

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.

The failure to perfect a claim to foreign priority benefit prior to issuance of the patent may be cured by filing a reissue application. *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968).

However, under certain conditions, this failure may also be cured by filing a certificate of correction request under 35 U.S.C. 255 and 37 CFR 1.323. For example, in the case of *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975), the Commissioner granted a request to issue a certificate of correction in order to perfect a claim to foreign priority benefits. In that case, a claim to foreign priority benefits had not been filed in the application prior to issuance of the patent. However, the application was a continuation of an earlier application in which the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied. Accordingly, the Commissioner held that the "applicant's perfection of a priority claim under 35 U.S.C. 119 in the parent application will satisfy the statute with respect to their continuation application."

Although *In re Van Esdonk* involved the patent of a continuation application filed under former 37 CFR 1.60, it is proper to apply the holding of that case in similar factual circumstances to any patented application having benefits under 35 U.S.C. 120. This is primarily because a claim to foreign priority benefits in a continuing application, where the claim has been perfected in the parent application, constitutes in essence a mere affirmation of the applicant's previously expressed desire to receive benefits under 35 U.S.C. 119(a)-(d) or (f) for subject matter common to the foreign, parent, and continuing applications.

In summary, a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patented continuing application if the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the parent application prior to issuance of the patent and the requirements of 37 CFR 1.55(a) are met. Furthermore, if the continuing application (other than a design application), which issued as a patent, was filed on or after November 29, 2000 or was filed

prior to November 29, 2000 and was voluntarily published, in addition to the filing of a certificate of correction request, patentee must also file a petition for an unintentionally delayed foreign priority claim under 37 CFR 1.55(c).

However, a claim to foreign priority benefits cannot be perfected via a certificate of correction if the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance and the requirements of 37 CFR 1.55(a) are not met. In this latter circumstance, the claim to foreign priority benefits can be perfected only by way of a reissue application in accordance with the rationale set forth in *Brenner v. State of Israel*, 158 USPQ 584.

A claim for priority under 35 U.S.C. 119(a)-(d) or (f) for the benefit of a prior foreign application may be added (or corrected) in an issued patent by reissue or certificate of correction (assuming the conditions for reissue or certificate of correction are otherwise met) provided the original application, which issued as the patent, was filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, or was filed prior to November 29, 2000 and was voluntarily published. In addition to the filing of a reissue application or a request for a certificate of correction, a petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or (f) along with the surcharge as set forth in 37 CFR 1.17(t) and a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional must be submitted. See 37 CFR 1.55(c).

202 Cross-Noting

202.01 In Specification

37 CFR 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.

Where an applicant in a nonprovisional application filed under 37 CFR 1.53(b) prior to November 29, 2000 seeks to claim the benefit under 35 U.S.C. 120 or 121 of a continued prosecution application (CPA) filed under 37 CFR 1.53(d), 37 CFR 1.78(a)(2) requires a reference to the CPA by application number in the first sentence of the specification of such application. For a nonprovisional application filed on or after November 29, 2000, unless the reference required by 37 CFR 1.78(a)(2) is included in an appli-

cation data sheet (37 CFR 1.76), the specification must contain or be amended to contain such reference in the first sentence of the specification. 37 CFR 1.78(a)(2) also provides that “[t]he 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.” Thus, where a referenced CPA is in a chain of CPAs, this reference will constitute a reference under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every CPA in the chain as well as the noncontinued prosecution application originally assigned such application number. Applicants are not permitted to delete such a claim for benefit under 35 U.S.C. 120 as to certain applications assigned that application number (e.g., for patent term purposes).

If a nonprovisional application that is filed on or after November 29, 2000 claims benefit to an international application, the first sentence of the specification must be amended to indicate whether the international application was published under PCT Article 21(2) in English. See 37 CFR 1.78(a)(2).

There is seldom a reason for one application to refer to another application with no common applicant where the applications are not assigned to a common assignee. Such reference ordinarily should not be permitted.

See also 37 CFR 1.78 and MPEP § 201.11.

202.02 Notation on File Wrapper Regarding Prior U.S. Applications, Including Provisional Applications

The heading of a printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, substitute, and reissue applications, as well as any provisional application from which priority is claimed. Therefore, the identifying data of all parent or prior applications, when given in the specification must be inserted by the examiner in black ink on the file wrapper (for applications with the 09/ series, on the PALM bib-data sheet) in the case of a DIVISION, a CONTINUATION, a CONTINUATION-IN-PART and, whether given in the specification or not, in the case of a SUBSTITUTE application. Similarly, the application number of any provisional application from which priority is claimed

should be printed on the file wrapper or on the PALM bib-data sheet for 09/ series applications.

The heading of a printed patent issuing on a continued prosecution application (CPA) filed under 37 CFR 1.53(d) will identify the application number and filing date of the most recent noncontinued prosecution application (but not the filing date of the CPA) as well as all parent application data from which priority was claimed in the most recent noncontinued prosecution application.

Where parent or prior application data, including provisional application data, is preprinted on the file wrapper or on the PALM bib-data sheet for 09/ series applications, the examiner should check that data for accuracy, including whether the application is, in fact, copending with the parent nonprovisional application or applications of which priority is claimed. If applicant claims benefit under 35 U.S.C.119(e) to a prior provisional application, and states that the provisional application claims priority to earlier domestic or foreign application(s), the earlier application(s) should not be reflected on the file wrapper or PALM bib-data sheet because a provisional application is not entitled to the right of priority of any other application. See 35 U.S.C. 111(b)(7). Where the data is correct, the examiner should initial the file wrapper or the PALM bib-data sheet for 09/ series applications in the provided space. Should there be error in the preprinted parent application data, the application should be forwarded to the Office of Initial Patent Examination (OIPE) Customer Corrections for correction or entry of the data in the PALM data base, accompanied by a completed OIPE Data Base Routing Slip. For 09/ series applications, it will not be necessary to forward the application to OIPE for correction of the parent application data in PALM. The correction or entry of the data in the PALM data base can be made by technical support staff of the Technology Center. Upon entry of the data, a new PALM bib-data sheet should be printed and placed in the file wrapper. Only these terms should be used to specify the relationship between applications because of clarity and ease of printing. The status of the parent application, but not a provisional application, should also be indicated if it has been patented, abandoned, or published under either the Defensive Publication Program or the Trial Voluntary Protest Program. Note MPEP § 1302.04(f). The "None" boxes must be marked when no parent or

prior application information is present on the file wrappers containing such boxes. This should be done no later than the first action.

The inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

See MPEP § 306 for work done by the Assignment Division pertaining to these particular types of applications.

