has supplied the agency with a plan for development or marketing of the invention, except that any such plan shall be treated by the Federal agency as commercial and financial information obtained from a person and privileged and confidential and not subject to disclosure under section 552 of title 5 of the United States Code.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3024; amended Nov. 1, 2000, Public Law 106-404, sec. 4, 114 Stat. 1743.)

35 U.S.C. 210 Precedence of chapter.

(a) This chapter shall take precedence over any other Act which would require a disposition of rights in subject inventions of small business firms or nonprofit organizations contractors in a manner that is inconsistent with this chapter, including but not necessarily limited to the following:

(1) section 10(a) of the Act of June 29, 1935, as added by title I of the Act of August 14, 1946 (7 U.S.C. 427i(a); 60 Stat. 1085);

(2) section 205(a) of the Act of August 14, 1946 (7 U.S.C. 1624(a); 60 Stat. 1090);

(3) section 501(c) of the Federal Mine Safety and Health Act of 1977 (30 U.S.C. 951(c); 83 Stat. 742);

(4) section 30168(e) of title 49;

(5) section 12 of the National Science Foundation Act of 1950 (42 U.S.C. 1871(a); 82 Stat. 360);

(6) section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182; 68 Stat. 943);

(7) section 305 of the National Aeronautics and Space Act of 1958 (42 U.S.C. 2457);

(8) section 6 of the Coal Research Development Act of 1960 (30 U.S.C. 666; 74 Stat. 337);

(9) section 4 of the Helium Act Amendments of 1960 (50 U.S.C. 167b; 74 Stat. 920);

(10) section 32 of the Arms Control and Disarmament Act of 1961 (22 U.S.C. 2572; 75 Stat. 634);

(11) section 9 of the Federal Nonnuclear Energy Research and Development Act of 1974 (42 U.S.C. 5901; 88 Stat. 1878);

(12) section 5(d) of the Consumer Product Safety Act (15 U.S.C. 2054(d); 86 Stat. 1211);

(13) section 3 of the Act of April 5, 1944 (30 U.S.C. 323; 58 Stat. 191);

(14) section 8001(c)(3) of the Solid Waste Disposal Act (42 U.S.C. 6981(c); 90 Stat. 2829);

(15) section 219 of the Foreign Assistance Act of 1961 (22 U.S.C. 2179; 83 Stat. 806);

(16) section 427(b) of the Federal Mine Health and Safety Act of 1977 (30 U.S.C. 937(b); 86 Stat. 155);

(17) section 306(d) of the Surface Mining and Reclamation Act of 1977 (30 U.S.C. 1226(d); 91 Stat. 455);

(18) section 21(d) of the Federal Fire Prevention and Control Act of 1974 (15 U.S.C. 2218(d); 88 Stat. 1548);

(19) section 6(b) of the Solar Photovoltaic Energy Research Development and Demonstration Act of 1978 (42 U.S.C. 5585(b); 92 Stat. 2516);

(20) section 12 of the Native Latex Commercialization and Economic Development Act of 1978 (7 U.S.C. 178(j); 92 Stat. 2533); and

(21) section 408 of the Water Resources and Development Act of 1978 (42 U.S.C. 7879; 92 Stat. 1360).

The Act creating this chapter shall be construed to take precedence over any future Act unless that Act specifically cites this Act and provides that it shall take precedence over this Act.

(b) Nothing in this chapter is intended to alter the effect of the laws cited in paragraph (a) of this section or any other laws with respect to the disposition of rights in inventions made in the performance of funding agreements with persons other than nonprofit organizations or small business firms.

(c) Nothing in this chapter is intended to limit the authority of agencies to agree to the disposition of rights in inventions made in the performance of work under funding agreements with persons other than nonprofit organizations or small business firms in accordance with the Statement of Government Patent Policy issued on February 18, 1983, agency regulations, or other applicable regulations or to otherwise limit the authority of agencies to allow such persons to retain ownership of inventions, except that all funding agreements, including those with other than small business firms and nonprofit organizations, shall include the requirements established in paragraph 202(c)(4) and section 203 of this title. Any disposition of rights in inventions made in accordance with the Statement or implementing regulations, including any disposition occurring before enactment of this section, are hereby authorized.

(d) Nothing in this chapter shall be construed to require the disclosure of intelligence sources or methods or to otherwise affect the authority granted to the Director of Central Intelligence by statute or Executive order for the protection of intelligence sources or methods.

(e) The provisions of the Stevenson-Wydler Technology Innovation Act of 1980 shall take precedence over the provisions of this chapter to the extent that they permit or require a disposition of rights in subject inventions which is inconsistent with this chapter.

(Added Dec. 12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3026.)

(Subsection (c) amended Nov. 8, 1984, Public Law 98-620, sec. 501(13), 98 Stat. 3367.)

(Subsection (e) added Oct. 20, 1986, Public Law 99-502, sec. 9(c), 100 Stat. 1796.)

(Subsection (a)(4) amended July 5, 1994, Public Law 103-272, sec. 5(j), 108 Stat. 1375.)

(Subsection (e) amended Mar. 7, 1996, Public Law 104-113, sec. 7, 110 Stat. 779.)

(Subsection (a) amended Nov. 13, 1998, Public Law 105-393, sec. 220(c)(2), 112 Stat. 3625.)

35 U.S.C. 211 Relationship to antitrust laws.

Nothing in this chapter shall be deemed to convey to any person immunity from civil or criminal liability, or to create any defenses to actions, under any antitrust law.

(Added Dec.12, 1980, Public Law 96-517, sec. 6(a), 94 Stat. 3027.)

35 U.S.C. 212 Disposition of rights in educational awards.

No scholarship, fellowship, training grant, or other funding agreement made by a Federal agency primarily to an awardee for educational purposes will contain any provision giving the Federal agency any rights to inventions made by the awardee.

(Added Nov. 8, 1984, Public Law 98-620, sec. 501(14), 98 Stat. 3368.)

PART III — PATENTS AND PROTECTION OF PATENT RIGHTS

CHAPTER 25 — AMENDMENT AND CORRECTION OF PATENTS

Sec.

35 U.S.C. 251 Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming

more or less then he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 252 Effect of reissue.

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

A reissued patent shall not abridge or affect the right of any person or that person's successors in business who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use, offer for sale, or sale of the thing made, purchased, offered for sale, used, or imported as specified, or for the manufacture, use, offer for sale, or sale in the United States of which substantial preparation was made before the grant of the reissue, and the court may also provide for the continued practice of any process patented by the reissue that is practiced, or for the practice of which substantial preparation was made, before the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(2), 108 Stat. 4989; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566 (S. 1948 sec. 4507(8)).)

35 U.S.C. 253 Disclaimer.

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 254 Certificate of correction of Patent and Trademark Office mistake.

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact

and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 255 Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 256 Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 6(b), 96 Stat. 320; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 26 — OWNERSHIP AND ASSIGNMENT

35 U.S.C. 261 Ownership; assignment.

Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, shall be *prima facie* evidence of the execution of an assignment, grant, or conveyance of a patent or application for patent.

An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Aug. 27, 1982, Public Law 97-247, sec. 14(b), 96 Stat. 321.)

35 U.S.C. 262 Joint owners.

In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(3), 108 Stat. 4989.)

CHAPTER 27 — GOVERNMENT INTERESTS IN PATENTS

Sec.

35 U.S.C. 266 [Repealed.]

(Repealed July 24, 1965, Public Law 89-83, sec. 8, 79 Stat. 261.)

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 28 — INFRINGEMENT OF PATENTS

Sec.

35 U.S.C. 271 Infringement of patent.

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to the development and submission of information under a Federal law which

regulates the manufacture, use, or sale of drugs or veterinary biological products.

(2) It shall be an act of infringement to submit —

(A) an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or

(B) an application under section 512 of such Act or under the Act of March 4, 1913 (21 U.S.C. 151 - 158) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent, if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

(3) In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

(4) For an act of infringement described in paragraph (2)—

(A) the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

(B) injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and

(C) damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product.

The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under section 285.

(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after —

(1) it is materially changed by subsequent processes; or

(2) it becomes a trivial and nonessential component of another product.

(h) As used in this section, the term "whoever" includes any State, any instrumentality of a State, any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

(i) As used in this section, an "offer for sale" or an "offer to sell" by a person other than the patentee or any assignee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

(Subsection (e) added Sept. 24, 1984, Public Law 98-417, sec. 202, 98 Stat. 1603.)

(Subsection (f) added Nov. 8, 1984, Public Law 98-622, sec. 101(a), 98 Stat. 3383.)

(Subsection (g) added Aug. 23, 1988, Public Law 100-418, sec. 9003, 102 Stat. 1564.)

(Subsection (e) amended Nov. 16, 1988, Public Law 100-670, sec. 201(i), 102 Stat. 3988.)

(Subsection (d) amended Nov. 19, 1988, Public Law 100-703, sec. 201, 102 Stat. 4676.)

(Subsection (h) added Oct. 28, 1992, Public Law 102-560, sec. 2(a)(1), 106 Stat. 4230.)

(Subsections (a), (c), (e), and (g) amended Dec. 8, 1994, Public Law 103-465, sec. 533(a), 108 Stat. 4988.)

(Subsection (i) added Dec. 8, 1994, Public Law 103-465, sec. 533(a), 108 Stat. 4988.)

35 U.S.C. 272 Temporary presence in the United States.

The use of any invention in any vessel, aircraft or vehicle of any country which affords similar privileges to vessels, aircraft, or vehicles of the United States, entering the United States temporarily or accidentally, shall not constitute infringement of any patent, if the invention is used exclusively for the needs of the vessel, aircraft, or vehicle and is not offered for sale or sold in or used for the manufacture of anything to be sold in or exported from the United States.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(4), 108 Stat. 4989.)

35 U.S.C. 273 Defense to infringement based on earlier inventor.

(a) DEFINITIONS.— For purposes of this section—

(1) the terms "commercially used" and "commercial use" mean use of a method in the United States, so long as such use is in connection with an internal commercial use or an actual arm's-length sale or other arm's-length commercial transfer of a useful end result, whether or not the subject matter at issue is accessible to or otherwise known to the public, except that the subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156(g), shall be deemed "commercially used" and in "commercial use" during such regulatory review period;

(2) in the case of activities performed by a nonprofit research laboratory, or nonprofit entity such as a university, research center, or hospital, a use for which the public is the intended beneficiary shall be considered to be a use described in paragraph (1), except that the use—

(A) may be asserted as a defense under this section only for continued use by and in the laboratory or nonprofit entity; and

(B) may not be asserted as a defense with respect to any subsequent commercialization or use outside such laboratory or nonprofit entity;

(3) the term "method" means a method of doing or conducting business; and

(4) the "effective filing date" of a patent is the earlier of the actual filing date of the application for the patent or the filing date of any earlier United States, foreign, or international application to which the subject matter at issue is entitled under section 119, 120, or 365 of this title.

(b) DEFENSE TO INFRINGEMENT.—

(1) IN GENERAL.— It shall be a defense to an action for infringement under section 271 of this title with respect to any subject matter that would otherwise infringe one or more claims for a method in the patent being asserted against a person, if such person had, acting in good faith, actually reduced the subject matter to practice at least 1 year before the effective filing date of such patent, and commercially used the

subject matter before the effective filing date of such patent.

(2) EXHAUSTION OF RIGHT.— The sale or other disposition of a useful end product produced by a patented method, by a person entitled to assert a defense under this section with respect to that useful end result shall exhaust the patent owner's rights under the patent to the extent such rights would have been exhausted had such sale or other disposition been made by the patent owner.

(3) LIMITATIONS AND QUALIFICATIONS OF DEFENSE.— The defense to infringement under this section is subject to the following:

(A) PATENT.— A person may not assert the defense under this section unless the invention for which the defense is asserted is for a method.

(B) DERIVATION.— A person may not assert the defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.

(C) NOT A GENERAL LICENSE.— The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter claimed in the patent with respect to which the person can assert a defense under this chapter, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the patent.

(4) BURDEN OF PROOF.— A person asserting the defense under this section shall have the burden of establishing the defense by clear and convincing evidence.

(5) ABANDONMENT OF USE.— A person who has abandoned commercial use of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken after the date of such abandonment.

(6) PERSONAL DEFENSE.— The defense under this section may be asserted only by the person who performed the acts necessary to establish the defense and, except for any transfer to the patent owner, the right to assert the defense shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.

(7) LIMITATION ON SITES.— A defense under this section, when acquired as part of a good faith assignment or transfer of an entire enterprise or line of business to which the defense relates, may only be asserted for uses at sites where the subject matter that would otherwise infringe one or more of the claims is in use before the later of the effective filing date of the patent or the date of the assignment or transfer of such enterprise or line of business.

(8) UNSUCCESSFUL ASSERTION OF DEFENSE.— If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285 of this title.

(9) INVALIDITY.— A patent shall not be deemed to be invalid under section 102 or 103 of this title solely because a defense is raised or established under this section.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555 (S. 1948 sec. 4302).)

CHAPTER 29 — REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

United States district court having jurisdiction of the parties.

Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

35 U.S.C. 290 Notice of patent suits.

The clerks of the courts of the United States, within one month after the filing of an action under this title, shall give notice thereof in writing to the Director, setting forth so far as known the names and addresses of the parties, name of the inventor, and the designating number of the patent upon which the action has been brought. If any other patent is subsequently included in the action he shall give like notice thereof. Within one month after the decision is rendered or a judgment issued the clerk of the court shall give notice thereof to the Director. The Director shall, on receipt of such notices, enter the same in the file of such patent.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 291 Interfering patents.

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

35 U.S.C. 292 False marking.

(a) Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by same person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words "patent," "patentee," or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article the word "patent" or any word or number importing the same is patented, for the purpose of deceiving the public; or

Whoever marks upon, or affixes to, or uses in advertising in connection with any article the words "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public —

Shall be fined not more than $500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.

(Subsection (a) amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(6), 108 Stat. 4990.)

35 U.S.C. 293 Nonresident patentee; service and notice.

Every patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder. If the person designated cannot be found at the address given in the last designation, or if no person has been designated, the United States District Court for the District of Columbia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs. The court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)

35 U.S.C. 294 Voluntary arbitration.

(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

(b) Arbitration of such disputes, awards by arbitrators, and confirmation of awards shall be governed by title 9, United States Code, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court to competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Director. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Director. The Director shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the Director, any party to the proceeding may provide such notice to the Director.

(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Director.

(Added Aug. 27, 1982, Public Law 97-247, sec. 17(b)(1), 96 Stat. 322; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 295 Presumption: Product made by patented process.

In actions alleging infringement of a process patent based on the importation, sale, offered for sale, or use of a product which is made from a process patented in the United States, if the court finds—

(1) that a substantial likelihood exists that the product was made by the patented process, and

(2) that the plaintiff has made a reasonable effort to determine the process actually used in the production of the product and was unable so to determine, the product shall be presumed to have been so made, and the burden of establishing that the product was not made by the process shall be on the party asserting that it was not so made.

(Added Aug. 23, 1988, Public Law 100-418, sec. 9005(a), 102 Stat. 1566; amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(7), 108 Stat. 4990.)

35 U.S.C. 296 Liability of States, instrumentalities of States, and State officials for infringement of patents.

(a) IN GENERAL. - Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State, acting in his official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for infringement of a patent under section 271, or for any other violation under this title.

(b) REMEDIES. - In a suit described in subsection (a) for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any private entity. Such remedies include damages, interest, costs, and treble damages under section 284, attorney fees under section 285, and the additional remedy for infringement of design patents under section 289.

(Added Oct. 28, 1992, Public Law 102-560, sec. 2(a)(2), 106 Stat. 4230.)

35 U.S.C. 297 Improper and deceptive invention promotion.

(a) IN GENERAL.— An invention promoter shall have a duty to disclose the following information to a customer in writing, prior to entering into a contract for invention promotion services:

(1) the total number of inventions evaluated by the invention promoter for commercial potential in the past 5 years, as well as the number of those inventions that received positive evaluations, and the num-

ber of those inventions that received negative evaluations;

(2) the total number of customers who have contracted with the invention promoter in the past 5 years, not including customers who have purchased trade show services, research, advertising, or other nonmarketing services from the invention promoter, or who have defaulted in their payment to the invention promoter;

(3) the total number of customers known by the invention promoter to have received a net financial profit as a direct result of the invention promotion services provided by such invention promoter;

(4) the total number of customers known by the invention promoter to have received license agreements for their inventions as a direct result of the invention promotion services provided by such invention promoter; and

(5) the names and addresses of all previous invention promotion companies with which the invention promoter or its officers have collectively or individually been affiliated in the previous 10 years.

(b) CIVIL ACTION.—

(1) Any customer who enters into a contract with an invention promoter and who is found by a court to have been injured by any material false or fraudulent statement or representation, or any omission of material fact, by that invention promoter (or any agent, employee, director, officer, partner, or independent contractor of such invention promoter), or by the failure of that invention promoter to disclose such information as required under subsection (a), may recover in a civil action against the invention promoter (or the officers, directors, or partners of such invention promoter), in addition to reasonable costs and attorneys' fees--

(A) the amount of actual damages incurred by the customer; or

(B) at the election of the customer at any time before final judgment is rendered, statutory damages in a sum of not more than $5,000, as the court considers just.

(2) Notwithstanding paragraph (1), in a case where the customer sustains the burden of proof, and the court finds, that the invention promoter intentionally misrepresented or omitted a material fact to such customer, or willfully failed to disclose such information as required under subsection (a), with the purpose of deceiving that customer, the court may increase damages to not more than three times the amount awarded, taking into account past complaints made against the invention promoter that resulted in regulatory sanctions or other corrective actions based on those records compiled by the Commissioner of Patents under subsection (d).

(c) DEFINITIONS.— For purposes of this section—

(1) a "contract for invention promotion services" means a contract by which an invention promoter undertakes invention promotion services for a customer;

(2) a "customer" is any individual who enters into a contract with an invention promoter for invention promotion services;

(3) the term "invention promoter" means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

(A) any department or agency of the Federal Government or of a State or local government;

(B) any nonprofit, charitable, scientific, or educational organization, qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;

(C) any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;

(D) any party participating in a transaction involving the sale of the stock or assets of a business; or

(E) any party who directly engages in the business of retail sales of products or the distribution of products; and

(4) the term "invention promotion services" means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

(d) RECORDS OF COMPLAINTS.—

(1) RELEASE OF COMPLAINTS.— The Commissioner of Patents shall make all complaints received by the Patent and Trademark Office involving invention promoters publicly available, together

with any response of the invention promoters. The Commissioner of Patents shall notify the invention promoter of a complaint and provide a reasonable opportunity to reply prior to making such complaint publicly available.

(2) REQUEST FOR COMPLAINTS.— The Commissioner of Patents may request complaints relating to invention promotion services from any Federal or State agency and include such complaints in the records maintained under paragraph (1), together with any response of the invention promoters.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-552 (S. 1948 sec. 4102(a)).)

CHAPTER 30 — PRIOR ART CITATIONS TO OFFICE AND EX PARTE REEXAMINATION OF PATENTS

35 U.S.C. 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015.)

35 U.S.C. 302 Request for reexamination.

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Director pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Director promptly will send a copy of the request to the owner of record of the patent.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 secs. 4732(a)(8) and 4732(a)(10)(A)).)

35 U.S.C. 303 Determination of issue by Director.

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

(b) A record of the Director's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3015; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-581, 582 (S. 1948 secs. 4732(a)(9) and (4732(a)(10)(A)).)

35 U.S.C. 304 Reexamination order by Director.

If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be

given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 305 Conduct of reexamination proceedings.

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Nov. 8, 1984, Public Law 98-622, sec. 204(c), 98 Stat. 3388.)

35 U.S.C. 306 Appeal.

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016.)

35 U.S.C. 307 Certificate of patentability, unpatentability, and claim cancellation.

(a) In a reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director will issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) Any proposed amended or new claim determined to be patentable and incorporated into a patent following a reexamination proceeding will have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation for the same, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Dec. 12, 1980, Public Law 96-517, sec. 1, 94 Stat. 3016; amended Dec. 8, 1994, Public Law 103-465, sec. 533(b)(8), 108 Stat. 4990; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 31 — OPTIONAL INTER PARTES REEXAMINATION PROCEDURES

Sec.

35 U.S.C. 311 Request for inter partes reexamination

(a) IN GENERAL.— Any person at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

(c) COPY.— Unless the requesting person is the owner of the patent, the Director promptly shall send a copy of the request to the owner of record of the patent.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 312 Determination of issue by Director

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On the Director's initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications.

(b) RECORD.— A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester, if any.

(c) FINAL DECISION.— A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 313 Inter partes reexamination order by Director

If, in a determination made under section 312(a), the Director finds that a substantial new question of patentability affecting a claim of a patent is raised, the determination shall include an order for inter partes reexamination of the patent for resolution of the question. The order may be accompanied by the initial action of the Patent and Trademark Office on the merits of the inter partes reexamination conducted in accordance with section 314.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 314 Conduct of inter partes reexamination proceedings

(a) IN GENERAL.— Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) RESPONSE.—

(1) This subsection shall apply to any inter partes reexamination proceeding in which the order for inter partes reexamination is based upon a request by a third-party requester.

(2) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the third-party requester shall receive a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

(3) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(c) SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 315 Appeal

(a) PATENT OWNER.— The patent owner involved in an inter partes reexamination proceeding under this chapter—

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

(b) THIRD-PARTY REQUESTER.— A third-party requester may—

(1) appeal under the provisions of section 134 with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; or

(2) be a party to any appeal taken by the patent owner under the provisions of section 134, subject to subsection (c).

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, United States Code, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 316 Certificate of patentability, unpatentability and claim cancellation

(a) IN GENERAL.— In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) AMENDED OR NEW CLAIM.— Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 317 Inter partes reexamination prohibited

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the patent owner nor the third-party requester, if any, nor privies of either, may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, United States Code, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that

party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

35 U.S.C. 318 Stay of litigation

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

PART IV — PATENT COOPERATION TREATY

CHAPTER 35 — DEFINITIONS

Sec.
351 Definitions.

35 U.S.C. 351 Definitions.

When used in this part unless the context otherwise indicates—

(a) The term "treaty" means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term "Regulations," when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term "regulations," when not capitalized, means the regulations established by the Director under this title.

(c) The term "international application" means an application filed under the treaty.

(d) The term "international application originating in the United States" means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term "international application designating the United States" means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term "Receiving Office" means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms "International Searching Authority" and "International Preliminary Examining Authority" mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term "International Bureau" means the inter national intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 685; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 2 (a)-(c), 100 Stat. 3485; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

CHAPTER 36 — INTERNATIONAL STAGE

Sec.
361 Receiving Office.
362 International Searching Authority and International Preliminary Examining Authority.
363 International application designating the United States: Effect.
364 International stage: Procedure.
365 Right of priority; benefit of the filing date of a prior application.
366 Withdrawn international application.
367 Actions of other authorities: Review.
368 Secrecy of certain inventions; filing international applications in foreign countries.

35 U.S.C. 361 Receiving Office.

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

(b) The Patent and Trademark Office shall perform all acts connected with the discharge of duties required of a Receiving Office, including the collection of international fees and their transmittal to the International Bureau.

(c) International applications filed in the Patent and Trademark Office shall be in the English language.

(d) The international fee, and the transmittal and search fees prescribed under section 376(a) of this part, shall either be paid on filing of an international application or within such later time as may be fixed by the Director.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 401(a), 403(a), 98 Stat. 3391-3392; Nov. 6, 1986, Public Law 99-616, sec. 2(d), 100 Stat. 3485; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 362 International Searching Authority and International Preliminary Examining Authority.

(a) The Patent and Trademark Office may act as an International Searching Authority and International Preliminary Examining Authority with respect to international applications in accordance with the terms and conditions of an agreement which may be concluded with the International Bureau, and may discharge all duties required of such Authorities, including the collection of handling fees and their transmittal to the International Bureau.

(b) The handling fee, preliminary examination fee, and any additional fees due for international preliminary examination shall be paid within such time as may be fixed by the Director.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403 (a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 4, 100 Stat. 3485; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 363 International application designating the United States: Effect.

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

35 U.S.C. 364 International stage: Procedure.

(a) International applications shall be processed by the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, in accordance with the applicable provisions of the treaty, the Regulations, and this title.

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Director of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392.)

(Subsection (a) amended Nov. 6, 1986, Public Law 99-616, sec. 5, 100 Stat. 3485.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(4), 108 Stat. 4987; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 366 Withdrawn international application.

Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal. However, such withdrawn international application may serve as the basis for a claim of priority under section 365 (a) and (b) of this part, if it designated a country other than the United States.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 401(b), 98 Stat. 3391.)

35 U.S.C. 367 Actions of other authorities: Review.

(a) Where a Receiving Office other than the Patent and Trademark Office has refused to accord an international filing date to an international application designating the United States or where it has held such application to be withdrawn either generally or as to the United States, the applicant may request review of the matter by the Director, on compliance with the requirements of and within the time limits specified by the treaty and the Regulations. Such review may result in a determination that such application be considered as pending in the national stage.

(b) The review under subsection (a) of this section, subject to the same requirements and conditions, may also be requested in those instances where an international application designating the United States is considered withdrawn due to a finding by the International Bureau under article 12 (3) of the treaty.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat 3392; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 368 Secrecy of certain inventions; filing international applications in foreign countries.

(a) International applications filed in the Patent and Trademark Office shall be subject to the provisions of chapter 17 of this title.

(b) In accordance with article 27 (8) of the treaty, the filing of an international application in a country other than the United States on the invention made in this country shall be considered to constitute the filing of an application in a foreign country within the meaning of chapter 17 of this title, whether or not the United States is designated in that international application.

(c) If a license to file in a foreign country is refused or if an international application is ordered to be kept secret and a permit refused, the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, may not disclose

the contents of such application to anyone not authorized to receive such disclosure.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 687; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 6, 100 Stat. 3486.)

CHAPTER 37 — NATIONAL STAGE

Sec.

35 U.S.C. 371 National stage: Commencement.

(a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

(c) The applicant shall file in the Patent and Trademark Office —

(1) the national fee provided in section 41(a) of this title;

(2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;

(3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;

(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants;

(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

(d) The requirement with respect to the national fee referred to in subsection (c)(1), the translation referred to in subsection (c)(2), and the oath or declaration referred to in subsection (c)(4) of this section shall be complied with by the date of the commencement of the national stage or by such later time as may be fixed by the Director. The copy of the international application referred to in subsection (c)(2) shall be submitted by the date of the commencement of the national stage. Failure to comply with these requirements shall be regarded as abandonment of the application by the parties thereof, unless it be shown to the satisfaction of the Director that such failure to comply was unavoidable. The payment of a surcharge may be required as a condition of accepting the national fee referred to in subsection (c)(1) or the oath or declaration referred to in subsection (c)(4) of this section if these requirements are not met by the date of the commencement of the national stage. The requirements of subsection (c)(3) of this section shall be complied with by the date of the commencement of the national stage, and failure to do so shall be regarded as a cancellation of the amendments to the claims in the international application made under article 19 of the treaty. The requirement of subsection (c)(5) shall be complied with at such time as may be fixed by the Director and failure to do so shall be regarded as cancellation of the amendments made under article 34 (2)(b) of the treaty.

(e) After an international application has entered the national stage, no patent may be granted or refused thereon before the expiration of the applicable time limit under article 28 or article 41 of the treaty, except with the express consent of the applicant. The applicant may present amendments to the specification, claims, and drawings of the application after the national stage has commenced.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 688; amended Nov. 8, 1984, Public Law 98-622, sec. 402(a)-(d), 403(a), 98 Stat. 3391, 3392.)

(Subsections (a), (b), (c), (d), and (e) amended Nov. 6, 1986, Public Law, 99-616, sec. 7, 100 Stat. 3486.)

(Subsection (c)(1) amended Dec. 10, 1991, Public Law 102-204, sec. 5(g)(2), 105 Stat. 1641.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 372 National stage: Requirements and procedure.

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office.

(b) In case of international applications designating but not originating in, the United States -

(1) the Director may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations; and

(3) the Director may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 8, 1984, Public Law 98-622, sec. 402(e), (f), 403(a), 98 Stat. 3392; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 373 Improper applicant.

An international application designating the United States, shall not be accepted by the Patent and Trademark Office for the national stage if it was filed by anyone not qualified under chapter 11 of this title to be an applicant for the purpose of filing a national application in the United States. Such international applications shall not serve as the basis for the benefit of an earlier filing date under section 120 of this title in a subsequently filed application, but may serve as the basis for a claim of the right of priority under subsections (a) through (d) of section 119 of this title, if the United States was not the sole country designated in such international application.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(5), 108 Stat. 4987.)

35 U.S.C. 374 Publication of international application.

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall confer the same rights and shall have the same effect under this title as an application for patent published under section 122(b), except as provided in sections 102(e) and 154(d) of this title.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-566 (S. 1948 sec. 4507(10)).)

35 U.S.C. 375 Patent issued on international application: Effect.

(a) A patent may be issued by the Director based on an international application designating the United States, in accordance with the provisions of this title. Subject to section 102(e) of this title, such patent shall have the force and effect of a patent issued on a national application filed under the provisions of chapter 11 of this title.

(b) Where due to an incorrect translation the scope of a patent granted on an international application designating the United States, which was not originally filed in the English language, exceeds the scope of the international application in its original language, a court of competent jurisdiction may retroactively limit the scope of the patent, by declaring it unenforceable to the extent that it exceeds the scope of the international application in its original language.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 689; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 376 Fees.

(a) The required payment of the international fee and the handling fee, which amounts are specified in the Regulations, shall be paid in United States currency. The Patent and Trademark Office shall charge a national fee as provided in section 41(a), and may also charge the following fees:

(1) A transmittal fee (see section 361(d));

(2) A search fee (see section 361(d));

(3) A supplemental search fee (to be paid when required);

(4) A preliminary examination fee and any additional fees (see section 362(b)).

(5) Such other fees as established by the Director.

(b) The amounts of fees specified in subsection (a) of this section, except the international fee and the handling fee, shall be prescribed by the Director. He may refund any sum paid by mistake or in excess of the fees so specified, or if required under the treaty and the Regulations. The Director may also refund any part of the search fee, the national fee, the preliminary examination fee and any additional fees, where he determines such refund to be warranted.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 690, amended Nov. 8, 1984, Public Law 98-622, sec. 402(g), 403(a), 98 Stat. 3392; Nov. 6, 1986, Public Law 99-616, sec. 8(a) & (b), 100 Stat. 3486; Dec. 10, 1991, Public Law 102-204, sec. 5(g)(1), 105 Stat. 1640; amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501-582 (S. 1948 sec. 4732(a)(10)(A)).)

LAWS NOT IN TITLE 35, UNITED STATES CODE

18 U.S.C. 1001 Statements or entries generally.

(a) Except as otherwise provided in this section, whoever, in any matter within the jurisdiction of the executive, legislative, or judicial branch of the Government of the United States, knowingly and willfully —

(1) falsifies, conceals, or covers up by any trick, scheme, or device a material fact;

(2) makes any materially false, fictitious, or fraudulent statement or representation; or

(3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry; shall be fined under this title or imprisoned not more than 5 years, or both.

(b) Subsection (a) does not apply to a party to a judicial proceeding, or that party's counsel, for statements, representations, writings or documents submitted by such party or counsel to a judge or magistrate in that proceeding.

(c) With respect to any matter within the jurisdiction of the legislative branch, subsection (a) shall apply only to —

(1) administrative matters, including a claim for payment, a matter related to the procurement of property or services, personnel or employment practices, or support services, or a document required by law, rule, or regulation to be submitted to the Congress or any office or officer within the legislative branch; or

(2) any investigation or review, conducted pursuant to the authority of any committee, subcommittee, commission or office of the Congress, consistent with applicable rules of the House or Senate.

(Amended Sept. 13, 1994, Public Law 103-322, sec. 330016(1)(L), 108 Stat. 2147; Oct. 11, 1996, Public Law 104-292, Sec. 2, 110 Stat. 3459.)

18 U.S.C. 2071 Concealment, removal, or mutilation generally.

(a) Whoever willfully and unlawfully conceals, removes, mutilates, obliterates, or destroys, or attempts to do so, or, with intent to do so takes and carries away any record, proceeding, map, book, paper, document, or other thing, filed or deposited with any clerk or officer of any court of the United States, or in any public office, or with any judicial or public officer of the United States, shall be fined under this title or imprisoned not more than three years, or both.

(b) Whoever, having the custody of any such record, proceeding, map, book, document, paper, or other thing, willfully and unlawfully conceals, removes, mutilates, obliterates, falsifies, or destroys the same, shall be fined under this title or imprisoned

not more than three years, or both; and shall forfeit his office and be disqualified from holding any office under the United States. As used in this subsection, the term "office" does not include the office held by any person as a retired officer of the Armed Forces of the United States.

(Amended Nov. 5, 1990, Public Law 101-510, sec. 552(a), 104 Stat. 1566; Sept. 13, 1994, Public Law 103-322, sec. 330016(1)(I), 108 Stat. 2147.)

INDEX OF PATENT LAWS

A

B

M

N

O

P

R

S

T

U

V

W

Appendix R PATENT RULES

Title 37 - Code of Federal Regulations
Patents, Trademarks, and Copyrights

CHAPTER I — UNITED STATES PATENT AND TRADEMARK OFFICE, DEPARTMENT OF COMMERCE

SUBCHAPTER A - GENERAL

PATENTS

Part

PRACTICE BEFORE THE PATENT AND TRADEMARK OFFICE

SUBCHAPTER B—GOVERNMENT INVENTIONS JURISDICTION

SUBCHAPTER C—PROTECTION OF FOREIGN MASK WORKS

SUBCHAPTER A - GENERAL

PART 1 - RULES OF PRACTICE IN PATENT CASES

Subpart A - General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

Sec.

RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

FEES AND PAYMENT OF MONEY

JOINDER OF INVENTIONS IN ONE APPLICATION; RESTRICTION

DESIGN PATENTS

PLANT PATENTS

REISSUES

PETITIONS AND ACTION BY THE COMMISSIONER

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

PUBLICATION OF APPLICATIONS

MISCELLANEOUS PROVISIONS

PROTESTS AND PUBLIC USE PROCEEDINGS

REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS BY COURT

ALLOWANCE AND ISSUE OF PATENT

DISCLAIMER

CORRECTION OF ERRORS IN PATENT

ARBITRATION AWARDS

AMENDMENT OF RULES

MAINTENANCE FEES

Subpart C - International Processing Provisions

GENERAL INFORMATION

WHO MAY FILE AN INTERNATIONAL APPLICATION

THE INTERNATIONAL APPLICATION

FEES

PRIORITY

REPRESENTATION

TRANSMITTAL OF RECORD COPY

TIMING

AMENDMENTS

UNITY OF INVENTION

INTERNATIONAL PRELIMINARY EXAMINATION

NATIONAL STAGE

Subpart D - *Ex Parte* Reexamination of Patents

CITATION OF PRIOR ART

REQUEST FOR REEXAMINATION

Subpart E - Interferences

Subpart F - Adjustment and Extension of Patent Term

ADJUSTMENT OF PATENT TERM DUE TO EXAMINATION DELAY

EXTENSION OF PATENT TERM DUE TO REGULATORY REVIEW

Subpart G - Biotechnology Invention Disclosures

DEPOSIT OF BIOLOGICAL MATERIAL

APPLICATION DISCLOSURES CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCES

Subpart H - *Inter Partes* Reexamination of Patents that Issued From an Original Application Filed in the United States on or After November 29, 1999

PRIOR ART CITATIONS

REQUIREMENTS FOR *INTER PARTES* REEXAMINATION PROCEEDINGS

INTER PARTES REEXAMINATION OF PATENTS

INFORMATION DISCLOSURE IN *INTER PARTES* REEXAMINATION

OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN *INTER PARTES* REEXAMINATION

INTERVIEWS PROHIBITED IN *INTER PARTES* REEXAMINATION

EXTENSIONS OF TIME, TERMINATION OF PROCEEDINGS, AND PETITIONS TO REVIVE IN *INTER PARTES* REEXAMINATION

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES IN *INTER PARTES* REEXAMINATION

PATENT OWNER APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN *INTER PARTES* REEXAMINATION

CONCURRENT PROCEEDINGS INVOLVING SAME PATENT IN *INTER PARTES* REEXAMINATION

REEXAMINATION CERTIFICATE IN *INTER PARTES* REEXAMINATION

SUBCHAPTER A – GENERAL

PART 1 — RULES OF PRACTICE IN PATENT CASES

Subpart A — General Provisions

GENERAL INFORMATION AND CORRESPONDENCE

§ 1.1 Addresses for correspondence with the Patent and Trademark Office.

(a) Except for § 1.1(a)(3) (i) and (ii), all correspondence intended for the Patent and Trademark Office must be addressed to either "Commissioner of Patents and Trademarks, Washington, DC 20231" or to specific areas within the Office as set out in paragraphs (a) (1), (2) and (3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

(1) *Patent correspondence.* All correspondence concerning patent matters processed by organizations reporting to the Assistant Commissioner for Patents should be addressed to "Assistant Commissioner for Patents, Washington, DC 20231."

(2) *Trademark correspondence.*

(i) Send all trademark filings and correspondence, except as specified below or unless submitting electronically, to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

(ii) Send trademark-related documents for the Assignment Division to record to: Commissioner of Patents and Trademarks, Box Assignment, Washington, DC 20231.

(iii) Send requests for certified or uncertified copies of trademark applications and registrations, other than coupon orders for uncertified copies of registrations, to: Commissioner of Patents and Trademarks, Box 10, Washington, DC 20231.

(iv) Send requests for coupon orders for uncertified copies of registrations to: Commissioner of Patents and Trademarks, Box 9, Washington, DC 20231.

(v) An applicant may transmit an application for trademark registration electronically, but only if the applicant uses the Patent and Trademark Office's electronic form.

(3) *Office of Solicitor correspondence.*

(i) Correspondence relating to pending litigation required by court rule or order to be served on the Solicitor shall be hand-delivered to the Office of the Solicitor or shall be mailed to: Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215; or such other address as may be designated in writing in the litigation. See §§ 1.302(c) and 2.145(b)(3) for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

(ii) Correspondence relating to disciplinary proceedings pending before an Administrative Law Judge or the Commissioner shall be mailed to: Office of the Solicitor, P.O. Box 16116, Arlington, Virginia 22215.

(iii) All other correspondence to the Office of the Solicitor shall be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

(iv) Correspondence improperly addressed to a Post Office Box specified in paragraphs (a)(3) (i) and (ii) of this section will not be filed elsewhere in the Patent and Trademark Office, and may be returned.

(b) Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked "Box PCT."

(c) Requests for reexamination should be additionally marked "Box Reexam."

(d) Payments of maintenance fees in patents and other communications relating thereto should be additionally marked "Box M. Fee."

(e) Communications relating to interferences and applications or patents involved in an interference should be additionally marked "BOX INTERFERENCE."

(f) All applications for extension of patent term and any communications relating thereto intended for the Patent and Trademark Office should be additionally marked "Box Patent Ext." When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(g) [Reserved]

(h) In applications under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), all statements of use filed under section 1(d) of the Act, and requests for extensions of time therefor, should be additionally marked "Box ITU."

(i) The filing of all provisional applications and any communications relating thereto should be additionally marked "Box Provisional Patent Application."

NOTE.—Sections 1.1 to 1.26 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of "national application" and "international application."

[46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (e), 49 FR 48416, Dec.12, 1984, effective Feb. 11, 1985; para. (f) added, 52 FR 9394, Mar. 24, 1987; para. (g) added, 53 FR 16413, May 9, 1988; para. (h) added, 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989; para. (i) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised and para. (g) removed and reserved, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (b) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 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.

§ 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.

[Amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996]

§ 1.4 Nature of correspondence and signature requirements.

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents or trademark registrations, orders for copies of records, transmission of assignments for recording, and the like, and

(2) Correspondence in and relating to a particular application or other proceeding in the Office. See particularly the rules relating to the filing, processing, or other proceedings of national applications in subpart B, §§ 1.31 to 1.378; of international applications in subpart C, §§ 1.401 to 1.499; of *ex parte* reexaminations of patents in subpart D, §§ 1.501 to 1.570; of interferences in subpart E, §§ 1.601 to 1.690; of extension of patent term in subpart F, §§ 1.710 to 1.785; of *inter partes* reexaminations of patents in subpart H, §§ 1.902 to 1.997; and of trademark applications §§ 2.11 to 2.189.

(b) Since each file must be complete in itself, a separate copy of every paper to be filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical. The filing of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding should be

avoided, except in situations in which the Office requires the filing of duplicate copies. The Office may dispose of duplicate copies of correspondence in the file of an application, patent, trademark registration file, or other proceeding.

(c) Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

(d)(1) Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in an application, patent file, trademark registration file, or other proceeding in the Office which requires a person's signature, must:

(i) Be an original, that is, have an original signature personally signed in permanent ink by that person; or

(ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§ 1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original; or

(iii) Where an electronically transmitted trademark filing is permitted, the person who signs the filing must either

(A) Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission; and print, sign and date in permanent ink, and maintain a paper copy of the electronic submission; or

(B) Sign the verified statement using some other form of electronic signature specified by the Commissioner.

(2) The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 10.18(b) of this chapter. Violations of § 10.18(b)(2) of this chapter by a party, whether a practitioner or non-practitioner, may result in the imposition of sanctions under § 10.18(c) of this chapter. Any practitioner violating § 10.18(b) may also be subject to disciplinary action. See §§ 10.18(d) and 10.23(c)(15).

(e) Correspondence requiring person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

(g) An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

[24 FR 10332, Dec. 22, 1959; 43 FR 20461, May 11, 1978; para. (a), 48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a)(2), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; paras. (d)-(f) added, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (d) revised & para. (g) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)(2) and (d)(1) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.5 Identification of application, patent, or registration.

(a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international

application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patent should also state the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

(b) When the letter concerns a patent other than for purposes of paying a maintenance fee, it should state the number and date of issue of the patent, the name of the patentee, and the title of the invention. For letters concerning payment of a maintenance fee in a patent, see the provisions of § 1.366(c).

(c)(1) A letter about a trademark application should identify the serial number, the name of the applicant, and the mark.

(2) A letter about a registered trademark should identify the registration number, the name of the registrant, and the mark.

(d) A letter relating to a reexamination proceeding should identify it as such by the number of the patent undergoing reexamination, the reexamination request control number assigned to such proceeding, and, if known, the group art unit and name of the examiner to which it been assigned.

(e) When a paper concerns an interference, it should state the names of the parties and the number of the interference. The name of the examiner-in-chief assigned to the interference (§ 1.610) and the name of the party filing the paper should appear conspicuously on the first page of the paper.

(f) When a paper concerns a provisional application, it should identify the application as such and include the application number.

[24 FR 10332, Dec. 22, 1959; 46 FR 29181, May 29, 1981; para. (a), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a) & (b), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (f) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (c) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 1.6 Receipt of correspondence.

(a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) Trademark-related correspondence transmitted electronically will be stamped with the date on which the Office receives the transmission.

(b) *Patent and Trademark Office Post Office pouch.* Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays, and Federal holidays within the District of Columbia, by the post office at Washington, DC, serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.

(c) *Correspondence delivered by hand.* In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) *Facsimile transmission.* Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

(1) Correspondence as specified in § 1.4(e), requiring an original signature;

(2) Certified documents as specified in § 1.4(f);

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), § 1.8(a)(2)(ii)(A), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

(4) Drawings submitted under §§ 1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;

(5) A request for reexamination under § 1.510 or § 1.913;

(6) Correspondence to be filed in a patent application subject to a secrecy order under §§ 5.1 through 5.5 of this chapter and directly related to the secrecy order content of the application;

(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);

(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of *ex parte* appeal;

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under § 1.621; a transcript of a deposition under § 1.676 or of interrogatories, or cross-interrogatories; or an evidentiary record and exhibits under § 1.653.

(e) *Interruptions in U.S. Postal Service.* If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

(f) *Facsimile transmission of a patent application under § 1.53(d).* In the event that the Office has no evidence of receipt of an application under § 1.53(d) (a continued prosecution application) transmitted to the Office by facsimile transmission, the party who transmitted the application under § 1.53(d) may petition the Commissioner to accord the application under § 1.53(d) a filing date as of the date the application under § 1.53(d) is shown to have been transmitted to and received in the Office,

(1) Provided that the party who transmitted such application under § 1.53(d):

(i) Informs the Office of the previous transmission of the application under § 1.53(d) promptly after becoming aware that the Office has no evidence of receipt of the application under § 1.53(d);

(ii) Supplies an additional copy of the previously transmitted application under § 1.53(d); and

(iii) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous transmission of the application under § 1.53(d) and is accompanied by a copy of the sending unit's report confirming transmission of the application under § 1.53(d) or evidence that came into being after the complete transmission and within one business day of the complete transmission of the application under § 1.53(d).

(2) The Office may require additional evidence to determine if the application under § 1.53(d) was transmitted to and received in the Office on the date in question.

[48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; para. (a), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d)(3), (d)(6) & (e) amended, para. (f) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para (a)(1) revised and para. (a)(4) added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; para.(d)(9) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d)(5) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 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.

[48 FR 2707, Jan. 20, 1983, effective Feb. 27, 1983; corrected 48 FR 4285, Jan. 31, 1983; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000)]

§ 1.8 Certificate of mailing or transmission.

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:

(i) *Relative to Patents and Patent Applications*—

(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d);

(B) The filing of correspondence in an interference which an examiner-in-chief orders to be filed by hand or "Express Mail";

(C) The filing of agreements between parties to an interference under 35 U.S.C. 135(c);

(D) The filing of an international application for patent;

(E) The filing of correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority;

(F) The filing of a copy of the international application and the basic national fee necessary to enter the national stage, as specified in § 1.494(b) or § 1.495(b).

(ii) *Relative to Trademark Registrations and Trademark Applications*—

(A) The filing of a trademark application.

(B) [Reserved]

(C) [Reserved]

(D) [Reserved]

(E) [Reserved]

(F) [Reserved]

(iii) *Relative to Disciplinary Proceedings*—

(A) Correspondence filed in connection with a disciplinary proceeding under part 10 of this chapter.

(B) [Reserved]

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

[41 FR 43721, Oct. 4, 1976; 43 FR 20461, May 11, 1978; para. (a). 47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; para. (a),48 FR 2708, Jan. 20, 1983; para. (a) 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 49 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; 52 FR 20046, May 28, 1987; subparas. (a)(2)(xiv)-(xvi), 54 FR 37588, Sept. 11, 1989, effective Nov. 16, 1989; revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) revised, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (a)(2)(i)(A) & (b) revised; 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.9 Definitions.

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

(c) A published application as used in this chapter means an application for patent which has been published under 35 U.S.C. 122(b).

(d) [Reserved]

(e) [Reserved]

(f) [Reserved]

(g) For definitions in interferences see § 1.601.

(h) A Federal holiday within the District of Columbia as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.

(i) National security classified as used in this chapter means specifically authorized under criteria established by an Act of Congress or Executive Order to be kept secret in the interest of national defense or foreign policy and, in fact, properly classified pursuant to such Act of Congress or Executive Order.

[43 FR 20461, May 11, 1978; 47 FR 40139, Sept. 10, 1982, effective Oct. 1, 1982; 47 FR 43275, Sept. 30, 1982, effective Oct. 1, 1982; para. (d), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (g), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (h) added, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (f) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (c)-(f) removed and reserved and para. (i) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.10 Filing of papers and fees by "Express Mail."

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within

one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

[48 FR 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983, paras. (a) & (c), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a)-(c) revised and paras. (d) - (f) added, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

RECORDS AND FILES OF THE PATENT AND TRADEMARK OFFICE

§ 1.11 Files open to the public.

(a) The specification, drawings, and all papers relating to the file of an abandoned published application, except if a redacted copy of the application was used for the patent application publication, a patent, or a statutory invention registration are open to inspection by the public, and copies may be obtained upon the payment of the fee set forth in § 1.19(b)(2). See § 2.27 for trademark files.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

(c) All requests for reexamination for which the fee under § 1.20(c) has been paid, will be announced in the *Official Gazette*. Any reexaminations at the initiative of the Commissioner pursuant to § 1.520 will also be announced in the *Official Gazette*. The announcement shall include at least the date of the request, if any, the reexamination request control number or the Commissioner initiated order control number, patent number, title, class and subclass, name of the inventor, name of the patent owner of record, and the examining group to which the reexamination is assigned.

(d) All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to

inspection by the general public, and copies may be furnished upon paying the fee therefor.

(e) The file of any interference involving a patent, a statutory invention registration, a reissue application, or an application on which a patent has been issued or which has been published as a statutory invention registration, is open to inspection by the public, and copies may be obtained upon paying the fee therefor, if:

(1) The interference has terminated or

(2) An award of priority or judgment has been entered as to all parties and all counts.

[42 FR 5593, Jan. 28, 1977; 43 FR 28477, June 30, 1978; 46 FR 29181, May 29, 1981, para. (c), 47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (a), (b) and (e), 50 FR 9278, Mar. 7, 1985, effective May 8, 1985; para. (e) revised, 60 FR 14488, Mar. 17, 1995, effective Mar. 17, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.12 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the United States Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes (for assignments recorded on or after May 1, 1957), published patent applications, and assignment records relating to pending or abandoned trademark applications and to trademark registrations (for assignments recorded on or after January 1, 1955), are open to public inspection at the United States Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 1.19 and § 2.6 of this chapter.

(2) All records of assignments of patents recorded before May 1, 1957, and all records of trademark assignments recorded before January 1, 1955, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned patent application which has not been published under 35 U.S.C. 122(b) are not available to the public. Copies of any such assignment records and related information shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided in this part.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in confidence under § 1.14, or any information with respect thereto, must:

(1) Be in the form of a petition including the fee set forth in § 1.17 (h); or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

(d) An order for a copy of an assignment or other document should identify the reel and frame number where the assignment or document is recorded. If a document is identified without specifying its correct reel and frame, an extra charge as set forth in § 1.21(j) will be made for the time consumed in making a search for such assignment.

[47 FR 41272, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (c), 54 FR 6893, Feb. 15, 1989, effective April 17, 1989; paras. (a) and (d), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1) and (d), 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (a)(2) added, 57 FR 29641, July 6, 1992, effective Sept. 4, 1992; para. (c) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (c) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (c)(1) amended, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(1) and (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and

Trademark Office and open to the public, will be furnished by the United States Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the appropriate fee.

(b) Certified copies of patents, patent application publications, and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the United States Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the United States Patent and Trademark Office and certified by the Commissioner, or in his or her name attested by an officer of the United States Patent and Trademark Office authorized by the Commissioner, upon payment of the fee for the certified copy.

[Revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.14 Patent applications preserved in confidence.

(a) *Confidentiality of patent application information.* Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

(1) Status information is:

(i) Whether the application is pending, abandoned, or patented;

(ii) Whether the application has been published under 35 U.S.C. 122(b); and

(iii) The application "numerical identifier" which may be:

(A) The eight-digit application number (the two-digit series code plus the six-digit serial number); or

(B) The six-digit serial number plus any one of the filing date of the national application, the international filing date, or date of entry into the national stage.

(2) Access is defined as providing the application file for review and copying of any material in the application file.

(b) *When status information may be supplied.* Status information of an application may be supplied by the Office to the public if any of the following apply:

(1) Access to the application is available pursuant to paragraph (e) of this section;

(2) The application is referred to by its numerical identifier in a published patent document (*e.g.*, a U.S. patent, a U.S. patent application publication, or an international application publication), or in a U.S. application open to public inspection (§ 1.11(b), or paragraph (e)(2)(i) or (e)(2)(ii) of this section);

(3) The application is a published international application in which the United States of America has been indicated as a designated state; or

(4) The application claims the benefit of the filing date of an application for which status information may be provided pursuant to paragraphs (b)(1) through (b)(3) of this section.

(c) *When copies may be supplied.* A copy of an application-as-filed or a file wrapper and contents may be supplied by the Office to the public, subject to paragraph (i) of this section (which addresses international applications), if any of the following apply:

(1) *Application-as-filed.*

(i) If a U.S. patent application publication or patent incorporates by reference, or includes a specific reference under 35 U.S.C. 119(e) or 120 to, a pending or abandoned application, a copy of that application-as-filed may be provided to any person upon written request including the fee set forth in § 1.19(b)(1); or

(ii) If an international application, which designates the U.S. and which has been published in accordance with PCT Article 21(2), incorporates by reference or claims priority under PCT Article 8 to a pending or abandoned U.S. application, a copy of that application-as-filed may be provided to any person upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee set forth in § 1.19(b)(1).

(2) *File wrapper and contents.* A copy of the specification, drawings, and all papers relating to the file of an abandoned or pending published application may be provided to any person upon written request,

including the fee set forth in § 1.19(b)(2). If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.

(d) *Power to inspect a pending or abandoned application.* Access to an application may be provided to any person if the application file is available, and the application contains written authority (*e.g.*, a power to inspect) granting access to such person. The written authority must be signed by:

(1) An applicant;

(2) An attorney or agent of record;

(3) An authorized official of an assignee of record (made of record pursuant to § 3.71 of this chapter); or

(4) A registered attorney or agent named in the papers accompanying the application papers filed under § 1.53 or the national stage documents filed under § 1.494 or § 1.495, if an executed oath or declaration pursuant to § 1.63 or § 1.497 has not been filed.

(e) *Public access to a pending or abandoned application.* Access to an application may be provided to any person, subject to paragraph (i) of this section, if a written request for access is submitted, the application file is available, and any of the following apply:

(1) The application is open to public inspection pursuant to § 1.11(b); or

(2) The application is abandoned, it is not within the file jacket of a pending application under § 1.53(d), and it is referred to:

(i) In a U.S. patent application publication or patent;

(ii) In another U.S. application which is open to public inspection either pursuant to § 1.11(b) or paragraph (e)(2)(i) of this section; or

(iii) In an international application which designates the U.S. and is published in accordance with PCT Article 21(2).

(f) *Applications reported to Department of Energy.* Applications for patents which appear to disclose, purport to disclose or do disclose inventions or discoveries relating to atomic energy are reported to the Department of Energy, which Department will be given access to the applications. Such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or is an invention or discovery, or that such application in fact discloses subject matter in categories specified by 42 U.S.C. 2181(c) and (d).

(g) *Decisions by the Commissioner or the Board of Patent Appeals and Interferences.* Any decision by the Commissioner or the Board of Patent Appeals and Interferences which would not otherwise be open to public inspection may be published or made available for public inspection if:

(1) The Commissioner believes the decision involves an interpretation of patent laws or regulations that would be of precedential value; and

(2) The applicant, or a party involved in an interference for which a decision was rendered, is given notice and an opportunity to object in writing within two months on the ground that the decision discloses a trade secret or other confidential information. Any objection must identify the deletions in the text of the decision considered necessary to protect the information, or explain why the entire decision must be withheld from the public to protect such information. An applicant or party will be given time, not less than twenty days, to request reconsideration and seek court review before any portions of a decision are made public under this paragraph over his or her objection.

(h) *Publication pursuant to § 1.47.* Information as to the filing of an application will be published in the *Official Gazette* in accordance with § 1.47(c).

(i) *International applications.*

(1) Copies of international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Article 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated, and upon payment of the appropriate fee (see § 1.19(b)(2) or 1.19(b)(3)), if:

(i) With respect to the Home Copy, the international application was filed with the U.S. Receiving Office;

(ii) With respect to the Search Copy, the U.S. acted as the International Searching Authority; or

(iii) With respect to the Examination Copy, the United States acted as the International Preliminary Examining Authority, an International Preliminary Examination Report has issued, and the United States was elected.

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

(3) Access to international application files for international applications which designate the U.S. and which have been published in accordance with PCT Article 21(2), or copies of a document in such application files, will be furnished in accordance with PCT Article 30 and 38 and PCT Rules 94.2 and 94.3, upon written request including a showing that the publication of the application has occurred and that the U.S. was designated.

(4) In accordance with PCT Article 30, copies of an international application-as-filed under paragraph (c)(1) of this section will not be provided prior to the international publication of the application pursuant to PCT Article 21(2).

(5) Access to international application files under paragraphs (e) and (i)(3) of this section will not be permitted with respect to the Examination Copy in accordance with PCT Article 38.

(j) *Access or copies in other circumstances.* The Office, either *sua sponte* or on petition, may also provide access or copies of all or part of an application if necessary to carry out an Act of Congress or if warranted by other special circumstances. Any petition by a member of the public seeking access to, or copies of, all or part of any pending or abandoned application preserved in confidence pursuant to paragraph (a) of this section, or any related papers, must include:

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

(2) A showing that access to the application is necessary to carry out an Act of Congress or that special circumstances exist which warrant petitioner being granted access to all or part of the application.

[42 FR 5593, Jan. 28, 1977; 43 FR 20462, May 11, 1978; para. (e) added, 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective Apr. 1, 1984; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (b), 50 FR 9378, Mar. 7, 1985, effective May 8, 1985; 53 FR 23733, June 23, 1988; para. (e), 54 FR 6893, Feb. 15, 1989, effective April 17, 1989; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (e) amended, 60 FR 20195, Apr. 25, 1995; effective June 8, 1995; paras. (a), (b) and (e) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) revised & para. (f) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (g) added, 63 FR 29614, June 1, 1998, effective July 1, 1998, (adopted as final, 63 FR 66040, Dec. 1, 1998); revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a), (b), (c), (e), (i) and (j) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para (h) corrected, 65 FR 78958, Dec. 18, 2000]

§ 1.15 Requests for identifiable records.

(a) Requests for records not disclosed to the public as part of the regular informational activity of the Patent and Trademark Office and which are not otherwise dealt with in the rules in this part shall be made in writing, with the envelope and the letter clearly marked "Freedom of Information Request." Each such request, so marked, should be submitted by mail addressed to the "Patent and Trademark Office, Freedom of Information Request Control Desk, Box 8, Washington, D.C. 20231," or hand-delivered to the Office of the Solicitor, Patent and Trademark Office, Arlington, Virginia. The request will be processed in accordance with the procedures set forth in Part 4 of Title 15, Code of Federal Regulations.

(b) Any person whose request for records has been initially denied in whole or in part, or has not been timely determined, may submit a written appeal as provided in § 4.8 of Title 15, Code of Federal Regulations.

(c) Procedures applicable in the event of service of process or in connection with testimony of employees on official matters and production of official documents of the Patent and Trademark Office in civil legal proceedings not involving the United States shall be those established in parts 15 and 15a of Title 15, Code of Federal Regulations.

[32 FR 13812, Oct. 4, 1967; 34 FR 18857, Nov. 26, 1969; amended 53 FR 47685, Nov. 25, 1988, effective Dec. 30, 1988]

FEES AND PAYMENT OF MONEY

§ 1.16 National application filing fees.

(a) Basic fee for filing each application for an original patent, except provisional, design, or plant applications:

By a small entity (§ 1.27(a)) . . . $355.00
By other than a small entity $710.00

(b) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.27(a)) $40.00
By other than a small entity $80.00

(c) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.27(a)) $9.00
By other than a small entity $18.00

(d) In addition to the basic filing fee in an original application, except provisional applications, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.27(a)) . . . $135.00
By other than a small entity $270.00

(e) Surcharge for filing the basic filing fee or oath or declaration on a date later than the filing date of the application, except provisional applications:

By a small entity (§ 1.27(a)) $65.00
By other than a small entity $130.00

(f) Basic fee for filing each design application:

By a small entity (§ 1.27(a)) . . . $160.00
By other than a small entity $320.00

(g) Basic fee for filing each plant application, except provisional applications:

By a small entity (§ 1.27(a)) . . . $245.00
By other than a small entity $490.00

(h) Basic fee for filing each reissue application:

By a small entity (§ 1.27(a)) . . . $355.00
By other than a small entity $710.00

(i) In addition to the basic filing fee in a reissue application, for filing or later presentation of each independent claim which is in excess of the number of independent claims in the original patent:

By a small entity (§ 1.27(a)). $40.00
By other than a small entity $80.00

(j) In addition to the basic filing fee in a reissue application, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 and also in excess of the number of claims in the original patent (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee purposes.):

By a small entity (§ 1.27(a)). $9.00
By other than a small entity $18.00

(k) Basic fee for filing each provisional application:

By a small entity (§ 1.27(a)). $75.00
By other than a small entity $150.00

(l) Surcharge for filing the basic filing fee or cover sheet (§ 1.51(c)(1)) on a date later than the filing date of the provisional application:

By a small entity (§ 1.27(a)). $25.00
By other than a small entity $50.00

(m) If the additional fees required by paragraphs (b), (c), (d), (i) and (j) of this section are not paid on filing or on later presentation of the claims for which the additional fees are due, they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency.

NOTE.—See §§ 1.445, 1.482 and 1.492 for international application filing and processing fees.

[Added, 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective date Oct. 5, 1985; paras. (a), (b), (d) - (i), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; paras. (a)-(j), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)-(d) and (f)-(j), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; paras. (a), (b), (d) and (f)-(i), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a)-(g) amended and paras. (k) and (l) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a), (b), (d), & (f)-(i) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a), (b), (d), and (f)-(i) amended and para. (m) added, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a), (b), (d), and (f) - (i) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (d) & (l) amended, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(d) and (f)-(j)

revised, 63 FR 6758, Dec. 8, 1998, effective Nov. 10, 1998; paras. (a) and (b) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (a), (b), (d), and (f)-(i) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (a)-(l) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.17 Patent application and reexamination processing fees.

(a) Extension fees pursuant to § 1.136(a):

(1) For reply within first month:
By a small entity (§ 1.27(a)) $55.00
By other than a small entity $110.00

(2) For reply within second month:
By a small entity (§ 1.27(a)) . . . $195.00
By other than a small entity $390.00

(3) For reply within third month:
By a small entity (§ 1.27(a)) . . . $445.00
By other than a small entity $890.00

(4) For reply within fourth month:
By a small entity (§ 1.27(a)) . . . $695.00
By other than a small entity . . . $1,390.00

(5) For reply within fifth month:
By a small entity (§ 1.27(a)) . . . $945.00
By other than a small entity . . . $1,890.00

(b) For filing a notice of appeal from the examiner to the Board of Patent Appeals and Interferences:
By a small entity (§ 1.27(a)) . . . $155.00
By other than a small entity $310.00

(c) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:
By a small entity (§ 1.27(a)) . . . $155.00
By other than a small entity $310.00

(d) For filing a request for an oral hearing before the Board of Patent Appeals and Interferences in an appeal under 35 U.S.C. 134:
By a small entity (§ 1.27(a)) . . . $135.00
By other than a small entity $270.00

(e) To request continued examination pursuant to § 1.114:
By a small entity (§1.27(a)) $355.00
By other than a small entity $710.00

(f) [Reserved]

(g) [Reserved]

(h) For filing a petition under one of the following sections which refers to this paragraph . . $130.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.47—for filing by other than all the inventors or a person not the inventor.

§ 1.53(e)—to accord a filing date.

§ 1.59—for expungement and return of information.

§ 1.84—for accepting color drawings or photographs.

§ 1.91—for entry of a model or exhibit.

§ 1.102—to make an application special.

§ 1.103(a)—to suspend action in an application.

§ 1.138(c)—to expressly abandon an application to avoid publication.

§ 1.182—for decision on a question not specifically provided for.

§ 1.183— to suspend the rules.

§ 1.295—for review of refusal to publish a statutory invention registration.

§ 1.313—to withdraw an application from issue.

§ 1.314—to defer issuance of a patent.

§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§ 1.644(e)—for petition in an interference.

§ 1.644(f)—for request for reconsideration of a decision on petition in an interference.

§ 1.666(b)—for access to an interference settlement agreement.

§ 1.666(c)—for late filing of interference settlement agreement.

§ 1.741(b)—to accord a filing date to an application under § 1.740 for extension of a patent term.

§ 5.12—for expedited handling of a foreign filing license.

§ 5.15—for changing the scope of a license.

§ 5.25—for retroactive license.

(i) Processing fee for taking action under one of the following sections which refers to this paragraph $130.00

§ 1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§ 1.41—for supplying the name or names of the inventor or inventors after the filing date without an oath or declaration as prescribed by § 1.63, except in provisional applications.

§ 1.48—for correcting inventorship, except in provisional applications.

§ 1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§ 1.53(b)(3)—to convert a provisional application filed under § 1.53(c) into a nonprovisional application under § 1.53(b).

§ 1.55—for entry of late priority papers.

§ 1.99(e)—for processing a belated submission under § 1.99.

§ 1.103(b)—for requesting limited suspension of action, continued prosecution application (§ 1.53(d)).

§ 1.103(c)—for requesting limited suspension of action, request for continued examination (§ 1.114).

§ 1.103(d)—for requesting deferred examination of an application.

§ 1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§ 1.221—for requesting voluntary publication or republication of an application.

§ 1.497(d)—for filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4) naming an inventive entity different from the inventive entity set forth in the international stage.

§ 3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

(j) For filing a petition to institute a public use proceeding under § 1.292 . . . . . $1,510.00

(k) For filing a request for expedited examination under § 1.155(a) $900.00

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371 for the unavoidably delayed payment of the issue fee under 35 U.S.C. 151 or for the revival of an unavoidably terminated reexamination proceeding under 35 U.S.C. 133 (§ 1.137(a)):

By a small entity (§ 1.27(a)) $55.00
By other than a small entity $110.00

(m) For filing a petition for the revival of an unintentionally abandoned application for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§ 1.137(b)):

By a small entity (§ 1.27(a)). . . . $620.00
By other than a small entity . . . $1,240.00

(n) For requesting publication of a statutory invention registration prior to the mailing of the first examiner's action pursuant to § 1.104 . . . . . .$920.00 reduced by the amount of the application basic filing fee paid.

(o) For requesting publication of a statutory invention registration after the mailing of the first examiner's action pursuant to § 1.104 . . . . . $1,840.00 reduced by the amount of the application basic filing fee paid.

(p) For an information disclosure statement under § 1.97(c) or (d) or a submission under §1.99 . . . . . $180.00

(q) Processing fee for taking action under one of the following sections which refers to this paragraph $50.00

§ 1.41—to supply the name or names of the inventor or inventors after the filing date without a cover sheet as prescribed by § 1.51(c)(1) in a provisional application

§ 1.48—for correction of inventorship in a provisional application.

§ 1.53(c)(2)—to convert a nonprovisional application filed under § 1.53(b) to a provisional application under § 1.53(c).

(r) For entry of a submission after final rejection under § 1.129(a):

By a small entity (§ 1.27(a)). . . . $355.00
By other than a small entity $710.00

(s) For each additional invention requested to be examined under § 1.129(b):

By a small entity (§ 1.27(a)). . . . $355.00
By other than a small entity $710.00

(t) For the acceptance of an unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365(a) or (c) (§§ 1.55 and 1.78): . . .$1,240.00

[Added 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; para. (h), 48 FR 2708, Jan. 20, 1983, effective Feb. 27, 1983; para. (h), 49 FR 13461, Apr. 4, 1984, effective June 4, 1984; para. (h), 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; paras. (e), (g), (h) and (i), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (h), (n) and (c), 50 FR 9379, Mar. 7, 1985, effective May 8, 1985;50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985; paras. (a)- (m), 54 FR 6893, Feb. 15, 1989, 54 FR 9431, March 7, 1989,

effective Apr. 17, 1989; para. (i)(1), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(o), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; para. (i)(1), 57 FR 2021, Jan. 17, 1992, effective March 16, 1992; para. (p) added, 57 FR 2021, Jan. 17, 1992, effective March 16, 1992; para. (i)(1), 57 FR 29642, July 6, 1992, effective Sept. 4, 1992; corrected 57 FR 32439, July 22, 1992; paras. (b)-(g), (j), and (m)-(o), 57 FR 38190,Aug. 21, 1992, effective Oct. 1, 1992; para. (h), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (b)-(g), (j) and (m)-(p), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (h) & (i) amended and paras. (q)-(s) added, 67 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (b)-(g), (j), (m)-(p), (r) & (s) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (b) - (g), (j), (m)-(p), (r) and (s) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (b) - (g), (j), (m) - (p), (r) & (s) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (a) - (d), (h), (i) & (q) revised, paras. (e) - (g) reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (q) corrected, 62 FR 61235, Nov. 17, 1997, effective Dec. 1, 1997; paras. (a)-(d), (l) and (m) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; paras. (r) and (s) revised, 63 FR 67578, Dec. 8, 1998, effective Dec. 8, 1998; paras. (r) and (s) revised, 64 FR 67774, Dec. 3, 1999, effective Jan. 10, 2000; para. (e) added and para. (i) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)-(e), (m), (r) and (s) revised, 65 FR 49193, August 11, 2000, effective October 1, 2000; paras. (h), (i), (k), (l), (m), (p), and (q) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading and paras. (h), (i), (l), (m) and (p) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (t) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)-(e), (r) and (s) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.18 Patent post allowance (including issue) fees.

(a) Issue fee for issuing each original or reissue patent, except a design or plant patent:

By a small entity (§ 1.27(a)) . . . $620.00

By other than a small entity . . . $1,240.00

(b) Issue fee for issuing a design patent:

By a small entity (§ 1.27(a)) . . . $220.00

By other than a small entity $440.00

(c) Issue fee for issuing a plant patent:

By a small entity (§ 1.27(a)) . . . $300.00

By other than a small entity $600.00

(d) Publication fee $300.00

(e) For filing an application for patent term adjustment under § 1.705 . . . . . $200.00

(f) For filing a request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) in an application for patent term adjustment under § 1.705 . . . . . $400.00

[Added, 47 FR 41273, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31824, Aug. 6, 1985, effective Oct. 5, 1985; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; revised, 56 FR 65142, Dec. 13. 1991, effective Dec. 16, 1991; paras. (a)-(c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; revised, 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; amended, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; heading revised and paras. (d)-(f) added, 65 FR 56366, Sept. 18, 2000, effective Nov. 17, 2000; para. (d) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)-(c) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.19 Document supply fees.

The United States Patent and Trademark Office will supply copies of the following documents upon payment of the fees indicated. The copies will be in black and white unless the original document is in color, a color copy is requested and the fee for a color copy is paid.

(a) Uncertified copies of patent application publications and patents:

(1) Printed copy of the paper portion of a patent application publication or patent, including a design patent, statutory invention registration, or defensive publication document:

(i) Regular service, which includes preparation of copies by the Office within two to three business days and delivery by United States Postal Service or to an Office Box; and preparation of copies by the Office within one business day of receipt and delivery by electronic means (*e.g.*, facsimile, electronic mail) $3.00

(ii) Next business day delivery to Office Box $6.00

(iii) Expedited delivery by commercial delivery service $25.00

(2) Printed copy of a plant patent in color: $15.00

(3) Color copy of a patent (other than a plant patent) or statutory invention registration containing a color drawing $25.00

(b) Certified and uncertified copies of Office documents:

(1) Certified or uncertified copy of the paper portion of patent application as filed:

(i) Regular service..... $15.00

(ii) Expedited regular service..... $30.00

(2) Certified or uncertified copy of paper portion of patent-related file wrapper and contents:

(i) File wrapper and paper contents of 400 or fewer pages $200.00

(ii) Additional fee for each additional 100 pages or portion thereof..... $40.00

(iii) Additional fee for certification. $25.00

(3) Certified or uncertified copy on compact disc of patent-related file-wrapper contents that were submitted on compact disc:

(i) First compact disc in a single order $55.00

(ii) Each additional compact disc in the single order of paragraph (b)(3)(i) of this section $15.00

(4) Certified or uncertified copy of Office records, per document except as otherwise provided in this section $25.00

(5) For assignment records, abstract of title and certification, per patent..... $25.00

(c) Library service (35 U.S.C. 13): For providing to libraries copies of all patents issued annually, per annum $50.00

(d) For list of all United States patents and statutory invention registrations in a subclass..... $3.00

(e) Uncertified statement as to status of the payment of maintenance fees due on a patent or expiration of a patent..... $10.00

(f) Uncertified copy of a non-United States patent document, per document..... $25.00

(g) [Reserved]

(h) [Reserved]

[Added 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; para. (b), 49 FR 552, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (f) and (g) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (a) and (c), 50 FR 9379, Mar. 7, 1985, effective date May 8,1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; revised, 54 FR 6893, Feb. 15, 1989; 54 FR 9432, March 7, 1989, effective Apr. 17, 1989, revised 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (b)(4), (f) and (h),57 FR 38190, Aug. 21, 1992, effective Oct.1, 1992; para. (a)(3), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (a)(1)(ii), (a)(1)(iii), (b)(1)(i), & (b)(1)(ii) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(2) and (a)(3) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (a)(1)(i) through (a)(1)(iii) revised, 64 FR 67486, Dec. 2, 1999, effective Dec. 2, 1999; introductory text and paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (g) and (h) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.20 Post issuance fees.

(a) For providing a certificate of correction for applicant's mistake (§ 1.323)..... $100.00

(b) Processing fee for correcting inventorship in a patent (§ 1.324)..... $130.00

(c) In reexamination proceedings

(1) For filing a request for *ex parte* reexamination (§ 1.510(a))..... $2,520.00

(2) For filing a request for *inter partes* reexamination (§ 1.915(a))..... $8,800.00

(d) For filing each statutory disclaimer (§ 1.321):

By a small entity (§ 1.27(a))..... $55.00

By other than a small entity $110.00

(e) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond four years; the fee is due by three years and six months after the original grant:

By small entity (§ 1.27(a)) $425.00

By other than a small entity $850.00

(f) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond eight years; the fee is due by seven years and six months after the original grant:

By a small entity (§ 1.27(a))..... $975.00

By other than a small entity ...$1,950.00

(g) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond twelve years; the fee is due by eleven years and six months after the original grant:

By a small entity (§ 1.27(a)) . . $1,495.00

By other than a small entity . . . $2,990.00

(h) Surcharge for paying a maintenance fee during the six-month grace period following the expiration of three years and six months, seven years and six months, and eleven years and six months after the date of the original grant of a patent based on an application filed on or after December 12, 1980:

By a small entity (§ 1.27(a)) $65.00

By other than a small entity $130.00

(i) Surcharge for accepting a maintenance fee after expiration of a patent for non-timely payment of a maintenance fee where the delay in payment is shown to the satisfaction of the Commissioner to have been —

(1) Unavoidable $700.00

(2) Unintentional $1,640.00

(j) For filing an application for extension of the term of a patent

(1) Application for extension under § 1.740 . . . . . $1,120.00

(2) Initial application for interim extension under § 1.790 . . . . . $420.00

(3) Subsequent application for interim extension under § 1.790 . . . . . $220.00

[Added 47 FR 41273, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (k), (l) and (m) added, 49 FR 34724, Aug. 31, 1984, effective date Nov. 1, 1984; paras. (c), (f), (g) and (m), 50 FR 9379, Mar. 7, 1985, effective date May 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986; 52 FR 9394, Mar. 24, 1987; paras. (a)-(n), 54 FR 6893, Feb. 15, 1989, 54 FR 8053, Feb. 24, 1989, effective Apr. 17, 1989; revised 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a), (c), (e)-(g) and (i), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (i), 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; paras. (c), (e)-(g), (i)(1) and (j), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (j) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; paras. (c), (e)-(g), (i)(2), & (j)(1) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a), (e) - (g), (i)(1), (i)(2), and (j)(1) -(j)(3) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (c), (e) - (g), (i)(1), (i)(2), and (j)(1) - (j)(3) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (d)-(g) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; para. (e) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (e)-(g) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (b) and (d)-(h) revised, 65 FR 78958, Dec. 18, 2000; para. (b) corrected, 65 FR 80755, Dec. 22, 2000; para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.21 Miscellaneous fees and charges.

The Patent and Trademark Office has established the following fees for the services indicated:

(a) Registration of attorneys and agents:

(l) For admission to examination for registration to practice:

(i) Application Fee (non-refundable $40.00

(ii) Registration examination fee . $310.00

(2) On registration to practice $100.00

(3) For reinstatement to practice $40.00

(4) For certificate of good standing as an attorney or agent $10.00

Suitable for framing $20.00

(5) For review of decision of the Director of Enrollment and Discipline under § 10.2(c) . . $130.00

(6) For requesting regrading of an examination under § 10.7(c):

(i) Regrading of seven or fewer questions $230.00

(ii) Regrading of eight or more questions $460.00

(b) Deposit accounts:

(1) For establishing a deposit account $10.00

(2) Service charge for each month when the balance at the end of the month is below $1,000 . . . . . $25.00

(3) Service charge for each month when the balance at the end of the month is below $300 for restricted subscription deposit accounts used exclusively for subscription order of patent copies as issued $25.00

(c) Disclosure document: For filing a disclosure document $10.00

(d) Delivery box: Local delivery box rental, per annum $50.00

(e) International type search reports: For preparing an international type search report of an international type search made at the time of the first action on the merits in a national patent application $40.00

(f) [Reserved]

(g) Self-service copy charge, per page . . $0.25

(h) For recording each assignment, agreement, or other paper relating to the property in a patent or application, per property $40.00

(i) Publication in *Official Gazette*: For publication in the *Official Gazette* of a notice of the availability of an application or a patent for licensing or sale:

Each application or patent $25.00

(j) Labor charges for services, per hour or fraction thereof $40.00

(k) For items and services that the Commissioner finds may be supplied, for which fees are not specified by statute or by this part, such charges as may be determined by the Commissioner with respect to each such item or service. . . . . Actual cost

(l) For processing and retaining any application abandoned pursuant to § 1.53(f), unless the required basic filing fee (§ 1.16) has been paid. $130.00

(m) For processing each payment refused (including a check returned "unpaid") or charged back by a financial institution $50.00

(n) For handling an application in which proceedings are terminated pursuant to § 1.53(e) $130.00

(o) Marginal cost, paid in advance, for each hour of terminal session time, including print time, using Automated Patent System full-text search capabilities, prorated for the actual time used. The Commissioner may waive the payment by an individual for access to the Automated Patent System full-text search capability (APS-Text) upon a showing of need or hardship and if such waiver is in the public interest. $40.00

[Added 47 FR 41274, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b) and (l), 49 FR 553, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (a)(5) and (6) added, 50 FR 5171, Feb. 6, 1985, effective date Apr. 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; paras. (a), (b)(1), (d)-(j), (l)-(m), 54 FR 6893, Feb. 15, 1989; 54 FR 8053, Feb. 24, 1989; 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (n) added 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (o)-(q) added 54 FR 50942, Dec.11, 1989, effective Feb. 12, 1990; paras. (a)-(c), (e)-(h), (j)-(l) & (n) amended, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (p) and (q) deleted, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1), (a)(5), (a)(6), (b)(2), (b)(3), (e) and (i), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) added, 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) deleted, 59 FR 43736, Aug.25, 1994, effective Oct. 1, 1994; para. (l) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a)(1) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(1), (a)(3) and (a)(6) revised, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a)(1)(ii), (a)(6), and (j) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; paras. (l) & (n) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(6)(ii) revised, 63 FR 67578, Dec. 8, 1998, effective Dec. 8, 1998; para (m) revised, 65 FR 33455, May 24, 2000, effective July 24, 2000; para. (a)(6) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000]

§ 1.22 Fee payable in advance.

(a) Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

(b) All fees paid to the United States Patent and Trademark Office must be itemized in each individual application, patent, trademark registration file, or other proceeding in such a manner that it is clear for which purpose the fees are paid. The Office may return fees that are not itemized as required by this paragraph. The provisions of § 1.5(a) do not apply to the resubmission of fees returned pursuant to this paragraph.

[48 FR 2708, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.23 Method of payment.

(a) All payments of money required for United States Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), shall be made in U.S. dollars and in the form of a cashier's or certified check, Treasury note, national bank notes, or United States Postal Service money order. If sent in any other form, the Office may delay or cancel the credit until collection is made. Checks and money orders must be made payable to the Director of the United States Patent and Trademark Office. (Checks made payable to the Commissioner of Patents and Trademarks will continue to be

accepted.) Payments from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent to the Office by mail will be at the risk of the sender, and letters containing money should be registered with the United States Postal Service.

(b) Payments of money required for United States Patent and Trademark Office fees may also be made by credit card. Payment of a fee by credit card must specify the amount to be charged to the credit card and such other information as is necessary to process the charge, and is subject to collection of the fee. The Office will not accept a general authorization to charge fees to a credit card. If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge.

[43 FR 20462, May 11, 1978; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; revised, 65 FR 33455, May 24, 2000, effective June 5, 2000]

§ 1.24 Reserved.

[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2708, Jan. 20, 1983, effective date Feb. 27, 1983; 50 FR 31825, Aug. 6, 1985, effective Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; removed and reserved, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.25 Deposit accounts.

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc. deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account § 1.21(b)(1)). A minimum deposit of $1,000 is required for paying any fee due or in ordering any services offered by the Office. However, a minimum deposit of $300 may be paid to establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit value. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§ 1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below $1,000. For restricted subscription deposit accounts, a service charge (§ 1.21(b)(3)) will be assessed for each month that the balance at the end of the month is below $300.

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with a particular paper filed. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee. An authorization to charge fees under § 1.16 in an application submitted under § 1.494 or § 1.495 will be treated as an authorization to charge fees under § 1.492. An authorization to charge fees set forth in § 1.18 to a deposit account is subject to the provisions of § 1.311(b). An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 or § 1.913 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination.

[49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; 47 FR 41274, Sept. 17, 1982, effective Oct. 1,1982; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.26 Refunds.

(a) The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not

entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Commissioner may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) If the Commissioner decides not to institute a reexamination proceeding, for *ex parte* reexaminations filed under § 1.510, a refund of $1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of $7,970 will be made to the reexamination requester. The reexamination requester should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.

[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826 Aug. 6, 1985, effective Oct. 5, 1985; para. (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (c), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a) and (c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1,1992; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

(a) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(1) *Person.* A person, as used in paragraph (c) of this section, means any inventor or other individual (*e.g.*, an individual to whom an inventor has transferred some rights in the invention), who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

(2) *Small business concern.* A small business concern, as used in paragraph (c) of this section, means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization.

(ii) Meets the standards set forth in 13 CFR part 121 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, S.W., Washington, D.C. 20416.

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights

in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization, and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(B) An organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a));

(C) Any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or

(D) Any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (a)(3)(ii)(B) of this section or (a)(3)(ii)(C) of this section if it were located in this country.

(4) *License to a Federal agency.* (i) For persons under paragraph (a)(1) of this section, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status.

(i) For persons under paragraph (a)(1) of this section, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status.

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (a)(3) of this section, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license for the purposes of paragraphs (a)(2)(i) and (a)(3)(i) of this section.

(b) *Establishment of small entity status permits payment of reduced fees.* A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (*e.g.*, an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national

fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(e), or § 1.16(l).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.* Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under § 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by § 1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due.

(2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in § 1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

[47 FR 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 FR 43276, Sept. 30, 1982; paras. (b), (c), and (d), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.28 Refunds when small entity status is later established; how errors in small entity status are excused.

(a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.

(b) *Date of payment.*

(1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid;

(2) The date when a deficiency payment is paid in full determines the amount of deficiency that is due, pursuant to paragraph (c) of this section.

(c) *How errors in small entity status are excused.* If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error, or that through error the Office was not notified of a loss of entitlement to small entity status as required by § 1.27(g)(2), the error will be excused upon: compliance with the separate submission and itemization requirements of paragraphs (c)(1) and (c)(2) of this section, and the deficiency payment requirement of paragraph (c)(2) of this section:

(1) *Separate submission required for each application or patent.* Any paper submitted under this paragraph must be limited to the deficiency payment (all fees paid in error), required by paragraph (c)(2) of this section, for one application or one patent. Where more than one application or patent is involved, separate submissions of deficiency payments (*e.g.*, checks) and itemizations are required for each application or patent. See § 1.4(b).

(2) *Payment of deficiency owed.* The deficiency owed, resulting from the previous erroneous payment of small entity fees, must be paid.

(i) *Calculation of the deficiency owed.* The deficiency owed for each previous fee erroneously paid as a small entity is the difference between the current fee amount (for other than a small entity) on the date the deficiency is paid in full and the amount of the previous erroneous (small entity) fee payment. The total deficiency payment owed is the sum of the individual deficiency owed amounts for each fee amount previously erroneously paid as a small entity. Where a fee paid in error as a small entity was subject to a fee decrease between the time the fee was paid in error and the time the deficiency is paid in full, the deficiency owed is equal to the amount (previously) paid in error;

(ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:

(A) Each particular type of fee that was erroneously paid as a small entity, (*e.g.*, basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;

(B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;

(C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

(3) *Failure to comply with requirements.* If the requirements of paragraphs (c)(1) and (c)(2) of this section are not complied with, such failure will either: be treated as an authorization for the Office to process the deficiency payment and charge the processing fee set forth in § 1.17(i), or result in a requirement for compliance within a one-month nonextendable time period under § 1.136(a) to avoid the

return of the fee deficiency paper, at the option of the Office.

(d) *Payment of deficiency operates as notification of loss of status.* Any deficiency payment (based on a previous erroneous payment of a small entity fee) submitted under paragraph (c) of this section will be treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

[47 FR 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; para. (d)(2), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (c) revised, 62 FR 53131, Oct. 10 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

Subpart B — National Processing Provisions

PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT

§ 1.31 Applicants may be represented by a registered attorney or agent.

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases. See §§ 10.6 and 10.9 of this subchapter. The Patent and Trademark Office cannot aid in the selection of a registered attorney or agent.

[50 FR 5171, Feb. 6,1985, effective Mar. 8, 1985]

§ 1.32 [Reserved]

[Deleted 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76(b)(1) and 1.63(c)(2)) as the correspondence address. The Office will direct all notices, official letters, and other communications relating to the application to the correspondence address. The Office will not engage in double correspondence with an applicant and a registered attorney or agent, or with more than one registered attorney or agent except as deemed necessary by the Commissioner. If more than one correspondence address is specified, the Office will establish one as the correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of § 1.63 oath or declaration by any of the inventors.* If a § 1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a registered attorney or agent, any other registered practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any registered practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a § 1.63 oath or declaration has been filed by any of the inventors.* If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(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.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 10.5 and 10.11 or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

[36 FR 12617, July 2, 1971; 46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (c), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; paras. (a) & (b) revised, 62 FR 53131, Oct. 10 1997, effective Dec. 1, 1997; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.34 Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity, pursuant to § 1.31, appears in person or signs a paper in practice before the United States Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the United States Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When a registered attorney or agent shall have filed his or her power of attorney, or authorization, duly executed by the person or persons entitled to prosecute an application or a patent involved in a reexamination proceeding, pursuant to § 1.31, he or she is a principal registered attorney or agent of record in the case. A principal registered attorney or agent, so appointed, may appoint an associate registered attorney or agent who shall also then be of record.

[46 FR 29181, May 29, 1981; para. (a), 50 FR 5171, Feb. 6, 1985, effective Mar. 6, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.36 Revocation of power of attorney or authorization; withdrawal of attorney or agent.

A power of attorney or authorization of agent, pursuant to § 1.31, may be revoked at any stage in the proceedings of a case, and a registered attorney or agent may withdraw, upon application to and approval by the Commissioner. A registered attorney or agent, except an associate registered attorney or agent whose address is the same as that of the principal registered attorney or agent, will be notified of the revocation of the power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the registered attorney or agent. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by a registered attorney or

agent of the assignee' s own selection. See § 1.613(d) for withdrawal in an interference.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

WHO MAY APPLY FOR A PATENT

§ 1.41 Applicant for patent.

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in §§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(i), supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless applicant files a paper including the processing fee set forth in § 1.17(q), supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to § 1.53(b) or § 1.53(c) are filed.

(4) The inventors who submitted an application under § 1.494 or § 1.495 are the inventors in the international application designating the United States (§ 1.48(f)(1) does not apply to applications entering the national stage).

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[48 FR 2708, Jan. 20, 1983; 48 FR 4285, Jan. 31, 1983; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.42 When the inventor is dead.

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.43 When the inventor is insane or legally incapacitated.

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.44 [Reserved]

[Removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.45 Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration: neither of them alone, nor less than the entire

number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

[paras. (b) and (c), 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

§ 1.46 Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s).

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.48 Correction of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor,

the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. If the nonprovisional application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

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

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventor's being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).

(c) *Nonprovisional application—inventors added for claims to previously unclaimed subject matter.* If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. If the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

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

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(d) *Provisional application—adding omitted inventors.* If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).

(e) *Provisional application—deleting the name or names of the inventor or inventors.* If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

(3) The processing fee set forth in § 1.17(q); and

(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(f)(1) *Nonprovisional application—filing executed oath/declaration corrects inventorship.* If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 and § 1.494 or § 1.495 naming an inventive entity different from the inventive entity set forth in the international stage.

(2) *Provisional application filing cover sheet corrects inventorship.* If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.

(g) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(h) *Reissue applications not covered.* The provisions of this section do not apply to reissue applications. See §§ 1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

(i) *Correction of inventorship in patent or interference.* See § 1.324 for correction of inventorship in a patent, and § 1.634 for correction of inventorship in an interference.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (a), 57 FR 56446, Nov. 30, 1992, effective Jan. 4, 1993; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

THE APPLICATION

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) An oath or declaration, see §§ 1.63 and 1.68;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, see § 1.16.

(c) A complete provisional application filed under § 1.53(c) comprises:

(1) A cover sheet identifying:

(i) The application as a provisional application,

(ii) The name or names of the inventor or inventors, (see § 1.41(a)(2)),

(iii) The residence of each named inventor,

(iv) The title of the invention,

(v) The name and registration number of the attorney or agent (if applicable),

(vi) The docket number used by the person filing the application to identify the application (if applicable),

(vii) The correspondence address, and

(viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(2) A specification as prescribed by the first paragraph of 35 U.S.C. 112, see § 1.71;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, see § 1.16.

(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See § 1.97 and § 1.98. No information disclosure statement may be filed in a provisional application.

[42 FR 5593, Jan. 28, 1977; paras. (a) and (c), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (b), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) & (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.52 Language, paper, writing, margins, compact disc specifications.

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

(1) All papers, other than drawings, that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding must be on sheets of paper that are the same size, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the preprinted information on forms provided by the Office, or to the copy of the patent submitted in double column format as the specification in a reissue application or request for reexamination.

(4) See § 1.58 for chemical and mathematical formulae and tables, and § 1.84 for drawings.

(5) If papers that do not comply with paragraph (a)(1) of this section are submitted as part of the permanent record, other than the drawings, applicant, or the patent owner, or the requester in a reexamination proceeding, will be notified and must provide substitute papers that comply with paragraph (a)(1) of this section within a set time period.

(b) *The application (specification, including the claims, drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.*

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier) lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate sheet (§ 1.75(h)).

(4) The abstract must commence on a separate sheet or be submitted as the first page of the patent in a reissue application or reexamination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered

consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (*e.g.*, [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (*e.g.*, tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(7) If papers that do not comply with paragraphs (b)(1) through (b)(5) of this section are submitted as part of the application, applicant, or patent owner, or requester in a reexamination proceeding, will be notified and the applicant, patent owner or requester in a reexamination proceeding must provide substitute papers that comply with paragraphs (b)(1) through (b)(5) of this section within a set time period.

(c)(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

(2) After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(3) Notwithstanding the provisions of this paragraph, if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.

(d) A nonprovisional or provisional application may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in § 1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See § 1.78(a) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

(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.

[43 FR 20462, May 11, 1978; paras. (a) and (d), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; para. (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) and (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a), (c) & (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000); paras. (a), (b), and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (d) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.53 Application number, filing date, and completion of application.

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section

or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements - Provisional application*. The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section;

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or

(iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C.112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(e) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date

accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under this paragraph (c).

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a)(4) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is either:

(A) A utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b); or

(B) A design application that is complete as defined by § 1.51(b); or

(C) The national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000, and is in compliance with 35 U.S.C. 371; and

(ii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in § 1.16; and

(ii) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application.

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

(9) Envelopes containing only requests and fees for filing an application under this paragraph should be marked "Box CPA." Requests for an application under this paragraph filed by facsimile transmission should be clearly marked "Box CPA."

(10) See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing—nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the filing fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or

§ 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file an oath or declaration, and pay the surcharge required by § 1.16(e) to avoid abandonment.

(3) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section.

(4) See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay one of the basic filing or the processing and retention fees (§ 1.21(l)) during the pendency of the application, the Office may dispose of the application.

(g) *Completion of application subsequent to filing—provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(k)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(l) to avoid abandonment.

(3) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(h) *Subsequent treatment of application - Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; paras. (c) and (d), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; paras. (b) and (c), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 63 FR 5734, Feb. 4, 1998, effective Feb. 4, 1998 (adopted as final, 63 FR 36184, Jul. 2, 1998); paras. (c)(3), (c)(4) and (d) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (paras. (c)(4) and (d) adopted as final, 65 FR 50092, Aug. 16, 2000); para. (c)(3) revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000; paras. (c)(1), (c)(2), (d)(4), (e)(2), (f), and (g) revised and para. (d)(10) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (c)(4) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.54 Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise, a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53(f) and (g) with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt, unless the application is an application filed under § 1.53(d).

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

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

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323

(3) When the application becomes involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section.

(4) An English language translation of a non-English language foreign application is not required except when the application is involved in an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

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

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

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

[para. (b), 48 FR 41275, Sept. 17, 1982, effective Oct. 1 1982; 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983;

para. (b), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) revised, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 60 FR 20195, Apr.25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised and para. (c) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a) and (c) corrected, 65 FR 66502, Nov. 6, 2000, effective Nov. 29, 2000]

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or

PCT international filing date of the continuation-in-part application.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.57 [Reserved]

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(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.

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (*e.g.*, elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

[43 FR 20463, May 11, 1978; para. (b) removed and reserved, para. (c) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.59 Expungement of information or copy of papers in application file.

(a)(1)Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.60 [Reserved]

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; paras. (a), (b) and (c), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; paras. (b) and (c) revised, para. (d) added, 57 FR 56446, Nov. 30, 1992, effective Jan. 4, 1993; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8,

1995; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.61 [Reserved]

(Editor's note: Substance moved to § 1.494)

[52 FR 20046, May 28, 1987, effective July 1, 1987]

§ 1.62 [Reserved]

[47 FR 47244, Oct. 25, 1982, added effective Feb. 27, 1983; 48 FR 2710, Jan. 20, 1983, effective date Feb. 27, 1983; paras. (a) and (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a), (c), and (h), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985; paras. (e) and (j), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a) and (e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (f) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

OATH OR DECLARATION

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, *i.e.*, signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, *i.e.*, understand the document that the person is signing;

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) Identify the country of citizenship of each inventor; and

(4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor; and

(2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

(d)(1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

(i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;

(ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney (or authorization of agent) or correspondence address was changed during the prosecution of the prior application, the change in power of attorney (or authorization of agent) or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney (or authorization of agent) or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983; 48 FR 4285, Jan. 31, 1983; paras. (b)(3) and (d), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a) & (d) revised, para. (e) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.64 Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

[48 FR 2711, Jan. 20, 1983, added effective Feb. 27, 1983; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.66 Officers authorized to administer oaths.