In the situation in which there has been no reference to a parent application because the benefit of its filing date is not desired, no notation as to the parent application is made on the face of the file wrapper or on the PALM bib-data sheet for 09/ series applications.

202.03 Notation on File Wrapper When Priority Is Claimed for Foreign Application

In accordance with MPEP § 201.14(c), the examiner will fill in the spaces concerning foreign applications on the face of the older file wrappers.

The information to be written on the face of the file wrapper consists of the country, application date (filing date), and if available, the application and patent numbers. In some instances, the particular nature of the foreign application such as "utility model" (Germany (Gebrauchsmuster) and Japan) must be written in parentheses before the application number. For example: Application Number (utility model) B62854.

At the present time the computer printed file wrapper labels (for 08/ or earlier series applications) or PALM bib-data sheet (for 09/ series applications) include the prior foreign application information. The examiner should check this information for accuracy. Should there be error, the examiner should make the appropriate corrections directly on the file wrapper or on the PALM bib-data sheet in black ink. The examiner should initial the file wrapper or the PALM bib-data sheet in the "VERIFIED" space provided when the information is correct or has been amended to be correct. However, the examiner must still indicate on the Office action and on the file wrapper or on the PALM bib-data sheet whether the conditions of 35 U.S.C. 119(a)-(d) or (f) have been met.

If the filing dates of several foreign applications are claimed (see MPEP § 201.15, last paragraph) and satisfactory papers have been received for each, information respecting each of the foreign applications is to be entered on the face of the file wrapper or on the PALM bib-data sheet.

The front page of the patent when it is issued, and the listing in the *Official Gazette*, will refer to the claim of priority, giving the country, the filing date, and the number of the foreign application in those applications in which the face of the file or the PALM bib-data sheet has been endorsed.

202.04 In Oath or Declaration

As will be noted by reference to MPEP § 201.14, 37 CFR 1.63 requires that the oath or declaration include certain information concerning applications filed in any foreign country.

202.05 In Case of Reissues

37 CFR 1.179 requires that a notice be placed in the file of an original patent for which an application for reissue has been filed. See MPEP § 1431.

203 Status of Applications

203.01 New

A "new" application is a nonprovisional one that has not yet received an action by the examiner. An amendment filed prior to the first Office Action does not alter the status of a "new" application.

203.02 Rejected

A nonprovisional application which, during its prosecution in the examining group and before allowance, contains an unanswered examiner's action is designated as a "rejected" application. Its status as a "rejected" application continues as such until acted upon by the applicant in reply to the examiner's action (within the allotted reply period), or until it becomes abandoned.

203.03 Amended

An "amended" or "old" nonprovisional application is one that having been acted on by the examiner, has in turn been acted on by the applicant in reply to the examiner's action. The applicant's reply may be con-

fined to an election, a traverse of the action taken by the examiner or may include an amendment of the application.

203.04 Allowed or in Issue

An "allowed" nonprovisional application or an application "in issue" is one which, having been examined, is passed to issue as a patent, subject to payment of the issue fee. Its status as an "allowed" application continues from the date of the notice of allowance until it is withdrawn from issue or until it issues as a patent or becomes abandoned, as provided in 37 CFR 1.316.

The files of allowed applications are kept in the Publishing Division.

203.05 Abandoned

An abandoned application is, *inter alia*, one which is removed from the Office docket of pending applications:

(A) through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or by the attorney or agent of record;

(B) through failure of applicant to take appropriate action at some stage in the prosecution of a nonprovisional application;

(C) for failure to pay the issue fee (MPEP § 203.07, § 711 to § 711.05); or

(D) in the case of a provisional application, no later than 12 months after the filing date of the provisional application (see MPEP § 711.03(c) and 35 U.S.C. 111 (b) (5)).

203.06 Incomplete

An application lacking some of the essential parts and not accepted for filing is termed an incomplete application. (MPEP § 506, § 506.01 and § 601.01(d)-(g)).

203.07 Abandonment for Failure to Pay Issue Fee

An allowed application in which the Issue Fee is not paid within 3 months after the Notice of Allowance in accordance with 35 U.S.C. 151 is abandoned for that reason (37 CFR 1.316). The issue fee may, however, be accepted by the Commissioner if on

petition it is shown that the delay in payment was unavoidable and payment of the fee for delayed payment of the issue fee under 37 CFR 1.17(l), in which case the patent will issue as though no abandonment had occurred (MPEP § 711.03(c)). (37 CFR 1.137(a)). The issue fee may also be accepted if on petition it is shown that the delay in payment was unintentional and upon payment of the fee for delayed payment of the issue fee under 37 CFR 1.17(m) (37 CFR 1.137(b)).

203.08 Status Inquiries

NEW APPLICATION

Current examining procedures now provide for the routine mailing from the Technology Centers (TCs) of Form PTOL-37 in every case of allowance of an application. Thus, the mailing of a form PTOL-37 in addition to a formal Notice of Allowance (PTOL-85) in all allowed applications would seem to obviate the need for status inquiries even as a precautionary measure where the applicant may believe his or her new application may have been passed to issue on the first examination. However, as an exception, a status inquiry would be appropriate where a Notice of Allowance is not received within three months from receipt of form PTOL-37.

Current examining procedures also aim to minimize the spread in dates among the various examiner dockets of each art unit and TC with respect to actions on new applications. Accordingly, the dates of the "oldest new applications" appearing in the *Official Gazette* are fairly reliable guides as to the expected time frames of when the examiners reach the applications or action.

Therefore, it should be rarely necessary to query the status of a new application.

AMENDED APPLICATIONS

Amended applications are expected to be taken up by the examiner and an action completed within two months of the date the examiner receives the application. Accordingly, a status inquiry is not in order after reply by the attorney until 5 or 6 months have elapsed with no response from the Office. A postcard receipt for replies to Office actions, adequately and specifically identifying the papers filed, will be considered *prima facie* proof of receipt of such papers. Where such proof indicates the timely filing of a reply, the

submission of a copy of the postcard with a copy of the reply will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely reply to a final action will obviate the need for a petition to revive only if the reply was in compliance with 37 CFR 1.113.

IN GENERAL

Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Office of Initial Patent Examination, to the TCs for direct action. Such letters will be stamped "Status Letters."

If the correspondent is not entitled to the information, in view of 37 CFR 1.14, he or she should be so informed. For Congressional and other official inquiries, see MPEP § 203.08(a).

Telephone inquiries regarding the status of applications, by persons entitled to the information, should be directed to the TC technical support personnel and not to the examiners. In as much as the official records and applications are located in the technical support section of the TCs, the technical support personnel can readily provide status information without contacting the examiners.

See also MPEP § 102 regarding status information.