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982]

§ 1.67 Supplemental oath or declaration.

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (*e.g.*, to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c) [Reserved]

[48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983; para. (c) added, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (c) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.68 Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned 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.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

§ 1.69 Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by an English translation together with a statement that the translation is accurate,

except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

[42 FR 5594, Jan. 28, 1977; para. (b), 48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.70 [Reserved]

(Editor's note: Substance moved to § 1.497)

[52 FR 20046, May 28, 1987, effective July 1, 1987]

SPECIFICATION

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe"(17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

> A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

[paras. (d) and (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; para. (d), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

§ 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet (§ 1.76), the title of the invention should appear as a heading on the first page of the specification.

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract will not be used for interpreting the scope of the claims.

[31 FR 12922, Oct. 4, 1966; 43 FR 20464, May 11, 1978; para. (b) amended, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.73 Summary of the invention.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

§ 1.74 Reference to drawings.

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter).

§ 1.75 Claim(s).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as "wherein the improvement comprises," and

(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (g) amended, paras. (h) and (i) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

§ 1.76 Application data sheet.

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be voluntarily sub-

mitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Applicant information.* This information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor.

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

(3) *Application information.* This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the suggested classification and Technology Center should be based upon the disclosure.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney or authorization of agent in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney or authorization of agent in the application (see § 1.34(b)).

(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(4), and need not otherwise be made part of the specification.

(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a).

(7) *Assignee information* This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) *Supplemental application data sheets* Supplemental application data sheets:

(1) May be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet, or an oath or declaration under § 1.63 or § 1.67, except that inventorship changes are governed by § 1.48, correspondence changes are governed by § 1.33(a), and citizenship changes are governed by § 1.63 or § 1.67; and

(2) Should identify the information that is being changed (added, deleted, or modified) and therefore need not contain all the previously submitted information that has not changed.

(d) *Inconsistencies between application data sheet and oath or declaration.* For inconsistencies between information that is supplied by both an application data sheet under this section and by an oath or declaration under §§ 1.63 and 1.67:

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, or by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);

(4) The Office will initially capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application data sheet containing errors may be recaptured by a request therefor and the submission of a supplemental application data sheet, an oath or declaration under § 1.63 or § 1.67, or a letter pursuant to § 1.33(b).

[Added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(7) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[43 FR 20464, May 11, 1978; 46 FR 2612, Jan. 12, 1981; paras. (h) and (i), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

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

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

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

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

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

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

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. This reference must be submitted during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. If the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit for such application is claimed in the application data sheet). The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross references to other related applications may be made when appropriate (see § 1.14). Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and this paragraph is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior application. The time period set forth in this paragraph does not apply to an application for a design patent.

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

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

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

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

(5) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number), and, if the provisional application is

filed in a language other than English, an English language translation of the non-English language provisional application and a statement that the translation is accurate. This reference and English language translation of a non-English language provisional application must be submitted during the pendency of the nonprovisional application, and within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior provisional application. This time period is not extendable. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following the title. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference and English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and this paragraph is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior provisional application.

(6) If the reference or English language translation of a non-English language provisional application required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the nonprovisional application if the reference identifying the prior application by provisional application number and any English language translation of a non-English language provisional application were unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application must be accompanied by:

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

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

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and, if not, indicate which named inventor is the prior inventor.

[36 FR 7312, Apr. 17, 1971; 49 FR 555, Jan. 4, 1984; paras. (a), (c) & (d), 50 FR 9380, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; para. (a) revised 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a)(1) and (a)(2) revised and paras. (a)(3) and (a)(4) added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (c) revised and para. (d) deleted, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(3) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)(2), (a)(4), and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a)(2), (a)(3), and (a)(4) revised and paras. (a)(5) and (a)(6) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.79 Reservation clauses not permitted.

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

THE DRAWINGS

§ 1.81 Drawings required in patent application.

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality

copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flowsheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

[43 FR 4015, Jan. 31, 1978; para. (a), 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989]

§ 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).

[31 FR 12923, Oct. 4, 1966; 43 FR 4015, Jan. 31, 1978; paras. (a) and (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

§ 1.84 Standards for drawings.

(a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink*. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color*. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility or design patent application or the subject matter of a statutory invention registration. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13), or in an application, or copy thereof, submitted under the Office electronic filing system. The Office will accept color drawings in utility or design patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(h);

(ii) Three (3) sets of color drawings;

(iii) A black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing; and

(iv) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

> The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) *Photographs.*—

(1) *Black and white.* Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (*e.g.*, immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs.* Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings.* 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.

(d) *Graphic forms in drawings.* Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two cater-corner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

(h) *Views.* The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) *Exploded views.* Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) *Partial views.* When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) *Sectional views.* The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) *Alternate position.* A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) *Modified forms.* Modified forms of construction must be shown in separate views.

(i) *Arrangement of views.* One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) *Front page view.* The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

(k) *Scale.* The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale 1/2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(l) *Character of lines, numbers, and letters.* All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) *Shading.* The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) *Symbols.* Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) *Numbers, letters, and reference characters.*

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, *e.g.*, encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) *Arrows.* Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of 32 cm. to 64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "*M* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.*

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) *Security markings.* Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) *Corrections.* Any corrections on drawings submitted to the Office must be durable and permanent.

(x) *Holes.* No holes should be made by applicant in the drawing sheets.

(y) *Types of drawings.* See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.

[24 FR 10332, Dec. 22, 1959; 31 FR 12923, Oct. 4, 1966; 36 FR 9775, May 28, 1971; 43 FR 20464, May 11, 1978; 45 FR 73657, Nov. 6,1980; paras. (a), (b), (i), (j), and (l) amended, paras. (n), (o), and (p) added, 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989; revised, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; paras. (c), (f), (g), and (x) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (a)(2)(i), (b), (c) & (g) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a), (b), (c), (j), (k), (o), and (x) revised, and para. (y) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2), (e), and (j) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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).

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.88 [Reserved]

[Deleted, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

MODELS, EXHIBITS, SPECIMENS

§ 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.

[Revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(3)(i) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.92 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 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.

§ 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 is 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.

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

§ 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.

[46 FR 2612, Jan. 12, 1981; para. (b)(1), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000]

INFORMATION DISCLOSURE STATEMENT

§ 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.

[48 FR 2712, Jan. 20, 1983, effective date Feb. 27, 1983; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; paras. (a)- (d) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; paras. (c)-(e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a) through (e) and (i) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 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.

[42 FR 5594, Jan. 28, 1977; para. (a) 48 FR 2712, Jan. 20, 1983, effective date Feb. 27, 1983; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[48 FR 2712, Jan. 20, 1983; effective Feb. 27, 1983; removed and reserved, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (f) corrected, 65 FR 66502, Nov. 6, 2000, effective Nov. 29, 2000]

EXAMINATION OF APPLICATIONS

§ 1.101 [Reserved]

[29 FR 13470, Sept. 30, 1964; para. (a), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 52 FR 20046, May 28, 1987, effective July 1, 1987; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 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).

[24 FR 10332, Dec. 22, 1959; paras. (a), (c), and (d), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (d) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 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.

[24 FR 10332, Dec. 22, 11959; 33 FR 5624, Apr. 11, 1968; paras. (a) and (b), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (d), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000; paras. (d) through (f) redesignated as (e) through (g) and para. (d) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[43 FR 20465, May 11, 1978; 46 FR 29182, May 29, 1981; para. (d), 47 FR 41276, Sept. 17, 1982, effective date Oct. 1, 1982; para. (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; para. (e), 57 FR 29642, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c)(4) revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a)(2) and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(5) removed and para. (d)(1) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec.1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.106 [Reserved]

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (c) added, 47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (d) and (e), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.107 [Reserved]

[46 FR 29182, May 29, 1981; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.108 [Reserved]

[50 FR 9381, Mar. 7, 1985, effective May 8, 1985; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.109 [Reserved]

[46 FR 29182, May 29, 1981; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.110 Inventorship and date of invention of the subject matter of individual claims.

When more than one inventor is named in an application or patent, the Patent and Trademark Office, when necessary for purposes of an Office proceeding, may require an applicant, patentee, or owner to identify the inventive entity of the subject matter of each claim in the application or patent. Where appropriate, the invention dates of the subject matter of each claim and the ownership of the subject matter on the date of invention may be required of the applicant, patentee or owner. See also §§ 1.78(c) and 1.130.

[50 FR 9381, Mar. 7, 1985, effective date May 8, 1985; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

ACTION BY APPLICANT AND FURTHER CONSIDERATION

§ 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.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 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).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 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.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 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.

[Added 65 FR 14865, Mar. 20, 2000, effective May 29, 2000; revised 65 FR 50092, Aug. 16, 2000]

AMENDMENTS

§ 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.

[46 FR 29183, May 29, 1981; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 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.

[24 FR 10332, Dec. 22, 1959; 46 FR 29183, May 29, 1981; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (b) and (d) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.117 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.118 [Reserved]

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.119 [Reserved]

[32 FR 13583, Sept. 28, 1967; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 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.

[32 FR 13583, Sept. 28, 1967; 46 FR 29183, May 29, 1981; para. (e), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.122 [Reserved]

[24 FR 10332, Dec. 22, 1959; para. (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.123 [Reserved]

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.124 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

(1) A statement that the substitute specification includes no new matter; and

(2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals

so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.127 Petition from refusal to admit amendment.

From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Commissioner under § 1.181.

TRANSITIONAL PROVISIONS

§ 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.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years 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 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made

prior to the notice, and pay the fee set forth in 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

AFFIDAVITS OVERCOMING REJECTIONS

§ 1.130 Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

[Added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a), 50 FR 9381, Mar. 7, 1985, effective May 8, 1985; 50 FR 11366, Mar. 21, 1985; 53 FR 23733, June 23, 1988, effective Sept. 12, 1988; para. (a)(1) revised and para. (a)(2) added, 60 FR 21043, May 1, 1995, effective May 31, 1995; para. (a) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (a) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

INTERVIEWS

§ 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.

[Para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

TIME FOR REPLY BY APPLICANT; ABANDONMENT OF APPLICATION

§ 1.134 Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 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.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 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).

[47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 54 FR 29551, July 13, 1989, effective Aug. 20, 1989; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a)(2) and (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (c) revised, 66 FR 21090, Apr. 27, 2001, effective May 29, 2001]

§ 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 disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:

(i) The period of abandonment of the application; or

(ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.

(2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under

35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.

(3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, 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.

[47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 FR 44277, Aug. 20,1993, effective Sept. 20, 1993; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[47 FR 47244, Oct. 25, 1982, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised and para. (c) added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.139 [Reserved]

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

JOINDER OF INVENTIONS IN ONE APPLICATION; RESTRICTION

§ 1.141 Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

[52 FR 20046, May 28, 1987, effective July 1, 1987]

§ 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

[Para (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.143 Reconsideration of requirement.

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

§ 1.144 Petition from requirement for restriction.

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

[Revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

§ 1.146 Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and

claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

[43 FR 20465, May 11, 1978; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

DESIGN PATENTS

§ 1.151 Rules applicable.

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

§ 1.152 Design drawings.

The design must be represented by a drawing that complies with the requirements of § 1.84 and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design. Appropriate and adequate surface shading should be used to show the character or contour of the surfaces represented. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Broken lines may be used to show visible environmental structure, but may not be used to show hidden planes and surfaces that cannot be seen through opaque materials. Alternate positions of a design component, illustrated by full and broken lines in the same view are not permitted in a design drawing. Photographs and ink drawings are not permitted to be combined as formal drawings in one application. Photographs submitted in lieu of ink drawings in design patent applications must not disclose environmental structure but must be limited to the design claimed for the article.

[53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.153 Title, description and claim, oath or declaration.

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; para. (b), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.154 Arrangement of application elements in a design application.

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

(1) Design application transmittal form.
(2) Fee transmittal form.
(3) Application data sheet (see § 1.76).
(4) Specification.
(5) Drawings or photographs.
(6) Executed oath or declaration (see § 1.153(b)).

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

(1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.

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

(3) Statement regarding federally sponsored research or development.

(4) Description of the figure or figures of the drawing.

(5) Feature description.

(6) A single claim.

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

[24 FR 10332, Dec. 22, 1959, para. (e), 48 FR 2713, Jan. 20, 1983, effective date Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (a)(3)

revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.155 Expedited examination of design applications.

(a) The applicant may request that the Office expedite the examination of a design application. To qualify for expedited examination:

(1) The application must include drawings in compliance with § 1.84;

(2) The applicant must have conducted a preexamination search; and

(3) The applicant must file a request for expedited examination including:

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

(ii) A statement that a preexamination search was conducted. The statement must also indicate the field of search and include an information disclosure statement in compliance with § 1.98.

(b) The Office will not examine an application that is not in condition for examination (*e.g*, missing basic filing fee) even if the applicant files a request for expedited examination under this section.

[47 FR 41277, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b)-(d) amended, paras. (e) and (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

PLANT PATENTS

§ 1.161 Rules applicable.

The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

§ 1.162 Applicant, oath or declaration.

The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43, and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has asexually reproduced the plant. Where the plant is a newly found plant the oath or declaration must also state that it was found in a cultivated area.

[48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983]

§ 1.163 Specification and arrangement of application elements in a plant application.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

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

(1) Plant application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings (in duplicate).

(6) Executed oath or declaration (§ 1.162).

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

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.

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

(3) Statement regarding federally sponsored research or development.

(4) Latin name of the genus and species of the plant claimed.

(5) Variety denomination.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the drawing.

(9) Detailed botanical description.

(10) A single claim.

(11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

[24 FR 10332, Dec. 22, 1959; para. (b), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (c) and (d) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.164 Claim.

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

§ 1.165 Plant Drawings.

(a) Plant patent drawings should be artistically and competently executed and must comply with the requirements of § 1.84. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs and a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

[24 FR 10332, Dec. 22, 1959; para. (b), 47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (b) amended, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993; para. (b) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.166 Specimens.

The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

§ 1.167 Examination.

Applications may be submitted by the Patent and Trademark Office to the Department of Agriculture for study and report.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

REISSUES

§ 1.171 Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 54 FR 6893, Feb. 17, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.172 Applicants, assignees.

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.173 Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch 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 approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on

compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* 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.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

[Revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.174 [Reserved.]

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.175 Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

[24 FR 10332, Dec. 22, 1959; 29 FR 18503, Dec. 29, 1964; 34 FR 18857, Nov. 26, 1969; para. (a), 47 FR 21752, May 19, 1982, effective July 1,1982; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a)(7), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.176 Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

[42 FR 5595, Jan. 28, 1977; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.177 Issuance of multiple reissue patents.

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for a reissue should be accompanied by either an offer to surrender the original patent, or the original patent itself, or if the original is lost or inaccessible, by a statement to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue application is refused, the original patent, if surrendered, will be returned to applicant upon request.

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.179 Notice of reissue application.

When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

PETITIONS AND ACTION BY THE COMMISSIONER

§ 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.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(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.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

[24 FR 10332, Dec. 22, 1959; 34 FR 18857, Nov. 26, 1969; paras. (d) and (g), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982]

§ 1.184 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, and every owner of a patent under *ex parte* reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex*

parte reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

(b) The signature requirement of § 1.33 does not apply to a notice of appeal filed under this section.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in §§ 1.193, 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136(b) for patent applications or § 1.550(c) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Commissioner may *sua sponte* order the application remanded to the examiner.

[46 FR 29183, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (d), 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (d) amended, para. (e) added, 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; para. (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) and (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.192 Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

(4) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review.

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing

out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) Describe the subject matter defined by each of the rejected claims,

(B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

[36 FR 5850, Mar. 30, 1971; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; 53 FR 23734, June 23, 1988, effective Sept. 12, 1988; para. (a), (c), and (d) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a)-(c) revised, 60 FR 14488, Mar 17, 1995, effective Apr. 21, 1995; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.193 Examiner's answer and reply brief.

(a)(1)The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as

appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

[24 FR 10332, Dec. 22, 1959; 34 FR 18858, Nov.26, 1969; para. (c), 47 FR 21752, May 19, 1982, added effective July 1, 1982; para. (b), 50 FR 9382, Mar. 7, 1985, effective May 8, 1985; 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (c) deleted, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b)(1) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.194 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. If the Board decides that a hearing is not necessary, the Board will so notify appellant.

[42 FR 5595, Jan. 28, 1977; paras. (b) & (c), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (b) revised 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.195 Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

[34 FR 18858, Nov. 26, 1969]

§ 1.196 Decision by the Board of Patent Appeals and Interferences.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner or remand the application to the examiner for further consideration. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal pursuant to §§ 1.191 through 1.195 to the Board of Patent Appeals and Interferences.

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for rehearing must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. Where request for such rehearing is made, the Board of Patent Appeals and Interferences shall rehear the new ground of rejection and, if necessary, render a new decision which shall include all grounds of rejection upon which a patent is refused. The decision on rehearing is deemed to incorporate the earlier decision for purposes of appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision.

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding on the examiner in the absence of new references or grounds of rejection.

(d) The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

(e) Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

(f) See § 1.136(b) for extensions of time to take action under this section in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding.

[24 FR 10332, Dec. 12, 1959; 49 FR 29183, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 12, 1985; para. (b) revised, 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; paras. (a), (b) & (d) amended, paras. (e) & (f) added, 54 FR 29552, July 13, 1989, effective Aug. 20, 1989; para. (f) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (b) & (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.197 Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the

application may require, to carry into effect the decision.

(b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See § 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

(c) Termination of proceedings. Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except: (1) Where claims stand allowed in an application or (2) Where the nature of the decision requires further action by the examiner. The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is received by the Office. A civil action is terminated when the time to appeal the judgment expires.

[46 FR 29184, May 29, 1981; para. (a), 47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a) and (b), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; paras. (b) and (c), 54 FR 29552, July 13, 1989, effective Aug. 20, 1989; para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; paras. (a) & (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.198 Reopening after decision.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[49 FR 48416, Dec. 12, 1984, effective date Feb. 11, 1985; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000)]

PUBLICATION OF APPLICATIONS

§ 1.211 Publication of applications.

(a) Each U.S. national application for patent filed in the Office under 35 U.S.C. 111(a) and each international application in compliance with 35 U.S.C. 371 will be published promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code, unless:

(1) The application is recognized by the Office as no longer pending;

(2) The application is national security classified (see § 5.2(c)), subject to a secrecy order under 35 U.S.C. 181, or under national security review;

(3) The application has issued as a patent in sufficient time to be removed from the publication process; or

(4) The application was filed with a nonpublication request in compliance with § 1.213(a).

(b) Provisional applications under 35 U.S.C. 111(b) shall not be published, and design applications under 35 U.S.C. chapter 16 and reissue applications under 35 U.S.C. chapter 25 shall not be published under this section.

(c) An application filed under 35 U.S.C. 111(a) will not be published until it includes the basic filing fee (§ 1.16(a) or 1.16(g)), any English translation required by § 1.52(d), and an executed oath or declaration under § 1.63. The Office may delay publishing any application until it includes a specification having papers in compliance with § 1.52 and an abstract (§ 1.72(b)), drawings in compliance with § 1.84, and a sequence listing in compliance with §§ 1.821 through 1.825 (if applicable), and until any petition under § 1.47 is granted.

(d) The Office may refuse to publish an application, or to include a portion of an application in the patent application publication (§ 1.215), if publication of the application or portion thereof would violate Federal or state law, or if the application or portion thereof contains offensive or disparaging material.

(e) The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the notice of allowance under § 1.311 will also include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.213 Nonpublication request.

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with § 1.33(b).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the application papers deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application, and any application papers or drawings submitted in reply to a preexamination notice requiring a title and abstract in compliance with § 1.72, application papers in compliance with § 1.52, drawings in compliance with § 1.84, or a sequence listing in compliance with §§ 1.821 through 1.825, except as otherwise provided in this section. The patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to paragraph (c) of this section.

(b) If applicant wants the patent application publication to include assignee information, the applicant must include the assignee information on the application transmittal sheet or the application data sheet (§ 1.76). Assignee information may not be included on the patent application publication unless this information is provided on the application transmittal sheet or application data sheet included with the application on filing. Providing this information on the application transmittal sheet or the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended during examination, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the actual filing date of the application or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

(d) If the copy of the application submitted pursuant to paragraph (c) of this section does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in paragraph (a) of this section. If, however, the Office has not started the publication process, the Office may use an untimely filed copy of the application supplied by the applicant under paragraph (c) of this section in creating the patent application publication.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.217 Publication of a redacted copy of an application.

(a) If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the Office, the applicant may submit a redacted copy of the application filed in the Office for publication, eliminating any part or description of the invention that is not also contained in any of the corresponding applications filed in a foreign country. The Office will publish the application as provided in § 1.215(a) unless the applicant files a redacted copy of the application in compliance with this section within sixteen months after the earliest filing date for which a benefit is sought under title 35, United States Code.

(b) The redacted copy of the application must be submitted in compliance with the Office electronic filing system requirements. The title of the invention in the redacted copy of the application must correspond to the title of the application at the time the redacted copy of the application is submitted to the Office. If the redacted copy of the application does not comply with the Office electronic filing system requirements, the Office will publish the application as provided in § 1.215(a).

(c) The applicant must also concurrently submit in paper (§ 1.52(a)) to be filed in the application:

(1) A certified copy of each foreign-filed application that corresponds to the application for which a redacted copy is submitted;

(2) A translation of each such foreign-filed application that is in a language other than English, and a statement that the translation is accurate;

(3) A marked-up copy of the application showing the redactions in brackets; and

(4) A certification that the redacted copy of the application eliminates only the part or description of the invention that is not contained in any application filed in a foreign country, directly or through a multilateral international agreement, that corresponds to the application filed in the Office.

(d) The Office will provide a copy of the complete file wrapper and contents of an application for which a redacted copy was submitted under this section to any person upon written request pursuant to § 1.14(c)(2), unless applicant complies with the requirements of paragraphs (d)(1), (d)(2), and (d)(3) of this section.

(1) Applicant must accompany the submission required by paragraph (c) of this section with the following:

(i) A copy of any Office correspondence previously received by applicant including any desired redactions, and a second copy of all Office correspondence previously received by applicant showing the redacted material in brackets; and

(ii) A copy of each submission previously filed by the applicant including any desired redactions, and a second copy of each submission previously filed by the applicant showing the redacted material in brackets.

(2) In addition to providing the submission required by paragraphs (c) and (d)(1) of this section, applicant must:

(i) Within one month of the date of mailing of any correspondence from the Office, file a copy of such Office correspondence including any desired redactions, and a second copy of such Office correspondence showing the redacted material in brackets; and

(ii) With each submission by the applicant, include a copy of such submission including any desired redactions, and a second copy of such submission showing the redacted material in brackets.

(3) Each submission under paragraph (d)(1) or (d)(2) of this paragraph must also be accompanied by the processing fee set forth in § 1.17(i) and a certification that the redactions are limited to the elimination of material that is relevant only to the part or description of the invention that was not contained in the redacted copy of the application submitted for publication.

(e) The provisions of § 1.8 do not apply to the time periods set forth in this section.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.219 Early publication.

Applications that will be published under § 1.211 may be published earlier than as set forth in § 1.211(a) at the request of the applicant. Any request for early publication must be accompanied by the publication fee set forth in § 1.18(d). If the applicant does not submit a copy of the application in compliance with the Office electronic filing system requirements pursuant to § 1.215(c), the Office will publish the application as provided in § 1.215(a). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.221 Voluntary publication or republication of patent application publication.

(a) Any request for publication of an application filed before, but pending on, November 29, 2000, and any request for republication of an application previously published under § 1.211, must include a copy of the application in compliance with the Office electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i). If the request does not comply with the requirements of this paragraph or the copy of the application does not comply with the Office electronic filing system requirements, the Office will not publish the application and will refund the publication fee.

(b) The Office will grant a request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section only when the Office makes a material mistake which is apparent from Office records. Any request for a corrected or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

MISCELLANEOUS PROVISIONS

§ 1.248 Service of papers; manner of service; proof of service in cases other than interferences.

(a) Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served with someone in his employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;

(4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;

(5) Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

(b) Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

(1) An acknowledgement of service by or on behalf of the person served or

(2) A statement signed by the attorney or agent containing the information required by this section.

(c) See § 1.646 for service of papers in interferences.

[46 FR 29184, May 29, 1981; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

§ 1.251 Unlocatable file.

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

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

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

(ii) A list of such correspondence; and

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

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

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

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

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

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

[Added, 65 FR 69446, Nov. 17, 2000, effective Nov. 17, 2000]

PROTESTS AND PUBLIC USE PROCEEDINGS

§ 1.291 Protests by the public against pending applications.

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

(1) The protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and

(2) The protest is either served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(b) Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office. A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if the application is still pending when the pro-

test and application file are brought before the examiner and it includes:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each listed item;

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

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

(c) A member of the public filing a protest in an application under paragraph (a) of this section will not receive any communications from the Office relating to the protest, other than the return of a self-addressed postcard which the member of the public may include with the protest in order to receive an acknowledgment by the Office that the protest has been received. In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. The limited involvement of the member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.

[47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (a) and (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) and (b) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(1) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.292 Public use proceedings.

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 through 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:

(1) The petition is accompanied by the fee set forth in § 1.17(j);

(2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a preliminary motion under § 1.633(a).

[42 FR 5595, Jan. 28, 1977; para. (a), 47 FR 41279, Sept. 17, 1982; paras. (a) and (c), 49 FR 48416, Dec. 12, 1984, effective Feb. 12, 1985; paras. (a) and (b) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b)(3) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.293 Statutory invention registration.

(a) An applicant for an original patent may request, at any time during the pendency of applicant's pending complete application, that the specification and drawings be published as a statutory invention registration. Any such request must be signed by (1) the applicant and any assignee of record or (2) an attorney or agent of record in the application.

(b) Any request for publication of a statutory invention registration must include the following parts:

(1) A waiver of the applicant's right to receive a patent on the invention claimed effective upon the date of publication of the statutory invention registration;

(2) The required fee for filing a request for publication of a statutory invention registration as provided for in § 1.17(n) or (o);

(3) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112; and

(4) A statement that, in the opinion of the requester, the application to which the request is directed complies with the formal requirements of this part for printing as a patent.

(c) A waiver filed with a request for a statutory invention registration will be effective, upon publication of the statutory invention registration, to waive the inventor's right to receive a patent on the invention claimed in the statutory invention registration, in any application for an original patent which is pending on, or filed after, the date of publication of the statutory invention registration. A waiver filed with a request for a statutory invention registration will not affect the rights of any other inventor even if the subject matter of the statutory invention registration and an application of another inventor are commonly owned. A waiver filed with a request for a statutory invention registration will not affect any rights in a patent to the inventor which issued prior to the date of publication of the statutory invention registration unless a reissue application is filed seeking to enlarge the scope of the claims of the patent. See also § 1.104(c)(5).

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.294 Examination of request for publication of a statutory invention registration and patent application to which the request is directed.

(a) Any request for a statutory invention registration will be examined to determine if the requirements of § 1.293 have been met. The application to which the request is directed will be examined to determine (1) if the subject matter of the application is appropriate for publication, (2) if the requirements for publication are met, and (3) if the requirements of 35 U.S.C. 112 and § 1.293 of this part are met.

(b) Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the requirements of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for reply established pursuant to this section are subject to the extension of time provisions of § 1.136. After reply by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

(c) If the examination pursuant to this section results in approval of the request for a statutory invention registration the applicant will be notified of the intent to publish a statutory invention registration.

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.295 Review of decision finally refusing to publish a statutory invention registration.

(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Commissioner accompanied by the fee set forth in § 1.17(h) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 1.191. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

[50 FR 9382, Mar. 7, 1985, effective May 8, 1985]

§ 1.296 Withdrawal of request for publication of statutory invention registration.

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date of the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of $130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).

[50 FR 9382, Mar. 7, 1985, effective date May 8, 1985; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991]

§ 1.297 Publication of statutory invention registration.

(a) If the request for a statutory invention registration is approved the statutory invention registration will be published. The statutory invention registration will be mailed to the requester at the correspondence address as provided for in § 1.33(a). A notice of the publication of each statutory invention registration will be published in the *Official Gazette*.

(b) Each statutory invention registration published will include a statement relating to the attributes of a statutory invention registration. The statement will read as follows:

> A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforceable attributes of a patent. No article or advertisement or the like may use the term patent, or any term suggestive of a patent, when referring to a statutory invention registration. For more specific information on the rights associated with a statutory invention registration see 35 U.S.C. 157.

[50 FR 9382, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]

REVIEW OF PATENT AND TRADEMARK OFFICE DECISIONS BY COURT

§ 1.301 Appeal to U.S. Court of Appeals for the Federal Circuit.

Any applicant or any owner of a patent involved in any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U.S. Patent and Trademark Office, file a written notice of appeal directed to the Commissioner (see §§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

[47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; 54 FR 29552, July 13, 1989, effective Aug. 20, 1989; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 20001]

§ 1.302 Notice of appeal.

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

(c) A notice of appeal, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

[24 FR 10332, Dec. 22, 1959; para. (a), 47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; para. (c) added, 53 FR 16414, May 8, 1988]

§ 1.303 Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case or an owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (§ 1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, the notice of election must be served as provided in § 1.646.

(d) For an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States on or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under § 1.913, no remedy by civil action under 35 U.S.C. 145 is available.

[47 FR 47381, Oct. 26, 1982, effective Oct. 26, 1982; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (c), 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (b) revised and para. (d) added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.304 Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b), § 1.658(b), or § 1.979(a), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences the time for filing a cross-appeal or cross-action expires:

(i) Fourteen days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of § 1.136, § 1.550(c), § 1.956, or § 1.645(a) or (b).

(3) The Commissioner may extend the time for filing an appeal or commencing a civil action:

(i) For good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or

(ii) Upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

(b) The times specified in this section in days are calendar days. The time specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 electing to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141. The time for filing a cross-action

expires 14 days after service of the summons and complaint.

[41 FR 758, Jan. 5, 1976; para. (a) and (c), 47 FR 47382, Oct. 26, 1982; para. (a), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; para. (a) 49 FR Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; paras. (a) and (c) revised 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a)(1) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)(1) and (a)(2) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

ALLOWANCE AND ISSUE OF PATENT

§ 1.311 Notice of Allowance.

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

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees:

(1) An incorrect issue fee; or

(2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

[47 FR 41279, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 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.

[Para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000)]

§ 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

(1) A mistake on the part of the Office;

(2) A violation of § 1.56 or illegality in the application;

(3) Unpatentability of one or more claims; or

(4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

[47 FR 41280, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (b), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (paras. (b), (c)(1), (c)(3) and (d) adopted as final, 65 FR 50092, Aug. 16, 2000); paras. (a) and c(2) revised, 65 FR 50092, Aug. 16, 2000, effective Aug. 16, 2000)]

§ 1.314 Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuances of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

[47 FR 41280, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.315 Delivery of patent.

The patent will be delivered or mailed upon issuance to the correspondence address of record. See § 1.33(a).

[Revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

§ 1.316 Application abandoned for failure to pay issue fee.

If the issue fee is not paid within three months from the date of the notice of allowance, the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

[47 FR 41280, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b)-(d) amended, paras. (e) and (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.317 Lapsed patents; delayed payment of balance of issue fee.

If the issue fee paid is the amount specified in the notice of allowance, but a higher amount is required at the time the issue fee is paid, any remaining balance of the issue fee is to be paid within three months from the date of notice thereof and, if not paid, the patent will lapse at the termination of the three-month period.

[47 FR 41280, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (a)-(d) amended, paras. (e) & (f) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.318 [Reserved]

[43 FR 20465, May 11, 1978; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

DISCLAIMER

§ 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the *Official Gazette* and attached to the printed copies of the specification. The

disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed by the patentee, or an attorney or agent of record;

(2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;

(3) State the present extent of patentee's ownership interest in the patent; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

(1) Be signed:

(i) By the applicant, or

(ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or

(iii) If there is an assignee of record of the entire interest, by such assignee, or

(iv) By an attorney or agent of record;

(2) Specify the portion of the term of the patent being disclaimed;

(3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and

(4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (c) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

CORRECTION OF ERRORS IN PATENT

§ 1.322 Certificate of correction of Office mistake.

(a)(1) The Commissioner may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i) At the request of the patentee or the patentee' s assignee;

(ii) Acting *sua sponte* for mistakes that the Office discovers; or

(iii) Acting on information about a mistake supplied by a third party.

(2)(i) There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii) of this section.

(ii) Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record) at the correspondence address of record as specified in § 1.33(a) and affording the patentee or an assignee an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

[24 FR 10332, Dec. 22, 1959; 34 FR 5550, Mar. 22, 1969; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.323 Certificate of correction of applicant's mistake.

The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

[34 FR 5550, Mar. 22, 1969; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. 256.

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application see §§ 1.48 and 1.497, and in an interference see § 1.634.

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; heading and para. (b)(1) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.325 Other mistakes not corrected.

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or for reexamination, will not be corrected after the date of the patent.

[48 FR 2714, Jan. 20, 1983, effective date Feb. 27, 1983]

ARBITRATION AWARDS

§ 1.331 [Reserved]

[24 FR 10332, Dec. 22, 1959; 43 FR 20465, May 11, 1978; 47 FR 41281, Sept. 17, 1982; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.332 [Reserved]

[47 FR 41281, Sept. 17, 1982; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.333 [Reserved]

[Deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.334 [Reserved]

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17,

1989; deleted, 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

§ 1.335 Filing of notice of arbitration awards.

(a) Written notice of any award by an arbitrator pursuant to 35 U.S.C. 294 must be filed in the Patent and Trademark Office by the patentee or the patentee's assignee or licensee. If the award involves more than one patent a separate notice must be filed for placement in the file of each patent. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the award.

(b) If an award by an arbitrator pursuant to 35 U.S.C. 294 is modified by a court, the party requesting the modification must file in the Patent and Trademark Office, a notice of the modification for placement in the file of each patent to which the modification applies. The notice must set forth the patent number, the names of the inventor and patent owner, and the names and addresses of the parties to the arbitration. The notice must also include a copy of the court's order modifying the award.

(c) Any award by an arbitrator pursuant to 35 U.S.C. 294 shall be unenforceable until any notices required by paragraph (a) or (b) of this section are filed in the Patent and Trademark Office. If any required notice is not filed by the party designated in paragraph (a) or (b) of this section, any party to the arbitration proceeding may file such a notice.

[48 FR 2718, Jan. 20, 1983, effective Feb. 8, 1983]

AMENDMENT OF RULES

§ 1.351 Amendments to rules will be published.

All amendments to the regulations in this part will be published in the *Official Gazette* and in the *Federal Register*.

§ 1.352 [Reserved]

[Para. (a) amended, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

MAINTENANCE FEES

§ 1.362 Time for payment of maintenance fees.

(a) Maintenance fees as set forth in §§ 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

(1) 3 years through 3 years and 6 months after grant for the first maintenance fee,

(2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and

(3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.

(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and

(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

(h) The periods specified in §§1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984; paras. (a) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (c)(4) and (e) revised and para. (h) added, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994]

§ 1.363 Fee address for maintenance fee purposes.

(a) All notices, receipts, refunds, and other communications relating to payment or refund of maintenance fees will be directed to the correspondence address used during prosecution of the application as indicated in § 1.33(a) unless:

(1) A fee address for purposes of payment of maintenance fees is set forth when submitting the issue fee, or

(2) A change in the correspondence address for all purposes is filed after payment of the issue fee, or

(3) A fee address or a change in the "fee address" is filed for purposes of receiving notices, receipts and other correspondence relating to the payment of maintenance fees after the payment of the issue fee, in which instance, the latest such address will be used.

(b) An assignment of a patent application or patent does not result in a change of the "correspondence address" or "fee address" for maintenance fee purposes.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984]

§ 1.366 Submission of maintenance fees.

(a) The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee need not be filed in the Patent and Trademark Office to pay maintenance fees and any necessary surcharges on behalf of the patentee.

(b) A maintenance fee and any necessary surcharge submitted for a patent must be submitted in the amount due on the date the maintenance fee and any necessary surcharge are paid. A maintenance fee or surcharge may be paid in the manner set forth in § 1.23 or by an authorization to charge a deposit account established pursuant to § 1.25. Payment of a maintenance fee and any necessary surcharge or the authorization to charge a deposit account must be submitted within the periods set forth in § 1.362(d), (e), or (f). Any payment or authorization of maintenance fees and surcharges filed at any other time will not be accepted and will not serve as a payment of the maintenance fee except insofar as a delayed payment of the maintenance fee is accepted by the Commissioner in an expired patent pursuant to a petition filed under § 1.378. Any authorization to charge a deposit account must authorize the immediate charging of the

maintenance fee and any necessary surcharge to the deposit account. Payment of less than the required amount, payment in a manner other than that set forth § 1.23, or in the filing of an authorization to charge a deposit account having insufficient funds will not constitute payment of a maintenance fee or surcharge on a patent. The procedures set forth in § 1.8 or § 1.10 may be utilized in paying maintenance fees and any necessary surcharges.

(c) In submitting maintenance fees and any necessary surcharges, identification of the patents for which maintenance fees are being paid must include the patent number, and the application number of the United States application for the patent on which the maintenance fee is being paid. If the payment includes identification of only the patent number (*i.e.*, does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.

(d) Payment of maintenance fees and any surcharges should identify the fee being paid for each patent as to whether it is the 3 1/2-, 7 1/2-, or 11 1/2-year fee, whether small entity status is being changed or claimed, the amount of the maintenance fee and any surcharge being paid, and any assigned customer number. If the maintenance fee and any necessary surcharge is being paid on a reissue patent, the payment must identify the reissue patent by reissue patent number and reissue application number as required by paragraph (c) of this section and should also include the original patent number.

(e) Maintenance fee payments and surcharge payments relating thereto must be submitted separate from any other payments for fees or charges, whether submitted in the manner set forth in § 1.23 or by an authorization to charge a deposit account. If maintenance fee and surcharge payments for more than one patent are submitted together, they should be submitted on as few sheets as possible with the patent numbers listed in increasing patent number order. If the payment submitted is insufficient to cover the maintenance fees and surcharges for all the listed patents, the payment will be applied in the order the patents are listed, beginning at the top of the listing.

(f) Notification of any change in status resulting in loss of entitlement to small entity status must be filed in a patent prior to paying, or at the time of paying, the earliest maintenance fee due after the date on which status as a small entity is no longer appropriate. See § 1.27(g).

(g) Maintenance fees and surcharges relating thereto will not be refunded except in accordance with §§1.26 and 1.28(a).

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (b) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (b) - (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; para. (f) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Commissioner to accept and record the maintenance fee.

(b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(h). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

[49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.378 Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent.

(a) The Commissioner may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the

satisfaction of the Commissioner to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired, but will be subject to the conditions set forth in 35 U.S.C. 41(c)(2).

(b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:

(1) The required maintenance fee set forth in § 1.20 (e) through (g);

(2) The surcharge set forth in § 1.20(i)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be filed within twenty-four months after the six-month grace period provided in § 1.362(e) and must include:

(1) The required maintenance fee set forth in § 1.20 (e) through (g);

(2) The surcharge set forth in § 1.20(i)(2); and

(3) A statement that the delay in payment of the maintenance fee was unintentional.

(d) Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

(e) Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in, the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. If the delayed payment of the maintenance fee is not accepted, the maintenance fee and the surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

[49 FR 34726, Aug. 31, 1984, added effective Nov. 1, 1984; para. (a), 50 FR 9383, Mar.7, 1985, effective May 8, 1985; paras. (b) and (c), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; paras. (a) - (c) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a) - (c) and (e), 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Subpart C — International Processing Provisions

GENERAL INFORMATION

§ 1.401 Definitions of terms under the Patent Cooperation Treaty.

(a) The abbreviation *PCT* and the term *Treaty* mean the Patent Cooperation Treaty.

(b) *International Bureau* means the World Intellectual Property Organization located in Geneva, Switzerland.

(c) *Administrative Instructions* means that body of instructions for operating under the Patent Cooperation Treaty referred to in PCT Rule 89.

(d) *Request,* when capitalized, means that element of the international application described in PCT Rules 3 and 4.

(e) *International application,* as used in this subchapter is defined in § 1.9(b).

(f) *Priority date* for the purpose of computing time limits under the Patent Cooperation Treaty is defined in PCT Art. 2(xi). Note also § 1.465.

(g) *Demand,* when capitalized, means that document filed with the International Preliminary Exam-

ining Authority which requests an international preliminary examination.

(h) *Annexes* means amendments made to the claims, description or the drawings before the International Preliminary Examining Authority.

(i) Other terms and expressions in this subpart C not defined in this section are to be taken in the sense indicated in PCT Art. 2 and 35 U.S.C. 351.

[43 FR 20466, May 11, 1978; 52 FR 20047, May 28, 1987]

§ 1.412 The United States Receiving Office.

(a) The United States Patent and Trademark Office is a Receiving Office only for applicants who are residents or nationals of the United States of America.

(b) The Patent and Trademark Office, when acting as a Receiving Office, will be identified by the full title "United States Receiving Office" or by the abbreviation "RO/US."

(c) The major functions of the Receiving Office include:

(1) According of international filing dates to international applications meeting the requirements of PCT Art. 11(1) and PCT Rule 20;

(2) Assuring that international applications meet the standards for format and content of PCT Art. 14(1), PCT Rule 9, 26, 29.1, 37, 38, 91, and portions of PCT Rules 3 through 11;

(3) Collecting and, when required, transmitting fees due for processing international applications (PCT Rule 14, 15, 16);

(4) Transmitting the record and search copies to the International Bureau and International Searching Authority, respectively (PCT Rules 22 and 23); and

(5) Determining compliance with applicable requirements of part 5 of this chapter.

(6) Reviewing and, unless prescriptions concerning national security prevent the application from being so transmitted (PCT Rule 19.4), transmitting the international application to the International Bureau for processing in its capacity as a Receiving Office:

(i) Where the United States Receiving Office is not the competent Receiving Office under PCT Rule 19.1 or 19.2 and § 1.421(a); or

(ii) Where the international application is not in English but is in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office; or

(iii) Where there is agreement and authorization in accordance with PCT Rule 19.4(a)(iii).

[Para. (c)(6) added, 60 FR 21438, May 2, 1995, effective June 1, 1995; para. (c)(6) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.413 The United States International Searching Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Searching Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Commissioner, in accordance with agreement between the Patent and Trademark Office and the International Bureau (PCT Art. 16(3)(b)).

(b) The Patent and Trademark Office, when acting as an International Searching Authority, will be identified by the full title "United States International Searching Authority" or by the abbreviation "ISA/US."

(c) The major functions of the International Searching Authority include:

(1) Approving or establishing the title and abstract;

(2) Considering the matter of unity of invention;

(3) Conducting international and international-type searches and preparing international and international-type search reports (PCT Art. 15, 17 and 18, and PCT Rules 25, 33 to 45 and 47); and

(4) Transmitting the international search report to the applicant and the International Bureau.

§ 1.414 The United States Patent and Trademark Office as a Designated Office or Elected Office.

(a) The United States Patent and Trademark Office will act as a Designated Office or Elected Office for international applications in which the United States of America has been designated or

elected as a State in which patent protection is desired.

(b) The United States Patent and Trademark Office, when acting as a Designated Office or Elected Office during international processing will be identified by the full title "United States Designated Office" or by the abbreviation "DO/US" or by the full title "United States Elected Office" or by the abbreviation "EO/US."

(c) The major functions of the United States Designated Office or Elected Office in respect to international applications in which the United States of America has been designated or elected, include:

(1) Receiving various notifications throughout the international stage and

(2) Accepting for national stage examination international applications which satisfy the requirements of 35 U.S.C. 371.

[52 FR 20047, May 28, 1987, effective July 1, 1987]

§ 1.415 The International Bureau.

(a) The International Bureau is the World Intellectual Property Organization located at Geneva, Switzerland. It is the international intergovernmental organization which acts as the coordinating body under the Treaty and the Regulations (PCT Art. 2 (xix) and 35 U.S.C. 351(h)).

(b) The major functions of the International Bureau include:

(1) Publishing of international applications and the International Gazette;

(2) Transmitting copies of international applications to Designated Offices;

(3) Storing and maintaining record copies; and

(4) Transmitting information to authorities pertinent to the processing of specific international applications.

§ 1.416 The United States International Preliminary Examining Authority.

(a) Pursuant to appointment by the Assembly, the United States Patent and Trademark Office will act as an International Preliminary Examining Authority for international applications filed in the United States Receiving Office and in other Receiving Offices as may be agreed upon by the Commissioner, in accordance with agreement between the Patent and Trademark Office and the International Bureau.

(b) The United States Patent and Trademark Office, when acting as an International Preliminary Examining Authority, will be identified by the full title "United States International Preliminary Examining Authority" or by the abbreviation "IPEA/US."

(c) The major functions of the International Preliminary Examining Authority include:

(1) Receiving and checking for defects in the Demand;

(2) Forwarding Demands in accordance with PCT Rule 59.3;

(3) Collecting the handling fee for the International Bureau and the preliminary examination fee for the United States International Preliminary Examining Authority;

(4) Informing applicant of receipt of the Demand;

(5) Considering the matter of unity of invention;

(6) Providing an international preliminary examination report which is a non-binding opinion on the questions of whether the claimed invention appears: to be novel, to involve an inventive step (to be nonobvious), and to be industrially applicable; and

(7) Transmitting the international preliminary examination report to applicant and the International Bureau.

[Added 52 FR 20047, May 28, 1987; para. (c) revised, 63 FR 29614, June 1, 1998, effective July 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.417. Submission of translation of international application.

The submission of the international publication or an English language translation of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and, unless it is being submitted pursuant to § 1.494 or § 1.495, be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4). Otherwise, the submission will be treated as a filing under 35 U.S.C. 111(a). Such submissions should be marked "Box PCT."

[Added, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 1.419 Display of currently valid control number under the Paperwork Reduction Act.

(a) Pursuant to the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*), the collection of information in this subpart has been reviewed and approved by the Office of Management and Budget under control number 0651-0021.

(b) Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid Office of Management and Budget control number. This section constitutes the display required by 44 U.S.C. 3512(a) and 5 CFR 1320.5(b)(2)(i) for the collection of information under Office of Management and Budget control number 0651-0021 (see 5 CFR 1320.5(b)(2)(ii)(D)).

[Added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

WHO MAY FILE AN INTERNATIONAL APPLICATION

§ 1.421 Applicant for international application.

(a) Only residents or nationals of the United States of America may file international applications in the United States Receiving Office. If an international application does not include an applicant who is indicated as being a resident or national of the United States of America, and at least one applicant:

(1) Has indicated a residence or nationality in a PCT Contracting State, or

(2) Has no residence or nationality indicated, applicant will be so notified and, if the international application includes a fee amount equivalent to that required by § 1.445(a)(5), the international application will be forwarded for processing to the International Bureau acting as a Receiving Office. (See also § 1.412(c)(6)).

(b) Although the United States Receiving Office will accept international applications filed by any resident or national of the United States of America for international processing, an international application designating the United States of America will be accepted by the Patent and Trademark Office for the national stage only if filed by the inventor or as provided in §§ 1.422, 1.423 or 1.425.

(c) International applications which do not designate the United States of America may be filed by the assignee or owner.

(d) The attorney or agent of the applicant may sign the international application Request and file the international application for the applicant if the international application when filed is accompanied by a separate power of attorney to that attorney or agent from the applicant. The separate power of attorney from the applicant may be submitted after filing if sufficient cause is shown for not submitting it at the time of filing. Note that paragraph (b) of this section requires that the applicant be the inventor if the United States of America is designated.