Processing Status Letters by the TCs

(A) All status letters sent to a TC will be delivered to a designated location (e.g., Customer Service Office) within the TC for action. Status requests with respect to PCT applications are to be processed by the PCT Legal Division and should be forwarded to that office for reply. Status information regarding an application identified in a published patent document should be forwarded to the File Information Unit for reply. See MPEP § 102.

(B) A designated representative of the TC will review the status letter to determine the nature of the request and whether the requester is entitled to receive the requested information. PALM Intranet should be used to determine whether the requester is entitled to the information. If after reviewing the information in PALM it is not clear whether the requester is entitled to receive the information requested, the TC representative should review the application file to resolve the issue.

(C) The TC representative will determine the appropriate reply to the status letter by

- (1) using PALM Intranet to determine the status of the application,
- (2) reviewing the new application dates within the TC,
- (3) reviewing any tracking system for the particular item or action at issue,
- (4) discussing the matter with the supervisory patent examiner or the examiner in charge of the application, or
- (5) when necessary, reviewing the application file.

The TC representative should discuss the matter with an appropriate resource person in the TC if it is not clear what the reply should be.

(D) The TC representative may reply to a status letter, other than an inquiry directed to an abandoned application, by placing a telephone call to the attorney or agent of record. If the status letter requests a date of expected action, the reply should make clear that the date provided is only an "expected" date of when the examiner will take action on the application. If the requester requests that the Office provide a written reply to the status letter, the reply may be faxed (preferable) or mailed (only if requested) to the correspondence address.

(E) The TC representative will note the reply to the status inquiry on the status letter with the initials of the TC representative and the date that the reply was completed.

(F) All TCs will employ the Status Letter Database to track the progress of the status letters. The TC will retain a record of the reply to the status letter. The record includes the entry of the information concern-

ing the status letter and the reply into the Status Letter Database.

(G) After the information has been entered into the Status Letter Database, the status letter along with the reply must be matched with the application file (including abandoned applications), entered as a formal paper and assigned a paper number.

203.08(a) Congressional and Other Official Inquiries

Correspondence and inquiries from the White House, Members of Congress, embassies, and heads of Executive departments and agencies normally are cleared through the Office of the Administrator for Legislative and International Affairs.

When persons from the designated official sources request services from the Office, or information regarding the business of the Office, they should, under long-standing instructions, be referred, at least initially, to the Congressional liaison in the Office of Legislative and International Affairs.

This procedure is used so that there will be uniformity in the handling of contacts from the indicated sources, and also so that compliance with directives of the Department of Commerce is attained.

Inquiries referred to in this section, particularly correspondence from Congress or the White House, should immediately be transmitted to the Administrator for Legislative and International Affairs by messenger, and the Congressional liaison in the Office of Legislative and International Affairs should be notified by phone that such correspondence has been received.



Chapter 300 Ownership and Assignment

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301 Ownership/Assignability of Patents and Applications

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 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.

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.

37 CFR 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.

OWNERSHIP

Ownership of a patent gives the patent owner the right to exclude others from making, using, offering

for sale, selling, or importing into the United States the invention claimed in the patent. 35 U.S.C. 154(a)(1). Ownership of the patent does not furnish the owner with the **right** to make, use, offer for sale, sell, or import the claimed invention because there may be other legal considerations precluding same (e.g., existence of another patent owner with a dominant patent, failure to obtain FDA approval of the patented invention, an injunction by a court against making the product of the invention, or a national security related issue).

The ownership of the patent (or the application for the patent) initially vests in the named inventors of the invention of the patent. See *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248, 26 USPQ2d 1572, 1582 (Fed. Cir. 1993). The patent (or patent application) is then assignable by an instrument in writing, and the assignment of the patent, or patent application, transfers to the assignee(s) an alienable (transferable) ownership interest in the patent or application. 35 U.S.C. 261.

ASSIGNMENT

“Assignment,” in general, is the act of transferring to another the ownership of one’s property, i.e., the interest and rights to the property. In 37 CFR 3.1, assignment of patent rights is defined as “a transfer by a party of all or part of its right, title and interest in a patent or patent application....” An assignment of a patent, or patent application, is the transfer to another of a party’s **entire** ownership interest or a percentage of that party’s ownership interest in the patent or application. In order for an assignment to take place, the transfer to another must include the entirety of the bundle of rights that is associated with the ownership interest, i.e., all of the bundle of rights that are inherent in the right, title and interest in the patent or patent application.

LICENSING

As compared to assignment of patent rights, the licensing of a patent transfers a bundle of rights which is less than the entire ownership interest, e.g., rights that may be limited as to time, geographical area, or field of use. A patent license is, in effect, a contractual agreement that the patent owner will not sue the licensee for patent infringement if the licensee makes, uses, offers for sale, sells, or imports the claimed

invention, as long as the licensee fulfills its obligations and operates within the bounds delineated by the license agreement.

An exclusive license may be granted by the patent owner to a licensee. The exclusive license prevents the patent owner (or any other party to whom the patent owner might wish to sell a license) from competing with the exclusive licensee, as to the geographic region, the length of time, and/or the field of use, set forth in the license agreement.

A license is not an assignment of the patent. Even if the license is an exclusive license, it is **not** an assignment of patent rights in the patent or application.

INDIVIDUAL AND JOINT OWNERSHIP

Individual ownership - An individual entity may own the entire right, title and interest of the patent property. This occurs where there is only one inventor, and the inventor has not assigned the patent property. Alternatively, it occurs where all parties having ownership interest (all inventors and assignees) assign the patent property to one party.

Joint ownership - Multiple parties may **together** own the entire right, title and interest of the patent property. This occurs when any of the following cases exist:

- (A) Multiple partial assignees of the patent property;
- (B) Multiple inventors who have not assigned their right, title and interest; or
- (C) A combination of partial assignee(s), and inventor(s) who have not assigned their right, title and interest.

Each individual inventor may only assign the interest he or she holds; thus, assignment by one joint inventor renders the assignee a partial assignee. A partial assignee likewise may only assign the interest it holds; thus, assignment by a partial assignee renders a subsequent assignee a partial assignee. All parties having any portion of the ownership in the patent property must act **together** as a composite entity in patent matters before the Office.

MAKING THE ASSIGNMENT OF RECORD

An assignment can be made of record in the United States Patent and Trademark Office (Office) in two

different ways, for two different purposes. The differences are important to note:

(A) An assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See 37 CFR 3.54 and MPEP § 317.03; and

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step is necessary to permit the assignee to "take action" in the application, patent, or other patent proceeding under the conditions set forth in 37 CFR 3.73 and MPEP § 324. Recordation of an assignment in the assignment records of the Office does **not**, by itself, permit the assignee to take action in the application, patent, or other patent proceeding.