(e) Any indication of different applicants for the purpose of different Designated Offices must be shown on the Request portion of the international application.

(f) Changes in the person, name, or address of the applicant of an international application shall be made in accordance with PCT Rule 92^{bis}.

(g) The wording of PCT Rule 92^{bis} is as follows:

PCT Rule 92^{bis} - Recording of Changes in Certain Indications in the Request or the Demand

92^{bis} Recording of Changes by the International Bureau

(a) The International Bureau shall, on the request of the applicant or the receiving Office, record changes in the following indications appearing in the request or demand:

(i) Person name, residence, nationality or address of the applicant,

(ii) Person, name or address of the agent, the common representative or the inventor.

(b) The International Bureau shall not record the requested change if the request for recording is received by it after the expiration:

(i) Of the time limit referred to in Article 22(1), where Article 39(1) is not applicable with respect to any Contracting State;

(ii) Of the time limit referred to in Article 39(1)(a), where Article 39(1) is applicable with respect to at least one Contracting State.

[Paras. (f) and (g), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (a) amended, 60 FR 21438, May 2, 1995, effective June 1, 1995]

§ 1.422 When the inventor is dead.

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may file an international application which designates the United States of America.

§ 1.423 When the inventor is insane or legally incapacitated.

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may file an international application which designates the United States of America.

§ 1.424 Joint inventors.

Joint inventors must jointly file an international application which designates the United States of America; the signature of either of them alone, or less than the entire number will be insufficient for an invention invented by them jointly, except as provided in § 1.425.

§ 1.425 Filing by other than inventor.

Where an international application which designates the United States of America is filed and where one or more inventors refuse to sign the Request for the international application or cannot be found or reached after diligent effort, the Request need not be signed by such inventor if it is signed by another applicant. Such international application must be accompanied by a statement explaining to the satisfaction of the Commissioner the lack of the signature concerned.

[Revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

THE INTERNATIONAL APPLICATION

§ 1.431 International application requirements.

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

(1) At least one applicant is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).

(2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).

(3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):

(i) An indication that it is intended as an international application (PCT Rule 4.2);

(ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);

(iii) The name of the applicant, as prescribed (note §§1.421-1.424);

(iv) A part which on the face of it appears to be a description; and

(v) A part which on the face of it appears to be a claim.

(c) Payment of the basic portion of the international fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. The basic, transmittal, and search fee payable is the basic, transmittal, and search fee in effect on the receipt date of the international application.

(1) If the basic, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees up to a maximum amount equal to the basic fee; or

(ii) An amount equal to the transmittal fee (PCT Rule 16*bis*).

(2) The one-month time limit set pursuant to this paragraph to pay deficient fees may not be extended.

(d) If the payment needed to cover the transmittal fee, the basic fee, the search fee, one designation fee and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with PCT Rule 16^{bis}.1(e), the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).

[43 FR 20486, May 11, 1978; paras. (b), (c), (d) and (e), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; para. (d) amended, 52 FR 20047, May 28, 1987; paras. (b)(1), (b)(3)(ii), (c) and (d) amended, para. (e) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (c) and (d) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.432 Designation of States and payment of designation and confirmation fees.

(a) The designation of States including an indication that applicant wishes to obtain a regional patent, where applicable, shall appear in the Request upon filing and must be indicated as set forth in PCT Rule 4.9 and section 115 of the Administrative Instructions. Applicant must specify at least one national or regional designation on filing of the international application for a filing date to be granted.

(b) If the fees necessary to cover all the national and regional designations specified in the Request are not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, applicant will be notified and given one month within which to pay the deficient designation fees plus a late payment fee. The late payment fee shall be equal to the greater of fifty percent of the amount of the deficient fees up to a maximum amount equal to the basic fee, or an amount equal to the transmittal fee (PCT Rule 16^{bis}). The one-month time limit set in the notification of deficient designation fees may not be extended. Failure to timely pay at least one designation fee will result in the withdrawal of the international application.

(1) The one designation fee must be paid:

(i) Within one year from the priority date;

(ii) Within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date; or

(iii) With the late payment fee defined in this paragraph within the time set in the notification of the deficient designation fees or in accordance with PCT Rule 16^{bis}.1(e).

(2) If after a notification of deficient designation fees the applicant makes timely payment, but the amount paid is not sufficient to cover the late payment fee and all designation fees, the Receiving Office will, after allocating payment for the basic, search, transmittal and late payment fees, allocate the amount paid in accordance with PCT Rule 16^{bis}.1(c) and withdraw the unpaid designations. The notification of deficient designation fees pursuant to this paragraph may be made simultaneously with any notification pursuant to § 1.431(c).

(c) The amount payable for the designation fee set forth in paragraph (b) is:

(1) The designation fee in effect on the filing date of the international application, if such fee is paid in full within one month from the date of receipt of the international application;

(2) The designation fee in effect on the date such fee is paid in full, if such fee is paid in full later than one month from the date of receipt of the international application but within one year from the priority date;

(3) The designation fee in effect on the date one year from the priority date, if the fee was due one year from the priority date, and such fee is paid in full later than one month from the date of receipt of the international application and later than one year from the priority date; or

(4) The designation fee in effect on the international filing date, if the fee was due one month from the international filing date and after one year from the priority date, and such fee is paid in full later than one month from the date of receipt of the international application and later than one year from the priority date.

(d) On filing the international application, in addition to specifying at least one national or regional designation under PCT Rule 4.9(a), applicant may

also indicate under PCT Rule 4.9(b) that all other designations permitted under the Treaty are made.

(1) Indication of other designations permitted by the Treaty under PCT Rule 4.9(b) must be made in a statement on the Request that any designation made under this paragraph is subject to confirmation (PCT Rule 4.9(c)) not later than the expiration of 15 months from the priority date by:

(i) Filing a written notice with the United States Receiving Office specifying the national and/or regional designations being confirmed;

(ii) Paying the designation fee for each designation being confirmed; and

(iii) Paying the confirmation fee specified in § 1.445(a)(4).

(2) Unconfirmed designations will be considered withdrawn. If the amount submitted is not sufficient to cover the designation fee and the confirmation fee for each designation being confirmed, the Receiving Office will allocate the amount paid in accordance with any priority of designations specified by applicant. If applicant does not specify any priority of designations, the allocation of the amount paid will be made in accordance with PCT Rule 16^{bis}.1(c).

[43 FR 20486, May 11, 1978; para. (b) amended 52 FR 20047, May 28, 1987; paras. (a), (b) amended and para. (c) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (b) and (c) revised, para. (d) added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.433 Physical requirements of international application.

(a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.

(b) All sheets of the international application must be on A4 size paper (21.0 x 29.7 cm.).

(c) Other physical requirements for international applications are set forth in PCT Rule 11 and sections 201-207 of the Administrative Instructions.

§ 1.434 The request.

(a) The request shall be made on a standardized form (PCT Rules 3 and 4). Copies of printed Request forms are available from the Patent and Trademark Office. Letters requesting printed forms should be marked "Box PCT."

(b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.

(c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.

(d) International applications which designate the United States of America:

(1) Shall include the name, address and signature of the inventor, except as provided by §§ 1.421(d), 1.422, 1.423 and 1.425;

(2) Shall include a reference to any copending national application or international application designating the United States of America, if the benefit of the filing date for the prior copending application is to be claimed; and

(3) May include in the Request a declaration of the inventors as provided for in PCT Rule 4.17(iv).

[Para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (d) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

§ 1.435 The description.

(a) The application must meet the requirements as to the content and form of the description set forth in PCT Rules 5, 9, 10, and 11 and sections 204 and 208 of the Administrative Instructions.

(b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

[Para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.436 The claims.

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10 and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

§ 1.437 The drawings.

(a) Subject to paragraph (b) of this section, when drawings are necessary for the understanding of the invention, or are mentioned in the description, they must be part of an international application as originally filed in the United States Receiving Office in order to maintain the international filing date during the national stage (PCT Art. 7).

(b) Drawings missing from the application upon filing will be accepted if such drawings are received within 30 days of the date of first receipt of the incomplete papers. If the missing drawings are received within the 30-day period, the international filing date shall be the date on which such drawings are received. If such drawings are not timely received, all references to drawings in the international application shall be considered non-existent (PCT Art. 14(2), Administrative Instruction 310).

(c) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

§ 1.438 The abstract.

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

FEES

§ 1.445 International application filing, processing and search fees.

(a) The following fees and charges for international applications are established by the Commissioner under the authority of 35 U.S.C. 376:

(1) A transmittal fee (see 35 U.S.C. 361(d) and PCT Rule 14) — $240.00

(2) A search fee (see 35 U.S.C. 361(d) and PCT Rule 16):

(i) Where a corresponding prior United States National application filed under 35 U.S.C. 111(a) with the filing fee under § 1.16(a) has been filed — $450.00

(ii) For all situations not provided for in paragraph (a)(2)(i) of this section — $700.00

(3) A supplemental search fee when required, per additional invention — $210.00

(4) A confirmation fee (PCT Rule 96) equal to fifty percent of the sum of designation fees for the national and regional designations being confirmed (§ 1.432(d)).

(5) A fee equivalent to the transmittal fee in paragraph (a)(1) of this section for transmittal of an international application to the International Bureau for processing in its capacity as a Receiving Office (PCT Rule 19.4).

(b) The basic fee and designation fee portion of the international fee shall be as prescribed in PCT Rule 15.

[43 FR 20466, May 11, 1978; para. (a), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para. (a)(4) - (6), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (a) amended 52 FR 20047, May 28, 1987; paras. (a)(2) and (3), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; para. (a), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (a)(4) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1)-(3), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (a)(5) added, 60 FR 21438, May 2, 1995, effective June 1, 1995; para. (a) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; para. (a) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; para. (a) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1,1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or treaty and its regulations, may be refunded. A mere change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested and will not notify the payor of such amounts. If the payor or party requesting a refund does not provide the banking information necessary for making refunds by electronic funds trans-

fer, the Office may use the banking information provided on the payment instrument to make any refund by electronic funds transfer.

(b) Any request for refund under paragraph (a) of this section must be filed within two years from the date the fee was paid. If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization under § 1.25(b), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Commissioner or the Commissioner's designee acting under PCT Rule 40.2(c).

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The search fee will be refunded if the application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

[43 FR 20466, May 11, 1978; para. (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para.(b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (d) amended and para. (e) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para (a) revised and para. (b) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

PRIORITY

§ 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must, subject to paragraph (d) of this section, be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application or international application filed with the United States Receiving Office is claimed in an international application, the applicant may request in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office or in a separate letter filed in the United States Receiving Office not later than 16 months after the priority date, that the United States Patent and Trademark Office prepare a certified copy of the prior application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is set forth in § 1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

(d) The applicant may correct or add a priority claim in accordance with PCT Rule 26^{bis}.1.

[43 FR 20466, May 11, 1978; 47 FR 40140, Sept. 10, 1982, effective Oct. 1, 1982; para. (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; paras. (b) & (c), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; para. (b), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, para. (d) added, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (b) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

REPRESENTATION

§ 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the Patent and Trademark Office or by an applicant appointed as a common representative

(PCT Art. 49, Rules 4, 8 and 90 and § 10.10). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by all applicants, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

[43 FR 20466, May 11, 1978; 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

TRANSMITTAL OF RECORD COPY

§ 1.461 Procedures for transmittal of record copy to the International Bureau.

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office or as provided by PCT Rule 19.4.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of part 5 of this chapter have been satisfied.

[43 FR 20466, May 11, 1978; paras. (a) and (b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

TIMING

§ 1.465 Timing of application processing based on the priority date.

(a) For the purpose of computing time limits under the Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is corrected or added under PCT Rule 26^{bis}.1(a), or withdrawn under PCT Rule 90^{bis}.3, or considered not to have been made under PCT Rule 26^{bis}.2, the priority date for the purposes of computing any non-expired time limits will be the date of the earliest valid remaining priority claim of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority date or dates, the Receiving Office shall proceed under PCT Rule 26^{bis}.2.

[Paras. (b) and (c) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.468 Delays in meeting time limits.

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in

meeting time limits in a national application, see § 1.137.

AMENDMENTS

§ 1.471 Corrections and amendments during international processing.

(a) Except as otherwise provided in this paragraph, all corrections submitted to the United States Receiving Office or United States International Searching Authority must be in English, in the form of replacement sheets in compliance with PCT Rules 10 and 11, and accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets. Replacement sheets are not required for the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet. These changes may be stated in a letter and, if appropriate, the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4). Amendments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered.

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

(c) Corrections or additions to the Request of any declarations under PCT Rule 4.17 should be submitted to the International Bureau as prescribed by PCT Rule 26*ter*.

[Para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (c) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

§ 1.472 Changes in person, name, or address of applicants and inventors.

All requests for a change in person, name or address of applicants and inventor should be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such changes should be submitted to the International Bureau.

[43 FR 20466, May 11, 1978; redesignated at 52 FR 20047, May 28, 1987]

UNITY OF INVENTION

§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other cat-

egories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[Added 52 FR 20047, May 28, 1987, effective July 1, 1987; paras. (a) - (e) amended and para. (f) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

§ 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note § 1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of non-compliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned ("main invention") in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may raise the objection of lack of unity of invention.

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

§ 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987]

INTERNATIONAL PRELIMINARY EXAMINATION

§ 1.480 Demand for international preliminary examination.

(a) On the filing of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent and for which the fees have been paid, the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due at the time of filing the Demand.

(b) The Demand shall be made on a standardized form. Copies of the printed Demand forms are available from the Patent and Trademark Office. Letters requesting printed Demand forms should be marked "Box PCT."

(c) If the Demand is made prior to the expiration of the 19th month from the priority date and the United States of America is elected, the provisions of § 1.495 shall apply rather than § 1.494.

(d) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

[52 FR 20048, May 28, 1987; para. (d), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.481 Payment of international preliminary examination fees.

(a) The handling and preliminary examination fees shall be paid within the time period set in PCT Rule 57.3. The handling fee or preliminary examination fee payable is the handling fee or preliminary examination fee in effect on the date of receipt of the Demand except under PCT Rule 59.3(a) where the fee payable is the fee in effect on the date of arrival of the Demand at the United States International Preliminary Examining Authority.

(1) If the handling and preliminary fees are not paid within the time period set in PCT Rule 57.3, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

(i) Fifty percent of the amount of the deficient fees, but not exceeding an amount equal to double the handling fee; or

(ii) An amount equal to the handling fee (PCT Rule 58*bis*.2).

(2) The one-month time limit set in this paragraph to pay deficient fees may not be extended.

(b) If the payment needed to cover the handling and preliminary examination fees, pursuant to paragraph (a) of this section, is not timely made in accordance with PCT Rule 58*bis*.1(d), the United States International Preliminary Examination Authority will declare the Demand to be considered as if it had not been submitted.

[63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.482 International preliminary examination fees.

(a) The following fees and charges for international preliminary examination are established by the Commissioner under the authority of 35 U.S.C. 376:

(1) A preliminary examination fee is due on filing the Demand:

(i) Where an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority, a preliminary examination fee of $490.00

(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office, a preliminary examination fee of $750.00

(2) An additional preliminary examination fee when required, per additional invention:

(i) Where the international Searching Authority for the international application was the United States Patent and Trademark Office.. $140.00

(ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office..... $260.00

(b) The handling fee is due on filing the Demand.

(35 U.S.C. 6, 376)

[52 FR 20048, May 28, 1987; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; paras. (a)(1) and (a)(2)(ii), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; paras. (a)(2)(i) and (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1) and (a)(2)(ii), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a)(1)(i), (a)(1)(ii), & (a)(2)(ii) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995; paras. (a)(1)(i), (a)(1)(ii), and (a)(2)(ii) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a)(1)(i), (a)(1)(ii), and (a)(2)(ii) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997]

§ 1.484 Conduct of international preliminary examination.

(a) An international preliminary examination will be conducted to formulate a non-binding opinion

as to whether the claimed invention has novelty, involves an inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin promptly upon receipt of a proper Demand in an application for which the United States International Preliminary Examining Authority is competent, for which the fees for international preliminary examination (§ 1.482) have been paid, and which requests examination based on the application as filed or as amended by an amendment which has been received by the United States International Preliminary Examining Authority. Where a Demand requests examination based on a PCT Article 19 amendment which has not been received, examination may begin at 20 months without receipt of the PCT Article 19 amendment. Where a Demand requests examination based on a PCT Article 34 amendment which has not been received, applicant will be notified and given a time period within which to submit the amendment.

(1) Examination will begin after the earliest of:

(i) Receipt of the amendment;

(ii) Receipt of applicant's statement that no amendment will be made; or

(iii) Expiration of the time period set in the notification.

(2) No international preliminary examination report will be established prior to issuance of an international search report.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to reply.

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the reply thereto or the expiration of the time limit for reply to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one copy will be submitted to the applicant.

(f) An applicant will be permitted a personal or telephone interview with the examiner, which must be conducted during the non-extendable time limit for reply by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant as a part of the reply to the written opinion or, if applicant files no reply, be made of record in the file by the examiner.

(g) If the application whose priority is claimed in the international application is in a language other than English, the United States International Preliminary Examining Authority may, where the validity of the priority claim is relevant for the formulation of the opinion referred to in Article 33(1), invite the applicant to furnish an English translation of the priority document within two months from the date of the invitation. If the translation is not furnished within that time limit, the international preliminary examination report may be established as if the priority had not been claimed.

[52 FR 20049, May 28, 1987; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (d)-(f) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para. (g) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001]

§ 1.485 Amendments by applicant during international preliminary examination.

(a) The applicant may make amendments at the time of filing the Demand. The applicant may also make amendments within the time limit set by the International Preliminary Examining Authority for reply to any notification under § 1.484(b) or to any written opinion. Any such amendments must:

(1) Be made by submitting a replacement sheet in compliance with PCT Rules 10 and 11.1 to 11.13 for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled; and

(2) Include a description of how the replacement sheet differs from the replaced sheet. Amend-

ments that do not comply with PCT Rules 10 and 11.1 to 11.13 may not be entered.

(b) If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

[Added 52 FR 20049, May 28, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998)]

§ 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

(1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or

(3) If applicant fails to restrict the claims or pay additional fees within the time limit set for reply, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (b)(3) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

[Added 52 FR 20050, May 28, 1987, effective July 1, 1987]

NATIONAL STAGE

§ 1.491 National stage commencement and entry.

(a) Subject to 35 U.S.C. 371(f), the national stage shall commence with the expiration of the applicable time limit under PCT Article 22(1) or (2), or under PCT Article 39(1)(a).

(b) An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the period set in § 1.494 or § 1.495.

[Added, 52 FR 20050, May 28, 1987; revised, 66 FR 45775, Aug. 30, 2001]

§ 1.492 National stage fees.

The following fees and charges are established for international applications entering the national stage under 35 U.S.C. 371:

(a) The basic national fee:

(1) Where an international preliminary examination fee as set forth in § 1.482 has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.27(a)) . . . $345.00
By other than a small entity $690.00

(2) Where no international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office, but an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

By a small entity (§ 1.27(a)) . . . $355.00
By other than a small entity $710.00

(3) Where no international preliminary examination fee as set forth in § 1.482 has been paid and no international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.27(a)) . . . $500.00
By other than a small entity . . . $1,000.00

(4) Where an international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see § 1.496(b)):

By a small entity (§ 1.27(a)). $50.00
By other than a small entity $100.00

(5) Where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office:

By a small entity (§ 1.27(a)). . . . $430.00
By other than a small entity $860.00

(b) In addition to the basic national fee, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.27(a)). $40.00
By other than a small entity $80.00

(c) In addition to the basic national fee, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.27(a)). $9.00
By other than a small entity $18.00

(d) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.27(a)). . . . $135.00
By other than a small entity $270.00

(e) Surcharge for filing the oath or declaration later than 20 months from the priority date pursuant to § 1.494(c) or later than 30 months from the priority date pursuant to § 1.495(c):

By a small entity (§ 1.27(a)). $65.00
By other than a small entity $130.00

(f) For filing an English translation of an international application later than 20 months after the priority date (§ 1.494(c)) or filing an English translation of the international application or of any annexes to the international preliminary examination report later than 30 months after the priority date (§§ 1.495(c) and (e)) $130.00

(g) If the additional fees required by paragraphs (b), (c), and (d) of this section are not paid on presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by

amendment, prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency.

(35 U.S.C. 6, 376)

[52 FR 20050, May 28, 1987, effective July 1, 1987; paras. (a)(1) - (3), (b), (d)- (f), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a)(5) added, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1)-(a)(3), (a)(5) and (b)-(d), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (e) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a), (b) and (d), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a), (b), & (d) amended, 60 FR 41018, Aug. 11, 1995, effective, Oct. 1, 1995; paras. (a), (b), & (d) amended, 61 FR 39585, July 30, 1996, effective Oct. 1, 1996; paras. (a), (b), & (d) amended, 62 FR 40450, July 29, 1997, effective Oct. 1, 1997; para. (g) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(d) revised, 63 FR 67578, Dec. 8, 1998, effective Nov. 10, 1998; para. (a)(2) revised, 64 FR 67774, Dec. 3, 1999, effective Dec. 29, 1999; paras. (a), (b) and (d) revised, 65 FR 49193, Aug. 11, 2000, effective Oct. 1, 2000; paras. (a)-(e) revised, 65 FR 78958, Dec. 18, 2000]

§ 1.494 Entering the national stage in the United States of America as a designated office.

(a) Where the United States of America has not been elected by the expiration of 19 months from the priority date (see § 1.495), the applicant must fulfill the requirements of PCT Article 22 and 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)). The 20-month time limit may not be extended.

(c) If applicant complies with paragraph (b) of this section before expiration of 20 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), and a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in the PCT Rule 26^{ter}.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 20 months after the priority date. A "Sequence Listing" need not be translated if the "Sequence Listing" complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 20 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 20 months from the priority date will be considered to be cancelled. The 20-month time limit may not be extended.

(e) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(f) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417, be clearly identified as a submission to enter the national stage under 35 U.S.C. 371.

Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

(g) An international application becomes abandoned as to the United States 20 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 20 months from the priority date where the United States has been designated but not elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 20 months from the priority date but any required translation of the international application as filed and/or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

[Added 52 FR 20050, May 28, 1987; paras. (a) - (d) and (g) amended and para. (h) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para (c) revised, 63 FR 29614, June 1, 1998, effective, July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998); para (f) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c)(2) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2000; para. (c)(2) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001]

§ 1.495 Entering the national stage in the United States of America as an elected office.

(a) Where the United States of America has been elected by the expiration of 19 months from the priority date, the applicant must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)). The 30-month time limit may not be extended.

(c) If applicant complies with paragraph (b) of this section before expiration of 30 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), and a declaration of inventorship in compliance with § 1.497 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26^{ter}.1, applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 30 months after the priority date. A "Sequence Listing" need not be translated if the "Sequence Listing" complies with PCT Rule 12.1(d) and the description complies with PCT Rule 5.2(b).

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled. The 30-month time limit may not be extended.

(e) A translation into English of any annexes to the international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of the annexes which are not received by the expiration of 30 months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in

§ 1.492(f). Annexes for which translations are not timely received will be considered cancelled. The 30-month time limit may not be extended.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must, except for a copy of the international publication or translation of the international application that is identified as provided in § 1.417 be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).

(h) An international application becomes abandoned as to the United States 30 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 30 months from the priority date and the United States has been elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 30 months from the priority date but any required translation of the international application as filed and/or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987; paras. (a) -(e) & (h) amended and para. (i) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para (c) revised, 63 FR 29614, June 1, 1998, effective July 1, 1998 (adopted as final, 63 FR 66040, Dec. 1, 1998), para. (g) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; para. (c)(2) revised, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001 para. (c)(2) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001]

§ 1.496 Examination of international applications in the national stage.

(a) International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met. However, unless an express request for early processing has been filed under 35 U.S.C. 371(f), no action may be taken prior to one month after entry into the national stage.

(b) A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in § 1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid will be taken up out of order.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987]

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26*ter*.1, he or she must file an oath or declaration that:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the specification to which it is directed;

(3) Identifies each inventor and the country of citizenship of each inventor; and

(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b)(1) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or §1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

(c) Subject to paragraph (f) of this section, if the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494(c) or 1.495(c). However, if the oath or declaration does not also meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 or an application data sheet will be required in accordance with § 1.67.

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any declaration which was filed under PCT Rule 4.17(iv), the oath or declaration must be accompanied by:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

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

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

(e) The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

(f) A new oath or declaration in accordance with this section must be filed to satisfy 35 U.S.C. 371(c)(4) if the declaration was filed under PCT Rule 4.17(iv), and:

(1) There was a change in the international filing date pursuant to PCT Rule 20.2 after the declaration was executed; or

(2) A change in the inventive entity was effected under PCT Rule 92^{bis} after the declaration was executed.

(g) If a priority claim has been corrected or added pursuant to PCT Rule 26^{bis} during the international stage after the declaration of inventorship was executed in the international application under PCT Rule 4.17(iv), applicant will be required to submit either a new oath or declaration or an application data sheet as set forth in § 1.76 correctly identifying the application upon which priority is claimed.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; paras. (a) and (b) revised and para. (c) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996; para. (b)(2) revised and paras. (d) and (e) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a), (c), and (d) revised and paras. (f) and (g) added, 66 FR 16004, Mar. 22, 2001, effective Mar. 1, 2001; para. (a)(1) corrected, 66 FR 28053, May 22, 2001, effective Mar. 22, 2001]

§ 1.499 Unity of invention during the national stage.

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

Subpart D — *Ex Parte* Reexamination of Patents

CITATION OF PRIOR ART

§ 1.501 Citation of prior art in patent files.

(a) At any time during the period of enforceability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

(b) If the person making the citation wishes his or her identity to be excluded from the patent file and kept confidential, the citation papers must be submitted without any identification of the person making the submission.

(c) Citation of patents or printed publications by the public in patent files should either: (1) Reflect that a copy of the same has been mailed to the patent owner at the address as provided for in § 1.33(c); or in the event service is not possible (2) Be filed with the Office in duplicate.

[46 FR 29185, May 29, 1981, effective July 1, 1981; para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.502 Processing of prior art citations during an *ex parte* reexamination proceeding.

Citations by the patent owner under § 1.555 and by an *ex parte* reexamination requester under either § 1.510 or § 1.535 will be entered in the reexamination file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or an *ex parte* reexamination requester under either § 1.510 or § 1.535, will be delayed until the reexamination proceeding has been terminated. See § 1.902 for processing of prior art citations in patent and reexamination files during an *inter partes* reexamination proceeding filed under § 1.913.

[Added 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

REQUEST FOR *EX PARTE* REEXAMINATION

§ 1.510 Request for *ex parte* reexamination.

(a) Any person may, at any time during the period of enforceability of a patent, file a request for an *ex parte* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501. The request must be accompanied by the fee for requesting reexamination set in § 1.20(c)(1).

(b) Any request for reexamination must include the following parts:

(1) A statement pointing out each substantial new question of patentability based on prior patents and printed publications.

(2) An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested. If appropriate the party requesting reexamination may also point out how claims distinguish over cited prior art.

(3) A copy of every patent or printed publication relied upon or referred to in paragraph (b)(1) and (2) of this section accompanied by an English language translation of all the necessary and pertinent parts of any non-English language patent or printed publication.

(4) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(5) A certification that a copy of the request filed by a person other than the patent owner has been served in its entirety on the patent owner at the address as provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy must be supplied to the Office.

(c) If the request does not include the fee for requesting reexamination or all of the parts required by paragraph (b) of this section, the person identified as requesting reexamination will be so notified and given an opportunity to complete the request within a specified time. If the fee for requesting reexamination has been paid but the defect in the request is not corrected within the specified time, the determination whether or not to institute reexamination will be made

on the request as it then exists. If the fee for requesting reexamination has not been paid, no determination will be made and the request will be placed in the patent file as a citation if it complies with the requirements of § 1.501(a).

(d) The filing date of the request is:

(1) The date on which the request including the entire fee for requesting reexamination is received in the Patent and Trademark Office; or

(2) The date on which the last portion of the fee for requesting reexamination is received.

(e) A request filed by the patent owner may include a proposed amendment in accordance with § 1.530.

(f) If a request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34(a).

[46 FR 29185, May 29, 1981, effective July 1, 1981; para. (a), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para. (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(4) and (e) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading and para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.515 Determination of the request for *ex parte* reexamination.

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination.

(b) Where no substantial new question of patentability has been found, a refund of a portion of the fee for requesting *ex parte* reexamination will be made to the requester in accordance with § 1.26(c).

(c) The requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

[46 FR 29185, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.520 *Ex parte* reexamination at the initiative of the Commissioner.

The Commissioner, at any time during the period of enforceability of a patent, may determine whether or not a substantial new question of patentability is raised by patents or printed publications which have been discovered by the Commissioner or which have been brought to the Commissioner's attention, even though no request for reexamination has been filed in accordance with § 1.510 or § 1.913. The Commissioner may initiate *ex parte* reexamination without a request for reexamination pursuant to § 1.510 or § 1.913. Normally requests from outside the Office that the Commissioner undertake reexamination on his own initiative will not be considered. Any determination to initiate *ex parte* reexamination under this section will become a part of the official file of the patent and will be mailed to the patent owner at the address as provided for in § 1.33(c).

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

EX PARTE REEXAMINATION

§ 1.525 Order for *ex parte* reexamination.

(a) If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for resolution of the question. If the order for *ex parte* reexamination resulted from a petition pursuant to § 1.515(c), the *ex parte* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.515(a).

(b) The notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice and *ex parte* reexamination will proceed.

[46 FR 29186, May 29, 1981, effective July 1, 1981; heading and paras. (a) and (b) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.530 Statement by patent owner in *ex parte* reexamination; amendment by patent owner in *ex parte* or *inter partes* reexamination; inventorship change in *ex parte* or *inter partes* reexamination.

(a) Except as provided in § 1.510(e), no statement or other response by the patent owner in an *ex parte* reexamination proceeding shall be filed prior to the determinations made in accordance with § 1.515 or § 1.520. If a premature statement or other response is filed by the patent owner, it will not be acknowledged or considered in making the determination.

(b) The order for *ex parte* reexamination will set a period of not less than two months from the date of the order within which the patent owner may file a statement on the new question of patentability, including any proposed amendments the patent owner wishes to make.

(c) Any statement filed by the patent owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents or printed publications, either alone or in any reasonable combinations. Where the reexamination request was filed by a third party requester, any statement filed by the patent owner must be served upon the *ex parte* reexamination requester in accordance with § 1.248.

(d) *Making amendments in a reexamination proceeding.* A proposed amendment in an *ex parte* or an *inter partes* reexamination proceeding is made by filing a paper directing that proposed specified changes be made to the patent specification, including the claims, or to the drawings. An amendment paper directing that proposed specified changes be made in a reexamination proceeding may be submitted as an accompaniment to a request filed by the patent owner in accordance with § 1.510(e), as part of a patent owner statement in accordance with paragraph (b) of this section, or, where permitted, during the prosecution of the reexamination proceeding pursuant to § 1.550(a) or § 1.937.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph including markings pursuant to paragraph (f) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph, without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (*see* §§ 1.96 and 1.825).

(2) *Claims.* An amendment paper must include the entire text of each patent claim which is being proposed to be changed by such amendment paper and of each new claim being proposed to be added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each patent claim proposed to be changed and each proposed added claim must include markings pursuant to paragraph (f) of this section, except that a patent claim or proposed added claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval of the changes by the examiner, only new sheets of drawings including the changes and in compliance with § 1.84 must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(4) The formal requirements for papers making up the reexamination proceeding other than those set forth in this section are set out in § 1.52.

(e) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (d) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

(f) *Changes shown by markings.* Any changes relative to the patent being reexamined which are

made to the specification, including the claims, must include the following markings:

(1) The matter to be omitted by the reexamination proceeding must be enclosed in brackets; and

(2) The matter to be added by the reexamination proceeding must be underlined.

(g) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claims added in the reexamination proceeding must follow the number of the highest numbered patent claim.

(h) *Amendment of disclosure may be required.* 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.

(i) *Amendments made relative to patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination.

(j) *No enlargement of claim scope.* No amendment may enlarge the scope of the claims of the patent or introduce new matter. No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.

(k) *Amendments not effective until certificate.* Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued.

(l) *Correction of inventorship in an ex parte or inter partes reexamination proceeding.*

(1) When it appears in a patent being reexamined that the correct inventor or inventors were not named through error without deceptive intention on the part of the actual inventor or inventors, the Commissioner may, on petition of all the parties set forth in § 1.324(b)(1)-(3), including the assignees, and satisfactory proof of the facts and payment of the fee set forth in § 1.20(b), or on order of a court before which such matter is called in question, include in the reexamination certificate to be issued under § 1.570 or § 1.977 an amendment naming only the actual inventor or inventors. The petition must be submitted as part of the reexamination proceeding and must satisfy the requirements of § 1.324.

(2) Notwithstanding the preceding paragraph (l)(1) of this section, if a petition to correct inventorship satisfying the requirements of § 1.324 is filed in a reexamination proceeding, and the reexamination proceeding is terminated other than by a reexamination certificate under § 1.570 or § 1.977, a certificate of correction indicating the change of inventorship stated in the petition will be issued upon request by the patentee.

[46 FR 29186, May 29, 1981, effective July 1, 1981; para. (d) revised, para. (e) removed, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; heading and para. (d) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (e) through (l) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; heading, paras. (a)-(c), para. (d) introductory text and para. (l) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.535 Reply by third party requester in *ex parte* reexamination.

A reply to the patent owner's statement under § 1.530 may be filed by the *ex parte* reexamination requester within two months from the date of service of the patent owner's statement. Any reply by the *ex parte* requester must be served upon the patent owner in accordance with § 1.248. If the patent owner does not file a statement under § 1.530, no reply or other submission from the *ex parte* reexamination requester will be considered.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.540 Consideration of responses in *ex parte* reexamination.

The failure to timely file or serve the documents set forth in § 1.530 or in § 1.535 may result in their being refused consideration. No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.550 Conduct of *ex parte* reexamination proceedings.

(a) All *ex parte* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. After issuance of the *ex parte* reexamination order and expiration of the time for submitting any responses, the examination will be conducted in accordance with §§ 1.104 through 1.116 and will result in the issuance of an *ex parte* reexamination certificate under § 1.570.

(b) The patent owner in an *ex parte* reexamination proceeding will be given at least thirty days to respond to any Office action. In response to any rejection, such response may include further statements and/or proposed amendments or new claims to place the patent in a condition where all claims, if amended as proposed, would be patentable.

(c) The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(d) If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the *ex parte* reexamination proceeding will be terminated, and the Commissioner will proceed to issue a certificate under § 1.570 in accordance with the last action of the Office.

(e) If a response by the patent owner is not timely filed in the Office,

(1) The delay in filing such response may be excused if it is shown to the satisfaction of the Commissioner that the delay was unavoidable; a petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a); or

(2) The response may nevertheless be accepted if the delay was unintentional; a petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

(f) The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

(g) The active participation of the *ex parte* reexamination requester ends with the reply pursuant to § 1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered. Further, no submissions on behalf of any third parties will be acknowledged or considered unless such submissions are:

(1) in accordance with § 1.510 or § 1.535; or

(2) entered in the patent file prior to the date of the order for *ex parte* reexamination pursuant to § 1.525.

(h) Submissions by third parties, filed after the date of the order for *ex parte* reexamination pursuant to § 1.525, must meet the requirements of and will be treated in accordance with § 1.501(a).

[46 FR 29186, May 29, 1981, effective July 1, 1981; para. (c), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (c), 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; paras. (a), (b), & (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.552 Scope of reexamination in *ex parte* reexamination proceedings.

(a) Claims in an *ex parte* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *ex parte* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in a reexamination proceeding. If such issues are raised by the patent owner or third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may consider the advisability of filing a reissue application to have such issues considered and resolved.

[46 FR 29186, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.555 Information material to patentability in *ex parte* reexamination and *inter partes* reexamination proceedings.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective reexamination occurs when, at the time a reexamination proceeding is being conducted, the Office is aware of and evaluates the teachings of all information material to patentability in a reexamination proceeding. Each individual associated with the patent owner in a reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding. The individuals who have a duty to disclose to the Office all information known to them to be material to patentability in a reexamination proceeding are the patent owner, each attorney or agent who represents the patent owner, and every other individual who is substantively involved on behalf of the patent owner in a reexamination proceeding. The duty to disclose the information exists with respect to each claim pending in the reexamination proceeding until the claim is cancelled. Information material to the patentability of a cancelled claim need not be submitted if the information is not material to patentability of any claim remaining under consideration in the reexamination proceeding. The duty to disclose all information known to be material to patentability in a reexamination proceeding is deemed to be satisfied if all information known to be material to patentability of any claim in the patent after issuance of the reexamination certificate was cited by the Office or submitted to the Office in an information disclosure statement. However, the duties of candor, good faith, and disclosure have not been complied with if any fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct by, or on behalf of, the patent owner in the reexamination proceeding. Any information disclosure statement must be filed with the items listed in § 1.98(a) as applied to individuals associated with the patent owner in a reexamination proceeding, and should be filed within two months of the date of the order for reexamination, or as soon thereafter as possible.

(b) Under this section, information is material to patentability in a reexamination proceeding when it is not cumulative to information of record or being made of record in the reexamination proceeding, and

(1) It is a patent or printed publication that establishes, by itself or in combination with other patents or printed publications, a *prima facie* case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the patent owner takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability of a claim pending in a reexamination proceeding is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.552(c).

[46 FR 29187, May 29, 1981, effective July 1, 1981; 47 FR 21752, May 19, 1982, effective July 1, 1982; paras. (a) and (b), 49 FR 556, Jan. 4, 1984, effective Apr. 1, 1984; revised 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; heading and para. (c) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.560 Interviews in *ex parte* reexamination proceedings.

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, 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. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an ex parte reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

[46 FR 29187, May 29, 1981, effective July 1, 1981; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.565 Concurrent office proceedings which include an *ex parte* reexamination proceeding.

(a) In an *ex parte* reexamination proceeding before the Office, the patent owner must inform the Office of any prior or concurrent proceedings in which the patent is or was involved such as interferences, reissues, *ex parte* reexaminations, *inter partes* reexaminations, or litigation and the results of such proceedings. See § 1.985 for notification of prior or concurrent proceedings in an *inter partes* reexamination proceeding.

(b) If a patent in the process of *ex parte* reexamination is or becomes involved in litigation, the Commissioner shall determine whether or not to suspend the reexamination. See § 1.987 for *inter partes* reexamination proceedings.

(c) If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will be consolidated and result in the issuance of a single certificate under § 1.570. For merger of *inter partes* reexamination proceedings, see § 1.989(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see § 1.989(b).

(d) If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *ex parte* reexamination proceeding is ordered, the merged examination will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *ex parte* reexamination proceeding during the pendency of the merged proceeding. The examiner's actions and responses by the patent owner in a merged proceeding will apply to both the reissue application and the *ex parte* reexamination proceeding and be physically entered into both files. Any *ex parte* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent. For merger of a reissue application and an *inter partes* reexamination, see § 1.991.

(e) If a patent in the process of *ex parte* reexamination is or becomes involved in an interference, the Commissioner may suspend the reexamination or the interference. The Commissioner will not consider a request to suspend an interference unless a motion (§ 1.635) to suspend the interference has been presented to, and denied by, an administrative patent judge, and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set. For concurrent *inter partes* reexamination and interference of a patent, see § 1.993.

[46 FR 29187, May 29, 1981, effective July 1, 1981; paras. (b) and (d), 47 FR 21753, May 19, 1982, effective July 1, 1982; paras. (b) & (e), 49 FR 48416, Dec. 12, 1984, 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; para (a) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7,

2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

CERTIFICATE

§ 1.570 Issuance of *ex parte* reexamination certificate after *ex parte* reexamination proceedings.

(a) Upon the conclusion of *ex parte* reexamination proceedings, the Commissioner will issue an *ex parte* reexamination certificate in accordance with 35 U.S.C. 307 setting forth the results of the *ex parte* reexamination proceeding and the content of the patent following the *ex parte* reexamination proceeding.

(b) An *ex parte* reexamination certificate will be issued in each patent in which an *ex parte* reexamination proceeding has been ordered under § 1.525 and has not been merged with any *inter partes* reexamination proceeding pursuant to § 1.989(a). Any statutory disclaimer filed by the patent owner will be made part of the *ex parte* reexamination certificate.

(c) The *ex parte* reexamination certificate will be mailed on the day of its date to the patent owner at the address as provided for in § 1.33(c). A copy of the *ex parte* reexamination certificate will also be mailed to the requester of the *ex parte* reexamination proceeding.

(d) If an *ex parte* reexamination certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *ex parte* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.565(d), the reissued patent will constitute the *ex parte* reexamination certificate required by this section and 35 U.S.C. 307.

(f) A notice of the issuance of each *ex parte* reexamination certificate under this section will be published in the *Official Gazette* on its date of issuance.

[46 FR 29187, May 29, 1981, effective July 1, 1981; para. (e), 47 FR 21753, May 19, 1982, effective July 1, 1982; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

Subpart E — Interferences

§ 1.601 Scope of rules, definitions.

This subpart governs the procedure in patent interferences in the Patent and Trademark Office. This subpart shall be construed to secure the just, speedy, and inexpensive determination of every interference. For the meaning of terms in the Federal Rules of Evidence as applied to interferences, see § 1.671(c). Unless otherwise clear from the context, the following definitions apply to this subpart:

(a) *Additional discovery* is discovery to which a party may be entitled under § 1.687 in addition to discovery to which the party is entitled as a matter of right under § 1.673(a) and (b).

(b) *Affidavit* means affidavit, declaration under § 1.68, or statutory declaration under 28 U.S.C. § 1746. A transcript of an *ex parte* deposition may be used as an affidavit.

(c) *Board* means the Board of Patent Appeals and Interferences.

(d) *Case-in-chief* means that portion of a party's case where the party has the burden of going forward with evidence.

(e) *Case-in-rebuttal* means that portion of a party's case where the party presents evidence in rebuttal to the case-in-chief of another party.

(f) A *count* defines the interfering subject matter between two or more applications or between one or more applications and one or more patents. When there is more than one count, each count shall define a separate patentable invention. Any claim of an application or patent that is designated to correspond to a count is a claim involved in the interference within the meaning of 35 U.S.C. 135(a). A claim of a patent or application that is designated to correspond to a count and is identical to the count is said to correspond exactly to the count. A claim of a patent or application that is designated to correspond to a count but is not identical to the count is said to correspond substantially to the count. When a count is broader in scope than all claims which correspond to the count, the count is a phantom count.

(g) The *effective filing date* of an application is the filing date of an earlier application, benefit of

which is accorded to the application under 35 U.S.C. 119, 120, 121, or 365 or, if no benefit is accorded, the filing date of the application. The effective filing date of a patent is the filing date of an earlier application, benefit of which is accorded to the patent under 35 U.S.C. 119, 120, 121, or 365 or, if no benefit is accorded, the filing date of the application which issued as the patent.

(h) In the case of an application, *filing date* means the filing date assigned to the application. In the case of a patent, "filing date" means the filing date assigned to the application which issued as the patent.

(i) An *interference* is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. An interference may be declared between two or more pending applications naming different inventors when, in the opinion of an examiner, the applications contain claims for the same patentable invention. An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an examiner, any application and any unexpired patent contain claims for the same patentable invention.

(j) An *interference-in-fact* exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention.

(k) A *lead* attorney or agent is a registered attorney or agent of record who is primarily responsible for prosecuting an interference on behalf of a party and is the attorney or agent whom an administrative patent judge may contact to set times and take other action in the interference.

(l) A *party* is an applicant or patentee involved in the interference or a legal representative or an assignee of record in the Patent and Trademark Office of an applicant or patentee involved in an interference. Where acts of a party are normally performed by an attorney or agent, "party" may be construed to mean the attorney or agent. An inventor is the individual named as inventor in an application involved in an interference or the individual named as inventor in a patent involved in an interference.

(m) A *senior party* is the party with the earliest effective filing date as to all counts or, if there is no party with the earliest effective filing date as to all counts, the party with the earliest filing date. A *junior party* is any other party.

(n) 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". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

(o) *Sworn* means sworn or affirmed.

(p) *United States* means the United States of America, its territories and possessions.

(q) A *final decision* is a decision awarding judgment as to all counts. An *interlocutory order* is any other action taken by an administrative patent judge or the Board in an interference, including the notice declaring an interference.

(r) *NAFTA country* means NAFTA country as defined in section 2(4) of the North American Free Trade Agreement Implementation Act, Pub. L. 103-182, 107 Stat. 2060 (19 U.S.C. 3301).

(s) *WTO member country* means WTO member country as defined in section 2(10) of the Uruguay Round Agreements Act, Pub. L. 103-465, 108 Stat. 4813 (19 U.S.C. 3501).

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985; para. (q) added, 58 FR 49432, Sept. 23, 1993, effective Oct. 25, 1993; paras. (f), (g), (j)-(n), and (q) revised, paras. (r) and (s) added, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; para. (f) revised, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000; (adopted as final, 65 FR 70489, Nov. 24, 2000)]

§ 1.602 Interest in applications and patents involved in an interference.

(a) Unless good cause is shown, an interference shall not be declared or continued between (1) applications owned by a single party or (2) applications and an unexpired patent owned by a single party.

(b) The parties, within 20 days after an interference is declared, shall notify the Board of any and all right, title, and interest in any application or patent

involved or relied upon in the interference unless the right, title, and interest is set forth in the notice declaring the interference.

(c) If a change of any right, title, and interest in any application or patent involved or relied upon in the interference occurs after notice is given declaring the interference and before the time expires for seeking judicial review of a final decision of the Board, the parties shall notify the Board of the change within 20 days after the change.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (c) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.603 Interference between applications; subject matter of the interference.

Before an interference is declared between two or more applications, the examiner must be of the opinion that there is interfering subject matter claimed in the applications which is patentable to each applicant subject to a judgment in the interference. The interfering subject matter shall be defined by one or more counts. Each application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. All claims in the applications which define the same patentable invention as a count shall be designated to correspond to the count.

[Added, 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.604 Request for interference between applications by an applicant.

(a) An applicant may seek to have an interference declared with an application of another by,

(1) Suggesting a proposed count and presenting at least one claim corresponding to the proposed count or identifying at least one claim in its application that corresponds to the proposed count,

(2) Identifying the other application and, if known, a claim in the other application which corresponds to the proposed count, and

(3) Explaining why an interference should be declared.

(b) When an applicant presents a claim known to the applicant to define the same patentable invention claimed in a pending application of another, the applicant shall identify that pending application, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where it appears an applicant may have failed to comply with the provisions of this paragraph.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a)(1) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.605 Suggestion of claim to applicant by examiner.

(a) If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner may suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent. 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. At the time the suggested claim is presented, the applicant may also call the examiner's attention to other claims already in the application or presented with the suggested claim and explain why the other claims would be more appropriate to be designated to correspond to a count in any interference which may be declared.

(b) The suggestion of a claim by the examiner for the purpose of an interference will not stay the period for response to any outstanding Office action. When a suggested claim is timely presented, *ex parte* proceedings in the application will be stayed pending a determination of whether an interference will be declared.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.606 Interference between an application and a patent; subject matter of the interference.

Before an interference is declared between an application and an unexpired patent, an examiner must determine that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference. The interfering subject matter will be defined by one or more counts. The application must contain, or be amended to contain, at least one claim that is patentable over the prior art and corresponds to each count. The claim in the application need not be, and most often will not be, identical to a claim in the patent. All claims in the application and patent which define the same patentable invention as a count shall be designated to correspond to the count.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; revised, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000 (adopted as final, 65 FR 70489, Nov. 24, 2000)]

§ 1.607 Request by applicant for interference with patent.