301.01 Accessibility of Assignment Records

37 CFR 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.

Assignment documents relating to patents, published patent applications, registrations of trademarks, and applications for registration of trademarks are open to public inspection.

The Office will not open only certain parts of an assignment document to public inspection. If such a document contains two or more items, any one of which, if alone, would be open to such inspection, then the entire document will be open. Thus, if a document covers either a trademark or a patent in addition to one or more patent applications, it will be available to the public *ab initio*; and if it covers a number of patent applications, it will be so available as soon as any one of them is published or patented. Documents relating only to one or more pending applications for patent which have not been published under 35 U.S.C. 122(b) will not be open to public inspection.

Copies of assignment records relating to pending or abandoned patent applications not published under 35 U.S.C. 122(b) and information related thereto are obtainable upon a showing of written authority from the applicant or applicant's assignee or from the attorney or agent of either, or upon a showing that the person seeking such information is a *bona fide* prospective or actual purchaser, mortgagee, or licensee of such application.

If the application on which a patent was granted is a division or continuation of an earlier application, the assignment records of that earlier application will be open to public inspection; similar situations involving continuation-in-part applications will be considered

on their individual merits upon petition to the Office of Petitions.

Assignment records relating to reissue applications are open to public inspection.

Requests for abstracts of title for assignments of patents recorded after May 1, 1957, are provided by the Certification Division upon request and payment of fee required in 37 CFR 1.19. Requests for copies of pre-1957 records for patents should be directed to the National Archives and Records Administration (NARA). Since these records are maintained by NARA, it is more expeditious to request copies directly from NARA, rather than from the Office, which would then have to route the requests to NARA. Payment of the fees required by NARA should accompany all requests for copies.

All assignment records from 1837 to April 30, 1957 for patents are now maintained and are open for public inspection in the National Archives Research Room located at the Washington National Records Center Building, 4205 Suitland Road, Suitland, Maryland 20746. Assignment documents recorded before 1837 are maintained at the National Archives and Records Administration, 841 South Pickett Street, Alexandria, Virginia 22304.

302 Recording of Assignment Documents

37 CFR 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.

37 CFR 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.

Effective September 4, 1992, Part 3 has been added to 37 CFR to set forth Office rules on recording assignments and other documents and the rights of an assignee.

302.01 Assignment Document Must Be Original or True Copy for Recording

37 CFR 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.

The United States Patent and Trademark Office will accept and record only an original, or a true copy of an original assignment or other document. See MPEP § 317.

Certification shall be made by the person submitting a copy of an original document that the document submitted is a true copy of the original. The certification is not required to be in oath or declaration form.

302.02 Translation of Assignment Document

37 CFR 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.

The assignment document, if not in the English language, will not be recorded unless accompanied by an English translation signed by the translator.

302.03 Identifying Patent or Application

37 CFR 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.

The patent or patent application to which an assignment relates must be identified by patent number or application number unless the assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed. Then, the application must be identified by the date of execution, the name(s) of the inventors, and the title of the invention. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name(s) of the inventors and the title of the invention.

The Office makes every effort to provide applicants with the application numbers for newly filed patent applications as soon as possible. It is suggested, however, that an assignment be written to allow entry of the identifying number after the execution of the assignment. An example of acceptable wording is:

"I hereby authorize and request my attorney, (Insert name), of (Insert address), to insert here in parentheses (Application number _____, filed _____) the filing date and application number of said application when known."

302.04 Foreign Assignee May Designate Domestic Representative

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.

37 CFR 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.

An assignee not domiciled in the United States may, by written document signed by such assignee, designate a domestic representative. The designation of domestic representative should always be a paper separate from any assignment document, in order that the paper of designation can be retained in the appropriate application or patent file. Also, there should be a separate paper of designation of representative for each patent or application, so that a designation paper can be placed in each file. The designation of a domestic representative should be directed to the Office of Public Records for processing.

302.05 Address of Assignee

The address of the assignee may be recited in the assignment document and must be given in the required cover sheet. See MPEP § 302.07.

302.06 Fee for Recording

37 CFR 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).

The recording fee set forth in 37 CFR 1.21(h) is charged for each patent application and patent identified in the required cover sheet except as provided in 37 CFR 3.41(b).

302.07 Assignment Document Must Be Accompanied by a Cover Sheet

37 CFR 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.

37 CFR 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.

Each assignment document submitted to the Office for recording must be accompanied by a cover sheet as required by 37 CFR 3.28. The cover sheet for patents or patent applications must contain:

- (A) The name of the party conveying the interest;
- (B) The name and address of the party receiving the interest;
- (C) A description of the interest conveyed or transaction to be recorded;
- (D) Each patent application number or patent number against which the document is to be recorded, or an indication that the document is filed together with a patent application;
- (E) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;
- (F) The date the document was executed; and
- (G) The signature of the party submitting the document.

Each patent cover sheet should contain the number of patent applications or patents identified in the cover sheet and the total fee.

Examples of the type of descriptions of the interest conveyed or transaction to be recorded that can be identified are:

- (A) assignment;
- (B) security agreement;
- (C) merger;
- (D) change of name;
- (E) license;
- (F) foreclosure;
- (G) lien; and
- (H) contract.

Cover sheets required by 37 CFR 3.28 seeking to record a governmental interest must also (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 37 CFR 3.58); and (2) indicate, if applicable, that the document to be recorded is not a document affecting title.

A patent cover sheet may not refer to trademark applications or registrations.

Form PTO-1595, Recordation Form Cover Sheet, may be used as the cover sheet for recording documents relating to patent(s) and/or patent application(s) in the Office.

Form PTO-1595 (Rev. 03/01) OMB No. 0651-0027 (exp. 5/31/2002) Tab settings	RECORDATION FORM COVER SHEET PATENTS ONLY	U.S. DEPARTMENT OF COMMERCE U.S. Patent and Trademark Office
To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.		
1. Name of conveying party(ies): Additional name(s) of conveying party(ies) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No	2. Name and address of receiving party(ies) Name: _____ Internal Address: _____ _____ Street Address: _____ _____ City: _____ State: _____ Zip: _____ Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input type="checkbox"/> No	
3. Nature of conveyance: <input type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other _____ Execution Date: _____		
4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date of the application is: _____ A. Patent Application No.(s) B. Patent No.(s) Additional numbers attached? <input type="checkbox"/> Yes <input type="checkbox"/> No		
5. Name and address of party to whom correspondence concerning document should be mailed: Name: _____ Internal Address: _____ _____ Street Address: _____ _____ City: _____ State: _____ Zip: _____	6. Total number of applications and patents involved: <input type="checkbox"/> 7. Total fee (37 CFR 3.41).....\$ _____ <input type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to be charged to deposit account 8. Deposit account number: _____ (Attach duplicate copy of this page if paying by deposit account)	
DO NOT USE THIS SPACE		
9. Statement and signature. <i>To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.</i> _____ Name of Person Signing Signature Date		
Total number of pages including cover sheet, attachments, and documents: <input type="checkbox"/>		

Mail documents to be recorded with required cover sheet information to:
 Commissioner of Patents & Trademarks, Box Assignments
 Washington, D.C. 20231

Guidelines for Completing Patents Cover Sheets

Cover Sheet information must be submitted with each document to be recorded. If the document to be recorded concerns both patents and trademarks separate patent and trademark cover sheets, including any attached pages for continuing information, must accompany the document. All pages of the cover sheet should be numbered consecutively, for example, if both a patent and trademark cover sheet is used, and information is continued on one additional page for both patents and trademarks, the pages of the cover sheet would be numbered from 1 to 4.