(a) An applicant may seek to have an interference declared between an application and an unexpired patent by,

(1) Identifying the patent,

(2) Presenting a proposed count,

(3) Identifying at least one claim in the patent corresponding to the proposed count,

(4) Presenting at least one claim corresponding to the proposed count or identifying at least one claim already pending in its application that corresponds to the proposed count, and, if any claim of the patent or application identified as corresponding to the proposed count does not correspond exactly to the proposed count, explaining why each such claim corresponds to the proposed count, and

(5) Applying the terms of any application claim,

(i) Identified as corresponding to the count, and

(ii) Not previously in the application to the disclosure of the application.

(6) Explaining how the requirements of 35 U.S.C. 135(b) are met, if the claim presented or identified under paragraph (a)(4) of this section was not present in the application until more than one year after the issue date of the patent.

(b) When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, an interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

(c) When an applicant presents a claim which corresponds exactly or substantially to a claim of a patent, the applicant shall identify the patent and the number of the patent claim, unless the claim is presented in response to a suggestion by the examiner. The examiner shall notify the Commissioner of any instance where an applicant fails to identify the patent.

(d) A notice that an applicant is seeking to provoke an interference with a patent will be placed in the file of the patent and a copy of the notice will be sent to the patentee. The identity of the applicant will not be disclosed unless an interference is declared. If a final decision is made not to declare an interference, a notice to that effect will be placed in the patent file and will be sent to the patentee.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a) amended, 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (a)(5)(i) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (a)(4) revised, para. (a)(6) added, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.608 Interference between an application and a patent; prima facie showing by applicant.

(a) When the effective filing date of an application is three months or less after the effective filing date of a patent, before an interference will be

declared, either the applicant or the applicant's attorney or agent of record shall file a statement alleging that there is a basis upon which the applicant is entitled to a judgment relative to the patentee.

(b) When the effective filing date of an application is more than three months after the effective filing date of a patent, the applicant, before an interference will be declared, shall file evidence which may consist of patents or printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment. Where the basis upon which an applicant is entitled to judgment relative to a patentee is priority of invention, the evidence shall include affidavits by the applicant, if possible, and one or more corroborating witnesses, supported by documentary evidence, if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would *prima facie* entitle the applicant to judgment on priority with respect to the effective filing date of the patent. To facilitate preparation of a record (§ 1.653(g)) for final hearing, an applicant should file affidavits on paper which is 21.8 by 27.9 cm. (8 1/2 x 11 inches). The significance of any printed publication or other document which is self-authenticating within the meaning of Rule 902 of the Federal Rules of Evidence or § 1.671(d) and any patent shall be discussed in an affidavit or the explanation. Any printed publication or other document which is not self-authenticating shall be authenticated and discussed with particularity in an affidavit. Upon a showing of good cause, an affidavit may be based on information and belief. If an examiner finds an application to be in condition for declaration of an interference, the examiner will consider the evidence and explanation only to the extent of determining whether a basis upon which the application would be entitled to a judgment relative to the patentee is alleged and, if a basis is alleged, an interference may be declared.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.609 [Reserved]

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (b)(1)-(b)(3) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; removed and reserved, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000]

§ 1.610 Assignment of interference to administrative patent judge, time period for completing interference.

(a) Each interference will be declared by an administrative patent judge who may enter all interlocutory orders in the interference, except that only the Board shall hear oral argument at final hearing, enter a decision under §1.617, 1.640(e), 1.652, 1.656(i) or 1.658, or enter any other order which terminates the interference.

(b) As necessary, another administrative patent judge may act in place of the one who declared the interference. At the discretion of the administrative patent judge assigned to the interference, a panel consisting of two or more members of the Board may enter interlocutory orders.

(c) Unless otherwise provided in this subpart, times for taking action by a party in the interference will be set on a case-by-case basis by the administrative patent judge assigned to the interference. Times for taking action shall be set and the administrative patent judge shall exercise control over the interference such that the pendency of the interference before the Board does not normally exceed two years.

(d) An administrative patent judge may hold a conference with the parties to consider simplification of any issues, the necessity or desirability of amendments to counts, the possibility of obtaining admissions of fact and genuineness of documents which will avoid unnecessary proof, any limitations on the number of expert witnesses, the time and place for conducting a deposition (§ 1.673(g)), and any other matter as may aid in the disposition of the interference. After a conference, the administrative patent judge may enter any order which may be appropriate.

(e) The administrative patent judge may determine a proper course of conduct in an interference for any situation not specifically covered by this part.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.611 Declaration of interference.

(a) Notice of declaration of an interference will be sent to each party.

(b) When a notice of declaration is returned to the Patent and Trademark Office undelivered, or in any other circumstance where appropriate, an administrative patent judge may send a copy of the notice to a patentee named in a patent involved in an interference or the patentee's assignee of record in the Patent and Trademark Office or order publication of an appropriate notice in the *Official Gazette*.

(c) The notice of declaration shall specify:

(1) The name and residence of each party involved in the interference;

(2) The name and address of record of any attorney or agent of record in any application or patent involved in the interference;

(3) The name of any assignee of record in the Patent and Trademark Office;

(4) The identity of any application or patent involved in the interference;

(5) Where a party is accorded the benefit of the filing date of an earlier application, the identity of the earlier application;

(6) The count or counts and, if there is more than one count, the examiner's explanation why the counts define different patentable inventions;

(7) The claim or claims of any application or any patent which correspond to each count;

(8) The examiner's explanation as to why each claim designated as corresponding to a count is directed to the same patentable invention as the count and why each claim designated as not corresponding to any count is not directed to the same patentable invention as any count; and

(9) The order of the parties.

(d) The notice of declaration may also specify the time for:

(1) Filing a preliminary statement as provided in § 1.621(a);

(2) Serving notice that a preliminary statement has been filed as provided in § 1.621(b); and

(3) Filing preliminary motions authorized by § 1.633.

(e) Notice may be given in the *Official Gazette* that an interference has been declared involving a patent.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985; paras. (b), (c)(6), (c)(7), (c)(8), (c)(9) & (d) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.612 Access to applications.

(a) After an interference is declared, each party shall have access to and may obtain copies of the files of any application set out in the notice declaring the interference, except for affidavits filed under § 1.131 and any evidence and explanation under § 1.608 filed separate from an amendment. A party seeking access to any abandoned or pending application referred to in the opponent's involved application or access to any pending application referred to in the opponent's patent must file a motion under § 1.635. See § 1.11(e) concerning public access to interference files.

(b) After preliminary motions under § 1.633 are decided (§ 1.640(b)), each party shall have access to and may obtain copies of any affidavit filed under § 1.131 and any evidence and explanation filed under § 1.608 in any application set out in the notice declaring the interference.

(c) Any evidence and explanation filed under § 1.608 in the file of any application identified in the notice declaring the interference shall be served when required by § 1.617(b).

(d) The parties at any time may agree to exchange copies of papers in the files of any application identified in the notice declaring the interference.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; para. (a) amended, 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (a) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.613 Lead attorney, same attorney representing different parties in an interference, withdrawal of attorney or agent.

(a) Each party may be required to designate one attorney or agent of record as the lead attorney or agent.

(b) The same attorney or agent or members of the same firm of attorneys or agents may not represent two or more parties in an interference except as may be permitted under this chapter.

(c) An administrative patent judge may make necessary inquiry to determine whether an attorney or

agent should be disqualified from representing a party in an interference. If an administrative patent judge is of the opinion that an attorney or agent should be disqualified, the administrative patent judge shall refer the matter to the Commissioner. The Commissioner will make a final decision as to whether any attorney or agent should be disqualified.

(d) No attorney or agent of record in an interference may withdraw as attorney or agent of record except with the approval of an administrative patent judge and after reasonable notice to the party on whose behalf the attorney or agent has appeared. A request to withdraw as attorney or agent of record in an interference shall be made by motion (§ 1.635).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (c) & (d) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.614 Jurisdiction over interference.

(a) The Board acquires jurisdiction over an interference when the interference is declared under § 1.611.

(b) When the interference is declared the interference is a contested case within the meaning of 35 U.S.C. 24.

(c) The examiner shall have jurisdiction over any pending application until the interference is declared. An administrative patent judge may for a limited purpose restore jurisdiction to the examiner over any application involved in the interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a) & (c) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.615 Suspension of *ex parte* prosecution.

(a) When an interference is declared, *ex parte* prosecution of an application involved in the interference is suspended. Amendments and other papers related to the application received during pendency of the interference will not be entered or considered in the interference without the consent of an administrative patent judge.

(b) *Ex parte* prosecution as to specified matters may be continued concurrently with the interference with the consent of the administrative patent judge.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.616 Sanctions for failure to comply with rules or order or for taking and maintaining a frivolous position.

(a) An administrative patent judge or the Board may impose an appropriate sanction against a party who fails to comply with the regulations of this part or any order entered by an administrative patent judge or the Board. An appropriate sanction may include among others entry of an order:

(1) Holding certain facts to have been established in the interference;

(2) Precluding a party from filing a paper;

(3) Precluding a party from presenting or contesting a particular issue;

(4) Precluding a party from requesting, obtaining, or opposing discovery;

(5) Awarding compensatory expenses and/or compensatory attorney fees; or

(6) Granting judgment in the interference.

(b) An administrative patent judge or the Board may impose a sanction, including a sanction in the form of compensatory expenses and/or compensatory attorney fees, against a party for taking and maintaining a frivolous position in papers filed in the interference.

(c) To the extent that an administrative patent judge or the Board has authorized a party to compel the taking of testimony or the production of documents or things from an individual or entity located in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention (§ 1.671(h)), but the testimony, documents or things have not been produced for use in the interference to the same extent as such information could be made available in the United States, the administrative patent judge or the Board shall draw such adverse inferences as may be appropriate under the circumstances, or take such other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the interference, including imposition of appropriate sanctions under paragraph (a) of this section.

(d) A party may file a motion (§ 1.635) for entry of an order imposing sanctions, the drawing of

adverse inferences or other action under paragraph (a), (b) or (c) of this section. Where an administrative patent judge or the Board on its own initiative determines that a sanction, adverse inference or other action against a party may be appropriate under paragraph (a), (b) or (c) of this section, the administrative patent judge or the Board shall enter an order for the party to show cause why the sanction, adverse inference or other action is not appropriate. The Board shall take action in accordance with the order unless, within 20 days after the date of the order, the party files a paper which shows good cause why the sanction, adverse inference or other action would not be appropriate.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.617 Summary judgment against applicant.

(a) An administrative patent judge shall review any evidence filed by an applicant under § 1.608(b) to determine if the applicant is *prima facie* entitled to a judgment relative to the patentee. If the administrative patent judge determines that the evidence shows the applicant is *prima facie* entitled to a judgment relative to the patentee, the interference shall proceed in the normal manner under the regulations of this part. If in the opinion of the administrative patent judge the evidence fails to show that the applicant is *prima facie* entitled to a judgment relative to the patentee, the administrative patent judge shall, concurrently with the notice declaring the interference, enter an order stating the reasons for the opinion and directing the applicant, within a time set in the order, to show cause why summary judgment should not be entered against the applicant.

(b) The applicant may file a response to the order, which may include an appropriate preliminary motion under § 1.633(c), (f) or (g), and state any reasons why summary judgment should not be entered. Any request by the applicant for a hearing before the Board shall be made in the response. Additional evidence shall not be presented by the applicant or considered by the Board unless the applicant shows good cause why any additional evidence was not initially presented with the evidence filed under § 1.608(b). At the time an applicant files a response, the applicant shall serve a copy of any evidence filed under § 1.608(b) and this paragraph.

(c) If a response is not timely filed by the applicant, the Board shall enter a final decision granting summary judgment against the applicant.

(d) If a response is timely filed by the applicant, all opponents may file a statement and may oppose any preliminary motion filed under § 1.633(c), (f) or (g) by the applicant within a time set by the administrative patent judge. The statement may set forth views as to why summary judgment should be granted against the applicant, but the statement shall be limited to discussing why all the evidence presented by the applicant does not overcome the reasons given by the administrative patent judge for issuing the order to show cause. Except as required to oppose a motion under § 1.633(c), (f) or (g) by the applicant, evidence shall not be filed by any opponent. An opponent may not request a hearing.

(e) Within a time authorized by the administrative patent judge, an applicant may file a reply to any statement or opposition filed by any opponent.

(f) When more than two parties are involved in an interference, all parties may participate in summary judgment proceedings under this section.

(g) If a response by the applicant is timely filed, the administrative patent judge or the Board shall decide whether the evidence submitted under § 1.608(b) and any additional evidence properly submitted under paragraphs (b) and (e) of this section shows that the applicant is *prima facie* entitled to a judgment relative to the patentee. If the applicant is not *prima facie* entitled to a judgment relative to the patentee, the Board shall enter a final decision granting summary judgment against the applicant. Otherwise, an interlocutory order shall be entered authorizing the interference to proceed in the normal manner under the regulations of this subpart.

(h) Only an applicant who filed evidence under § 1.608(b) may request a hearing. If that applicant requests a hearing, the Board may hold a hearing prior to entry of a decision under paragraph (g) of this section. The administrative patent judge shall set a date and time for the hearing. Unless otherwise ordered by the administrative patent judge or the Board, the applicant and any opponent will each be entitled to no more than 30 minutes of oral argument at the hearing.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a), (b), (d), (e), (g), & (h) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.618 Return of unauthorized papers.

(a) An administrative patent judge or the Board shall return to a party any paper presented by the party when the filing of the paper is not authorized by, or is not in compliance with the requirements of, this subpart. Any paper returned will not thereafter be considered in the interference. A party may be permitted to file a corrected paper under such conditions as may be deemed appropriate by an administrative patent judge or the Board.

(b) When presenting a paper in an interference, a party shall not submit with the paper a copy of a paper previously filed in the interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; amended, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.621 Preliminary statement, time for filing, notice of filing.

(a) Within the time set for filing preliminary motions under § 1.633, each party may file a preliminary statement. The preliminary statement may be signed by any individual having knowledge of the facts recited therein or by an attorney or agent of record.

(b) When a party files a preliminary statement, the party shall also simultaneously file and serve on all opponents in the interference a notice stating that a preliminary statement has been filed. A copy of the preliminary statement need not be served until ordered by the administrative patent judge.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.622 Preliminary statement, who made invention, where invention made.

(a) A party's preliminary statement must identify the inventor who made the invention defined by each count and must state on behalf of the inventor the facts required by paragraph (a) of §§ 1.623, 1.624, and 1.625 as may be appropriate. When an inventor identified in the preliminary statement is not an inventor named in the party's application or patent, the party shall file a motion under § 1.634 to correct inventorship.

(b) The preliminary statement shall state whether the invention was made in the United States, a NAFTA country (and, if so, which NAFTA country), a WTO member country (and, if so, which WTO member country), or in a place other than the United States, a NAFTA country, or a WTO member country. If made in a place other than the United States, a NAFTA country, or a WTO member country, the preliminary statement shall state whether the party is entitled to the benefit of 35 U.S.C. 104(a)(2).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (b) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.623 Preliminary statement; invention made in United States, a NAFTA country, or a WTO member country.

(a) When the invention was made in the United States, a NAFTA country, or a WTO member country, or a party is entitled to the benefit of 35 U.S.C. 104(a)(2), the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which the first drawing of the invention was made.

(2) The date on which the first written description of the invention was made.

(3) The date on which the invention was first disclosed by the inventor to another person.

(4) The date on which the invention was first conceived by the inventor.

(5) The date on which the invention was first actually reduced to practice. If the invention was not actually reduced to practice by or on behalf of the inventor prior to the party's filing date, the preliminary statement shall so state.

(6) The date after the inventor's conception of the invention when active exercise of reasonable diligence toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was made, a copy of the

first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or written description cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.624 Preliminary statement; invention made in a place other than the United States, a NAFTA country, or a WTO member country.

(a) When the invention was made in a place other than the United States, a NAFTA country, or a WTO member country and a party intends to rely on introduction of the invention into the United States, a NAFTA country, or a WTO member country, the preliminary statement must state the following facts as to the invention defined by each count:

(1) The date on which a drawing of the invention was first introduced into the United States, a NAFTA country, or a WTO member country.

(2) The date on which a written description of the invention was first introduced into the United States, a NAFTA country, or a WTO member country.

(3) The date on which the invention was first disclosed to another person in the United States, a NAFTA country, or a WTO member country.

(4) The date on which the inventor's conception of the invention was first introduced into the United States, a NAFTA country, or a WTO member country.

(5) The date on which an actual reduction to practice of the invention was first introduced into the United States, a NAFTA country, or a WTO member country. If an actual reduction to practice of the invention was not introduced into the United States, a NAFTA country, or a WTO member country, the preliminary amendment shall so state.

(6) The date after introduction of the inventor's conception into the United States, a NAFTA country, or a WTO member country when active exercise of reasonable diligence in the United States, a NAFTA country, or a WTO member country toward reducing the invention to practice began.

(b) If a party intends to prove derivation, the preliminary statement must also comply with § 1.625.

(c) When a party alleges under paragraph (a)(1) of this section that a drawing was introduced into the United States, a NAFTA country, or a WTO member country, a copy of that drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(2) of this section that a written description of the invention was introduced into the United States, a NAFTA country, or a WTO member country, a copy of that written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a copy of the first drawing or first written description introduced in the United States, a NAFTA country, or a WTO member country cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; para. (a) & (c) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.625 Preliminary statement; derivation by an opponent

(a) When a party intends to prove derivation by an opponent from the party, the preliminary statement must state the following as to the invention defined by each count:

(1) The name of the opponent.

(2) The date on which the first drawing of the invention was made.

(3) The date on which the first written description of the invention was made.

(4) The date on which the invention was first disclosed by the inventor to another person.

(5) The date on which the invention was first conceived by the inventor.

(6) The date on which the invention was first communicated to the opponent.

(b) If a party intends to prove priority, the preliminary statement must also comply with § 1.623 or § 1.624.

(c) When a party alleges under paragraph (a)(2) of this section that a drawing was made, a copy of the first drawing shall be filed with and identified in the preliminary statement. When a party alleges under paragraph (a)(3) of this section that a written descrip-

tion of the invention was made, a copy of the first written description shall be filed with and identified in the preliminary statement. See § 1.628(b) when a first drawing or first written description cannot be filed with the preliminary statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11,1985; para. (a) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.626 Preliminary statement; earlier application.

When a party does not intend to present evidence to prove a conception or an actual reduction to practice and the party intends to rely solely on the filing date of an earlier filed application to prove a constructive reduction to practice, the preliminary statement may so state and identify the earlier filed application with particularity.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.627 Preliminary statement; sealing before filing, opening of statement.

(a) The preliminary statement and copies of any drawing or written description shall be filed in a sealed envelope bearing only the name of the party filing the statement and the style (e.g., Jones v. Smith) and number of the interference. The sealed envelope should contain only the preliminary statement and copies of any drawing or written description. If the preliminary statement is filed through the mail, the sealed envelope should be enclosed in an outer envelope addressed to the Commissioner of Patents and Trademarks in accordance with § 1.1(e).

(b) A preliminary statement may be opened only at the direction of an administrative patent judge.

[49 FR48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (b) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.628 Preliminary statement; correction of error.

(a) A material error arising through inadvertence or mistake in connection with a preliminary statement or drawings or a written description submitted therewith or omitted therefrom may be corrected by a motion (§ 1.635) for leave to file a corrected statement. The motion shall be supported by an affidavit stating the date the error was first discovered, shall be accompanied by the corrected statement and shall be filed as soon as practical after discovery of the error. If filed on or after the date set by the administrative patent judge for service of preliminary statements, the motion shall also show that correction of the error is essential to the interest of justice.

(b) When a party cannot attach a copy of a drawing or a written description to the party's preliminary statement as required by § 1.623(c), § 1.624(c) or § 1.625(c), the party shall show good cause and explain in the preliminary statement why a copy of the drawing or written description cannot be attached to the preliminary statement and shall attach to the preliminary statement the earliest drawing or written description made in or introduced into the United States, a NAFTA country, or a WTO member country which is available. The party shall file a motion (§ 1.635) to amend its preliminary statement promptly after the first drawing, first written description, or drawing or written description first introduced into the United States, a NAFTA country, or a WTO member country becomes available. A copy of the drawing or written description may be obtained, where appropriate, by a motion (§ 1.635) for additional discovery under § 1.687 or during a testimony period.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.629 Effect of preliminary statement.

(a) A party shall be strictly held to any date alleged in the preliminary statement. Doubts as to definiteness or sufficiency of any allegation in a preliminary statement or compliance with formal requirements will be resolved against the party filing the statement by restricting the party to its effective filing date or to the latest date of a period alleged in the preliminary statement, as may be appropriate. A party may not correct a preliminary statement except as provided by § 1.628.

(b) Evidence which shows that an act alleged in the preliminary statement occurred prior to the date alleged in the statement shall establish only that the

act occurred as early as the date alleged in the statement.

(c) If a party does not file a preliminary statement, the party:

(1) Shall be restricted to the party's effective filing date and

(2) Will not be permitted to prove that:

(i) The party made the invention prior to the party's filing date or

(ii) Any opponent derived the invention from the party.

(d) If a party files a preliminary statement which contains an allegation of a date of first drawing or first written description and the party does not file a copy of the first drawing or written description with the preliminary statement as required by § 1.623(c), § 1.624(c), or § 1.625(c), the party will be restricted to the party's effective filing date as to that allegation unless the party complies with § 1.628(b). The content of any drawing or written description submitted with a preliminary statement will not normally be evaluated or considered by the Board.

(e) A preliminary statement shall not be used as evidence on behalf of the party filing the statement.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a), (c)(1) & (d) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.630 Reliance on earlier application.

A party shall not be entitled to rely on the filing date of an earlier filed application unless the earlier application is identified (§ 1.611(c)(5)) in the notice declaring the interference or the party files a preliminary motion under § 1.633 seeking the benefit of the filing date of the earlier application.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.631 Access to preliminary statement, service of preliminary statement.

(a) Unless otherwise ordered by an administrative patent judge, concurrently with entry of a decision on preliminary motions filed under § 1.633 any preliminary statement filed under § 1.621(a) shall be opened to inspection by the senior party and any junior party who filed a preliminary statement. Within a time set by the administrative patent judge, a party shall serve a copy of its preliminary statement on each opponent who served a notice under § 1.621(b).

(b) A junior party who does not file a preliminary statement shall not have access to the preliminary statement of any other party.

(c) If an interference is terminated before the preliminary statements have been opened, the preliminary statements will remain sealed and will be returned to the respective parties who submitted the statements.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.632 Notice of intent to argue abandonment, suppression or concealment by opponent.

A notice shall be filed by a party who intends to argue that an opponent has abandoned, suppressed, or concealed an actual reduction to practice (35 U.S.C. 102(g)). A party will not be permitted to argue abandonment, suppression, or concealment by an opponent unless the notice is timely filed. Unless authorized otherwise by an administrative patent judge, a notice is timely when filed within ten (10) days after the close of the testimony-in-chief of the opponent.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.633 Preliminary motions.

A party may file the following preliminary motions:

(a) A motion for judgment against an opponent's claim designated to correspond to a count on the ground that the claim is not patentable to the opponent. The motion shall separately address each claim alleged to be unpatentable. In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears. A motion under this paragraph shall not be based on:

(1) Priority of invention by the moving party as against any opponent or

(2) Derivation of the invention by an opponent from the moving party. See § 1.637(a).

(b) A motion for judgment on the ground that there is no interference-in-fact. A motion under this paragraph is proper only if the interference involves a design application or patent or a plant application or patent or no claim of a party which corresponds to a count is identical to any claim of an opponent which corresponds to that count. See § 1.637(a). When claims of different parties are presented in "means plus function" format, it may be possible for the claims of the different parties not to define the same patentable invention even though the claims contain the same literal wording.

(c) A motion to redefine the interfering subject matter by (1) adding or substituting a count, (2) amending an application claim corresponding to a count or adding a claim in the moving party's application to be designated to correspond to a count, (3) designating an application or patent claim to correspond to a count, (4) designating an application or patent claim as not corresponding to a count, or (5) requiring an opponent who is an applicant to add a claim and to designate the claim to correspond to a count. See § 1.637(a) and (c).

(d) A motion to substitute a different application owned by a party for an application involved in the interference. See § 1.637(a) and (d).

(e) A motion to declare an additional interference (1) between an additional application not involved in the interference and owned by a party and an opponent's application or patent involved in the interference or (2) when an interference involves three or more parties, between less than all applications and any patent involved in the interference. See § 1.637 (a) and (e).

(f) A motion to be accorded the benefit of the filing date of an earlier filed application. See § 1.637 (a) and (f).

(g) A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier filed application. See § 1.637 (a) and (g).

(h) When a patent is involved in an interference and the patentee has on file or files an application for reissue under § 1.171, a motion to add the application for reissue to the interference. See § 1.637(a) and (h).

(i) When a motion is filed under paragraph (a), (b), or (g) of this section, an opponent, in addition to opposing the motion, may file a motion to redefine the interfering subject matter under paragraph (c) of this section, a motion to substitute a different application under paragraph (d) of this section, or a motion to add a reissue application to the interference under paragraph (h) of this section.

(j) When a motion is filed under paragraph (c)(1) of this section an opponent, in addition to opposing the motion, may file a motion for benefit under paragraph (f) of this section as to the count to be added or substituted.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a), (b), (f), (g), & (i) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.634 Motion to correct inventorship.

A party may file a motion to (a) amend its application involved in an interference to correct inventorship as provided by § 1.48 or (b) correct inventorship of its patent involved in an interference as provided in § 1.324. See § 1.637(a).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.635 Miscellaneous motions.

A party seeking entry of an order relating to any matter other than a matter which may be raised under §§ 1.633 or 1.634 may file a motion requesting entry of the order. See § 1.637 (a) and (b).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.636 Motions, time for filing.

(a) A preliminary motion under § 1.633 (a) through (h) shall be filed within a time period set by an administrative patent judge.

(b) A preliminary motion under § 1.633 (i) or (j) shall be filed within 20 days of the service of the preliminary motion under § 1.633 (a), (b), (c)(1), or (g) unless otherwise ordered by an administrative patent judge.

(c) A motion under § 1.634 shall be diligently filed after an error is discovered in the inventorship of an application or patent involved in an interference

unless otherwise ordered by an administrative patent judge.

(d) A motion under § 1.635 shall be filed as specified in this subpart or when appropriate unless otherwise ordered by an administrative patent judge.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.637 Content of motions.

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full statement of the reasons why the relief requested should be granted. If a party files a motion for judgment under § 1.633(a) against an opponent based on the ground of unpatentability over prior art, and the dates of the cited prior art are such that the prior art appears to be applicable to the party, it will be presumed, without regard to the dates alleged in the preliminary statement of the party, that the cited prior art is applicable to the party unless there is included with the motion an explanation, and evidence if appropriate, as to why the prior art does not apply to the party.

(b) Unless otherwise ordered by an administrative patent judge or the Board, a motion under § 1.635 shall contain a certificate by the moving party stating that the moving party has conferred with all opponents in an effort in good faith to resolve by agreement the issues raised by the motion. The certificate shall indicate whether any opponent plans to oppose the motion. The provisions of this paragraph do not apply to a motion to suppress evidence (§ 1.656(h)).

(c) A preliminary motion under § 1.633(c) shall explain why the interfering subject matter should be redefined.

(1) A preliminary motion seeking to add or substitute a count shall:

(i) Propose each count to be added or substituted.

(ii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iii) Identify all claims in an opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claims to the opponent and apply the terms of the claims to the disclosure of the opponent's application.

(iv) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(v) Show that each proposed count defines a separate patentable invention from every other count proposed to remain in the interference.

(vi) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit of the earlier filed application is desired with respect to a proposed count.

(vii) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not also entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.

(2) A preliminary motion seeking to amend an application claim corresponding to a count or adding a claim to be designated to correspond to a count shall:

(i) Propose an amended or added claim.

(ii) Show that the claim proposed to be amended or added defines the same patentable invention as the count.

(iii) Show the patentability to the applicant of each claim proposed to be amended or added and apply the terms of the claim proposed to be amended or added to the disclosure of the application; when necessary a moving party applicant shall file with the motion a proposed amendment to the application amending the claim corresponding to the count or adding the proposed additional claim to the application.

(3) A preliminary motion seeking to designate an application or patent claim to correspond to a count shall:

(i) Identify the claim and the count.

(ii) Show the claim defines the same patentable invention as another claim whose designation as corresponding to the count the moving party does not dispute.

(4) A preliminary motion seeking to designate an application or patent claim as not corresponding to a count shall:

(i) Identify the claim and the count.

(ii) Show that the claim does not define the same patentable invention as any other claim whose designation in the notice declaring the interference as corresponding to the count the party does not dispute.

(5) A preliminary motion seeking to require an opponent who is an applicant to add a claim and designate the claim as corresponding to a count shall:

(i) Propose a claim to be added by the opponent.

(ii) Show the patentability to the opponent of the claim and apply the terms of the claim to the disclosure of the opponent's application.

(iii) Identify the count to which the claim shall be designated to correspond.

(iv) Show the claim defines the same patentable invention as the count to which it will be designated to correspond.

(d) A preliminary motion under § 1.633(d) to substitute a different application of the moving party shall:

(1) Identify the different application.

(2) Certify that a complete copy of the file of the different application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents.

(3) Show the patentability to the applicant of all claims in, or proposed to be added to, the different application which correspond to each count and apply the terms of the claims to the disclosure of the different application; when necessary the applicant shall file with the motion an amendment adding a claim to the different application.

(e) A preliminary motion to declare an additional interference under § 1.633(e) shall explain why an additional interference is necessary.

(1) When the preliminary motion seeks an additional interference under § 1.633(e)(1), the motion shall:

(i) Identify the additional application.

(ii) Certify that a complete copy of the file of the additional application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents.

(iii) Propose a count for the additional interference.

(iv) Show the patentability to the applicant of all claims in, or proposed to be added to, the additional application which correspond to each proposed count for the additional interference and apply the terms of the claims to the disclosure of the additional application; when necessary the applicant shall file with the motion an amendment adding any claim to the additional application.

(v) When the opponent is an applicant, show the patentability to the opponent of any claims in, or proposed to be added to, the opponent's application which correspond to the proposed count and apply the terms of the claims to the disclosure of the opponent's application.

(vi) Identify all claims in the opponent's application or patent which should be designated to correspond to each proposed count; if the opponent's application does not contain any such claim, the motion shall propose a claim to be added to the opponent's application.

(vii) Show that each proposed count for the additional interference defines a separate patentable invention from all counts of the interference in which the motion is filed.

(viii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of

an earlier filed application, if benefit is desired with respect to a proposed count.

(ix) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not also entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.

(2) When the preliminary motion seeks an additional interference under § 1.633(e)(2), the motion shall:

(i) Identify any application or patent to be involved in the additional interference.

(ii) Propose a count for the additional interference.

(iii) When the moving party is an applicant, show the patentability to the applicant of all claims in, or proposed to be added to, the party's application which correspond to each proposed count and apply the terms of the claims to the disclosure of the party's application; when necessary a moving party applicant shall file with the motion an amendment adding any proposed claim to the application.

(iv) Identify all claims in any opponent's application which should be designated to correspond to each proposed count; if an opponent's application does not contain such a claim, the moving party shall propose a claim to be added to the opponent's application. The moving party shall show the patentability of any proposed claim to the opponent and apply the terms of the claim to the disclosure of the opponent's application.

(v) Designate the claims of any patent involved in the interference which define the same patentable invention as each proposed count.

(vi) Show that each proposed count for the additional interference defines a separate patentable invention from all counts in the interference in which the motion is filed.

(vii) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of an earlier filed application, if benefit is desired with respect to a proposed count.

(viii) If an opponent is accorded the benefit of the filing date of an earlier filed application in the notice of declaration of the interference, show why the opponent is not also entitled to benefit of the earlier filed application with respect to the proposed count. Otherwise, the opponent will be presumed to be entitled to the benefit of the earlier filed application with respect to the proposed count.

(f) A preliminary motion for benefit under § 1.633(f) shall:

(1) Identify the earlier application.

(2) When the earlier application is an application filed in the United States, certify that a complete copy of the file of the earlier application, except for documents filed under § 1.131 or § 1.608, has been served on all opponents. When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.

(3) Show that the earlier application constitutes a constructive reduction to practice of each count.

(g) A preliminary motion to attack benefit under § 1.633(g) shall explain, as to each count, why an opponent should not be accorded the benefit of the filing date of the earlier application.

(h) A preliminary motion to add an application for reissue under § 1.633(h) shall:

(1) Identify the application for reissue.

(2) Certify that a complete copy of the file of the application for reissue has been served on all opponents.

(3) Show the patentability of all claims in, or proposed to be added to, the application for reissue which correspond to each count and apply the terms of the claims to the disclosure of the application for reissue; when necessary a moving applicant for reissue shall file with the motion an amendment adding any proposed claim to the application for reissue.

(4) Be accompanied by a motion under § 1.633(f) requesting the benefit of the filing date of any earlier filed application, if benefit is desired.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; para. (e)(1)(vi) revised 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; para. (a) revised, 58 FR 49432, Sept. 23, 1993, effective Oct. 25, 1993; paras. (a), (b), (c)(1)(v), (c)(1)(vi), (c)(20(ii), (c)(2)(iii), (c)(3)(ii), (c)(4)(ii), (d), (e)(1)(viii), (e)(2)(vii), (f)(2), & (h)(4) revised, paras. (c)(2)(iv), (c)(3)(iii), & (d)(4) removed, paras. (c)(1)(vii), (e)(1)(ix),

& (e)(2)(viii) added, 60 FR 14488. Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.638 Opposition and reply; time for filing opposition and reply.

(a) Unless otherwise ordered by an administrative patent judge, any opposition to any motion shall be filed within 20 days after service of the motion. An opposition shall identify any material fact set forth in the motion which is in dispute and include an argument why the relief requested in the motion should be denied.

(b) Unless otherwise ordered by an administrative patent judge, any reply shall be filed within 15 days after service of the opposition. A reply shall be directed only to new points raised in the opposition.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.639 Evidence in support of motion, opposition, or reply.

(a) Except as provided in paragraphs (c) through (g) of this section, proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

(b) Proof may be in the form of patents, printed publications, and affidavits. The pages of any affidavits filed under this paragraph shall, to the extent possible, be given sequential numbers, which shall also serve as the record page numbers for the affidavits in the event they are included in the party's record (§ 1.653). Any patents and printed publications submitted under this paragraph and any exhibits identified in affidavits submitted under this paragraph shall, to the extent possible, be given sequential exhibit numbers, which shall also serve as the exhibit numbers in the event the patents, printed publications and exhibits are filed with the party's record (§ 1.653).

(c) If a party believes that additional evidence in the form of testimony that is unavailable to the party is necessary to support or oppose a preliminary motion under § 1.633 or a motion to correct inventorship under § 1.634, the party shall describe the nature of any proposed testimony as specified in paragraphs (d) through (g) of this section. If the administrative patent judge finds that testimony is needed to decide the motion, the administrative patent judge may grant appropriate interlocutory relief and enter an order authorizing the taking of testimony and deferring a decision on the motion to final hearing.

(d) When additional evidence in the form of expert-witness testimony is needed in support of or opposition to a preliminary motion, the moving party or opponent should:

(1) Identify the person whom it expects to use as an expert;

(2) State the field in which the person is alleged to be an expert; and

(3) State:

(i) The subject matter on which the person is expected to testify;

(ii) The facts and opinions to which the person is expected to testify; and

(iii) A summary of the grounds and basis for each opinion.

(e) When additional evidence in the form of fact-witness testimony is necessary, state the facts to which the witness is expected to testify.

(f) If the opponent is to be called, or if evidence in the possession of the opponent is necessary, explain the evidence sought, what it will show, and why it is needed.

(g) When *inter partes* tests are to be performed, describe the tests stating what they will be expected to show.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (c) revised, 58 FR 49432, Sept. 23, 1993, effective Oct. 25, 1993; paras. (d)-(g) added, 58 FR 49432, Sept. 23, 1993, effective Oct. 25, 1993; paras. (a)-(d)(1) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.640 Motions, hearing and decision, redeclaration of interference, order to show cause.

(a) A hearing on a motion may be held in the discretion of the administrative patent judge. The administrative patent judge shall set the date and time for any hearing. The length of oral argument at a hearing on a motion is a matter within the discretion of the

administrative patent judge. An administrative patent judge may direct that a hearing take place by telephone.

(b) Unless an administrative patent judge or the Board is of the opinion that an earlier decision on a preliminary motion would materially advance the resolution of the interference, decision on a preliminary motion shall be deferred to final hearing. Motions not deferred to final hearing will be decided by an administrative patent judge. An administrative patent judge may consult with an examiner in deciding motions. An administrative patent judge may take up motions for decisions in any order, may grant, deny, or dismiss any motion, and may take such other action which will secure the just, speedy, and inexpensive determination of the interference. A matter raised by a party in support of or in opposition to a motion that is deferred to final hearing will not be entitled to consideration at final hearing unless the matter is raised in the party's brief at final hearing. If the administrative patent judge determines that the interference shall proceed to final hearing on the issue of priority or derivation, a time shall be set for each party to file a paper identifying any decisions on motions or on matters raised *sua sponte* by the administrative patent judge that the party wishes to have reviewed at final hearing as well as identifying any deferred motions that the party wishes to have considered at final hearing. Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified by the party or by an opponent for consideration or review at final hearing shall be filed or, if appropriate, noticed under § 1.671(e) during the testimony-in-chief period of the party.

(1) When appropriate after the time expires for filing replies to oppositions to preliminary motions, the administrative patent judge will set a time for filing any amendment to an application involved in the interference and for filing a supplemental preliminary statement as to any new counts which may become involved in the interference if a preliminary motion to amend or substitute a count has been filed. Failure or refusal of a party to timely present an amendment required by an administrative patent judge shall be taken without further action as a disclaimer by that party of the invention involved. A supplemental preliminary statement shall meet the requirements specified in § 1.623, 1.624, 1.625, or 1.626, but need not be filed if a party states that it intends to rely on a preliminary statement previously filed under § 1.621(a). At an appropriate time in the interference, and when necessary, an order will be entered redeclaring the interference.

(2) After the time expires for filing preliminary motions, a further preliminary motion under § 1.633 will not be considered except as provided by § 1.645(b).

(c) When a decision on any motion under §§ 1.633, 1.634, or 1.635 or on any matter raised *sua sponte* by an administrative patent judge is entered which does not result in the issuance of an order to show cause under paragraph (d) of this section, a party may file a request for reconsideration within 14 days after the date of the decision. The request for reconsideration shall be filed and served by hand or Express Mail. The filing of a request for reconsideration will not stay any time period set by the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. No opposition to a request for reconsideration shall be filed unless requested by an administrative patent judge or the Board. A decision ordinarily will not be modified unless an opposition has been requested by an administrative patent judge or the Board. The request for reconsideration normally will be acted on by the administrative patent judge or the panel of the Board which issued the decision.

(d) An administrative patent judge may issue an order to show cause why judgment should not be entered against a party when:

(1) A decision on a motion or on a matter raised sua sponte by an administrative patent judge is entered which is dispositive of the interference against the party as to any count;

(2) The party is a junior party who fails to file a preliminary statement; or

(3) The party is a junior party whose preliminary statement fails to overcome the effective filing date of another party.

(e) When an order to show cause is issued under paragraph (d) of this section, the Board shall enter judgment in accordance with the order unless, within 20 days after the date of the order, the party against whom the order issued files a paper which

shows good cause why judgment should not be entered in accordance with the order.

(1) If the order was issued under paragraph (d)(1) of this section, the paper may:

(i) Request that final hearing be set to review any decision which is the basis for the order as well as any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at final hearing or

(ii) Fully explain why judgment should not be entered.

(2) Any opponent may file a response to the paper within 20 days of the date of service of the paper. If the order was issued under paragraph (d)(1) of this section and the party's paper includes a request for final hearing, the opponent's response must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. If the order was issued under paragraph (d)(1) of this section and the paper does not include a request for final hearing, the opponent's response may include a request for final hearing, which must identify every decision of the administrative patent judge that the opponent wishes to have reviewed by the Board at a final hearing. Where only the opponent's response includes a request for a final hearing, the party filing the paper shall, within 14 days from the date of service of the opponent's response, file a reply identifying any other decision of the administrative patent judge that the party wishes to have reviewed by the Board at a final hearing.

(3) The paper or the response should be accompanied by a motion (§ 1.635) requesting a testimony period if either party wishes to introduce any evidence to be considered at final hearing (§ 1.671). Any evidence that a party wishes to have considered with respect to the decisions and deferred motions identified for consideration or review at final hearing shall be filed or, if appropriate, noticed under § 1.671(e) during the testimony period of the party. A request for a testimony period shall be construed as including a request for final hearing.

(4) If the paper contains an explanation of why judgment should not be entered in accordance with the order, and if no party has requested a final hearing, the decision that is the basis for the order shall be reviewed based on the contents of the paper and the response. If the paper fails to show good cause, the Board shall enter judgment against the party against whom the order issued.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a)-(e) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.641 Unpatentability discovered by administrative patent judge.

(a) During the pendency of an interference, if the administrative patent judge becomes aware of a reason why a claim designated to correspond to a count may not be patentable, the administrative patent judge may enter an order notifying the parties of the reason and set a time within which each party may present its views, including any argument and any supporting evidence, and, in the case of the party whose claim may be unpatentable, any appropriate preliminary motions under §§ 1.633(c), (d) and (h).

(b) If a party timely files a preliminary motion in response to the order of the administrative patent judge, any opponent may file an opposition (§ 1.638(a)). If an opponent files an opposition, the party may reply (§ 1.638(b)).

(c) After considering any timely filed views, including any timely filed preliminary motions under § 1.633, oppositions and replies, the administrative patent judge shall decide how the interference shall proceed.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.642 Addition of application or patent to interference.

During the pendency of an interference, if the administrative patent judge becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the administrative patent judge may add the application or patent to the interference on such terms as may be fair to all parties.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised. 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.643 Prosecution of interference by assignee.

(a) An assignee of record in the Patent and Trademark Office of the entire interest in an application or patent involved in an interference is entitled to conduct prosecution of the interference to the exclusion of the inventor.

(b) An assignee of a part interest in an application or patent involved in an interference may file a motion (§ 1.635) for entry of an order authorizing it to prosecute the interference. The motion shall show the inability or refusal of the inventor to prosecute the interference or other cause why it is in the interest of justice to permit the assignee of a part interest to prosecute the interference. The administrative patent judge may allow the assignee of a part interest to prosecute the interference upon such terms as may be appropriate.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; para. (b) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.644 Petitions in interferences.

(a) There is no appeal to the Commissioner in an interference from a decision of an administrative patent judge or the Board. The Commissioner will not consider a petition in an interference unless:

(1) The petition is from a decision of an administrative patent judge or the Board and the administrative patent judge or the Board shall be of the opinion that the decision involves a controlling question of procedure or an interpretation of a rule as to which there is a substantial ground for a difference of opinion and that an immediate decision on petition by the Commissioner may materially advance the ultimate termination of the interference;

(2) The petition seeks to invoke the supervisory authority of the Commissioner and does not relate to the merits of priority of invention or patentability or the admissibility of evidence under the Federal Rules of Evidence; or

(3) The petition seeks relief under § 1.183.

(b) A petition under paragraph (a)(1) of this section filed more than 15 days after the date of the decision of the administrative patent judge or the Board may be dismissed as untimely. A petition under paragraph (a)(2) of this section shall not be filed prior to the party's brief for final hearing (see § 1.656). Any petition under paragraph (a)(3) of this section shall be timely if it is filed simultaneously with a proper motion under § 1.633, 1.634, or 1.635 when granting the motion would require waiver of a rule. Any opposition to a petition under paragraphs (a)(1) or (a)(2) of this section shall be filed within 20 days of the date of service of the petition. Any opposition to a petition under paragraph (a)(3) of this section shall be filed within 20 days of the date of service of the petition or the date an opposition to the motion is due, whichever is earlier.

(c) The filing of a petition shall not stay the proceeding unless a stay is granted in the discretion of the administrative patent judge, the Board, or the Commissioner.

(d) Any petition must contain a statement of the facts involved, in numbered paragraphs, and the point or points to be reviewed and the action requested. The petition will be decided on the basis of the record made before the administrative patent judge or the Board, and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record in the interference shall not be submitted with the petition or opposition.

(e) Any petition under paragraph (a) of this section shall be accompanied by the petition fee set forth in § 1.17(h).

(f) Any request for reconsideration of a decision by the Commissioner shall be filed within 14 days of the decision of the Commissioner and must be accompanied by the fee set forth in § 1.17(h). No opposition to a request for reconsideration shall be filed unless requested by the Commissioner. The decision will not ordinarily be modified unless such an opposition has been requested by the Commissioner.

(g) Where reasonably possible, service of any petition, opposition, or request for reconsideration shall be such that delivery is accomplished within one working day. Service by hand or Express Mail complies with this paragraph.

(h) An oral hearing on the petition will not be granted except when considered necessary by the Commissioner.

(i) The Commissioner may delegate to appropriate Patent and Trademark Office employees the determination of petitions under this section.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a)-(a)(2), (b)-(g)

revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.645 Extension of time, late papers, stay of proceedings.

(a) Except to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action, a party may file a motion (§ 1.635) seeking an extension of time to take action in an interference. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action. The motion shall be filed within sufficient time to actually reach the administrative patent judge before expiration of the time for taking action. A moving party should not assume that the motion will be granted even if there is no objection by any other party. The motion will be denied unless the moving party shows good cause why an extension should be granted. The press of other business arising after an administrative patent judge sets a time for taking action will not normally constitute good cause. A motion seeking additional time to take testimony because a party has not been able to procure the testimony of a witness shall set forth the name of the witness, any steps taken to procure the testimony of the witness, the dates on which the steps were taken, and the facts expected to be proved through the witness.

(b) Any paper belatedly filed will not be considered except upon motion (§ 1.635) which shows good cause why the paper was not timely filed, or where an administrative patent judge or the Board, *sua sponte*, is of the opinion that it would be in the interest of justice to consider the paper. See § 1.304(a) for exclusive procedures relating to belated filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or belated commencement of a civil action.

(c) The provisions of § 1.136 do not apply to time periods in interferences.

(d) An administrative patent judge may stay proceedings in an interference.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a) and (b), 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; paras. (a), (b), & (d) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.646 Service of papers, proof of service.

(a) A copy of every paper filed in the Patent and Trademark Office in an interference or an application or patent involved in the interference shall be served upon all other parties except:

(1) Preliminary statements when filed under § 1.621; preliminary statements shall be served when service is ordered by an administrative patent judge.

(2) Certified transcripts and exhibits which accompany the transcripts filed under § 1.676; copies of transcripts shall be served as part of a party's record under § 1.653(c).

(b) Service shall be on an attorney or agent for a party. If there is no attorney or agent for the party, service shall be on the party. An administrative patent judge may order additional service or waive service where appropriate.

(c) Unless otherwise ordered by an administrative patent judge, or except as otherwise provided by this subpart, service of a paper shall be made as follows:

(1) By handing a copy of the paper or causing a copy of the paper to be handed to the person served.

(2) By leaving a copy of the paper with someone employed by the person at the person's usual place of business.

(3) When the person served has no usual place of business, by leaving a copy of the paper at the person's residence with someone of suitable age and discretion then residing therein.

(4) By mailing a copy of the paper by first class mail; when service is by first class mail the date of mailing is regarded as the date of service.

(5) By mailing a copy of the paper by Express Mail; when service is by Express Mail the date of deposit with the U.S. Postal Service is regarded as the date of service.

(6) When it is shown to the satisfaction of an administrative patent judge that none of the above methods of obtaining or serving the copy of the paper was successful, the administrative patent judge may order service by publication of an appropriate notice in the *Official Gazette*.

(d) An administrative patent judge may order that a paper be served by hand or Express Mail.

(e) The due date for serving a paper is the same as the due date for filing the paper in the Patent and

Trademark Office. Proof of service must be made before a paper will be considered in an interference. Proof of service may appear on or be affixed to the paper. Proof of service shall include the date and manner of service. In the case of personal service under paragraphs (c)(1) through (c)(3) of this section, proof of service shall include the names of any person served and the person who made the service. Proof of service may be made by an acknowledgment of service by or on behalf of the person served or a statement signed by the party or the party's attorney or agent containing the information required by this section. A statement of an attorney or agent attached to, or appearing in, the paper stating the date and manner of service will be accepted as *prima facie* proof of service.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11,1985; 50 FR 23124, May 31, 1985; paras. (a)(1)-(c)(1), (c)(4)-(c)(5) revised, para. (c)(6) added, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.647 Translation of document in foreign language.

When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a) and (d), 56 FR 42528, Aug. 28, 1991, effective Sept. 27, 1991; 56 FR 46823, Sept. 16, 1991; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.651 Setting times for discovery and taking testimony, parties entitled to take testimony.

(a) At an appropriate stage in an interference, an administrative patent judge shall set a time for filing motions (§ 1.635) for additional discovery under § 1.687(c) and testimony periods for taking any necessary testimony.

(b) Where appropriate, testimony periods will be set to permit a party to:

(1) Present its case-in-chief and/or case-in-rebuttal and/or

(2) Cross-examine an opponent's case-in-chief and/or a case-in-rebuttal.

(c) A party is not entitled to take testimony to present a case-in-chief unless:

(1) The administrative patent judge orders the taking of testimony under § 1.639(c);

(2) The party alleges in its preliminary statement a date of invention prior to the effective filing date of the senior party;

(3) A testimony period has been set to permit an opponent to prove a date of invention prior to the effective filing date of the party and the party has filed a preliminary statement alleging a date of invention prior to that date; or

(4) A motion (§ 1.635) is filed showing good cause why a testimony period should be set.

(d) Testimony, including any testimony to be taken in a place outside the United States, shall be taken and completed during the testimony periods set under paragraph (a) of this section. A party seeking to extend the period for taking testimony must comply with §§ 1.635 and 1.645(a).

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a) and (d), 56 FR 42528, Aug. 28, 1991, effective Sept. 27, 1991; 56 FR 46823, Sept. 16, 1991; paras. (a) (c)(1)-(c)(3) & (d) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.652 Judgment for failure to take testimony or file record.

If a junior party fails to timely take testimony authorized under § 1.651, or file a record under § 1.653(c), an administrative patent judge, with or without a motion (§ 1.635) by another party, may issue an order to show cause why judgment should not be entered against the junior party. When an order is issued under this section, the Board shall enter judgment in accordance with the order unless, within 15 days after the date of the order, the junior party files a paper which shows good cause why judgment should not be entered in accordance with the order. Any other party may file a response to the paper within 15 days of the date of service of the paper. If the party against whom the order was issued fails to show good cause, the Board shall enter judgment against the party.

[49 FR 48416, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.653 Record and exhibits.

(a) Testimony shall consist of affidavits under §§ 1.672(b), (c) and (g), 1.682(c), 1.683(b) and 1.688(b), transcripts of depositions under §§ 1.671(g) and 1.672(a) when a deposition is authorized by an administrative patent judge, transcripts of depositions under §§ 1.672(d), 1.682(d), 1.683(c) and 1.688(c), agreed statements under § 1.672(h), transcripts of interrogatories, cross-interrogatories, and recorded answers and copies of written interrogatories and answers and written requests for admissions and answers under § 1.688(a).

(b) An affidavit shall be filed as set forth in § 1.677. A certified transcript of a deposition, including a deposition cross-examining an affiant, shall be filed as set forth in §§ 1.676, 1.677 and 1.678. An original agreed statement shall be filed as set forth in § 1.672(h).

(c) In addition to the items specified in paragraph (b) of this section and within a time set by an administrative patent judge, each party shall file three copies and serve one copy of a record consisting of:

(1) An index of the names of the witnesses for the party, giving the pages of the record where the direct testimony and cross-examination of each witness begins.

(2) An index of exhibits briefly describing the nature of each exhibit and giving the page of the record where each exhibit is first identified and offered into evidence.

(3) The count or counts.

(4) Each affidavit by a witness for the party, transcript, including transcripts of cross-examination of any affiant who testified for the party and transcripts of compelled deposition testimony by a witness for the party, agreed statement relied upon by the party, and transcript of interrogatories, cross-interrogatories and recorded answers.

(5) [Reserved]

(6) Any evidence from another interference, proceeding, or action relied upon by the party under § 1.683.

(7) Each request for an admission and the admission and each written interrogatory and the answer upon which a party intends to rely under § 1.688.

(d) The pages of the record shall be consecutively numbered to the extent possible.

(e) The name of each witness shall appear at the top of each page of each affidavit or transcript.

(f) [Reserved]

(g) The record may be produced by standard typographical printing or by any other process capable of producing a clear black permanent image. All printed matter except on covers must appear in at least 11 point type on opaque, unglazed paper. Footnotes may not be printed in type smaller than 9 point. The page size shall be 21.8 by 27.9 cm. (8 1/2 by 11 inches) (letter size) with printed matter 16.5 by 24.1 cm. (6 1/2 by 9 1/2 inches). The record shall be bound with covers at their left edges in such manner as to lie flat when open to any page and in one or more volumes of convenient size (approximately 100 pages per volume is suggested). When there is more than one volume, the numbers of the pages contained in each volume shall appear at the top of the cover for each volume.

(h) [Reserved]

(i) Each party shall file its exhibits with the record specified in paragraph (c) of this section. Exhibits include documents and things identified in affidavits or on the record during the taking of oral depositions as well as official records and publications filed by the party under § 1.682(a). One copy of each documentary exhibit shall be served. Documentary exhibits shall be filed in an envelope or folder and shall not be bound as part of the record. Physical exhibits, if not filed by an officer under § 1.676(d), shall be filed with the record. Each exhibit shall contain a label which identifies the party submitting the exhibit and an exhibit number, the style of the interference (e.g., Jones v. Smith), and the interference number. Where possible, the label should appear at the bottom right-hand corner of each documentary exhibit. Upon termination of an interference, an administrative patent judge may return an exhibit to the party filing the exhibit. When any exhibit is returned, an order shall be entered indicating that the exhibit has been returned.

(j) Any testimony, record, or exhibit which does not comply with this section may be returned under § 1.618(a).

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a), (b), (c), (c)(1), (c)(4), (d), (g), & (i) revised, paras. (c)(5) (f) & (h) removed, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.654 Final hearing.

(a) At an appropriate stage of the interference, the parties will be given an opportunity to appear before the Board to present oral argument at a final hearing. An administrative patent judge may set a date and time for final hearing. Unless otherwise ordered by an administrative patent judge or the Board, each party will be entitled to no more than 30 minutes of oral argument at final hearing. A party who does not file a brief for final hearing (§ 1.656(a)) shall not be entitled to appear at final hearing.

(b) The opening argument of a junior party shall include a fair statement of the junior party's case and the junior party's position with respect to the case presented on behalf of any other party. A junior party may reserve a portion of its time for rebuttal.

(c) A party shall not be entitled to argue that an opponent abandoned, suppressed, or concealed an actual reduction to practice unless a notice under § 1.632 was timely filed.

(d) After final hearing, the interference shall be taken under advisement by the Board. No further paper shall be filed except under § 1.658(b) or as authorized by an administrative patent judge or the Board. No additional oral argument shall be had unless ordered by the Board.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a) & (d) revised, 60 FR 14488, Mar. 17, 1995, effective April 21, 1995]

§ 1.655 Matters considered in rendering a final decision.

(a) In rendering a final decision, the Board may consider any properly raised issue, including priority of invention, derivation by an opponent from a party who filed a preliminary statement under § 1.625, patentability of the invention, admissibility of evidence, any interlocutory matter deferred to final hearing, and any other matter necessary to resolve the interference. The Board may also consider whether an interlocutory order should be modified. The burden of showing that an interlocutory order should be modified shall be on the party attacking the order. The abuse of discretion standard shall apply only to procedural matters.

(b) A party shall not be entitled to raise for consideration at final hearing any matter which properly could have been raised by a motion under § 1.633 or 1.634 unless the matter was properly raised in a motion that was timely filed by the party under § 1.633 or 1.634 and the motion was denied or deferred to final hearing, the matter was properly raised by the party in a timely filed opposition to a motion under § 1.633 or 1.634 and the motion was granted over the opposition or deferred to final hearing, or the party shows good cause why the issue was not properly raised by a timely filed motion or opposition. A party that fails to contest, by way of a timely filed preliminary motion under § 1.633(c), the designation of a claim as corresponding to a count, or fails to timely argue the separate patentability of a particular claim when the ground for unpatentability is first raised, may not subsequently argue to an administrative patent judge or the Board the separate patentability of claims designated to correspond to the count with respect to that ground.

(c) In the interest of justice, the Board may exercise its discretion to consider an issue even though it would not otherwise be entitled to consideration under this section.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a) revised, 58 FR 49432, Sept. 23, 1993, effective Oct. 25, 1993; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; para. (a) revised, 64 FR 12900, Mar. 16, 1999, effective Mar. 16, 1999]

§ 1.656 Briefs for final hearing.

(a) Each party shall be entitled to file briefs for final hearing. The administrative patent judge shall determine the briefs needed and shall set the time and order for filing briefs.

(b) The opening brief of a junior party shall contain under appropriate headings and in the order indicated:

(1) A statement of interest indicating the full name of every party represented by the attorney in the interference and the name of the real party in interest if the party named in the caption is not the real party in interest.

(2) A statement of related cases indicating whether the interference was previously before the

Board for final hearing and the name and number of any related appeal or interference which is pending before, or which has been decided by, the Board, or which is pending before, or which has been decided by, the U.S. Court of Appeals for the Federal Circuit or a district court in a proceeding under 35 U.S.C. 146. A related appeal or interference is one which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending interference.

(3) A table of contents, with page references, and a table of cases (alphabetically arranged), statutes, and other authorities cited, with references to the pages of the brief where they are cited.

(4) A statement of the issues presented for decision in the interference.

(5) A statement of the facts, in numbered paragraphs, relevant to the issues presented for decision with appropriate references to the record.

(6) An argument, which may be preceded by a summary, which shall contain the contentions of the party with respect to the issues it is raising for consideration at final hearing, and the reasons therefor, with citations to the cases, statutes, other authorities, and parts of the record relied on.

(7) A short conclusion stating the precise relief requested.

(8) An appendix containing a copy of the counts.

(c) The opening brief of the senior party shall conform to the requirements of paragraph (b) of this section except:

(1) A statement of the issues and of the facts need not be made unless the party is dissatisfied with the statement in the opening brief of the junior party and

(2) An appendix containing a copy of the counts need not be included if the copy of the counts in the opening brief of the junior party is correct.

(d) Unless ordered otherwise by an administrative patent judge, briefs shall be double-spaced (except for footnotes, which may be single-spaced) and shall comply with the requirements of § 1.653(g) for records except the requirement for binding.

(e) An original and four copies of each brief must be filed.

(f) Any brief which does not comply with the requirements of this section may be returned under § 1.618(a).

(g) Any party, separate from its opening brief, but filed concurrently therewith, may file an original and four copies of concise proposed findings of fact and conclusions of law. Any proposed findings of fact shall be in numbered paragraphs and shall be supported by specific references to the record. Any proposed conclusions of law shall be in numbered paragraphs and shall be supported by citation of cases, statutes, or other authority. Any opponent, separate from its opening or reply brief, but filed concurrently therewith, may file a paper accepting or objecting to any proposed findings of fact or conclusions of law; when objecting, a reason must be given. The Board may adopt the proposed findings of fact and conclusions of law in whole or in part.

(h) If a party wants the Board in rendering its final decision to rule on the admissibility of any evidence, the party shall file with its opening brief an original and four copies of a motion (§ 1.635) to suppress the evidence. The provisions of § 1.637(b) do not apply to a motion to suppress under this paragraph. Any objection previously made to the admissibility of the evidence of an opponent is waived unless the motion required by this paragraph is filed. A party that failed to challenge the admissibility of the evidence of an opponent on a ground that could have been raised in a timely objection under § 1.672(c), 1.682(c), 1.683(b) or 1.688(b) may not move under this paragraph to suppress the evidence on that ground at final hearing. An original and four copies of an opposition to the motion may be filed with an opponent's opening brief or reply brief as may be appropriate.

(i) When a junior party fails to timely file an opening brief, an order may issue requiring the junior party to show cause why the Board should not treat failure to file the brief as a concession of priority. If the junior party fails to show good cause within a time period set in the order, judgment may be entered against the junior party.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a), (b)(1)-(b)(8), (d), (e), (g), (h), & (i) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.657 Burden of proof as to date of invention.

(a) A rebuttable presumption shall exist that, as to each count, the inventors made their invention in the chronological order of their effective filing dates. The burden of proof shall be upon a party who contends otherwise.

(b) In an interference involving copending applications or involving a patent and an application having an effective filing date on or before the date the patent issued, a junior party shall have the burden of establishing priority by a preponderance of the evidence.

(c) In an interference involving an application and a patent and where the effective filing date of the application is after the date the patent issued, a junior party shall have the burden of establishing priority by clear and convincing evidence.

[49 FR 48466, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.658 Final decision.

(a) After final hearing, the Board shall enter a decision resolving the issues raised at final hearing. The decision may enter judgment, in whole or in part, remand the interference to an administrative patent judge for further proceedings, or take further action not inconsistent with law. A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. When the Board enters a decision awarding judgment as to all counts, the decision shall be regarded as a final decision for the purpose of judicial review (35 U.S.C. 141-144, 146) unless a request for reconsideration under paragraph (b) of this section is timely filed.

(b) Any request for reconsideration of a decision under paragraph (a) of this section shall be filed within one month after the date of the decision. The request for reconsideration shall specify with particularity the points believed to have been misapprehended or overlooked in rendering the decision. Any opposition to a request for reconsideration shall be filed within 14 days of the date of service of the request for reconsideration. Service of the request for reconsideration shall be by hand or Express Mail. The Board shall enter a decision on the request for reconsideration. If the Board shall be of the opinion that the decision on the request for reconsideration significantly modifies its original decision under paragraph (a) of this section, the Board may designate the decision on the request for reconsideration as a new decision. A decision on reconsideration is a final decision for the purpose of judicial review (35 U.S.C. 141-144, 146).

(c) A judgment in an interference settles all issues which (1) were raised and decided in the interference, (2) could have been properly raised and decided in the interference by a motion under § 1.633 (a) through (d) and (f) through (j) or § 1.634, and (3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). A losing party who could have properly moved, but failed to move, under § 1.633 or 1.634, shall be estopped to take *ex parte* or *inter partes* action in the Patent and Trademark Office after the interference which is inconsistent with that party's failure to properly move, except that a losing party shall not be estopped with respect to any claims which correspond, or properly could have corresponded, to a count as to which that party was awarded a favorable judgment.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985; para. (b), 54 FR 29553, July 13, 1989, effective Aug. 20, 1989; paras. (a) & (b) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.659 Recommendation.

(a) Should the Board have knowledge of any ground for rejecting any application claim not involved in the judgment of the interference, it may include in its decision a recommended rejection of the claim. Upon resumption of *ex parte* prosecution of the application, the examiner shall be bound by the recommendation and shall enter and maintain the recommended rejection unless an amendment or showing of facts not previously of record is filed which, in the opinion of the examiner, overcomes the recommended rejection.

(b) Should the Board have knowledge of any ground for reexamination of a patent involved in the interference as to a patent claim not involved in the judgment of the interference, it may include in its decision a recommendation to the Commissioner that the patent be reexamined. The Commissioner will determine whether reexamination will be ordered.

(c) The Board may make any other recommendation to the examiner or the Commissioner as may be appropriate.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

§ 1.660 Notice of reexamination, reissue, protest, or litigation.

(a) When a request for reexamination of a patent involved in an interference is filed, the patent owner shall notify the Board within 10 days of receiving notice that the request was filed.

(b) When an application for reissue is filed by a patentee involved in an interference, the patentee shall notify the Board within 10 days of the day the application for reissue is filed.

(c) When a protest under § 1.291 is filed against an application involved in an interference, the applicant shall notify the Board within 10 days of receiving notice that the protest was filed.

(d) A party in an interference shall notify the Board promptly of any litigation related to any patent or application involved in an interference, including any civil action commenced under 35 U.S.C. 146.

(e) The notice required by this section is designed to assist the administrative patent judge and the Board in efficiently handling interference cases. Failure of a party to comply with the provisions of this section may result in sanctions under § 1.616. Knowledge by, or notice to, an employee of the Office other than an employee of the Board, of the existence of the reexamination, application for reissue, protest, or litigation shall not be sufficient. The notice contemplated by this section is notice addressed to the administrative patent judge in charge of the interference in which the application or patent is involved.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985; para. (e) added, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.661 Termination of interference after judgment.

After a final decision is entered by the Board, an interference is considered terminated when no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

§ 1.662 Request for entry of adverse judgment; reissue filed by patentee.

(a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. The filing by a party of a written disclaimer of the invention defined by a count, concession of priority or unpatentability of the subject matter of a count, abandonment of the invention defined by a count, or abandonment of the contest as to a count will be treated as a request for entry of an adverse judgment against the applicant or patentee as to all claims which correspond to the count. Abandonment of an application, other than an application for reissue having a claim of the patent sought to be reissued involved in the interference, will be treated as a request for entry of an adverse judgment against the applicant as to all claims corresponding to all counts. Upon the filing by a party of a request for entry of an adverse judgment, the Board may enter judgment against the party.

(b) If a patentee involved in an interference files an application for reissue during the interference and the reissue application does not include a claim that corresponds to a count, judgment may be entered against the patentee. A patentee who files an application for reissue which includes a claim that corresponds to a count shall, in addition to complying with the provisions of § 1.660(b), timely file a preliminary motion under § 1.633(h) or show good cause why the motion could not have been timely filed or would not be appropriate.

(c) The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985; para. (b) amended, 53 FR 23735, June 23, 1988, effective Sept. 12, 1988; paras. (a) & (e) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.663 Status of claim of defeated applicant after interference.

Whenever an adverse judgment is entered as to a count against an applicant from which no appeal (35 U.S.C. 141) or other review (35 U.S.C. 146) has been or can be taken or had, the claims of the application corresponding to the count stand finally disposed of without further action by the examiner. Such claims are not open to further *ex parte* prosecution.

[49 FR 48467, Dec. 12, 1984, added effective Feb. 11, 1985]

§ 1.664 Action after interference.

(a) After termination of an interference, the examiner will promptly take such action in any application previously involved in the interference as may be necessary. Unless entered by order of an administrative patent judge, amendments presented during the interference shall not be entered, but may be subsequently presented by the applicant subject to the provisions of this subpart provided prosecution of the application is not otherwise closed.

(b) After judgment, the application of any party may be held subject to further examination, including an interference with another application.

[49 FR 48467, Dec. 12, 1984; 50 FR 23124, May 31, 1985, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.665 Second interference.

A second interference between the same parties will not be declared upon an application not involved in an earlier interference for an invention defined by a count of the earlier interference. See § 1.658(c).

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985]

§ 1.666 Filing of interference settlement agreements.

(a) Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, must be in writing and a true copy thereof must be filed before the termination of the interference (§ 1.661) as between the parties to the agreement or understanding.

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause.

(c) Failure to file the copy of the agreement or understanding under paragraph (a) of this section will render permanently unenforceable such agreement or understanding and any patent of the parties involved in the interference or any patent subsequently issued on any application of the parties so involved. The Commissioner may, however, upon petition accompanied by the fee set forth in § 1.17(h) and on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; para. (b), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; amended 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; paras. (a) & (b) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.671 Evidence must comply with rules.

(a) Evidence consists of affidavits, transcripts of depositions, documents and things.

(b) Except as otherwise provided in this subpart, the Federal Rules of Evidence shall apply to interference proceedings. Those portions of the Federal Rules of Evidence relating to criminal actions, juries, and other matters not relevant to interferences shall not apply.

(c) Unless the context is otherwise clear, the following terms of the Federal Rules of Evidence shall be construed as follows:

(1) *Courts of the United States, U.S. Magistrate, court, trial court,* or *trier of fact* means administrative patent judge or Board as may be appropriate.

(2) *Judge* means administrative patent judge.

(3) *Judicial notice* means official notice.

(4) *Civil action, civil proceeding, action,* or *trial* mean interference.

(5) *Appellate court* means United States Court of Appeals for the Federal Circuit or a United States district court when judicial review is under 35 U.S.C. 146.

(6) *Before the hearing* in Rule 703 of the Federal Rules of Evidence means before giving testimony by affidavit or oral deposition.

(7) *The trial or hearing* in Rules 803(24) and 804(5) of the Federal Rules of Evidence means the taking of testimony by affidavit or oral deposition.

(d) Certification is not necessary as a condition to admissibility when the record is a record of the Patent and Trademark Office to which all parties have access.

(e) A party may not rely on an affidavit (including exhibits), patent, or printed publication previously submitted by the party under § 1.639(b) unless a copy of the affidavit, patent, or printed publication has been served and a written notice is filed prior to the close of the party's relevant testimony period stating that the party intends to rely on the affidavit, patent, or printed publication. When proper notice is given under this paragraph, the affidavit, patent, or printed publication shall be deemed as filed under § 1.640(b), § 1.640(e)(3), or § 1.672, as appropriate.

(f) The significance of documentary and other exhibits identified by a witness in an affidavit or during oral deposition shall be discussed with particularity by a witness.

(g) A party must file a motion (§ 1.635) seeking permission from an administrative patent judge prior to compelling testimony or production of documents or things under 35 U.S.C. 24 or from an opposing party. The motion shall describe the general nature and the relevance of the testimony, document, or thing. If permission is granted, the party shall notice a deposition under § 1.673 and may proceed to take testimony.

(h) A party must file a motion (§ 1.635) seeking permission from an administrative patent judge prior to compelling testimony or production of documents or things in a foreign country.

(1) In the case of testimony, the motion shall:

(i) Describe the general nature and relevance of the testimony;

(ii) Identify the witness by name or title;

(iii) Identify the foreign country and explain why the party believes the witness can be compelled to testify in the foreign country, including a description of the procedures that will be used to compel the testimony in the foreign country and an estimate of the time it is expected to take to obtain the testimony; and

(iv) Demonstrate that the party has made reasonable efforts to secure the agreement of the witness to testify in the United States but has been unsuccessful in obtaining the agreement, even though the party has offered to pay the expenses of the witness to travel to and testify in the United States.

(2) In the case of production of a document or thing, the motion shall:

(i) Describe the general nature and relevance of the document or thing;

(ii) Identify the foreign country and explain why the party believes production of the document or thing can be compelled in the foreign country, including a description of the procedures that will be used to compel production of the document or thing in the foreign country and an estimate of the time it is expected to take to obtain production of the document or thing; and

(iii) Demonstrate that the party has made reasonable efforts to obtain the agreement of the individual or entity having possession, custody, or control of the document to produce the document or thing in the United States but has been unsuccessful in obtaining that agreement, even though the party has offered to pay the expenses of producing the document or thing in the United States.

(i) Evidence which is not taken or sought and filed in accordance with this subpart shall not be admissible.

(j) The weight to be given deposition testimony taken in a foreign country will be determined in view of all the circumstances, including the laws of the foreign country governing the testimony. Little, if any, weight may be given to deposition testimony taken in a foreign country unless the party taking the testimony proves by clear and convincing evidence, as a matter of fact, that knowingly giving false testimony in that country in connection with an interference proceeding in the United States Patent and Trademark Office is punishable under the laws of that country

and that the punishment in that country for such false testimony is comparable to or greater than the punishment for perjury committed in the United States. The administrative patent judge and the Board, in determining foreign law, may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence.

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; paras. (a), (c)(1), (c)(2), (c)(6), (c)(7), (e)-(j) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; para. (a) revised, 65 FR 56972, Sept. 20, 2000, effective Oct. 20, 2000 (adopted as final, 65 FR 70489, Nov. 24, 2000); para. (e) revised, 65 FR 70489, Nov. 24, 2000, effective Dec. 26, 2000]

§ 1.672 Manner of taking testimony.

(a) Unless testimony must be compelled under 35 U.S.C. 24, compelled from a party, or compelled in a foreign country, testimony of a witness shall be taken by affidavit in accordance with this subpart. Testimony which must be compelled under 35 U.S.C. 24, compelled from a party, or compelled in a foreign country shall be taken by oral deposition.

(b) A party presenting testimony of a witness by affidavit shall, within the time set by the administrative patent judge for serving affidavits, file a copy of the affidavit or, if appropriate, notice under § 1.671(e). If the affidavit relates to a party's case-in-chief, it shall be filed or noticed no later than the date set by an administrative patent judge for the party to file affidavits for its case-in-chief. If the affidavit relates to a party's case-in-rebuttal, it shall be filed or noticed no later than the date set by an administrative patent judge for the party to file affidavits for its case-in-rebuttal. A party shall not be entitled to rely on any document referred to in the affidavit unless a copy of the document is filed with the affidavit. A party shall not be entitled to rely on any thing mentioned in the affidavit unless the opponent is given reasonable access to the thing. A thing is something other than a document. The pages of affidavits filed under this paragraph and of any other testimony filed therewith under §§ 1.683(a) and 1.688(a) shall, to the extent possible, be given sequential numbers which shall also serve as the record page numbers for the affidavits and other testimony in the party's record to be filed under § 1.653. Exhibits identified in the affidavits or in any other testimony filed under §§ 1.683(a) and 1.688(a) and any official records and printed publications filed under § 1.682(a) shall, to the extent possible, be given sequential exhibit numbers, which shall also serve as the exhibit numbers when the exhibits are filed with the party's record. The affidavits, testimony filed under §§ 1.683(a) and 1.688(a) and exhibits shall be accompanied by an index of the names of the witnesses, giving the number of the page where the testimony of each witness begins, and by an index of the exhibits briefly describing the nature of each exhibit and giving the number of the page where each exhibit is first identified and offered into evidence.

(c) If an opponent objects to the admissibility of any evidence contained in or submitted with an affidavit filed under paragraph (b) of this section, the opponent must, no later than the date set by the administrative patent judge for filing objections under this paragraph, file objections stating with particularity the nature of each objection. An opponent that fails to object to the admissibility of the evidence contained in or submitted with an affidavit on a ground that could have been raised in a timely objection under this paragraph will not be entitled to move under § 1.656(h) to suppress the evidence on that ground. If an opponent timely files objections, the party may, within 20 days of the due date for filing objections, file one or more supplemental affidavits, official records or printed publications to overcome the objections. No objection to the admissibility of the supplemental evidence shall be made, except as provided by § 1.656(h). The pages of supplemental affidavits filed under this paragraph shall, to the extent possible, be sequentially numbered beginning with the number following the last page number of the party's testimony submitted under paragraph (b) of this section. The page numbers assigned to the supplemental affidavits shall also serve as the record page numbers for the supplemental affidavits in the party's record filed under § 1.653. Additional exhibits identified in supplemental affidavits and any supplemental official records and printed publications shall, to the extent possible, be given sequential numbers beginning with the number following the last number of the exhibits submitted under paragraph (b) of this section. The exhibit numbers shall also serve as the exhibit numbers when the exhibits are filed with the party's

record. The supplemental affidavits shall be accompanied by an index of the names of the witnesses and an index of exhibits of the type specified in paragraph (b) of this section.

(d) After the time expires for filing objections and supplemental affidavits, or earlier when appropriate, the administrative patent judge shall set a time within which any opponent may file a request to cross-examine an affiant on oral deposition. If any opponent requests cross-examination of an affiant, the party shall notice a deposition at a reasonable location within the United States under § 1.673(e) for the purpose of cross-examination by any opponent. Any redirect and recross shall take place at the deposition. At any deposition for the purpose of cross-examination of a witness, the party shall not be entitled to rely on any document or thing not mentioned in one or more of the affidavits filed under paragraphs (b) and (c) of this section, except to the extent necessary to conduct proper redirect. The party who gives notice of a deposition shall be responsible for providing a translator if the witness does not testify in English, for obtaining a court reporter, and for filing a certified transcript of the deposition as required by § 1.676. Within 45 days of the close of the period for taking cross-examination, the party shall serve (but not file) a copy of each transcript on each opponent together with copies of any additional documentary exhibits identified by the witness during the deposition. The pages of the transcripts served under this paragraph shall, to the extent possible, be sequentially numbered beginning with the number following the last page number of the party's supplemental affidavits submitted under paragraph (c) of this section. The numbers assigned to the transcript pages shall also serve as the record page numbers for the transcripts in the party's record filed under § 1.653. Additional exhibits identified in the transcripts, shall, to the extent possible, be given sequential numbers beginning with the number following the last number of the exhibits submitted under paragraphs (b) and (c) of this section. The exhibit numbers assigned to the additional exhibits shall also serve as the exhibit numbers when those exhibits are filed with the party's record. The deposition transcripts shall be accompanied by an index of the names of the witnesses, giving the number of the page where cross-examination, redirect and recross of each witness begins, and an index of exhibits of the type specified in paragraph (b) of this section.

(e) [Reserved]

(f) When a deposition is authorized to be taken within the United States under this subpart and if the parties agree in writing, the deposition may be taken in any place within the United States, before any person authorized to administer oaths, upon any notice, and in any manner, and when so taken may be used like other depositions.

(g) If the parties agree in writing, the affidavit testimony of any witness may be submitted without opportunity for cross-examination.

(h) If the parties agree in writing, testimony may be submitted in the form of an agreed statement setting forth how a particular witness would testify, if called, or the facts in the case of one or more of the parties. The agreed statement shall be filed in the Patent and Trademark Office. See § 1.653(a).

(i) In an unusual circumstance and upon a showing that testimony cannot be taken in accordance with the provisions of this subpart, an administrative patent judge upon motion (§ 1.635) may authorize testimony to be taken in another manner.

[49 FR 48468, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.673 Notice of examination of witness.

(a) A party authorized to take testimony of a witness by deposition shall, after complying with paragraphs (b) and (g) of this section, file and serve a single notice of deposition stating the time and place of each deposition to be taken. Depositions to be taken in the United States may be noticed for a reasonable time and place in the United States. A deposition may not be noticed for any other place without approval of an administrative patent judge. The notice shall specify the name and address of each witness and the general nature of the testimony to be given by the witness. If the name of a witness is not known, a general description sufficient to identify the witness or a particular class or group to which the witness belongs may be given instead.

(b) Unless the parties agree or an administrative patent judge or the Board determine otherwise, a party shall serve, but not file, at least three working days prior to the conference required by paragraph (g) of

this section, if service is made by hand or Express Mail, or at least 14 days prior to the conference if service is made by any other means, the following:

(1) A list and copy of each document in the party's possession, custody, or control and upon which the party intends to rely at any deposition and

(2) A list of and a proffer of reasonable access to things in the party's possession, custody, or control and upon which the party intends to rely at any deposition.

(c) A party shall not be permitted to rely on any witness not listed in the notice, or any document not served or any thing not listed as required by paragraph (b) of this section:

(1) Unless all opponents agree in writing or on the record to permit the party to rely on the witness, document or thing, or

(2) Except upon a motion (§ 1.635) promptly filed which is accompanied by any proposed notice, additional documents, or lists and which shows good cause why the notice, documents, or lists were not served in accordance with this section.

(d) Each opponent shall have a full opportunity to attend a deposition and cross-examine.

(e) A party who has presented testimony by affidavit and is required to notice depositions for the purpose of cross-examination under § 1.672(b), shall, after complying with paragraph (g) of this section, file and serve a single notice of deposition stating the time and place of each cross-examination deposition to be taken.

(f) The parties shall not take depositions in more than one place at the same time or so nearly at the same time that reasonable opportunity to travel from one place of deposition to another cannot be had.

(g) Before serving a notice of deposition and after complying with paragraph (b) of this section, a party shall have an oral conference with all opponents to attempt to agree on a mutually acceptable time and place for conducting the deposition. A certificate shall appear in the notice stating that the oral conference took place or explaining why the conference could not be had. If the parties cannot agree to a mutually acceptable place and time for conducting the deposition at the conference, the parties shall contact an administrative patent judge who shall then designate the time and place for conducting the deposition.

(h) A copy of the notice of deposition shall be attached to the certified transcript of the deposition filed under § 1.676(a).

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (a)-(e) & (g) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.674 Persons before whom depositions may be taken.

(a) A deposition shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held.

(b) Unless the parties agree in writing, the following persons shall not be competent to serve as an officer:

(1) a relative or employee of a party,

(2) a relative or employee of an attorney or agent of a party, or

(3) a person interested, directly or indirectly, in the interference either as counsel, attorney, agent, or otherwise.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985; para. (a) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.675 Examination of witness, reading and signing transcript of deposition.

(a) Each witness before giving an oral deposition shall be duly sworn according to law by the officer before whom the deposition is to be taken.

(b) The testimony shall be taken in answer to interrogatories with any questions and answers recorded in their regular order by the officer or by some other person, who shall be subject to the provisions of § 1.674(b), in the presence of the officer unless the presence of the officer is waived on the record by agreement of all parties.

(c) All objections made at the time of the deposition to the qualifications of the officer taking the deposition, the manner of taking it, the evidence presented, the conduct of any party, and any other objection to the proceeding shall be noted on the record by the officer. Evidence objected to shall be taken subject to any objection.

(d) Unless the parties agree in writing or waive reading and signature by the witness on the record at

the deposition, when the testimony has been transcribed a transcript of the deposition shall, unless the witness refuses to read and/or sign the transcript of the deposition, be read by the witness and then signed by the witness in the form of:

(1) An affidavit in the presence of any notary or

(2) A declaration.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985; para. (d) revised, 60 FR 14488, Mar 17, 1995, effective Apr. 21, 1995]

§ 1.676 Certification and filing by officer, marking exhibits.

(a) The officer shall prepare a certified transcript of the deposition by attaching to a transcript of the deposition a copy of the notice of deposition, any exhibits to be annexed to the certified transcript, and a certificate signed and sealed by the officer and showing:

(1) The witness was duly sworn by the officer before commencement of testimony by the witness.

(2) The transcript is a true record of the testimony given by the witness.

(3) The name of the person by whom the testimony was recorded and, if not recorded by the officer, whether the testimony was recorded in the presence of the officer.

(4) The presence or absence of any opponent.

(5) The place where the deposition was taken and the day and hour when the deposition began and ended.

(6) The officer is not disqualified under § 1.674.

(b) If the parties waived any of the requirements of paragraph (a) of this section, the certificate shall so state.

(c) The officer shall note on the certificate the circumstances under which a witness refuses to sign a transcript.

(d) Unless the parties agree otherwise in writing or on the record at the deposition, the officer shall securely seal the certified transcript in an envelope endorsed with the style of the interference (e.g., Smith v. Jones), the interference number, the name of the witness, and the date of sealing and shall promptly forward the envelope to BOX INTERFERENCE, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Documents and things produced for inspection during the examination of a witness, shall, upon request of a party, be marked for identification and annexed to the certified transcript, and may be inspected and copied by any party, except that if the person producing the documents and things desires to retain them, the person may: (1) Offer copies to be marked for identification and annexed to the certified transcript and to serve thereafter as originals if the person affords to all parties fair opportunity to verify the copies by comparison with the originals or (2) Offer the originals to be marked for identification, after giving each party an opportunity to inspect and copy them, in which event the documents and things may be used in the same manner as if annexed to the certified transcript. The exhibits shall then be filed as specified in § 1.653(i). If the weight or bulk of a document or thing shall reasonably prevent the document or thing from being annexed to the certified transcript, it shall, unless waived on the record at the deposition of all parties, be authenticated by the officer and forwarded to the Commissioner in a separate package marked and addressed as provided in this paragraph.

[49 FR 48469, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; para. (a)(4) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.677 Form of an affidavit or a transcript of deposition.

(a) An affidavit or a transcript of a deposition must be on opaque, unglazed, durable paper approximately 21.8 by 27.9 cm. (8 1/2 by 11 inches) in size (letter size). The printed matter shall be double-spaced on one side of the paper in not smaller than 11 point type with a margin of 3.8 cm. (1 1/2 inches) on the left-hand side of the page. The pages of each transcript must be consecutively numbered and the name of the witness shall appear at the top of each page (§ 1.653(e)). In transcripts of depositions, the questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used and each question must be followed by its answer.

(b) Exhibits must be numbered consecutively to the extent possible and each must be marked as required by § 1.653(i).

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.678 Time for filing transcript of deposition.

Unless otherwise ordered by an administrative patent judge, a certified transcript of a deposition must be filed in the Patent and Trademark Office within one month after the date of deposition. If a party refuses to file a certified transcript, the administrative patent judge or the Board may take appropriate action under § 1.616. If a party refuses to file a certified transcript, any opponent may move for leave to file the certified transcript and include a copy of the transcript as part of the opponent's record.

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.679 Inspection of transcript.

A certified transcript of a deposition filed in the Patent and Trademark Office may be inspected by any party. The certified transcript may not be removed from the Patent and Trademark Office unless authorized by an administrative patent judge upon such terms as may be appropriate.

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.682 [Reserved]

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; removed and reserved, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000]

§ 1.683 [Reserved]

[49 FR 48470, Dec. 12, 1984, added effective Feb. 11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; removed and reserved, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000]

§ 1.684 [Reserved]

§ 1.685 Errors and irregularities in depositions.

(a) An error in a notice for taking a deposition is waived unless a motion (§ 1.635) to quash the notice is filed as soon as the error is, or could have been, discovered.

(b) An objection to a qualification of an officer taking a deposition is waived unless:

(1) The objection is made on the record of the deposition before a witness begins to testify.

(2) If discovered after the deposition, a motion (§ 1.635) to suppress the deposition is filed as soon as the objection is, or could have been, discovered.

(c) An error or irregularity in the manner in which testimony is transcribed, a certified transcript is signed by a witness, or a certified transcript is prepared, signed, certified, sealed, endorsed, forwarded, filed, or otherwise handled by the officer is waived unless a motion (§ 1.635) to suppress the deposition is filed as soon as the error of irregularity is, or could have been, discovered.

(d) An objection to the deposition on any grounds, such as the competency of a witness, admissibility of evidence, manner of taking the deposition, the form of questions and answers, any oath or affirmation, or conduct of any party at the deposition, is waived unless an objection is made on the record at the deposition stating the specific ground of objection. Any objection which a party wishes considered by the Board at final hearing shall be included in a motion to suppress under § 1.656(h).

(e) Nothing in this section precludes taking notice of plain errors affecting substantial rights although they were not brought to the attention of an administrative patent judge or the Board.

[49 FR 48471, Dec. 12, 1984, added effective Feb. 11, 1985; 50 FR 23124, May 31, 1985; amended, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.687 Additional discovery.

(a) A party is not entitled to discovery except as authorized in this subpart.

(b) Where appropriate, a party may obtain production of documents and things during cross-examination of an opponent's witness or during the testimony period of the party's case-in-rebuttal.

(c) Upon a motion (§ 1.635) brought by a party within the time set by an administrative patent judge

under § 1.651 or thereafter as authorized by § 1.645 and upon a showing that the interest of justice so requires, an administrative patent judge may order additional discovery, as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure, specifying the terms and conditions of such additional discovery. See § 1.647 concerning translations of documents in a foreign language.

(d) The parties may agree to discovery among themselves at any time. In the absence of an agreement, a motion for additional discovery shall not be filed except as authorized by this subpart.

[49 FR 48471, Dec. 12, 1984, added effective Feb. 11, 1985; paras. (d) & (e) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

§ 1.688 [Reserved]

[49 FR 48471, Dec. 12, 1984, added effective Feb.11, 1985; revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995; removed and reserved, 65 FR 56792, Sept. 20, 2000, effective Oct. 20, 2000]

§ 1.690 Arbitration of interferences.

(a) Parties to a patent interference may determine the interference or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of Title 9, United States Code. The parties must notify the Board in writing of their intention to arbitrate. An agreement to arbitrate must be in writing, specify the issues to be arbitrated, the name of the arbitrator or a date not more than thirty (30) days after the execution of the agreement for the selection of the arbitrator, and provide that the arbitrator's award shall be binding on the parties and that judgment thereon can be entered by the Board. A copy of the agreement must be filed within twenty (20) days after its execution. The parties shall be solely responsible for the selection of the arbitrator and the rules for conducting proceedings before the arbitrator. Issues not disposed of by the arbitration will be resolved in accordance with the procedures established in this subpart, as determined by the administrative patent judge.

(b) An arbitration proceeding under this section shall be conducted within such time as may be authorized on a case-by-case basis by an administrative patent judge.

(c) An arbitration award will be given no consideration unless it is binding on the parties, is in writing and states in a clear and definite manner the issue or issues arbitrated and the disposition of each issue The award may include a statement of the grounds and reasoning in support thereof. Unless otherwise ordered by an administrative patent judge, the parties shall give notice to the Board of an arbitration award by filing within twenty (20) days from the date of the award a copy of the award signed by the arbitrator or arbitrators. When an award is timely filed, the award shall, as to the parties to the arbitration, be dispositive of the issue or issues to which it relates.

(d) An arbitration award shall not preclude the Office from determining patentability of any invention involved in the interference.

[Added, 52 FR 13838, Apr. 27, 1987; paras. (a)-(c) revised, 60 FR 14488, Mar. 17, 1995, effective Apr. 21, 1995]

Subpart F — Extension of Patent Term

ADJUSTMENT OF PATENT TERM DUE TO EXAMINATION DELAY

§ 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended

for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

[Added, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (e) added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000]

§ 1.702 Grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, on or after May 29, 2000).

(a) *Failure to take certain actions within specified time frames.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later

than four months after the date on which the reply was or the appeal was taken;

(3) Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application; or

(4) Issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

(b) *Failure to issue a patent within three years of the actual filing date of the application.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

(1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);

(2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

(3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;

(4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or

(5) Any delay in the processing of the application by the Office that was requested by the applicant.

(c) *Delays caused by interference proceedings.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a).

(d) *Delays caused by secrecy order.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the application being placed under a secrecy order under 35 U.S.C. 181.

(e) *Delays caused by successful appellate review.* Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to review by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability.

(f) The provisions of this section and §§1.703 through 1.705 apply only to original applications, except applications for a design patent, filed on or after May 29, 2000, and patents issued on such applications.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000]

§ 1.703 Period of adjustment of patent term due to examination delay.

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(3) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply in compliance with § 1.113(c) was and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

(5) The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of

Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first; and

(6) The number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was and ending on the date the patent was issued;

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3)(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was under 35 U.S.C. 134 and § 1.191 and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

(c) The period of adjustment under § 1.702(c) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(2) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(d) The period of adjustment under § 1.702(d) is the sum of the following periods, to the extent that the periods are not overlapping:

(1) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(2) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order was removed;

(3) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy

order and ending on the date the secrecy order was removed; and

(4) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151.

(e) The period of adjustment under § 1.702(e) is the sum of the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was under 35 U.S.C. 134 and § 1.191 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(f) The adjustment will run from the expiration date of the patent as set forth in 35 U.S.C. 154(a)(2). To the extent that periods of adjustment attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. The term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section, to the extent that such periods are not overlapping, less the sum of the periods calculated under § 1.704. The date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

(g) No patent, the term of which has been disclaimed beyond a specified date, shall be adjusted under § 1.702 and this section beyond the expiration date specified in the disclaimer.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000]

§ 1.704 Reduction of period of adjustment of patent term.

(a) The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

(b) With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(1) Suspension of action under § 1.103 at the applicant's request, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under § 1.103 was and ending on the date of the termination of the suspension;

(2) Deferral of issuance of a patent under § 1.314, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for deferral of issuance of a patent under § 1.314 was filed and ending on the date the patent was issued;

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

(4) Failure to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed;

(5) Conversion of a provisional application under 35 U.S.C. 111(b) to a nonprovisional application under 35 U.S.C. 111(a) pursuant to 35 U.S.C. 111(b)(5), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date the application was filed under 35 U.S.C. 111(b) and ending on the date a request in compliance with §1.53(c)(3) to convert the provisional application into a nonprovisional application was filed;

(6) Submission of a preliminary amendment or other preliminary paper less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the date of mailing of the supplemental Office action or notice of allowance; or

(ii) Four months;

(7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

(9) Submission of an amendment or other paper after a decision by the Board of Patent Appeals and Interferences, other than a decision designated as containing a new ground of rejection under § 1.196(b) or statement under § 1.196(c), or a decision by a Federal court, less than one month before the mailing of an Office action under 35 U.S.C. 132 or notice of allowance under 35 U.S.C. 151 that requires the mailing of a supplemental Office action or supplemental notice of allowance, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the day after the mailing date of the original Office action or notice of allowance and ending on the mailing date of the supplemental Office action or notice of allowance; or

(ii) Four months;

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; and

(11) Further prosecution via a continuing application, in which case the period of adjustment set forth in § 1.703 shall not include any period that is prior to the actual filing date of the application that resulted in the patent.

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart application and that this

communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

(e) Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000]

§ 1.705 Patent term adjustment determination.

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance. An application for patent term adjustment under this section must be accompanied by:

(1) The fee set forth in § 1.18(e); and

(2) A statement of the facts involved, specifying:

(i) The correct patent term adjustment and the basis or bases under § 1.702 for the adjustment;

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled;

(iii) Whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer; and

(iv)(A) Any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704; or

(B) That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(c) Any application for patent term adjustment under this section that requests reinstatement of all or part of the period of adjustment reduced pursuant to § 1.704(b) for failing to reply to a rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request must also be accompanied by:

(1) The fee set forth in § 1.18(f); and

(2) A showing to the satisfaction of the Commissioner that, in spite of all due care, the applicant was unable to reply to the rejection, objection, argument, or other request within three months of the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request. The Office shall not grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office communication notifying the applicant of the rejection, objection, argument, or other request.

(d) If the patent is issued on a date other than the projected date of issue and this change necessitates a revision of the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates a revised patent term adjustment due to the patent being issued on a date other than the projected date of issue, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within thirty days of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section.

(e) The periods set forth in this section are not extendable.

(f) No submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office. Any such submission or petition will be returned to the third party, or otherwise disposed of, at the convenience of the Office.

[Added, 65 FR 56366, Sept. 18, 2000, effective Oct. 18, 2000]

EXTENSION OF PATENT TERM DUE TO REGULATORY REVIEW

§ 1.710 Patents subject to extension of the patent term.

(a) A patent is eligible for extension of the patent term if the patent claims a product as defined in paragraph (b) of this section, either alone or in combination with other ingredients that read on a composition that received permission for commercial marketing or use, or a method of using such a product, or a method of manufacturing such a product, and meets all other conditions and requirements of this subpart.

(b) The term *product* referred to in paragraph (a) of this section means —

(l) The active ingredient of a new human drug, antibiotic drug, or human biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Public Health Service Act) including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(2) The active ingredient of a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Virus-Serum-Toxin Act) that is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes including site specific genetic manipulation techniques, including any salt or ester of the active ingredient, as a single entity or in combination with another active ingredient; or

(3) Any medical device, food additive, or color additive subject to regulation under the Federal Food, Drug, and Cosmetic Act.