Item 1. Name of Conveying Party(ies).

Enter the full name of the party(ies) conveying the interest. If there is insufficient space, enter a check mark in the "Yes" box to indicate that additional information is attached. The name of the additional conveying party(ies) should be placed on an attached page clearly identified as a continuation of the information Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page.

Item 2. Name and Address of Receiving Party(ies).

Enter the name and full address of the first party receiving the interest. If there is more than one party receiving the interest, enter a check mark in the "Yes" box to indicate that additional information is attached. Enter a check mark in the "No" box, if no information is contained on an attached page.

Item 3. Nature of Conveyance.

Place a check mark in the appropriate box describing the nature of the conveying document. If the "Other" box is checked, specify the nature of the conveyance. Enter the execution date of the document. It is preferable to use the name of the month, or an abbreviation of that name, in order that confusion over dates is minimized.

Item 4. Application Number(s) or Patent Number(s).

Indicate the application number(s), and/or patent number(s) against which the document is to be recorded. National application numbers must include both the series code and a six-digit number; and international application numbers must be complete, e.g., 07/123,456 for national application numbers, and PCTUS91/12345 for international application numbers. Enter a check mark in the appropriate box: "Yes" or "No" if additional numbers appear on attached pages. Be sure to identify numbers included on attached pages as the continuation of Item 4.

Item 5. Name and Address of Party to whom correspondence concerning the document should be mailed.

Enter the name and full address of the party to whom correspondence is to be mailed.

Item 6. Total Applications and Patents involved.

Enter the total number of applications and patents identified for recordation. Be sure to include all applications and patents identified on the cover sheet and on additional pages.

Block 7. Total Fee Enclosed.

Enter the total fee enclosed or authorized to be charged. A fee is required for each application and patent against which the document is recorded.

Item 8. Deposit Account Number.

Enter the deposit account number to authorize charges. Attach a duplicate copy of cover sheet to be used for the deposit charge account transaction.

Item 9. Statement and Signature.

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet, confirming that to the best of the persons knowledge and belief, the information contained on the cover sheet is correct and that any copy of the document is a true copy of the original document. Enter the total number of pages including the cover sheet, attachments, and document.

This collection of information is required by 35 USC 261 and 262 and 15 USC 1057 and 1060. The information is used by the public to submit (and by the USPTO to process) patent and trademark assignment requests. After the USPTO records the information, the records for patent and trademarks, assignments, and other associated documents can be inspected by the public. To view documents recorded under secrecy orders or documents recorded due to the interest of the federal government, a written authorization must be submitted. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the form to the USPTO. 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 Manager of the Assignment Division, Crystal Gateway 4, Room 310, 1213 Jefferson Davis Highway, Arlington, Va. 22202. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C., 20231.

302.08 Mailing Address for Submitting Assignment Documents

37 CFR 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.

37 CFR 3.27 sets out how documents submitted for recording should be addressed to the Office. In order to ensure prompt and proper processing, documents and their cover sheets 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 37 CFR 3.81. Requests for recording documents which accompany new applications should be addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231. Requests under 37 CFR 3.81 will be processed by the Office of Patent Publications. Therefore, such requests should be marked to the attention of the Office of Patent Publications and addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

302.09 Facsimile Submission of Assignment Documents

Assignments and other documents affecting title may be submitted to the Office via facsimile (fax). See MPEP § 1730 for the facsimile number. This process allows customers to submit their documents directly into the automated Patent and Trademark Assignment System and receive the resulting recordation notice at their fax machine. The customer's fax machine must be connected to a dedicated line because recordation notices will be returned automatically to the sending fax number through the Patent and Trademark Assignment System. If the Office system is unable to complete transmission of the recordation notice, the notice will be printed and mailed to the sender by U.S. Postal Service first class mail. Recorded documents will not be returned with the "Notice of Recordation."

Any assignment-related document submitted by facsimile must include:

- (A) an identified application or patent number;
 - (B) one cover sheet to record a single transaction;
- and
- (C) payment of the recordation fee by a USPTO Deposit Account.

The following documents **cannot** be submitted via facsimile:

- (A) Assignments submitted concurrently with newly filed patent applications;
- (B) Documents with two or more cover sheets (e.g., a single document with one cover sheet to record an assignment, and a separate cover sheet to record separately a license relating to the same property);
- (C) Requests for corrections to documents recorded previously;
- (D) Requests for "at cost" recordation services;
- (E) Documents with payment of the recordation fee by credit card; and
- (F) Resubmission of a non-recorded assignment.

The date of receipt accorded to an assignment document sent to the Office by facsimile transmission is the date the complete transmission is received in the Office. See MPEP § 502.01. The benefits of a certificate of transmission under 37 CFR 1.8 are available.

If a document submitted by fax is determined not to be recordable, the entire document, with its associated cover sheet, and the Office "Notice of Non-Recordation" will be transmitted via fax back to the sender. Once corrections are made, the initial submission, amended, may then be resubmitted by mailing the corrected submission to the address set forth in 37 CFR 3.27. Timely resubmission will provide the sender with the benefit of the initial receipt date as the recordation date in accordance with 37 CFR 3.51.

The Patent and Trademark Assignment System assigns reel and frame numbers and superimposes recordation stampings on the processed and stored electronic images. Accordingly, copies of all recorded documents will have the reel and frame numbers and recordation stampings.

303 Assignment Documents Not Endorsed on Pending Applications

Certified copies of patent applications as filed do not include an indication of assignment documents.

Applicants desiring an indication of assignment documents of record should request separately certified copies of assignment documents and submit the fees required by 37 CFR 1.19.

When the assignment condition of an application is significant, such as when applications of different inventors contain conflicting claims or there is a question as to who should direct prosecution, it is necessary for the examiner to obtain assignment information from PALM. See MPEP § 320.