[Added 52 FR 9394, Mar. 24, 1987, effective May 26, 1987; amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.720 Conditions for extension of patent term.

The term of a patent may be extended if:

(a) The patent claims a product or a method of using or manufacturing a product as defined in § 1.710;

(b) The term of the patent has never been previously extended, except for extensions issued pursuant to §§ 1.701, 1.760, or 1.790;

(c) An application for extension is submitted in compliance with § 1.740;

(d) The product has been subject to a regulatory review period as defined in 35 U.S.C. 156(g) before its commercial marketing or use;

(e) The product has received permission for commercial marketing or use and —

(1) The permission for the commercial marketing or use of the product is the first received permission for commercial marketing or use under the provision of law under which the applicable regulatory review occurred, or

(2) In the case of a patent other than one directed to subject matter within § 1.710(b)(2) claiming a method of manufacturing the product that primarily uses recombinant DNA technology in the manufacture of the product, the permission for the commercial marketing or use is the first received permission for the commercial marketing or use of a product manufactured under the process claimed in the patent, or

(3) In the case of a patent claiming a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and has received permission for the commercial marketing or use in non-food-producing animals and in food-producing animals, and was not extended on the basis of the regulatory review period for use in non-food-producing animals, the permission for the commercial marketing or use of the drug or product after the regulatory review period for use in food-producing animals is the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal.

(f) The application is submitted within the sixty-day period beginning on the date the product first received permission for commercial marketing or use under the provisions of law under which the applicable regulatory review period occurred; or in the case of a patent claiming a method of manufacturing the

product which primarily uses recombinant DNA technology in the manufacture of the product, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of a product manufactured under the process claimed in the patent; or in the case of a patent that claims a new animal drug or a veterinary biological product that is not covered by the claims in any other patent that has been extended, and said drug or product has received permission for the commercial marketing or use in non-food-producing animals, the application for extension is submitted within the sixty-day period beginning on the date of the first permitted commercial marketing or use of the drug or product for administration to a food-producing animal;

(g) The term of the patent, including any interim extension issued pursuant to § 1.790, has not expired before the submission of an application in compliance with § 1.741; and

(h) No other patent term has been extended for the same regulatory review period for the product.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; paras. (e) & (f) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; paras. (b) and (g) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.730 Applicant for extension of patent term; signature requirements.

(a) Any application for extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of § 1.740.

(b) If the application is submitted by the patent owner, the application must be signed either by:

(1) The patent owner in compliance with § 3.73(b) of this chapter; or

(2) A registered practitioner on behalf of the patent owner.

(c) If the application is submitted on behalf of the patent owner by an agent of the patent owner (*e.g.*, a licensee of the patent owner), the application must be signed by a registered practitioner on behalf of the agent. The Office may require proof that the agent is authorized to act on behalf of the patent owner.

(d) If the application is signed by a registered practitioner, the Office may require proof that the practitioner is authorized to act on behalf of the patent owner or agent of the patent owner.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.740 Formal requirements for application for extension of patent term; correction of informalities.

(a) An application for extension of patent term must be made in writing to the Commissioner. A formal application for the extension of patent term must include:

(1) A complete identification of the approved product as by appropriate chemical and generic name, physical structure or characteristics;

(2) A complete identification of the Federal statute including the applicable provision of law under which the regulatory review occurred;

(3) An identification of the date on which the product received permission for commercial marketing or use under the provision of law under which the applicable regulatory review period occurred;

(4) In the case of a drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug, and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a statement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients), the use for which it was approved, and the provision of law under which it was approved.

(5) A statement that the application is being submitted within the sixty day period permitted for submission pursuant to § 1.720(f) and an identification of the date of the last day on which the application could be submitted;

(6) A complete identification of the patent for which an extension is being sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(7) A copy of the patent for which an extension is being sought, including the entire specification (including claims) and drawings;

(8) A copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(9) A statement that the patent claims the approved product, or a method of using or manufacturing the approved product, and a showing which lists each applicable patent claim and demonstrates the manner in which at least one such patent claim reads on:

(i) The approved product, if the listed claims include any claim to the approved product;

(ii) The method of using the approved product, if the listed claims include any claim to the method of using the approved product; and

(iii) The method of manufacturing the approved product, if the listed claims include any claim to the method of manufacturing the approved product;

(10) A statement beginning on a new page of the relevant dates and information pursuant to 35 U.S.C. 156(g) in order to enable the Secretary of Health and Human Services or the Secretary of Agriculture, as appropriate, to determine the applicable regulatory review period as follows:

(i) For a patent claiming a human drug, antibiotic, or human biological product:

(A) The effective date of the investigational new drug (IND) application and the IND number;

(B) The date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number; and

(C) The date on which the NDA was approved or the Product License issued;

(ii) For a patent claiming a new animal drug:

(A) The date a major health or environmental effects test on the drug was initiated, and any available substantiation of that date, or the date of an exemption under subsection (j) of Section 512 of the Federal Food, Drug, and Cosmetic Act became effective for such animal drug;

(B) The date on which a new animal drug application (NADA) was initially submitted and the NADA number; and

(C) The date on which the NADA was approved;

(iii) For a patent claiming a veterinary biological product:

(A) The date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective;

(B) The date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(C) The date the license issued;

(iv) For a patent claiming a food or color additive:

(A) The date a major health or environmental effects test on the additive was initiated and any available substantiation of that date;

(B) The date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number; and

(C) The date on which the FDA published a *Federal Register* notice listing the additive for use;

(v) For a patent claiming a medical device:

(A) The effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device, if no IDE was submitted, and any available substantiation of that date;

(B) The date on which the application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application; and

(C) The date on which the application was approved or the protocol declared to be completed;

(11) A brief description beginning on a new page of the significant activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities;

(12) A statement beginning on a new page that in the opinion of the applicant the patent is eligible for the extension and a statement as to the length of extension claimed, including how the length of extension was determined;

(13) A statement that applicant acknowledges a duty to disclose to the Commissioner of Patents and

Trademarks and the Secretary of Health and Human Services or the Secretary of Agriculture any information which is material to the determination of entitlement to the extension sought (see § 1.765);

(14) The prescribed fee for receiving and acting upon the application for extension (see § 1.20(j)); and

(15) The name, address, and telephone number of the person to whom inquiries and correspondence relating to the application for patent term extension are to be directed.

(b) The application under this section must be accompanied by two additional copies of such application (for a total of three copies).

(c) If an application for extension of patent term is informal under this section, the Office will so notify the applicant. The applicant has two months from the mail date of the notice, or such time as is set in the notice, within which to correct the informality. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

[Added 52 FR 9395, Mar. 24, 1987, effective May 26, 1987; para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a)(14), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; heading, introductory text of paragraph (a), and paras. (a)(9), (a)(10), (a)(14), (a)(15), (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; paras. (a)(16) and (a)(17) removed, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.741 Complete application given a filing date; petition procedure.

(a) The filing date of an application for extension of a patent term is the date on which a complete application is received in the Office or filed pursuant to the procedures set forth in §1.8 or § 1.10. A complete application must include:

(1) An identification of the approved product;

(2) An identification of each Federal statute under which regulatory review occurred;

(3) An identification of the patent for which an extension is being sought;

(4) An identification of each claim of the patent which claims the approved product or a method of using or manufacturing the approved product;

(5) Sufficient information to enable the Commissioner to determine under subsections (a) and (b) of 35 U.S.C. 156 the eligibility of a patent for extension, and the rights that will be derived from the extension, and information to enable the Commissioner and the Secretary of Health and Human Services or the Secretary of Agriculture to determine the length of the regulatory review period; and

(6) A brief description of the activities undertaken by the marketing applicant during the applicable regulatory review period with respect to the approved product and the significant dates applicable to such activities.

(b) If an application for extension of patent term is incomplete under this section, the Office will so notify the applicant. If applicant requests review of a notice that an application is incomplete, or review of the filing date accorded an application under this section, applicant must file a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(h) within two months of the mail date of the notice that the application is incomplete, or the notice according the filing date complained of. Unless the notice indicates otherwise, this time period may be extended under the provisions of § 1.136.

[Added 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (a) correcting amendment, 61 FR 64027, Dec. 3, 1996; heading, introductory text of paragraph (a), and paras. (a)(5) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.750 Determination of eligibility for extension of patent term.

A determination as to whether a patent is eligible for extension may be made by the Commissioner solely on the basis of the representations contained in the application for extension filed in compliance with § 1.740 or § 1.790. This determination may be delegated to appropriate Patent and Trademark Office officials and may be made at any time before the certificate of extension is issued. The Commissioner or other appropriate officials may require from applicant further information or make such independent inquiries as desired before a final determination is made on whether a patent is eligible for extension. In an application for extension filed in compliance with § 1.740, a notice will be mailed to applicant containing the determination as to the eligibility of the patent for

extension and the period of time of the extension, if any. This notice shall constitute the final determination as to the eligibility and any period of extension of the patent. A single request for reconsideration of a final determination may be made if filed by the applicant within such time as may be set in the notice of final determination or, if no time is set, within one month from the date of the final determination. The time periods set forth herein are subject to the provisions of § 1.136.

[Added 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; revised, 60 FR 25615, May 12, 1995, effective July 11, 1995]

§ 1.760 Interim extension of patent term under 35 U.S.C. 156(e)(2).

An applicant who has filed a formal application for extension in compliance with § 1.740 may request one or more interim extensions for periods of up to one year each pending a final determination on the application pursuant to § 1.750. Any such request should be filed at least three months prior to the expiration date of the patent. The Commissioner may issue interim extensions, without a request by the applicant, for periods of up to one year each until a final determination is made. The patent owner or agent will be notified when an interim extension is granted and notice of the extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. The notice will be recorded in the official file of the patent and will be considered as part of the original patent. In no event will the interim extensions granted under this section be longer than the maximum period for extension to which the applicant would be eligible.

[Added, 52 FR 9396, Mar. 24, 1987, effective May 26, 1987; heading revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000]

§ 1.765 Duty of disclosure in patent term extension proceedings.

(a) A duty of candor and good faith toward the Patent and Trademark Office and the Secretary of Health and Human Services or the Secretary of Agriculture rests on the patent owner or its agent, on each attorney or agent who represents the patent owner and on every other individual who is substantively involved on behalf of the patent owner in a patent term extension proceeding. All such individuals who are aware, or become aware, of material information adverse to a determination of entitlement to the extension sought, which has not been previously made of record in the patent term extension proceeding must bring such information to the attention of the Office or the Secretary, as appropriate, in accordance with paragraph (b) of this section, as soon as it is practical to do so after the individual becomes aware of the information. Information is material where there is a substantial likelihood that the Office or the Secretary would consider it important in determinations to be made in the patent term extension proceeding.

(b) Disclosures pursuant to this section must be accompanied by a copy of each written document which is being disclosed. The disclosure must be made to the Office or the Secretary, as appropriate, unless the disclosure is material to determinations to be made by both the Office and the Secretary, in which case duplicate copies, certified as such, must be filed in the Office and with the Secretary. Disclosures pursuant to this section may be made to the Office or the Secretary, as appropriate, through an attorney or agent having responsibility on behalf of the patent owner or its agent for the patent term extension proceeding or through a patent owner acting on his or her own behalf. Disclosure to such an attorney, agent or patent owner shall satisfy the duty of any other individual. Such an attorney, agent or patent owner has no duty to transmit information which is not material to the determination of entitlement to the extension sought.

(c) No patent will be determined eligible for extension and no extension will be issued if it is determined that fraud on the Office or the Secretary was practiced or attempted or the duty of disclosure was violated through bad faith or gross negligence in connection with the patent term extension proceeding. If it is established by clear and convincing evidence that any fraud was practiced or attempted on the Office or the Secretary in connection with the patent term extension proceeding or that there was any violation of the duty of disclosure through bad faith or gross negligence in connection with the patent term extension proceeding, a final determination will be made

pursuant to § 1.750 that the patent is not eligible for extension.

(d) The duty of disclosure pursuant to this section rests on the individuals identified in paragraph (a) of this section and no submission on behalf of third parties, in the form of protests or otherwise, will be considered by the Office. Any such submissions by third parties to the Office will be returned to the party making the submission, or otherwise disposed of, without consideration by the Office.

[Added, 52 FR 9396, Mar. 24 1987, effective May 26, 1987, para. (a) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; para. (a) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995]

§ 1.770 Express withdrawal of application for extension of patent term.

An application for extension of patent term may be expressly withdrawn before a determination is made pursuant to § 1.750 by filing in the Office, in duplicate, a written declaration of withdrawal signed by the owner of record of the patent or its agent. An application may not be expressly withdrawn after the date permitted for reply to the final determination on the application. An express withdrawal pursuant to this section is effective when acknowledged in writing by the Office. The filing of an express withdrawal pursuant to this section and its acceptance by the Office does not entitle applicant to a refund of the filing fee (§ 1.20(j)) or any portion thereof.

[Added 52 FR 9397, Mar. 24 1987, effective May 26, 1987; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.775 Calculation of patent term extension for a human drug, antibiotic drug, or human biological product.

(a) If a determination is made pursuant to § 1.750 that a patent for a human drug, antibiotic drug, or human biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a human drug, antibiotic drug or human biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a human drug, antibiotic drug or human biological product will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(1)(B), it is the sum of —

(1) The number of days in the period beginning on the date an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act became effective for the approved product and ending on the date an application was initially submitted for such product under those sections or under section 351 of the Public Health Service Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved product under section 351 of the Public Health Service Act, subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for a human drug, antibiotic drug or human biological product will be determined by—

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 351 of the Public Health Service Act, or subsection (b) of section 505 or section 507 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by—

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request was submitted for an exemption under subsection (i) of section 505 or subsection (d) of section 507 of the Federal Food, Drug, or Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by -

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier filing date.

[Added, 52 FR 9397, Mar. 24 1987, effective May 26, 1987]

§ 1.776 Calculation of patent term extension for a food additive or color additive.

(a) If a determination is made pursuant to § 1.750 that a patent for a food additive or color additive is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a food additive or color additive will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a food additive or color additive will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(2)(B), it is the sum of -

(1) The number of days in the period beginning on the date a major health or environmental effects test on the additive was initiated and ending on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug, and Cosmetic Act requesting the issuance of a regulation for use of the product; and

(2) The number of days in the period beginning on the date a petition was initially submitted with respect to the approved product under the Federal Food, Drug and Cosmetic Act requesting the issuance of a regulation for use of the product, and ending on the date such regulation became effective or, if objections were filed to such regulation, ending on the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, ending on the date such proceedings were finally resolved and commercial marketing was permitted.

(d) The term of the patent as extended for a food additive or color additive will be determined by

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which

were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) The number of days equal to one-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date a regulation for use of the product became effective or, if objections were filed to such regulation, to the date such objections were resolved and commercial marketing was permitted or, if commercial marketing was permitted and later revoked pending further proceedings as a result of such objections, to the date such proceedings were finally resolved and commercial marketing was permitted;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no major health or environmental effects test was initiated and no petition for a regulation or application for registration was submitted before September 24, 1984, by

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a petition for a regulation or application for registration was submitted by September 24, 1984, and the commercial marketing or use of the product was not approved before September 24, 1984, by —

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 52 FR 9397, Mar. 24, 1987, effective May 26, 1987]

§ 1.777 Calculation of patent term extension for a medical device.

(a) If a determination is made pursuant to § 1.750 that a patent for a medical device is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or earlier date as set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a medical device will be extended by the length of the regulatory review period for the product as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a medical device will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(3)(B), it is the sum of

(1) The number of days in the period beginning on the date a clinical investigation on humans involving the device was begun and ending on the date an application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted with respect to the device under section 515 of the Federal Food, Drug, and Cosmetic Act, and ending on the date such application was approved under such Act or the period beginning on the date a notice of

completion of a product development protocol was initially submitted under section 515(f)(5) of the Act and ending on the date the protocol was declared completed under section 515(f)(6) of the Act.

(d) The term of the patent as extended for a medical device will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period pursuant to paragraph (c) of this section:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section which were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1) (i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 515 of the Federal Food, Drug, and Cosmetic Act or the date a product development protocol was declared completed under section 515(f)(6) of the Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after September 24, 1984,

(i) By adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(ii) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before September 24, 1984, and

(i) If no clinical investigation on humans involving the device was begun or no product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a clinical investigation on humans involving the device was begun or a product development protocol was submitted under section 515(f)(5) of the Federal Food, Drug, and Cosmetic Act before September 24, 1984 and the commercial marketing or use of the product was not approved before September 24, 1984, by

(A) Adding 2 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) By comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 52 FR 9398, Mar. 24 1987, effective May 26, 1987]

§ 1.778 Calculation of patent term extension for an animal drug product.

(a) If a determination is made pursuant to § 1.750 that a patent for an animal drug is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for an animal drug will be extended by the length of the regulatory review period for the drug as determined by the Secretary of Health and Human Services, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for an animal drug will be determined by the Secretary of Health and Human Services. Under 35 U.S.C. 156(g)(4)(B), it is the sum of —

(1) The number of days in the period beginning on the earlier of the date a major health or environmental effects test on the drug was initiated or the

date an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act became effective for the approved animal drug and ending on the date an application was initially submitted for such animal drug under section 512 of the Federal Food, Drug, and Cosmetic Act; and

(2) The number of days in the period beginning on the date the application was initially submitted for the approved animal drug under subsection (b) of section 512 of the Federal Food, Drug, and Cosmetic Act and ending on the date such application was approved under such section.

(d) The term of the patent as extended for an animal drug will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Health and Human Services to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Health and Human Services that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of approval of the application under section 512 of the Federal Food, Drug, and Cosmetic Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by —

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no major health or environmental effects test on the drug was initiated and no request was submitted for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act before November 16, 1988, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a major health or environmental effects test was initiated or a request for an exemption under subsection (j) of section 512 of the Federal Food, Drug, and Cosmetic Act was submitted before November 16, 1988, and the application for commercial marketing or use of the animal drug was not approved before November 16, 1988, by —

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer, and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.779 Calculation of patent term extension for a veterinary biological product.

(a) If a determination is made pursuant to § 1.750 that a patent for a veterinary biological product is eligible for extension, the term shall be extended by the time as calculated in days in the manner indicated by this section. The patent term extension will run from the original expiration date of the patent or any earlier date set by terminal disclaimer (§ 1.321).

(b) The term of the patent for a veterinary biological product will be extended by the length of the regulatory review period for the product as determined by the Secretary of Agriculture, reduced as appropriate pursuant to paragraphs (d)(1) through (d)(6) of this section.

(c) The length of the regulatory review period for a veterinary biological product will be determined

by the Secretary of Agriculture. Under 35 U.S.C. 156(g)(5)(B), it is the sum of —

(1) The number of days in the period beginning on the date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective and ending on the date an application for a license was submitted under the Virus-Serum-Toxin Act; and

(2) The number of days in the period beginning on the date an application for a license was initially submitted for approval under the Virus-Serum-Toxin Act and ending on the date such license was issued.

(d) The term of the patent as extended for a veterinary biological product will be determined by —

(1) Subtracting from the number of days determined by the Secretary of Agriculture to be in the regulatory review period:

(i) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section that were on and before the date on which the patent issued;

(ii) The number of days in the periods of paragraphs (c)(1) and (c)(2) of this section during which it is determined under 35 U.S.C. 156(d)(2)(B) by the Secretary of Agriculture that applicant did not act with due diligence;

(iii) One-half the number of days remaining in the period defined by paragraph (c)(1) of this section after that period is reduced in accordance with paragraphs (d)(1)(i) and (ii) of this section; half days will be ignored for purposes of subtraction;

(2) By adding the number of days determined in paragraph (d)(1) of this section to the original term of the patent as shortened by any terminal disclaimer;

(3) By adding 14 years to the date of the issuance of a license under the Virus-Serum-Toxin Act;

(4) By comparing the dates for the ends of the periods obtained pursuant to paragraphs (d)(2) and (d)(3) of this section with each other and selecting the earlier date;

(5) If the original patent was issued after November 16, 1988, by —

(i) Adding 5 years to the original expiration date of the patent or any earlier date set by terminal disclaimer; and

(ii) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(5)(i) of this section with each other and selecting the earlier date;

(6) If the original patent was issued before November 16, 1988, and

(i) If no request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, by —

(A) Adding 5 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(i)(A) of this section with each other and selecting the earlier date; or

(ii) If a request for the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act was submitted before November 16, 1988, and the commercial marketing or use of the product was not approved before November 16, 1988, by —

(A) Adding 3 years to the original expiration date of the patent or earlier date set by terminal disclaimer; and

(B) Comparing the dates obtained pursuant to paragraphs (d)(4) and (d)(6)(ii)(A) of this section with each other and selecting the earlier date.

[Added, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989]

§ 1.780 Certificate or order of extension of patent term.

If a determination is made pursuant to § 1.750 that a patent is eligible for extension and that the term of the patent is to be extended, a certificate of extension, under seal, or an order granting interim extension under 35 U.S.C. 156(d)(5), will be issued to the applicant for the extension of the patent term. Such certificate or order will be recorded in the official file of the patent and will be considered as part of the original patent. Notification of the issuance of the certificate or order of extension will be published in the *Official Gazette of the United States Patent and Trademark Office*. Notification of the issuance of the order granting an interim extension under 35 U.S.C. 156(d)(5), including the identity of the product currently under regulatory review, will be published in the *Official Gazette of the United States Patent and Trademark* Office and in the *Federal Register*. No certificate of, or order granting, an extension will be issued if the term of the patent cannot be extended, even though

the patent is otherwise determined to be eligible for extension. In such situations, the final determination made pursuant to § 1.750 will indicate that no certificate or order will issue.

[Added, 52 FR 9399, Mar. 24 1987, effective May 26, 1987; para. (a) revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

(a) Only one patent may be extended for a regulatory review period for any product § 1.720 (h). If more than one application for extension of the same patent is filed, the certificate of extension of patent term, if appropriate, will be issued based upon the first filed application for extension.

(b) If more than one application for extension is filed by a single applicant which seeks the extension of the term of two or more patents based upon the same regulatory review period, and the patents are otherwise eligible for extension pursuant to the requirements of this subpart, in the absence of an election by the applicant, the certificate of extension of patent term, if appropriate, will be issued upon the application for extension of the patent term having the earliest date of issuance of those patents for which extension is sought.

(c) If an application for extension is filed which seeks the extension of the term of a patent based upon the same regulatory review period as that relied upon in one or more applications for extension pursuant to the requirements of this subpart, the certificate of extension of patent term will be issued on the application only if the patent owner or its agent is the holder of the regulatory approval granted with respect to the regulatory review period.

(d) An application for extension shall be considered complete and formal regardless of whether it contains the identification of the holder of the regulatory approval granted with respect to the regulatory review period. When an application contains such information, or is amended to contain such information, it will be considered in determining whether an application is eligible for an extension under this section. A request may be made of any applicant to supply such information within a non-extendable period of not less than one month whenever multiple applications for extension of more than one patent are received and rely upon the same regulatory review period. Failure to provide such information within the period for reply set shall be regarded as conclusively establishing that the applicant is not the holder of the regulatory approval.

(e) Determinations made under this section shall be included in the notice of final determination of eligibility for extension of the patent term pursuant to § 1.750 and shall be regarded as part of that determination.

[Added, 52 FR 9399, Mar. 24 1987, effective May 26, 1987; para. (b) amended, 54 FR 30375, July 20, 1989, effective Aug. 22, 1989; revised, 60 FR 25615, May 12, 1995, effective July 11, 1995; para. (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.790 Interim extension of patent term under 35 U.S.C. 156(d)(5)

(a) An owner of record of a patent or its agent who reasonably expects that the applicable regulatory review period described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) that began for a product that is the subject of such patent may extend beyond the expiration of the patent term in effect may submit one or more applications for interim extensions for periods of up to one year each. The initial application for interim extension must be filed during the period beginning 6 months and ending 15 days before the patent term is due to expire. Each subsequent application for interim extension must be filed during the period beginning 60 days before and ending 30 days before the expiration of the preceding interim extension. In no event will the interim extensions granted under this section be longer than the maximum period of extension to which the applicant would be entitled under 35 U.S.C. 156(c).

(b) A complete application for interim extension under this section shall include all of the information required for a formal application under § 1.740 and a complete application under § 1.741. Sections (a)(1), (a)(2), (a)(4), and (a)(6) - (a)(17) of § 1.740 and § 1.741 shall be read in the context of a product currently undergoing regulatory review. Sections (a)(3) and (a)(5) of § 1.740 are not applicable to

an application for interim extension under this section.

(c) The content of each subsequent interim extension application may be limited to a request for a subsequent interim extension along with a statement that the regulatory review period has not been completed along with any materials or information required under §§ 1.740 and 1.741 that are not present in the preceding interim extension application.

[Added, 60 FR 25615, May 12, 1995, effective July 11, 1995]

§ 1.791 Termination of interim extension granted prior to regulatory approval of a product for commercial marketing or use.

Any interim extension granted under 35 U.S.C. 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files an application for extension under §§ 1.740 and 1.741 including any additional information required under 35 U.S.C. 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. 156.

[Added, 60 FR 25615, May 12, 1995, effective July 11, 1995]

Subpart G — Biotechnology Invention Disclosures

DEPOSIT OF BIOLOGICAL MATERIAL

§ 1.801 Biological material.

For the purposes of these regulations pertaining to the deposit of biological material for purposes of patents for inventions under 35 U.S.C. 101, the term biological material shall include material that is capable of self-replication either directly or indirectly. Representative examples include bacteria, fungi including yeast, algae, protozoa, eukaryotic cells, cell lines, hybridomas, plasmids, viruses, plant tissue cells, lichens and seeds. Viruses, vectors, cell organelles and other non-living material existing in and reproducible from a living cell may be deposited by deposit of the host cell capable of reproducing the non-living material.

[Added, 54 FR 34880, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.802 Need or opportunity to make a deposit.

(a) Where an invention is, or relies on, a biological material, the disclosure may include reference to a deposit of such biological material.

(b) Biological material need not be deposited unless access to such material is necessary for the satisfaction of the statutory requirements for patentability under 35 U.S.C. 112. If a deposit is necessary, it shall be acceptable if made in accordance with these regulations. Biological material need not be deposited, *inter alia*, if it is known and readily available to the public or can be made or isolated without undue experimentation. Once deposited in a depository complying with these regulations, a biological material will be considered to be readily available even though some requirement of law or regulation of the United States or of the country in which the depository institution is located permits access to the material only under conditions imposed for safety, public health or similar reasons.

(c) The reference to a biological material in a specification disclosure or the actual deposit of such material by an applicant or patent owner does not create any presumption that such material is necessary to satisfy 35 U.S.C. 112 or that deposit in accordance with these regulations is or was required.

[Added, 54 FR 34880, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.803 Acceptable depository.

(a) A deposit shall be recognized for the purposes of these regulations if made in

(1) Any International Depositary Authority (IDA) as established under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, or

(2) Any other depository recognized to be suitable by the Office. Suitability will be determined by the Commissioner on the basis of the administrative and technical competence, and agreement of the depository to comply with the terms and conditions applicable to deposits for patent purposes. The Com-

missioner may seek the advice of impartial consultants on the suitability of a depository. The depository must:

(i) Have a continuous existence;

(ii) Exist independent of the control of the depositor;

(iii) Possess the staff and facilities sufficient to examine the viability of a deposit and store the deposit in a manner which ensures that it is kept viable and uncontaminated;

(iv) Provide for sufficient safety measures to minimize the risk of losing biological material deposited with it;

(v) Be impartial and objective;

(vi) Furnish samples of the deposited material in an expeditious and proper manner; and

(vii) Promptly notify depositors of its inability to furnish samples, and the reasons why.

(b) A depository seeking status under paragraph (a)(2) of this section must direct a communication to the Commissioner which shall:

(1) Indicate the name and address of the depository to which the communication relates;

(2) Contain detailed information as to the capacity of the depository to comply with the requirements of paragraph (a)(2) of this section, including information on its legal status, scientific standing, staff, and facilities;

(3) Indicate that the depository intends to be available, for the purposes of deposit, to any depositor under these same conditions;

(4) Where the depository intends to accept for deposit only certain kinds of biological material, specify such kinds;

(5) Indicate the amount of any fees that the depository will, upon acquiring the status of suitable depository under paragraph (a)(2) of this section, charge for storage, viability statements and furnishings of samples of the deposit.

(c) A depository having status under paragraph (a)(2) of this section limited to certain kinds of biological material may extend such status to additional kinds of biological material by directing a communication to the Commissioner in accordance with paragraph (b) of this section. If a previous communication under paragraph (b) of this section is of record, items in common with the previous communication may be incorporated by reference.

(d) Once a depository is recognized to be suitable by the Commissioner or has defaulted or discontinued its performance under this section, notice thereof will be published in the *Official Gazette* of the Patent and Trademark Office.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.804 Time of making an original deposit.

(a) Whenever a biological material is specifically identified in an application for patent as filed, an original deposit thereof may be made at any time before filing the application for patent or, subject to § 1.809, during pendency of the application for patent.

(b) When the original deposit is made after the effective filing date of an application for patent, the applicant must promptly submit a statement from a person in a position to corroborate the fact, stating that the biological material which is deposited is a biological material specifically identified in the application as filed.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 1990; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.805 Replacement or supplement of deposit.

(a) A depositor, after receiving notice during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, shall notify the Office in writing, in each application for patent or patent affected. In such a case, or where the Office otherwise learns, during the pendency of an application for patent, application for reissue patent or reexamination proceeding, that the depository possessing a deposit either cannot furnish samples thereof or can furnish samples thereof but the deposit has become contaminated or has lost its capability to function as described in the specification, the need for making a replacement or supplemental deposit will be governed by the same considerations governing the need for making an original deposit under the provisions set forth in § 1.802(b).

A replacement or supplemental deposit made during the pendency of an application for patent shall not be accepted unless it meets the requirements for making an original deposit under these regulations, including the requirement set forth under § 1.804(b). A replacement or supplemental deposit made in connection with a patent, whether or not made during the pendency of an application for reissue patent or a reexamination proceeding or both, shall not be accepted unless a certificate of correction under § 1.323 is requested by the patent owner which meets the terms of paragraphs (b) and (c) of this section.

(b) A request for certificate of correction under this section shall not be granted unless the certificate identifies:

(1) The accession number for the replacement or supplemental deposit;

(2) The date of the deposit; and

(3) The name and address of the depository.

(c) A request for a certificate of correction under this section shall not be granted unless the request is made promptly after the replacement or supplemental deposit has been made and the request:

(1) Includes a statement of the reason for making the replacement or supplemental deposit;

(2) Includes a statement from a person in a position to corroborate the fact, and stating that the replacement or supplemental deposit is of a biological material which is identical to that originally deposited;

(3) Includes a showing that the patent owner acted diligently —

(i) In the case of a replacement deposit, in making the deposit after receiving notice that samples could no longer be furnished from an earlier deposit; or

(ii) In the case of a supplemental deposit, in making the deposit after receiving notice that the earlier deposit had become contaminated or had lost its capability to function as described in the specification;

(4) Includes a statement that the term of the replacement or supplemental deposit expires no earlier than the term of the deposit being replaced or supplemented; and

(5) Otherwise establishes compliance with these regulations.

(d) A depositor's failure to replace a deposit, or in the case of a patent, to diligently replace a deposit and promptly thereafter request a certificate of correction which meets the terms of paragraphs (b) and (c) of this section, after being notified that the depository possessing the deposit cannot furnish samples thereof, shall cause the application or patent involved to be treated in any Office proceeding as if no deposit were made.

(e) In the event a deposit is replaced according to these regulations, the Office will apply a rebuttable presumption of identity between the original and the replacement deposit where a patent making reference to the deposit is relied upon during any Office proceeding.

(f) A replacement or supplemental deposit made during the pendency of an application for patent may be made for any reason.

(g) In no case is a replacement or supplemental deposit of a biological material necessary where the biological material, in accordance with § 1.802(b), need not be deposited.

(h) No replacement deposit of a biological material is necessary where a depository can furnish samples thereof but the depository for national security, health or environmental safety reasons is unable to provide samples to requesters outside of the jurisdiction where the depository is located.

(i) The Office will not recognize in any Office proceeding a replacement deposit of a biological material made by a patent owner where the depository could furnish samples of the deposit being replaced.

[Added, 54 FR 34881, Aug. 22, 1989, effective Jan. 1, 1990; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 1.806 Term of deposit.

A deposit made before or during pendency of an application for patent shall be made for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposit was received by the depository. In any case, samples must be stored under agreements that would make them available beyond the enforceable life of the patent for which the deposit was made.

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.807 Viability of deposit.

(a) A deposit of biological material that is capable of self-replication either directly or indirectly must be viable at the time of deposit and during the term of deposit. Viability may be tested by the depository. The test must conclude only that the deposited material is capable of reproduction. No evidence is necessarily required regarding the ability of the deposited material to perform any function described in the patent application.

(b) A viability statement for each deposit of a biological material defined in paragraph (a) of this section not made under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure must be filed in the application and must contain:

(1) The name and address of the depository;

(2) The name and address of the depositor;

(3) The date of deposit;

(4) The identity of the deposit and the accession number given by the depository;

(5) The date of the viability test;

(6) The procedures used to obtain a sample if the test is not done by the depository; and

(7) A statement that the deposit is capable of reproduction.

(c) If a viability test indicates that the deposit is not viable upon receipt, or the examiner cannot, for scientific or other valid reasons, accept the statement of viability received from the applicant, the examiner shall proceed as if no deposit has been made. The examiner will accept the conclusion set forth in a viability statement issued by a depository recognized under § 1.803(a).

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.808 Furnishing of samples.

(a) A deposit must be made under conditions that assure that:

(1) Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Commissioner to be entitled thereto under § 1.14 and 35 U.S.C. 122, and

(2) Subject to paragraph (b) of this section, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of the patent.

(b) The depositor may contract with the depository to require that samples of a deposited biological material shall be furnished only if a request for a sample, during the term of the patent:

(1) Is in writing or other tangible form and dated;

(2) Contains the name and address of the requesting party and the accession number of the deposit; and

(3) Is communicated in writing by the depository to the depositor along with the date on which the sample was furnished and the name and address of the party to whom the sample was furnished.

(c) Upon request made to the Office, the Office will certify whether a deposit has been stated to have been made under conditions which make it available to the public as of the issue date of the patent grant provided the request contains:

(1) The name and address of the depository;

(2) The accession number given to the deposit;

(3) The patent number and issue date of the patent referring to the deposit; and

(4) The name and address of the requesting party.

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990]

§ 1.809 Examination procedures.

(a) The examiner shall determine pursuant to § 1.104 in each application for patent, application for reissue patent or reexamination proceeding if a deposit is needed, and if needed, if a deposit actually made is acceptable for patent purposes. If a deposit is needed and has not been made or replaced or supplemented in accordance with these regulations, the examiner, where appropriate, shall reject the affected claims under the appropriate provision of 35 U.S.C.

112, explaining why a deposit is needed and/or why a deposit actually made cannot be accepted.

(b) The applicant for patent or patent owner shall reply to a rejection under paragraph (a) of this section by—

(1) In the case of an applicant for patent, either making an acceptable original, replacement, or supplemental deposit, or assuring the Office in writing that an acceptable deposit will be made; or, in the case of a patent owner, requesting a certificate of correction of the patent which meets the terms of paragraphs (b) and (c) of § 1.805, or

(2) Arguing why a deposit is not needed under the circumstances of the application or patent considered and/or why a deposit actually made should be accepted. Other replies to the examiner's action shall be considered nonresponsive. The rejection will be repeated until either paragraph (b)(1) of this section is satisfied or the examiner is convinced that a deposit is not needed.

(c) If an application for patent is otherwise in condition for allowance except for a needed deposit and the Office has received a written assurance that an acceptable deposit will be made, applicant will be notified and given a period of time within which the deposit must be made in order to avoid abandonment. This time period is not extendable under § 1.136(a) or (b) if set forth in a "Notice of Allowability" or in an Office action having a mail date on or after the mail date of a "Notice of Allowability" (see § 1.136(c)).

(d) For each deposit made pursuant to these regulations, the specification shall contain:

(1) The accession number for the deposit;

(2) The date of the deposit;

(3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and

(4) The name and address of the depository.

(e) Any amendment required by paragraphs (d)(1), (d)(2) or (d)(4) of this section must be filed before or with the payment of the issue fee (see § 1.312).

[Added, 54 FR 34882, Aug. 22, 1989, effective Jan. 1, 1990; paras. (b) and (c) revised and para. (e) added, 66 FR 21092, Apr. 27, 2001, effective May 29, 2001]

APPLICATION DISCLOSURES CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCES

§ 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.

(a) Nucleotide and/or amino acid sequences as used in §§ 1.821 through 1.825 are interpreted to mean an unbranched sequence of four or more amino acids or an unbranched sequence of ten or more nucleotides. Branched sequences are specifically excluded from this definition. Sequences with fewer than four specifically defined nucleotides or amino acids are specifically excluded from this section. "Specifically defined" means those amino acids other than "Xaa" and those nucleotide bases other than "n" defined in accordance with the World Intellectual Property Organization (WIPO) Handbook on Industrial Property Information and Documentation, Standard ST.25: Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings in Patent Applications (1998), including Tables 1 through 6 in Appendix 2, herein incorporated by reference. (Hereinafter "WIPO Standard ST.25 (1998)"). This incorporation by reference was approved by the Director of the Federal Register in accordance with 5 U.S.C. 552(a) and 1 CFR part 51. Copies of WIPO Standard ST.25 (1998) may be obtained from the World Intellectual Property Organization; 34 chemin des Colombettes; 1211 Geneva 20 Switzerland. Copies of ST.25 may be inspected at the Patent Search Room; Crystal Plaza 3, Lobby Level; 2021 South Clark Place; Arlington, VA 22202. Copies may also be inspected at the Office of the Federal Register, 800 North Capitol Street, NW, Suite 700, Washington, DC. Nucleotides and amino acids are further defined as follows:

(1) *Nucleotides:* Nucleotides are intended to embrace only those nucleotides that can be represented using the symbols set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 1. Modifications, *e.g.*, methylated bases, may be described as set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 2,

but shall not be shown explicitly in the nucleotide sequence.

(2) *Amino acids:* Amino acids are those L-amino acids commonly found in naturally occurring proteins and are listed in WIPO Standard ST.25 (1998), Appendix 2, Table 3. Those amino acid sequences containing D-amino acids are not intended to be embraced by this definition. Any amino acid sequence that contains post-translationally modified amino acids may be described as the amino acid sequence that is initially translated using the symbols shown in WIPO Standard ST.25 (1998), Appendix 2, Table 3 with the modified positions; *e.g.*, hydroxylations or glycosylations, being described as set forth in WIPO Standard ST.25 (1998), Appendix 2, Table 4, but these modifications shall not be shown explicitly in the amino acid sequence. Any peptide or protein that can be expressed as a sequence using the symbols in WIPO Standard ST.25 (1998), Appendix 2, Table 3 in conjunction with a description in the Feature section to describe, for example, modified linkages, cross links and end caps, non-peptidyl bonds, etc., is embraced by this definition.

(b) Patent applications which contain disclosures of nucleotide and/or amino acid sequences, in accordance with the definition in paragraph (a) of this section, shall, with regard to the manner in which the nucleotide and/or amino acid sequences are presented and described, conform exclusively to the requirements of §§ 1.821 through 1.825.

(c) Patent applications which contain disclosures of nucleotide and/or amino acid sequences must contain, as a separate part of the disclosure, a paper or compact disc copy (*see* § 1.52(e)) disclosing the nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of §§ 1.822 and 1.823. This paper or compact disc copy is referred to elsewhere in this subpart as the "Sequence Listing." Each sequence disclosed must appear separately in the "Sequence Listing." Each sequence set forth in the "Sequence Listing" must be assigned a separate sequence identifier. The sequence identifiers must begin with 1 and increase sequentially by integers. If no sequence is present for a sequence identifier, the code "000" must be used in place of the sequence. The response for the numeric identifier <160> must include the total number of SEQ ID NOs, whether followed by a sequence or by the code "000."

(d) Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.

(e) A copy of the "Sequence Listing" referred to in paragraph (c) of this section must also be submitted in computer readable form (CRF) in accordance with the requirements of § 1.824. The computer readable form must be a copy of the "Sequence Listing" and may not be retained as a part of the patent application file. If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of this subpart. The new application must be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper or compact disc copy of the "Sequence Listing" in the new application is identical to the computer readable copy filed for the other application.

(f) In addition to the paper or compact disc copy required by paragraph (c) of this section and the computer readable form required by paragraph (e) of this section, a statement that the "Sequence Listing" content of the paper or compact disc copy and the computer readable copy are the same must be submitted with the computer readable form, *e.g.*, a statement that "the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing."

(g) If any of the requirements of paragraphs (b) through (f) of this section are not satisfied at the

Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<307>	Date.....	Journal date on which data published; specify as yyyy- mm-dd, MMM-yyyy or Season- yyyy.	O.
<308>	Database Accession Number.	Accession number assigned by database including database name.	O.
<309>	Database Entry Date.....	Date of entry in database; specify as yyyy-mm-dd or MMM-yyyy.	O.
<310>	Patent Document Number.	Document number; for patent-type citations only. Specify as, for example, US 07/ 999,999.	O.
<311>	Patent Filing Date.....	Document filing date, for patent-type citations only; specify as yyyy-mm-dd.	O.
<312>	Publication Date.....	Document publication date, for patent-type citations only; specify as yyyy-mm-dd.	O.
<313>	Relevant Residues.....	FROM (position) TO (position).....	O.
<400>	Sequence.....	SEQ ID NO should follow the numeric identifier and should appear on the line preceding the actual sequence.	M.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; heading and para. (a) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000)]

§ 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.

(a) The computer readable form required by § 1.821(e) shall meet the following requirements:

(1) The computer readable form shall contain a single "Sequence Listing" as either a diskette, series of diskettes, or other permissible media outlined in paragraph (c) of this section.

(2) The "Sequence Listing" in paragraph (a)(1) of this section shall be submitted in American Standard Code for Information Interchange (ASCII) text. No other formats shall be allowed.

(3) The computer readable form may be created by any means, such as word processors, nucleotide/amino acid sequence editors' or other custom computer programs; however, it shall conform to all requirements detailed in this section.

(4) File compression is acceptable when using diskette media, so long as the compressed file is in a self-extracting format that will decompress on one of the systems described in paragraph (b) of this section.

(5) Page numbering must not appear within the computer readable form version of the "Sequence Listing" file.

(6) All computer readable forms must have a label permanently affixed thereto on which has been hand-printed or typed: the name of the applicant, the title of the invention, the date on which the data were recorded on the computer readable form, the operating system used, a reference number, and an applica-

space provided between each codon or group of 10 bases.

(5) A nucleotide sequence shall be presented, only by a single strand, in the 5 to 3 direction, from left to right.

(6) The enumeration of nucleotide bases shall start at the first base of the sequence with number 1. The enumeration shall be continuous through the whole sequence in the direction 5 to 3. The enumeration shall be marked in the right margin, next to the line containing the one-letter codes for the bases, and giving the number of the last base of that line.

(7) For those nucleotide sequences that are circular in configuration, the enumeration method set forth in paragraph (c)(6) of this section remains applicable with the exception that the designation of the first base of the nucleotide sequence may be made at the option of the applicant.

(d) *Representation of amino acids.* (1) The amino acids in a protein or peptide sequence shall be listed using the three-letter abbreviation with the first letter as an upper case character, as in WIPO Standard ST.25 (1998), Appendix 2, Table 3.

(2) A protein or peptide sequence shall be listed with a maximum of 16 amino acids per line, with a space provided between each amino acid.

(3) An amino acid sequence shall be presented in the amino to carboxy direction, from left to right, and the amino and carboxy groups shall not be presented in the sequence.

(4) The enumeration of amino acids may start at the first amino acid of the first mature protein, with the number 1. When presented, the amino acids preceding the mature protein, *e.g.*, pre-sequences, pro-sequences, pre-pro-sequences and signal sequences, shall have negative numbers, counting backwards starting with the amino acid next to number 1. Otherwise, the enumeration of amino acids shall start at the first amino acid at the amino terminal as number 1. It shall be marked below the sequence every 5 amino acids. The enumeration method for amino acid sequences that is set forth in this section remains applicable for amino acid sequences that are circular in configuration, with the exception that the designation of the first amino acid of the sequence may be made at the option of the applicant.

(5) An amino acid sequence that contains internal terminator symbols (*e.g.*, "Ter", "*", or ".", etc.) may not be represented as a single amino acid sequence, but shall be presented as separate amino acid sequences.

(e) A sequence with a gap or gaps shall be presented as a plurality of separate sequences, with separate sequence identifiers, with the number of separate sequences being equal in number to the number of continuous strings of sequence data. A sequence that is made up of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective, July 1, 1998]

§ 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application.

(a)(1) If the "Sequence Listing" required by § 1.821(c) is submitted on paper: The "Sequence Listing," setting forth the nucleotide and/or amino acid sequence and associated information in accordance with paragraph (b) of this section, must begin on a new page and must be titled "Sequence Listing." The pages of the "Sequence Listing" preferably should be numbered independently of the numbering of the remainder of the application. Each page of the "Sequence Listing" shall contain no more than 66 lines and each line shall contain no more than 72 characters. A fixed-width font should be used exclusively throughout the "Sequence Listing."

(2) If the "Sequence Listing" required by § 1.821(c) is submitted on compact disc: The "Sequence Listing" must be submitted on a compact disc in compliance with § 1.52(e). The compact disc may also contain table information if the application contains table information that may be submitted on a compact disc (§ 1.52(e)(1)(iii)). The specification must contain an incorporation-by-reference of the Sequence Listing as required by § 1.52(e)(5). The presentation of the "Sequence Listing" and other materials on compact disc under § 1.821(c) does not substitute for the Computer Readable Form that must be submitted on disk, compact disc, or tape in accordance with § 1.824.