306 Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to Parent Application

In the case of a division or continuation application, a prior assignment recorded against the original application is applied to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications.

In the case of a substitute or continuation-in-part application, a prior assignment of the original application is not applied to the substitute or continuation-in-part application because the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications. Substitute or continuation-in-part applications require a new assignment if they are to be issued to an assignee.

The front page of the printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, and reissue applications. It should be noted, however, that inclusion of this information does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

306.01 Assignment of an Application Claiming the Benefits of a Provisional Application

If an application which claims the earlier filing date of a provisional application under 35 U.S.C. 119(e) includes only subject matter which formed a part of the provisional application, an assignment recorded against the provisional application will be effective in the later application, similar to the practice with

respect to continuations and divisions filed under 35 U.S.C. 120. See MPEP § 306. If an application claiming the earlier filing date of a provisional application includes subject matter that is not common with subject matter of the provisional application, new assignment papers must be submitted in the later application, similar to the practice with respect to continuations-in-part filed under 35 U.S.C. 120. See MPEP § 306.

307 Issue to Assignee

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.

37 CFR 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.

Normally, for a patent to issue to an assignee, a request for issuance of the application in the name(s) of the assignee(s) must be filed in the United States Patent and Trademark Office (Office) at a date not later than the day on which the issue fee is paid. If the request for such issuance is submitted after the day on which the issue fee is paid, the patent may issue to an assignee upon submission of a request under 37 CFR 3.81(b) along with the processing fee set forth in

37 CFR 1.17(i). The extent to which the Office can comply with such a request will depend upon when the request is filed, the time it takes to match the request with the file, and whether there is sufficient time for the appropriate Office official to act on the request before the date of issue.

37 CFR 3.81 permits proof of the application's assignment to be submitted so that a patent may issue in the name(s) of the assignee(s) consistent with the application's assignment. The prior requirement for submitting a copy of an actual assignment for recording (in the assignment records of the Office) has been replaced with a requirement that proof of the assignment be submitted pursuant to 37 CFR 3.73(b) (which may include a copy of the assignment, or alternatively, may make reference to a reel and frame number if the assignment is recorded in the Office assignment records). Recording of the assignment is not required; only proof of its existence is required. Reliance may be had on a 37 CFR 3.73(b) statement already of record in the application, if the statement is still accurate at the time the request for issue of the application in the name(s) of the assignee(s) is submitted.

Only the first appearing name of an assignee will be printed on the patent where multiple names for the same party are identified on the Issue Fee Transmittal form, PTOL-85B. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the existing practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL-85B should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and, therefore, the PTOL-85B assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to the assignee if so indicated on the Issue Fee Transmittal form PTOL-85B. Unless an assignee's name and address are identified in item 3 of the Issue Fee Transmittal form PTOL-85B, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for a certificate of correction under 37 CFR 1.323 (see MPEP § 1481 and § 1485) arising from incomplete or erroneous assignee's name furnished in item 3 of PTOL-85B will not be granted unless a petition under 37 CFR 1.183 has been granted. Any such petition under 37 CFR 1.183 should be directed to the Office of Petitions and should include:

- (A) the petition fee required by 37 CFR 1.17(h);
- (B) a request that 37 CFR 3.81(a) be waived to permit the correct name of the assignee to be provided after issuance of the patent;
- (C) a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
- (D) a copy of the Notice of Recordation of Assignment Document.

309 Restrictions Upon Employees of Patent and Trademark Office

35 U.S.C. 4. Restrictions on officers and employees as to interests 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.

310 Government License Rights to Contractor-Owned Inventions Made Under Federally Sponsored Research and Development

Where a Government contractor retains U.S. domestic patent rights, the contractor is under an obligation by virtue of 35 U.S.C. 202(c)(6) to include the following statement at the beginning of the application and any patents issued thereon:

"The U.S. Government has a paid-up license in this invention and the right in limited circumstances to require the patent owner to license others on reasonable terms as provided for by the terms of (contract No. or Grant No.) awarded by (Agency)."

If reference is made in the first sentence of the application to prior copending applications of the applicant, such prior applications must be referred to

in the first sentence of the specification (37 CFR 1.78(a) and MPEP § 201.11), and in this case the above "Government License Rights" statement should follow immediately as the second paragraph of the specification.

If there is no reference to an earlier application, the "Government License Rights" statement should appear as the first paragraph of the specification. See 37 CFR 1.77.

311 Filing of Notice of Arbitration Awards

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.

37 CFR 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.

The written notices required by this section should be directed to the attention of the Office of the Solicitor. The Office of the Solicitor will be responsible for processing such notices.

313 Recording of Licenses, Security Interests, and Other Documents Other Than Assignments

In addition to assignments and documents required to be recorded by Executive Order 9424, documents affecting title to a patent or application will be recorded in the Assignment Division of the United States Patent and Trademark Office (Office). Other documents not affecting title may be recorded at the discretion of the Commissioner. 37 CFR 3.11(a).

Thus, some documents which relate to patents or applications will be recorded, although they do not constitute a transfer or change of title. Typical of these documents which are accepted for recording are license agreements and agreements which convey a security interest. Such documents are recorded in the public interest in order to give third parties notification of equitable interests or other matters relevant to the ownership of a patent or application.

Any document returned unrecorded, which the sender nevertheless believes represents an unusual case which justifies recordation, may be submitted to

the Office of Petitions with a petition under 37 CFR 1.181 requesting recordation of the document.

The recordation of a document is not a determination of the effect of the document on the chain of title. The determination of what, if any, effect a document has on title will be made by the Office at such times as ownership must be established to permit action to be taken by the Office in connection with a patent or an application. See MPEP § 324.

314 Certificates of Change of Name or of Merger

Certificates issued by appropriate authorities showing a change of name of a business or a merger of businesses are recordable. Although a mere change of name does not constitute a change in legal entity, it is properly a link in the chain of title. Documents of merger are also proper links in the chain of title. They may represent a change of entity as well as a change of name.

315 Indexing Against a Recorded Certificate

Prior to amendment of the Rules of Practice to add Part 3 to 37 CFR, it had been the practice of the United States Patent and Trademark Office (Office) to process requests for "indexing" or "cross-referencing" additional patent numbers or application numbers against a document, other than an assignment, previously recorded in the Assignment Division, upon submission of a transmittal letter and recording fee. The Office no longer processes such indexing requests. Such requests do not comply with 37 CFR 3.11, 3.28, and 3.31, which require that each request for recordation include the document to be recorded and a cover sheet.

Therefore, even where a document has already been recorded in the Assignment Division in connection with a patent or patent application, a party that wishes recordation of that document with respect to additional patents and/or patent applications must submit the following to the Assignment Division:

(A) the original document, or a true copy of the original document (which may consist of the previously recorded papers on which the Assignment Division has stamped the reel and frame numbers at which they are recorded, or a copy of such papers);

(B) a completed cover sheet (see 37 CFR 3.31 and MPEP § 302.07); and

(C) the appropriate recording fee (see 37 CFR 1.21(h) and 3.41).

The Office will assign a new recording date to that submission, update the assignment database, and microfilm the cover sheet and document, which shall become part of the official record.

317 Handling of Documents in the Assignment Division

All documents and cover sheets submitted for recording are examined for formal requirements in the Assignment Division in order to separate documents which are recordable from those which are not recordable.

Documents and cover sheets that are considered not to be recordable are returned to the sender by the Assignment Division with an explanation. If the sender disagrees or believes that the document represents an unusual case which justifies recordation, the sender may present the question to the Commissioner by way of petition under 37 CFR 1.181, filed with the Office of Petitions.

After an assignment and cover sheet have been recorded, they will be returned to the name and address indicated on the cover sheet to receive correspondence, showing the reel and frame number.

317.01 Recording Date

37 CFR 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 con-

sidered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

The date of recording of a document is the date the document meeting the requirements for recording set forth in the regulations is filed in the Office. A document which does not comply with the identification requirements of 37 CFR 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 when a correspondence address is available.

317.02 Correction of Returned Documents and Cover Sheets

Assignment documents and cover sheets which are returned by Assignment Division will be stamped with the original date of receipt by the Office and 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 receipt of the papers as the date of recording of the document. See 37 CFR 3.51. The certification procedure under 37 CFR 1.8 or the "Express Mail" procedure under 37 CFR 1.10 may be used for resubmissions of returned papers to obtain 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 receipt 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.

317.03 Effect of Recording

37 CFR 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.

37 CFR 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 canceled with the written consent of all parties or by the decree of a court of compe-

tent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

The recording of a document 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 or patent. 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. See MPEP § 324.

37 CFR 3.56 provides that an assignment, which at the time of its execution is conditional on a given act or event, will be treated by the Office as an absolute assignment. This rule serves as notification as to how a conditional assignment will be treated by the Office in any proceeding requiring a determination of the owner of an application, patent, or registration. Since the Office will not determine whether a condition has been fulfilled, the Office will treat the submission of such an assignment for recordation as signifying that the act or event has occurred. A security agreement that does not convey the right, title, and interest of a patent property is not a conditional assignment.

318 Documents Not to be Placed in Files

Assignment documents submitted for recording should not be placed directly in application or patent files, but should be forwarded to Assignment Division for recording.

320 Title Reports

The "title report" is a form which can be used under certain circumstances by the Assignment Division to report to someone within the Office the name of the owner of an application or patent as shown by the Assignment Division records on the date the title report is made. For example, a title report is requested by the Reexamination Preprocessing Staff when a request for reexamination is filed. Title reports may not be ordered by applicants or attorneys.

Information as to the title is not normally required by the examiner to examine an application. It is only in limited circumstances when the ownership becomes an issue and an examiner needs a title report. See MPEP § 303. Examiners may obtain a title report using the PALM Intranet, Patent Assignment Information (either link to the Assignments home page from the OASIS home page or go to [HTTP://A16/ASGN/OBJECT/ASNINFO](http://A16/ASGN/OBJECT/ASNINFO)). The screen resulting from the

search may be printed to yield the copy of the title report.

NOTE: The public can request a certified abstract of title. The fee for this service is set forth at 37 CFR 1.19(b)(5). See MPEP § 301.01 for a discussion of which assignment records are publicly available.

323 Procedures for Correcting Errors in Recorded Assignment Document

An error in a recorded assignment document will be corrected by Assignment Division provided a "corrective document" is submitted. The "corrective document" must include the following:

(A) The original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and

(B) A new Recordation Form Cover Sheet (form PTO-1619) (See MPEP § 302.07).

The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06.

Corrections may be made on the original assignment document, for example, by lining out an incorrect patent or application number in a merger or change of name (see MPEP § 314).

Office policy regarding recordation of assignment documents is directed toward maintaining a complete history of claimed interests in property and, therefore, recorded assignment documents will not be expunged even if subsequently found to be invalid. See *In re Ratny*, 24 USPQ2d 1713 (Comm'r Pat. 1992).

323.01 Correction of Error in Recorded Cover Sheet

37 CFR 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.

Any alleged error in a recorded cover sheet will only be corrected if the error is apparent from a comparison with the recorded assignment document. The corrected cover sheet should be directed to Assignment Division.

324 Establishing Right of Assignee To Take Action

37 CFR 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).

37 CFR 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.

The owner or assignee of a patent property can take action in a patent application or patent proceeding in numerous instances. The owner or assignee can sign a reply to an Office action (37 CFR 1.33(b)(3) and (4)), a request for a continued prosecution application under 37 CFR 1.53(d) (MPEP § 201.06(d)), a terminal disclaimer (MPEP § 1490), an Issue Fee Transmittal (PTOL-85B) (MPEP § 1306), or a request for status of an application (MPEP § 102). The owner or assignee can file an application under 37 CFR 1.47(b) (MPEP § 409.03(b)) or 37 CFR 1.425, appoint its own registered attorney or agent to prosecute an application (37 CFR 3.71 and MPEP

§ 402.07), grant a power to inspect an application (MPEP § 104), and acquiesce to express abandonment of an application (MPEP § 711.01). The owner or assignee consents to the filing of a reissue application (MPEP § 1410.01), and to the correction of inventorship (MPEP § 201.03 or § 1481).

I. THE ASSIGNEE/OWNER THAT CAN TAKE ACTION IN PATENT MATTERS

The provisions of 37 CFR 3.71(b)(1) and (2) identify the owner or assignee that can take action in patent matters, e.g., the assignee which may conduct the prosecution of a U.S. national application for a patent (35 U.S.C. 111(a)), or any other patent proceeding (e.g., a reexamination proceeding, an interference proceeding). A national patent application is owned by one of the following individual or composite entities:

(A) the inventor(s);

(B) an assignee or multiple assignees of the inventor(s); or

(C) some combination of the assignee(s), and inventor(s) who have not assigned away their right, title and interest in the application.

Pursuant to 37 CFR 3.73(b), a party must be established as the assignee by satisfying the requirements of that subsection, in order to be recognized as an owner or part owner, for purposes of taking action in patent matters before the Office.

As discussed in subsection II below, all parties having any portion of the ownership must join in "taking action" (i.e., act together as a composite entity) in order to be entitled to conduct the prosecution in patent matters.