(b) The "Sequence Listing" shall, except as otherwise indicated, include the actual nucleotide and/or amino acid sequence, the numeric identifiers and their

APPENDIX A TO SUBPART G TO PART 1 — SAMPLE SEQUENCE LISTING

```
<110> Smith, John
      Smith, Jane

<120> Example of a Sequence Listing

<130> 01-00001

<140> US 08/999,999

<141> 1998-02-28

<150> EP 91000000
<151> 1997-12-31

<160> 2

<170> PatentIn ver. 2.0

<210> 1
<211> 403
<212> DNA
<213> Paramecium aurelia

<220>
<221> CDS
<222> 341..394

<300>
<301> Doe, Richard
<302> Isolation and Characterization of a Gene Encoding a
      Protease from Paramecium sp.
<303> Journal of Fictional Genes
<304> 1
<305> 4
<306> 1 - 7
<307> 1988-06-20

<400> 1
ctactctact ctactctcat ctactatctt ctttggatct ctgagtctgc ctgagtggta      60

ctcttgagtc ctggagatct ctcctctcac atgtgatcgt cgagactgac cgatagatcg      120

ctgactgact ctgagatagt cgagcccgta cgagacccgt cgagggtgac agagagtggg      180

cgcgtgcgcg cagagcgccg cgccggtgcg cgcgcgagtg cgcggtgggc cgcgcgaggg      240

ctttcgcggc agcggcggcg ctttccggcg cgcgcccgtc cgcccctaga cctgagaggt      300

cttctcttcc ctcctcttca ctagagaggt ctatatatac atg gtt tca atg ttc        355
                                     Met Val Ser Met Phe
                                     1               5
```

Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<213>	Organism.....	Scientific name, i.e. Genus/ species, Unknown or Artificial Sequence. In addition, the "Unknown" or "Artificial Sequence" organisms shall be further described in the <220> to <223> feature section.	M.
<220>	Feature.....	Leave blank after <220>. <221-223> provide for a description of points of biological significance in the sequence.	M, under the following conditions: if "n," "Xaa," or a modified or unusual L-amino acid or modified base was used in a sequence; if ORGANISM is "Artificial Sequence" or "Unknown"; if molecule is combined DNA/RNA.
<221>	Name/Key.....	Provide appropriate identifier for feature, preferably from WIPO Standard ST.25 (1998), Appendix 2, Tables 5 and 6.	M, under the following conditions: if "n," "Xaa," or a modified or unusual L-amino acid or modified base was used in a sequence.
Numeric Identifier	Definition	Comments and format	Mandatory (M) or Optional (O)
<222>	Location.....	Specify location within sequence; where appropriate state number of first and last bases/amino acids in feature.	M, under the following conditions: if "n," "Xaa," or a modified or unusual L-amino acid or modified base was used in a sequence.
<223>	Other Information.....	Other relevant information; four lines maximum.....	M, under the following conditions: if "n," "Xaa," or a modified or unusual L-amino acid or modified base was used in a sequence; if ORGANISM is "Artificial Sequence" or "Unknown"; if molecule is combined DNA/RNA.
<300>	Publication Information	Leave blank after <300>	O.
<301>	Authors.....	Preferably max. of ten named authors of publication; specify one name per line; preferable format: Surname, Other Names and/or Initials.	O.
<302>	Title.....	.....	O.
<303>	Journal.....	.....	O.
<304>	Volume	.....	O.
<305>	Issue	.....	O.
<306>	Pages	.....	O.

Subpart H — *Inter Partes* Reexamination of Patents That Issued From an Original Application Filed in the United States on or After November 29, 1999

PRIOR ART CITATIONS

§ 1.902 Processing of prior art citations during an *inter partes* reexamination proceeding.

Citations by the patent owner in accordance with § 1.933 and by an *inter partes* reexamination third party requester under § 1.915 or § 1.948 will be entered in the *inter partes* reexamination file. The entry in the patent file of other citations submitted after the date of an order for reexamination pursuant to § 1.931 by persons other than the patent owner, or the third party requester under either § 1.915 or § 1.948, will be delayed until the *inter partes* reexamination proceeding has been terminated. See § 1.502 for processing of prior art citations in patent and reexamination files during an *ex parte* reexamination proceeding filed under § 1.510.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

REQUIREMENTS FOR *INTER PARTES* REEXAMINATION PROCEEDINGS

§ 1.903 Service of papers on parties in *inter partes* reexamination.

The patent owner and the third party requester will be sent copies of Office actions issued during the *inter partes* reexamination proceeding. After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.904 Notice of *inter partes* reexamination in *Official Gazette*.

A notice of the filing of an *inter partes* reexamination request will be published in the *Official Gazette*. The notice published in the *Official Gazette* under § 1.11(c) will be considered to be constructive notice of the *inter partes* reexamination proceeding and *inter partes* reexamination will proceed.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.905 Submission of papers by the public in *inter partes* reexamination.

Unless specifically provided for, no submissions on behalf of any third parties other than third party requesters as defined in 35 U.S.C. 100(e) will be considered unless such submissions are in accordance with § 1.915 or entered in the patent file prior to the date of the order for reexamination pursuant to § 1.931. Submissions by third parties, other than third party requesters, filed after the date of the order for reexamination pursuant to § 1.931, must meet the requirements of § 1.501 and will be treated in accordance with § 1.902. Submissions which do not meet the requirements of § 1.501 will be returned.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.906 Scope of reexamination in *inter partes* reexamination proceeding.

(a) Claims in an *inter partes* reexamination proceeding will be examined on the basis of patents or printed publications and, with respect to subject matter added or deleted in the reexamination proceeding, on the basis of the requirements of 35 U.S.C. 112.

(b) Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

(c) Issues other than those indicated in paragraphs (a) and (b) of this section will not be resolved in an *inter partes* reexamination proceeding. If such issues are raised by the patent owner or the third party requester during a reexamination proceeding, the existence of such issues will be noted by the examiner in the next Office action, in which case the patent owner may desire to consider the advisability of filing

tion number and filing date, if known. If multiple diskettes are submitted, the diskette labels must indicate their order (*e.g.*, "1 of X").

(b) Computer readable form submissions must meet these format requirements:

(1) Computer Compatibility: IBM PC/XT/AT or Apple Macintosh;

(2) Operating System Compatibility: MS-DOS, MS-Windows, Unix or Macintosh;

(3) Line Terminator: ASCII Carriage Return plus ASCII Line Feed; and

(4) Pagination: Continuous file (no "hard page break" codes permitted).

(c) Computer readable form files submitted may be in any of the following media:

(1) Diskette: 3.50 inch, 1.44 Mb storage; 3.50 inch, 720 Kb storage; 5.25 inch, 1.2 Mb storage; 5.25 inch, 360 Kb storage.

(2) Magnetic tape: 0.5 inch, up to 24000 feet; Density: 1600 or 6250 bits per inch, 9 track; Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(3) 8mm Data Cartridge: Format: Unix tar command; specify blocking factor (not "block size"); Line Terminator: ASCII Carriage Return plus ASCII Line Feed.

(4) Compact disc: Format: ISO 9660 or High Sierra Format.

(5) Magneto Optical Disk: Size/Storage Specifications: 5.25 inch, 640 Mb.

(d) Computer readable forms that are submitted to the Office will not be returned to the applicant.

[Added, 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000)]

§ 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

(a) Any amendment to a paper copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of substitute sheets and include a statement that the substitute sheets include no new matter. Any amendment to a compact disc copy of the "Sequence Listing" (§ 1.821(c)) must be made by the submission of a replacement compact disc (2 copies) in compliance with § 1.52(e). Amendments must also be accompanied by a statement that indicates support for the amendment in the application, as filed, and a statement that the replacement compact disc includes no new matter.

(b) Any amendment to the paper copy of the "Sequence Listing," in accordance with paragraph (a) of this section, must be accompanied by a substitute copy of the computer readable form (§ 1.821(e)) including all previously submitted data with the amendment incorporated therein, accompanied by a statement that the copy in computer readable form is the same as the substitute copy of the "Sequence Listing."

(c) Any appropriate amendments to the "Sequence Listing" in a patent; *e.g.*, by reason of reissue or certificate of correction, must comply with the requirements of paragraphs (a) and (b) of this section.

(d) If, upon receipt, the computer readable form is found to be damaged or unreadable, applicant must provide, within such time as set by the Commissioner, a substitute copy of the data in computer readable form accompanied by a statement that the substitute data is identical to that originally filed.

[Added 55 FR 18230, May 1, 1990, effective Oct. 1, 1990; revised, 63 FR 29620, June 1, 1998, effective July 1, 1998; paras. (a) and (b) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000 (effective date corrected, 65 FR 78958, Dec. 18, 2000)]

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

(c) If an *inter partes* request is filed by an attorney or agent identifying another party on whose behalf the request is being filed, the attorney or agent must have a power of attorney from that party or be acting in a representative capacity pursuant to § 1.34(a).

(d) If the *inter partes* request does not meet all the requirements of subsection 1.915(b), the person identified as requesting *inter partes* reexamination may be so notified and given an opportunity to complete the formal requirements of the request within a specified time. Failure to comply with the notice may result in the *inter partes* reexamination proceeding being vacated.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies the fee requirement of § 1.915(a).

(b) If the request is not granted a filing date, the request will be placed in the patent file as a citation of prior art if it complies with the requirements of § 1.501.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.923 Examiner's determination on the request for *inter partes* reexamination.

Within three months following the filing date of a request for *inter partes* reexamination under § 1.919, the examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art citation. The examiner' s determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the third party requester. If the examiner determines that no substantial new question of patentability is present, the examiner shall refuse the request and shall not order *inter partes* reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.925 Partial refund if request for *inter partes* reexamination is not ordered.

Where *inter partes* reexamination is not ordered, a refund of a portion of the fee for requesting *inter partes* reexamination will be made to the requester in accordance with § 1.26(c).

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.927 Petition to review refusal to order *inter partes* reexamination.

The third party requester may seek review by a petition to the Commissioner under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

INTER PARTES REEXAMINATION OF PATENTS

§ 1.931 Order for *inter partes* reexamination.

(a) If a substantial new question of patentability is found, the determination will include an order for *inter partes* reexamination of the patent for resolution of the question.

(b) If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.923.

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agc ttg tct ttc aaa tgg cct gga ttt tgt ttg ttt gtt tgtttgctc     403
Ser Leu Ser Phe Lys Trp Pro Gly Phe Cys Leu Phe Val
                 10                  15

<210> 2
<211> 18
<212> PRT
<213> Paramecium aurelia

<400> 2

Met Val Ser Met Phe Ser Leu Ser Phe Lys Trp Pro Gly Phe Cys Leu
1               5                   10                  15

Phe Val
```

§ 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination.

(a) The form of responses, written comments, briefs, appendices, and other papers must be in accordance with the requirements of § 1.52.

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

(c) Appellant' s briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination.

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

(b) [Reserved].

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

a reissue application to have such issues considered and resolved.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.907 *Inter partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Commissioner.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.915 Content of request for *inter partes* reexamination.

(a) The request must be accompanied by the fee for requesting *inter partes* reexamination set forth in § 1.20(c)(2).

(b) A request for *inter partes* reexamination must include the following parts:

(1) An identification of the patent by patent number and every claim for which reexamination is requested.

(2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.

(3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

(4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.

(5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.

(6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

§ 1.957 Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

(a) If the third party requester files an untimely or inappropriate comment, notice of appeal or brief in an *inter partes* reexamination, the paper will be refused consideration.

(b) If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the reexamination proceeding will be terminated and the Commissioner will proceed to issue a certificate under § 1.997 in accordance with the last action of the Office.

(c) If claims are found patentable and the patent owner fails to file a timely and appropriate response to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

(d) When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.958 Petition to revive terminated *inter partes* reexamination or claims terminated for lack of patent owner response.

(a) If a response by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A grantable petition to accept an unavoidably delayed response must be filed in compliance with § 1.137(a).

(b) Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES IN *INTER PARTES* REEXAMINATION

§ 1.959 Notice of appeal and cross appeal to Board of Patent Appeals and Interferences in *inter partes* reexamination.

(a)(1) Upon the issuance of a Right of Appeal Notice under § 1.953, the patent owner involved in an *inter partes* reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to the final rejection of any claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(2) Upon the issuance of a Right of Appeal Notice under § 1.953, a third party requester involved in an *inter partes* reexamination proceeding may appeal to the Board of Patent Appeals and Interferences with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent by filing a notice of appeal within the time provided in the Right of Appeal Notice and paying the fee set forth in § 1.17(b).

(b)(1) Within fourteen days of service of a third party requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 1.17(b), a patent owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.

(2) Within fourteen days of service of a patent owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 1.17(b), a third party requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

(c) The notice of appeal or cross appeal in an *inter partes* reexamination proceeding must identify the appealed claim(s) and must be signed by the

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

INFORMATION DISCLOSURE IN *INTER PARTES* REEXAMINATION

§ 1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN *INTER PARTES* REEXAMINATION

§ 1.935 Initial Office action usually accompanies order for *inter partes* reexamination.

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.937 Conduct of *inter partes* reexamination.

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Commissioner makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.941 Amendments by patent owner in *inter partes* reexamination.

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)-(k) and 1.943.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

(b) A party's appeal shall stand dismissed upon failure of that party to file an appellant's brief, accompanied by the requisite fee, within the time allowed.

(c) The appellant's brief shall contain the following items under appropriate headings and in the order indicated below, unless the brief is filed by a party who is not represented by a registered practitioner. The brief may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest.* A statement identifying the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to the appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

(3) *Status of Claims.* A statement of the status of all the claims, pending or canceled. If the appellant is the patent owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a third party requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(4) *Status of Amendments.* A statement of the status of any amendment filed subsequent to the close of prosecution.

(5) *Summary of Invention.* A concise explanation of the invention or subject matter defined in the claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review. No new ground of rejection can be proposed by a third party requester appellant.

(7) *Grouping of Claims.* If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to a group of two or more claims, the Board of Patent Appeals and Interferences shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together; and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of this group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the bases therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate, numbered heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, or for each determination favorable to patentability, including a determination not to make a proposed rejection under 35 U.S.C. 112, first paragraph, which appellant contests, the argument shall specify the errors in the rejection or the determination and how the first paragraph of 35 U.S.C. 112 is complied with, if the appellant is the patent owner, or is not complied with, if the appellant is a third party requester, including, as appropriate, how the specification and drawing(s), if any,

(A) Describe, if the appellant is the patent owner, or fail to describe, if the appellant is a third party requester, the subject matter defined by each of the appealed claims; and

(B) Enable, if the appellant is the patent owner, or fail to enable, if the appellant is a third party requester, any person skilled in the art to make and use the subject matter defined by each of the appealed claims.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 112, second paragraph, which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or the determination, if the appellant is a third party requester, and how the claims do, if the appellant is the patent owner, or do not, if the appellant is a third party requester, particularly point out and distinctly claim the subject matter which the inventor regards as the invention.

(iii) For each rejection under 35 U.S.C. 102 or for each determination favorable to patentability including a determination not to make a proposed rejection under 35 U.S.C. 102 which appellant contests, the argument shall specify the errors in the

§ 1.951 Options after Office action closing prosecution in *inter partes* reexamination.

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.953 Examiner's Right of Appeal Notice in *inter partes* reexamination.

(a) Upon considering the comments of the patent owner and the third party requester subsequent to the Office action closing prosecution in an *inter partes* reexamination, or upon expiration of the time for submitting such comments, the examiner shall issue a Right of Appeal Notice, unless the examiner reopens prosecution and issues another Office action on the merits.

(b) Expedited Right of Appeal Notice: At any time after the patent owner's response to the initial Office action on the merits in an *inter partes* reexamination, the patent owner and all third party requesters may stipulate that the issues are appropriate for a final action, which would include a final rejection and/or a final determination favorable to patentability, and may request the issuance of a Right of Appeal Notice. The request must have the concurrence of the patent owner and all third party requesters present in the proceeding and must identify all the appealable issues and the positions of the patent owner and all third party requesters on those issues. If the examiner determines that no other issues are present or should be raised, a Right of Appeal Notice limited to the identified issues shall be issued. Any appeal by the parties shall be conducted in accordance with §§ 1.959-1.983.

(c) The Right of Appeal Notice shall be a final action, which comprises a final rejection setting forth each ground of rejection and/or final decision favorable to patentability including each determination not to make a proposed rejection, an identification of the status of each claim, and the reasons for decisions favorable to patentability and/or the grounds of rejection for each claim. No amendment can be made in response to the Right of Appeal Notice. The Right of Appeal Notice shall set a one-month time period for either party to appeal. If no notice of appeal is filed, the *inter partes* reexamination proceeding will be terminated, and the Commissioner will proceed to issue a certificate under § 1.997 in accordance with the Right of Appeal Notice.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

INTERVIEWS PROHIBITED IN *INTER PARTES* REEXAMINATION

§ 1.955 Interviews prohibited in *inter partes* reexamination proceedings.

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

EXTENSIONS OF TIME, TERMINATION OF PROCEEDINGS, AND PETITIONS TO REVIVE IN *INTER PARTES* REEXAMINATION

§ 1.956 Patent owner extensions of time in *inter partes* reexamination.

The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

(3) *Status of claims.* A statement accepting or disputing appellant's statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(4) *Status of amendments.* A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(5) *Summary of invention.* A statement accepting or disputing appellant's summary of the invention or subject matter defined in the claims involved in the appeal. If appellant's summary of the invention or subject matter defined in the claims involved in the appeal is disputed, the errors in appellant' s summary must be specified.

(6) *Issues.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a third party requester respondent.

(7) *Argument.* A statement accepting or disputing the contentions of the appellant with each of the issues. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading. The provisions of § 1.965 (c)(8)(iii) and (iv) of these regulations shall apply to any argument raised under 35 U.S.C. 102 or § 103.

(8) *Certificate of Service.* A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the respondent does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief will not be considered.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.969 Examiner's answer in *inter partes* reexamination

(a) The primary examiner in an *inter partes* reexamination appeal may, within such time as directed by the Commissioner, furnish a written statement in answer to the patent owner's and/or third party requester's appellant brief or respondent brief including, as may be necessary, such explanation of the invention claimed and of the references, the grounds of rejection, and the reasons for patentability, including grounds for not adopting a proposed rejection. A copy of the answer shall be supplied to all parties to the reexamination proceeding. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, he or she shall so state.

(b) An examiner's answer may not include a new ground of rejection.

(c) An examiner's answer may not include a new determination not to make a proposed rejection of a claim.

(d) Any new ground of rejection, or any new determination not to make a proposed rejection, must be made in an Office action reopening prosecution.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.971 Rebuttal brief in *inter partes* reexamination.

Within one month of the examiner's answer in an *inter partes* reexamination appeal, any appellant may once file a rebuttal brief in triplicate. The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of any third party requester may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief of a third party requester may not be directed to the respondent brief of any other third party requester. No new ground of

patent owner, the third party requester, or their duly authorized attorney or agent.

(d) An appeal or cross appeal, when taken, must be taken from all the rejections of the claims in a Right of Appeal Notice which the patent owner proposes to contest or from all the determinations favorable to patentability, including any final determination not to make a proposed rejection, in a Right of Appeal Notice which a third party requester proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal is decided.

(e) The times for filing a notice of appeal or cross appeal may not be extended.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.961 Jurisdiction over appeal in *inter partes* reexamination.

Jurisdiction over the *inter partes* reexamination proceeding passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board of Patent Appeals and Interferences. Prior to the entry of a decision on the appeal, the Commissioner may *sua sponte* order the *inter partes* reexamination proceeding remanded to the examiner for action consistent with the Commissioner's order.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.962 Appellant and respondent in *inter partes* reexamination defined.

For the purposes of *inter partes* reexamination, appellant is any party, whether the patent owner or a third party requester, filing a notice of appeal or cross appeal. If more than one party appeals or cross appeals, each appealing or cross appealing party is an appellant with respect to the claims to which his or her appeal or cross appeal is directed. A respondent is any third party requester responding under § 1.967 to the appellant' s brief of the patent owner, or the patent owner responding under § 1.967 to the appellant's brief of any third party requester. No third party requester may be a respondent to the appellant brief of any other third party requester.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.963 Time for filing briefs in *inter partes* reexamination.

(a) An appellant's brief in an *inter partes* reexamination must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the *inter partes* reexamination is entitled to file an appeal or cross appeal but fails to timely do so, the expiration of time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant' s brief may not be extended.

(b) Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief may not be extended.

(c) The examiner will consider both the appellant's and respondent's briefs and may prepare an examiner' s answer under § 1.969.

(d) Any appellant may file a rebuttal brief under § 1.971 within one month of the date of the examiner's answer. The time for filing a rebuttal brief may not be extended.

(e) No further submission will be considered and any such submission will be treated in accordance with § 1.939.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.965 Appellant's brief in *inter partes* reexamination.

(a) Appellant(s) may once, within time limits for filing set forth in § 1.963, file a brief in triplicate and serve the brief on all other parties to the *inter partes* reexamination proceeding in accordance with § 1.903. The brief must be signed by the appellant, or the appellant's duly authorized attorney or agent and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

with respect to the new ground of rejection to avoid termination of the appeal proceeding as to the rejected claim:

(1) The patent owner may submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim, or both.

(2) The patent owner may file a request for rehearing of the decision of the Board of Patent Appeals and Interferences under § 1.979(a).

(c) Where the patent owner has responded under paragraph (b)(1) of this section, any third party requester, within one month of the date of service of the patent owner response, may once file comments on the response. Such written comments must be limited to the issues raised by the decision of the Board of Patent Appeals and Interferences and the patent owner' s response. Any third party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 1.17(b) and (c), respectively, which must accompany the comments or reply.

(d) Following any response by the patent owner under paragraph (b)(1) of this section and any written comments from a third party requester under paragraph (c) of this section, the reexamination proceeding will be remanded to the examiner. The statement of the Board of Patent Appeals and Interferences shall be binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection. The examiner will consider any response under paragraph (b)(1) of this section and any written comments by a third party requester under paragraph (c) of this section and issue a determination that the rejection should be maintained or has been overcome.

(e) Within one month of the examiner's determination pursuant to paragraph (d) of this section, the patent owner or any third party requester may once submit comments in response to the examiner's determination. Within one month of the date of service of comments in response to the examiner's determination, any party may file a reply to the comments. No third party requester reply may address the comments of any other third party requester reply. Any third party requester that had not previously filed an appeal or cross appeal and is seeking under this subsection to file comments or a reply to the comments is subject to the appeal and brief fees under § 1.17(b) and (c), respectively, which must accompany the comments or reply.

(f) After submission of any comments and any reply pursuant to paragraph (e) of this section, or after time has expired, the reexamination proceeding will be returned to the Board of Patent Appeals and Interferences which shall reconsider the matter and issue a new decision. The new decision will incorporate the earlier decision, except for those portions specifically withdrawn.

(g) The time period set forth in paragraph (b) of this section is subject to the extension of time provisions of § 1.956. The time periods set forth in paragraphs (c) and (e) of this section may not be extended.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.979 Action following decision by the Board of Patent Appeals and Interferences or dismissal of appeal in *inter partes* reexamination.

(a) Parties to the appeal may file a request for rehearing of the decision within one month of the date of:

(1) The original decision of the Board of Patent Appeals and Interferences under § 1.977(a),

(2) The original § 1.977(b) decision under the provisions of § 1.977(b)(2),

(3) The expiration of the time for the patent owner to take action under § 1.977(b)(2), or

(4) The new decision of the Board of Patent Appeals and Interferences under § 1.977(f).

(b) Within one month of the date of service of any request for rehearing under paragraph (a) of this section, or any further request for rehearing under paragraph (c) of this section, any party to the appeal may once file comments in opposition to the request for rehearing or the further request for rehearing. The comments in opposition must be limited to the issues raised in the request for rehearing or the further request for rehearing.

(c) If a party to an appeal files a request for rehearing under paragraph (a) of this section, or a further request for rehearing under this section, the Board of Patent Appeals and Interferences will issue a decision on rehearing. This decision is deemed to

rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester, and why the appealed claims are, if the appellant is the patent owner, or are not, if the appellant is a third party requester, patentable under 35 U.S.C. 102, including any specific limitations in the appealed claims which are or are not described in the prior art.

(iv) For each rejection under 35 U.S.C. 103 or for each determination favorable to patentability, including a determination not to make a proposed rejection under 35 U.S.C. 103 which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester. If appropriate, also state the specific limitations in the appealed claims which are or are not described in the prior art and explain how such limitations render the claimed subject matter obvious, if the appellant is a third party requester, or unobvious, if the appellant is the patent owner, over the prior art. If the rejection or determination is based upon a combination of references, the argument shall explain why the references, taken as a whole, do or do not suggest the claimed subject matter. The argument should include, as may be appropriate, an explanation of why features disclosed in one reference may or may not properly be combined with features disclosed in another reference. A general argument that all the limitations are or are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section or for each determination favorable to patentability, including any determination not to make a proposed rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section which appellant contests, the argument shall specify the errors in the rejection, if the appellant is the patent owner, or determination, if the appellant is a third party requester, and the specific limitations in the appealed claims, if appropriate, or other reasons, which cause the rejection or determination to be in error.

(9) *Appendix.* An appendix containing a copy of the claims appealed by the appellant.

(10) *Certificate of Service.* A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a non-extendable period of one month within which to file an amended brief. If the appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.967 Respondent's brief in *inter partes* reexamination

(a) Respondent(s) in an *inter partes* reexamination appeal may once, within the time limit for filing set forth in § 1.963, file a respondent brief in triplicate and serve the brief on all parties in accordance with § 1.903. The brief must be signed by the party, or the party' s duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 1.17(c). The brief must state the authorities and arguments on which respondent will rely. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown. The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed. A third party respondent brief may not address any brief of any other third party.

(b) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(1) *Real Party in Interest.* A statement identifying the real party in interest.

(2) *Related Appeals and Interferences.* A statement identifying by number and filing date all other appeals or interferences known to the respondent, the respondent's legal representative, or assignee (if any) which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences in the pending appeal.

CONCURRENT PROCEEDINGS INVOLVING SAME PATENT IN *INTER PARTES* REEXAMINATION

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Commissioner shall determine whether or not to suspend the *inter partes* reexamination proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.989 Merger of concurrent reexamination proceedings.

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

rejection can be proposed by a third party requester. The time for filing a rebuttal brief may not be extended. The rebuttal brief must include a certification that a copy of the rebuttal brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.973 Oral hearing in *inter partes* reexamination.

(a) An oral hearing in an *inter partes* reexamination appeal should be requested only in those circumstances in which an appellant or a respondent considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as an appeal decided after oral hearing.

(b) If an appellant or a respondent desires an oral hearing, he or she must file a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months after the date of the examiner' s answer. The time for requesting an oral hearing may not be extended.

(c) An oral argument may be presented at oral hearing by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board of Patent Appeals and Interferences.

(d) If an appellant or a respondent has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a hearing date will be set, and notice given to all parties to the reexamination proceeding, as well as the primary examiner. The notice shall set a non-extendable period within which all requests for oral hearing shall be submitted by any other party to the appeal desiring to participate in the oral hearing. A hearing will be held as stated in the notice, and oral argument will be limited to thirty minutes for each appellant and respondent who has requested an oral hearing, and twenty minutes for the primary examiner unless otherwise ordered before the hearing begins. No appellant or respondent will be permitted to participate in an oral hearing unless he or she has requested an oral hearing and submitted the fee set forth in § 1.17(d).

(e) If no request and fee for oral hearing have been timely filed by an appellant or a respondent, the appeal will be assigned for consideration and decision on the written record.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.975 Affidavits or declarations after appeal in *inter partes* reexamination.

Affidavits, declarations, or exhibits submitted after the *inter partes* reexamination has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.977 Decision by the Board of Patent Appeals and Interferences; remand to examiner in *inter partes* reexamination.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse each decision of the examiner on all issues raised on each appealed claim, or remand the reexamination proceeding to the examiner for further consideration. The reversal of the examiner's determination not to make a rejection proposed by the third party requester constitutes a decision adverse to the patentability of the claims which are subject to that proposed rejection which will be set forth in the decision of the Board of Patent Appeals and Interferences as a new ground of rejection under paragraph (b) of this section. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not raised in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement shall constitute a new ground of rejection of the claim. A decision which includes a new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new ground of rejection, the patent owner, within one month from the date of the decision, must exercise one of the following two options

§ 3.1 Definitions.

For purposes of this part, the following definitions shall apply:

Application means a national application for patent, an international application that designates the United States of America, or an application to register a trademark unless otherwise indicated.

Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed.

Document means a document which a party requests to be recorded in the Office pursuant to § 3.11 and which affects some interest in an application, patent, or registration.

Office means the Patent and Trademark Office.

Recorded document means a document which has been recorded in the Office pursuant to § 3.11.

Registration means a trademark registration issued by the Office.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

DOCUMENTS ELIGIBLE FOR RECORDING

§ 3.11 Documents which will be recorded.

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Commissioner.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Commissioner of Patents and Trademarks for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 3.16 Assignability of trademarks prior to filing an allegation of use.

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

incorporate the earlier decision, except for those portions specifically withdrawn. If the decision on rehearing becomes, in effect, a new decision, and the Board of Patent Appeals and Interferences so states, then any party to the appeal may, within one month of the new decision, file a further request for rehearing of the new decision under this subsection.

(d) Any request for rehearing shall state the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.

(e) The patent owner may not appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983 until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board of Patent Appeals and Interferences is final and appealable by the patent owner.

(f) An appeal by a third party requester is considered terminated by the dismissal of the third party requester' s appeal, the failure of the third party requester to timely request rehearing under § 1.979(a) or (c), or a final decision under § 1.979(e). The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the decision of the Board of Patent Appeals and Interferences is final. An appeal by the patent owner is considered terminated by the dismissal of the patent owner' s appeal, the failure of the patent owner to timely request rehearing under § 1.979(a) or (c), or the failure of the patent owner to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit under § 1.983. The date of such termination is the date on which the appeal is dismissed, the date on which the time for rehearing expires, or the date on which the time for the patent owner' s appeal to the U.S. Court of Appeals for the Federal Circuit expires. If an appeal to the U.S. Court of Appeals for the Federal Circuit has been filed, the patent owner' s appeal is considered terminated when the mandate is received by the Office. Upon termination of an appeal, if no other appeal is present, the reexamination proceeding will be terminated and the Commissioner will issue a certificate under § 1.997.

(g) The times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.981 Reopening after decision by the Board of Patent Appeals and Interferences in *inter partes* reexamination.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.977 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

PATENT OWNER APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN *INTER PARTES* REEXAMINATION

§ 1.983 Patent owner appeal to the United States Court of Appeals for the Federal Circuit in *inter partes* reexamination.

(a) The patent owner in a reexamination proceeding who is dissatisfied with the decision of the Board of Patent Appeals and Interferences may, subject to § 1.979(e), appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

(1) In the U. S. Patent and Trademark Office, file a timely written notice of appeal directed to the Commissioner in accordance with §§ 1.302 and 1.304; and

(2) In the Court, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the Court.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 3.28 Requests for recording.

Each document submitted to the Office for recording must include at least one cover sheet as specified in § 3.31 referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes interests in, or transactions involving, both patents and trademarks, separate patent and trademark cover sheets should be submitted. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion. The document and a completed cover sheet should be resubmitted.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

COVER SHEET REQUIREMENTS

§ 3.31 Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

(1) The name of the party conveying the interest;

(2) The name and address of the party receiving the interest;

(3) A description of the interest conveyed or transaction to be recorded;

(4) Identification of the interests involved:

(i) For trademark assignments and trademark name changes: Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) For any other document affecting title to a trademark or patent application, registration or patent: Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

(5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;

(6) The date the document was executed;

(7) An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative (see § 3.61); and

(8) The signature of the party submitting the document.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document is to be recorded on the Governmental Register, and, if applicable, that the document is to be recorded on the Secret Register (see § 3.58); and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (c) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(b) revised, paras. (d)-(e) added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the Commissioner may suspend the *inter partes* reexamination or the interference. The Commissioner will not consider a request to suspend an interference unless a motion under § 1.635 to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.995 Third party requester's participation rights preserved in merged proceeding.

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester' s right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

REEXAMINATION CERTIFICATE IN *INTER PARTES* REEXAMINATION

§ 1.997 Issuance of *inter partes* reexamination certificate.

(a) Upon the conclusion of an *inter partes* reexamination proceeding, the Commissioner will issue a certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

PART 3 — ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

Sec.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

§ 3.58 Governmental registers.

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424. This Departmental Register will not be open to public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in § 1.12.

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424. Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Commissioner of Patents and Trademarks. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.

[Added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

DOMESTIC REPRESENTATIVE

§ 3.61 Domestic representative.

If the assignee of a trademark application or registration is not domiciled in the United States, the assignee must designate, in writing to the Office, a domestic representative. An assignee of a patent application or patent may designate a domestic representative if the assignee is not residing in the United States. The designation shall state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

ACTION TAKEN BY ASSIGNEE

§ 3.71 Prosecution by assignee.

(a) *Patents — conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents — assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents — Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

REQUIREMENTS FOR RECORDING

§ 3.21 Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (*e.g.*, PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.

The document and cover sheet must be legible. Either the original document or a true copy of the original document, may be submitted for recording. Only one side of each page shall be used. The paper used should be flexible, strong white, non-shiny, durable, and preferably no larger than 21.6 x 33.1 cm. (8 1/2 x 14 inches) with a 2.5 cm. (one-inch) margin on all sides.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; heading revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 3.25 Recording requirements for trademark applications and registrations.

(a) Documents affecting title. To record documents affecting title to a trademark application or registration, a legible cover sheet (see § 3.31) and one of the following must be submitted:

(1) The original document;

(2) A copy of the document;

(3) A copy of an extract from the document evidencing the effect on title; or

(4) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) Name changes. Only a legible cover sheet is required (See § 3.31).

(c) All documents. All documents submitted to the Office should be on white and non-shiny paper that is no larger than 8 1/2 x 14 inches (21.6 x 33.1 cm.) with a one-inch (2.5 cm) margin on all sides. Only one side of each page should be used.

[Added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

§ 3.26 English language requirement.

The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets to be recorded should be addressed to the Commissioner, United States Patent and Trademark Office, Box Assignment, Washington, D.C. 20231, unless they are filed together with new applications or with a request under § 3.81.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec.

§ 3.85 Issue of registration to assignee.

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

PART 4 — COMPLAINTS REGARDING INVENTION PROMOTERS

Sec.

§ 4.1 Complaints Regarding Invention Promoters

These regulations govern the Patent and Trademark Office's (Office) responsibilities under the Inventors' Rights Act of 1999, which can be found in the U.S. Code at 35 U.S.C. 297. The Act requires the Office to provide a forum for the publication of complaints concerning invention promoters. The Office will not conduct any independent investigation of the invention promoter. Although the Act provides additional civil remedies for persons injured by invention promoters, those remedies must be pursued by the injured party without the involvement of the Office.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

§ 4.2 Definitions.

(a) *Invention Promoter* means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

(1) Any department or agency of the Federal Government or of a State or local government;

(2) Any nonprofit, charitable, scientific, or educational organization qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;

(3) Any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;

(4) Any party participating in a transaction involving the sale of the stock or assets of a business; or

(5) Any party who directly engages in the business of retail sales of products or the distribution of products.

(b) *Customer* means any individual who enters into a contract with an invention promoter for invention promotion services.

(c) *Contract for Invention Promotion Services* means a contract by which an invention promoter undertakes invention promotion services for a customer.

(d) *Invention Promotion Services* means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

§ 4.3 Submitting Complaints

(a) A person may submit a complaint concerning an invention promoter with the Office. A person submitting a complaint should understand that the complaint may be forwarded to the invention promoter and may become publicly available. The Office will not accept any complaint that requests that it be kept confidential.

(b) A complaint must be clearly marked, or otherwise identified, as a complaint under these rules. The complaint must include:

(1) The name and address of the complainant;

§ 3.34 Correction of cover sheet errors.

(a) An error in a cover sheet recorded pursuant to § 3.11 will be corrected only if:

(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains and

(2) A corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by the originally recorded document or a copy of the originally recorded document and by the recording fee as set forth in § 3.41.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

FEES

§ 3.41 Recording fees.

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)); and

(2) The document and cover sheet are mailed to the Office in compliance with § 3.27(b).

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) amended, 63 FR 48081, Sept. 9, 1998, effective October 9, 1998; para. (a) corrected, 63 FR 52158, Sept. 10, 1998]

DATE AND EFFECT OF RECORDING

§ 3.51 Recording date.

The date of recording of a document is the date the document meeting the requirements for recording set forth in this part is filed in the Office. A document which does not comply with the identification requirements of § 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 3.54 Effect of recording.

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

§ 3.56 Conditional assignments.

Assignments which are made conditional on the performance of certain acts or events, such as the payment of money or other condition subsequent, if recorded in the Office, are regarded as absolute assignments for Office purposes until cancelled with the written consent of all parties or by the decree of a court of competent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

LICENSES FOR FOREIGN EXPORTING AND FILING

GENERAL

§ 5.1 Applications and correspondence involving national security.

(a) All correspondence in connection with this part, including petitions, should be addressed to "Commissioner for Patents (Attention Licensing and Review), Washington, D.C. 20231."

(b) Application as used in this part includes provisional applications filed under 35 U.S.C. 111(b) (§ 1.9(a)(2) of this chapter), nonprovisional applications filed under 35 U.S.C. 111(a) or entering the national stage from an international application after compliance with 35 U.S.C. 371 (§ 1.9(a)(3)), or international applications filed under the Patent Cooperation Treaty prior to entering the national stage of processing (§ 1.9(b)).

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (*e.g.*, "Confidential," "Secret" or "Top Secret") are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application.

(e) An application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

ISSUANCE TO ASSIGNEE

§ 3.81 Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance is submitted with payment of the issue fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(b) *After payment of the issue fee:* An application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee set forth in § 1.17(i) of this chapter is submitted after the date of payment of the issue fee, but prior to issuance of the patent, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request should be accompanied by the assignment and either a direction to record the assignment in the Office pursuant to § 3.28, or a statement under § 3.73(b).

(c) *Partial assignees.*

(1) If one or more assignee(s) together with one or more inventor(s) hold the entire right, title, and interest in the application, the patent may issue in the names of the assignee(s) and the inventor(s).

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

complete data as to such publications or patents and should be accompanied by copies thereof.

(c) The petition must identify any contract between the Government and any of the principals under which the subject matter of the application or any significant part thereof was developed or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

(d) Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within sixty days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued, will be notified of the time and place of hearing.

[24 FR 10381, Dec. 22, 1959; paras. (a) and (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.5 Permit to disclose or modification of secrecy order.

(a) Consent to disclosure, or to the filing of an application abroad, as provided in 35 U.S.C. 182, shall be made by a "permit" or "modification" of the secrecy order.

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclose is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate.

(c) In a petition for modification of a secrecy order to permit filing abroad, all countries in which it is proposed to file must be made known, as well as all attorneys, agents and others to whom the material will be consigned prior to being lodged in the foreign patent office. The petition should include a statement vouching for the loyalty and integrity of the proposed disclosees and where their clearance status in this or the foreign country is known all details should be given.

(d) Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common subject matter in other applications under secrecy order so long as the subject matter is not taken out of context in a manner disclosing material beyond the modification granted in the first application.

(e) Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.

[24 FR 10381, Dec. 22, 1959; paras. (b) and (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.6 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.7 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.8 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

LICENSES FOR FOREIGN EXPORTING AND FILING

§ 5.11 License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.

(a) A license from the Commissioner of Patents and Trademarks under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign patent office or any foreign patent agency or any international agency other than the United States Receiving Office, if the invention was made in the United States and:

(2) The name and address of the invention promoter;

(3) The name of the customer;

(4) The invention promotion services offered or performed by the invention promoter;

(5) The name of the mass media in which the invention promoter advertised providing such services;

(6) An explanation of the relationship between the customer and the invention promoter, and

(7) A signature of the complainant.

(c) The complaint should fairly summarize the action of the invention promoter about which the person complains. Additionally, the complaint should include names and addresses of persons believed to be associated with the invention promoter. Complaints, and any replies, must be addressed to Office of Independent Inventor Programs, U.S. Patent and Trademark Office, Washington, DC 20231.

(d) Complaints that do not provide the information requested in paragraphs (b) and (c) of this section will be returned. If complainant's address is not provided, the complaint will be destroyed.

(e) No originals of documents should be included with the complaint.

(f) A complaint can be withdrawn by the complainant or the named customer at any time prior to its publication.

§ 4.4 Invention Promoter Reply.

(a) If a submission appears to meet the requirements of a complaint, the invention promoter named in the complaint will be notified of the complaint and given 30 days to respond. The invention promoter's response will be made available to the public along with the complaint. If the invention promoter fails to reply within the 30-day time period set by the Office, the complaint will be made available to the public. Replies sent after the complaint is made available to the public will also be published.

(b) A response must be clearly marked, or otherwise identified, as a response by an invention promoter. The response must contain:

(1) The name and address of the invention promoter;

(2) A reference to a complaint forwarded to the invention promoter or a complaint previously published;

(3) The name of the individual signing the response; and

(4) The title or authority of the individual signing the response.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

§ 4.5 Notice by Publication.

If the copy of the complaint that is mailed to the invention promoter is returned undelivered, then the Office will publish a Notice of Complaint Received in the *Official Gazette*, the Federal Register, or on the Office's Internet home page. The invention promoter will be given 30 days from such notice to submit a reply to the complaint. If the Office does not receive a reply from the invention promoter within 30 days, the complaint alone will become publicly available.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

§ 4.6 Attorneys and Agents.

Complaints against registered patent attorneys and agents will not be treated under this section, unless a complaint fairly demonstrates that invention promotion services are involved. Persons having complaints about registered patent attorneys or agents should contact the Office of Enrollment and Discipline at the U.S. Patent and Trademark Office, Box OED, Washington, DC 20231, and the attorney discipline section of the attorney's state licensing bar if an attorney is involved.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

PART 5 — SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

SECRECY

Sec.

[48 FR 2714, Jan. 20, 1983; amended 49 FR 13462, Apr. 4, 1984; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 5.13 Petition for license; no corresponding application.

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.14 Petition for license; corresponding U.S. application.

(a) When there is a corresponding United States application on file, a petition for license under § 5.12(b) must also identify this application by application number, filing date, inventor, and title, but a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application.

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign or international application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

(c) Where the application to be filed or exported abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed in the foreign country or international application which is to be transmitted to a foreign international or national agency for filing in the Receiving Office, must be furnished with the petition. If however, all new matter in the foreign or international application to be filed is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.15 Scope of license.

(a) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign patent application, if such changes to the application do not alter the general nature of the invention in a manner which would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizing the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign or international application provided that the adding of subject matter or taking of any action under paragraphs (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export Con-

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

[43 FR 20470, May 11, 1978; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (e) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]

§ 5.2 Secrecy order.

(a) When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner of Patents and Trademarks.

(b) Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office, but directly to the department or agency which caused the secrecy order to be issued.

(c) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section also falls within the scope of such secrecy order. Any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to paragraph (a) of this section. Any subsequently filed application containing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section must either be hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

[24 FR 10381, Dec. 22, 1959; para. (b) revised, paras. (c) and (d) removed, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 5.3 Prosecution of application under secrecy orders; withholding patent.

Unless specifically ordered otherwise, action on the application by the Office and prosecution by the applicant will proceed during the time an application is under secrecy order to the point indicated in this section:

(a) National applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commissioner will not be set for hearing until the secrecy order is removed.

(b) An interference will not be declared involving national applications under secrecy order. However, if an applicant whose application is under secrecy order seeks to provoke an interference with an issued patent, a notice of that fact will be placed in the file wrapper of the patent. (See § 1.607(d)).

(c) When the national application is found to be in condition for allowance except for the secrecy order the applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under § 1.311 of this chapter) does not require reply by the applicant and places the national application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent and Trademark Office will issue a notice of allowance under § 1.311 of this chapter, or take such other action as may then be warranted.

(d) International applications under secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant. International applications under secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

[43 FR 20470, May 11, 1978; amended 43 FR 28479, June 30, 1978; para. (b) amended 53 FR 23736, June 23, 1988, effective Sept. 12, 1988; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.4 Petition for rescission of secrecy order.

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate.

(b) The petition must recite any and all facts that purport to render the order ineffectual or futile if this is the basis of the petition. When prior publications or patents are alleged the petition must give

is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR parts 120 through 130); the articles designated as arms, ammunitions, and implements of war are enumerated in the U.S. Munitions List (22 CFR part 121). However, if a patent applicant complies with regulations issued by the Commissioner of Patents and Trademarks under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner is required by the provisions of §§ 5.11 and 5.12 (22 CFR part 125).

(b) When a patent application containing subject matter on the Munitions List (22 CFR part 121) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR part 125).

[35 FR 6430., Apr. 22, 1970; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.19 Export of technical data.

(a) Under regulations (15 CFR 770.10(j)) established by the Department of Commerce, a license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office.

(b) An export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 779A.3(e)).

[45 FR 72654, Nov. 3, 1980; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.20 Export of technical data relating to sensitive nuclear technology.

Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office and eligible for foreign filing under 35 U.S.C. 184, is considered to be information available to the public in published form and a generally authorized activity for the purposes of the Department of Energy regulations.

[49 FR 13463, Apr. 4, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.25 Petition for retroactive license.

(a) A petition for retroactive license under 35 U.S.C. 184 shall be presented in accordance with § 5.13 or § 5.14(a), and shall include:

(1) A listing of each of the foreign countries in which the unlicensed patent application material was filed,

(2) The dates on which the material was filed in each country,

(3) A verified statement (oath or declaration) containing:

(i) An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,

(ii) A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and

(iii) An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and

(4) The required fee (§ 1.17(h)).

The above explanation must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed, or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner of Patents and Trademarks referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR part 779 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR part 810 (Foreign Atomic Energy Programs of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner of Patents and Trademarks referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 768-799 (Export Administration Regulations of the Department of Commerce) and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon.The term "exported" means export as it is defined in 22 CFR part 120, 15 CFR part 779 and activities covered by 10 CFR part 810.

(d) If a secrecy order has been issued under § 5.2, an application cannot be exported to, or filed in, a foreign country (including an international agency in a foreign country), except in accordance with § 5.5.

(e) No license pursuant to paragraph (a) of this section is required:

(1) If the invention was not made in the United States, or

(2) If the corresponding United States application is not subject to a secrecy order under § 5.2, and was filed at least six months prior to the date on which the application is filed in a foreign country, or

(3) For subsequent modifications, amendments and supplements containing additional subject matter to, or divisions of, a foreign patent application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign patent application;

(ii) The corresponding United States application was not required to be made available for inspection under 35 U.S.C. 181; and

(iii) Such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181.

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the Patent and Trademark Office. An authorization to file a foreign patent application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

[49 FR 13461, Apr. 4, 1984; paras. (a) and (e), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; paras. (b), (c), and (e)(3) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.12 Petition for license.

(a) Filing of an application for patent for inventions made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

(b) A petition for license must include the fee set forth in § 1.17(h) of this chapter, the petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

Index I – RULES RELATING TO PATENTS

A

trol Act, as amended, and 22 CFR parts 121 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Unclassified Activities in Foreign Atomic Energy Programs, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign or international application, provided subject matter additional to that covered by the license is not involved.

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(h)), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

(d) In those cases in which no license is required to file the foreign application or transmit the international application, no license is required to file papers in connection with the prosecution of the foreign or international application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign or international application which changes the general nature of the subject matter disclosed at the time of filing in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 or which involves the disclosure of subject matter listed in paragraphs (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign or international application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency which involves the disclosure of additional subject matter must be licensed in the same manner as a foreign or international application.

(f) Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided:

(1) Subject matter which changes the general nature of the subject matter disclosed at the time of filing or which involves subject matter listed in paragraphs (a)(3) (i) or (ii) of this section is not introduced and,

(2) In the case where at least one of the licenses was obtained under § 5.12(b), additional subject matter is not introduced.

(g) A license does not apply to acts done before the license was granted. See § 5.25 for petitions for retroactive licenses.

[49 FR 13462, Apr. 4, 1984; paras. (a) - (c), (e) and (f), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; paras. (a)-(c) and (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.16 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.17 [Reserved]

[49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.18 Arms, ammunition, and implements of war.

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally

B

(b) If a petition for a retroactive license is denied, a time period of not less than thirty days shall be set, during which the petition may be renewed. Failure to renew the petition within the set time period will result in a final denial of the petition. A final denial of a petition stands unless a petition is filed under § 1.181 within two months of the date of the denial. If the petition for a retroactive license is denied with respect to the invention of a pending application and no petition under § 1.181 has been filed, a final rejection of the application under 35 U.S.C. 185 will be made.

[49 FR 13463, Apr. 4, 1984; para. (a), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; para. (c) removed, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

GENERAL

§ 5.31 [Reserved]

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.32 [Reserved]

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

§ 5.33 [Reserved]

[49 FR 13463, Apr. 4, 1984; amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

PART 7 — [RESERVED]

[Part 7 removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

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