Individual and Partial Assignees

If there is a single assignee of the **entire** right, title and interest in the patent application, 37 CFR 3.71(b)(1) provides that the single assignee (i.e., individual assignee) may act alone to conduct the prosecution of an application or other patent proceeding (upon complying with 37 CFR 3.73(b)).

If there is no assignee of the **entire** right, title and interest of the patent application, then two possibilities exist:

(A) The application has not been assigned, and ownership resides solely in the inventor(s) (i.e., the applicant(s)). In this situation, 37 CFR 3.71 does not apply, since there is no assignee, and the combination of all inventors is needed to conduct the prosecution of an application.

(B) The application has been assigned by at least one of the inventors, and there is thus at least one "partial assignee." As defined in 37 CFR 3.71(b)(2), a partial assignee is any assignee of record who has less than the entire right, title and interest in the application. The application is owned by the combination of all partial assignees and all inventors who have not assigned away their right, title and interest in the application.

Where at least one inventor retains an ownership interest together with the partial assignee(s), the combination of all partial assignees and inventors retaining ownership interest is needed to conduct the prosecution of an application. Where no inventor retains an ownership interest, the combination of all partial assignees is needed to conduct the prosecution of an application.

Example

Inventors A and B invent a process and file their application. Inventors A and B together may conduct prosecution. Inventor A then assigns all his/her rights in the application to Corporation X. As soon as Corporation X (now a partial assignee) is made of record in the application as a partial assignee (by filing a statement pursuant to 37 CFR 3.73(b) stating fifty percent ownership), Corporation X and Inventor B together may conduct prosecution. Corporation X and Inventor B then both assign their rights in the application to Corporation Y. As soon as Corporation Y (now an assignee of the entire right, title and interest) is made of record in the application as the assignee (by filing a statement pursuant to 37 CFR 3.73(b) stating one-hundred percent ownership), Corporation Y may, by itself, conduct prosecution.

II. ESTABLISHING OWNERSHIP

When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property

to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee's ownership may be established under 37 CFR 3.73(b) by submitting to the Office, in the Office file related to the matter in which action is sought to be taken:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording); or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

The action taken by the assignee, and the 37 CFR 3.73(b) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The 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. 37 CFR 3.73(c). If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or the date of the assignee's action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. See discussion below. Once 37 CFR 3.73(b) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a 37 CFR 3.73(b) submission each time, provided that ownership has not changed.

The submission establishing ownership by the assignee pursuant to 37 CFR 3.73(b) is generally referred to as the "statement under 37 CFR 3.73(b)" or the "37 CFR 3.73(b) statement." A duplicate copy of the 37 CFR 3.73(b) statement is not required and should not be submitted. See 37 CFR 1.4(b) and MPEP § 502.04.

CONTINUING APPLICATIONS

When an assignee files a continuation or divisional application under 37 CFR 1.53, other than a continued

prosecution application (CPA) under 37 CFR 1.53(d), the application papers must:

(A) refer to a statement filed under 37 CFR 3.73(b) in the parent application;

(B) contain a copy of a statement filed under 37 CFR 3.73(b) in the parent application; or

(C) contain a newly executed statement under 37 CFR 3.73(b).

When a continuation-in-part application is filed by an assignee, a newly executed statement under 37 CFR 3.73(b) must be filed. When a CPA under 37 CFR 1.53(d) is filed, the statement filed under 37 CFR 3.73(b) in the parent application will serve as the statement for the CPA.

REQUESTS FOR CONTINUED EXAMINATION

Where a Request for Continued Examination of an application is filed under 37 CFR 1.114 (which can be filed on or after May 29, 2000 for an application filed on or after June 8, 1995), the application is not considered to be abandoned; rather the finality of the Office action is withdrawn and the prosecution continues. Thus, the statement under 37 CFR 3.73(b) in the application will continue to serve as the statement establishing ownership.

PARTY WHO MUST SIGN

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the

board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney (37 CFR 1.34(b)) from the inventors or the assignee to a patent practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

WHEN OWNERSHIP MUST BE ESTABLISHED

Examples of situations where ownership must be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), unless papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d)); signs a request for status of an application or gives a power to inspect an application (MPEP § 102 and § 104); acquiesces to express abandonment of an application (MPEP § 711.01); appoints its own registered attorney or agent to prosecute an application (37 CFR 3.71 and MPEP § 402.07); signs a terminal disclaimer (MPEP § 1490); consents to the filing of a reissue application (MPEP § 1410.01); consents to the correction of inventorship (MPEP § 201.03 or § 1481); files an application under 37 CFR 1.47(b) (MPEP § 409.03(b)) or 37 CFR 1.425; signs an Issue Fee Transmittal (PTOL-85B) (MPEP § 1306); or signs a reply to an Office action.

WHEN OWNERSHIP NEED NOT BE ESTABLISHED

Examples of situations where ownership need not be established under 37 CFR 3.73(b) are when the assignee: signs a request for a continued prosecution application under 37 CFR 1.53(d), where papers establishing ownership under 37 CFR 3.73(b) were filed in the prior application and ownership has not changed (MPEP § 201.06(d)); signs a small entity statement (MPEP § 509.03); signs a statement of common ownership of two inventions (MPEP § 706.02(l)(2)); signs a NASA or DOE property rights statement (MPEP § 151); signs an affidavit under 37 CFR 1.131 where the inventor is unavailable (MPEP § 715.04); signs a certificate under 37 CFR 1.8 (MPEP § 512); or files a request for reexamination of a patent under 37 CFR 1.510 (MPEP § 2210).

MULTIPLE ASSIGNEES

When an assignee seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding and the right, title, and interest therein is held by more than one assignee, each partial assignee must provide a submission under 37 CFR 3.73(b). In each submission, the extent of each assignee's interest must be set forth so

that the Office can determine whether it has obtained action by the entirety of the right, title and interest holders (owners). 37 CFR 3.73(c)(2). If the extent of the partial assignee's ownership interest is not set forth in the submission under 37 CFR 3.73(b), the Office may refuse to accept the submission as an establishment of ownership interest.

CONFLICTING 37 CFR 3.73(b) STATEMENTS

Where there are two or more conflicting 37 CFR 3.73(b) statements in an application or other Office proceeding, the statement with the latest date of submission to the Office will normally control as to establishment of the assignee. If, however, the ownership established as controlling is contested on the record by another party who has submitted a conflicting 37 CFR 3.73(b) statement, then the application or other proceeding shall be forwarded by the Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolution of the ownership question.

FORMS

Form PTO/SB/96 may be used to establish ownership under 37 CFR 3.73(b).

PTO/SB/96 (08-00)
 Approved for use through 10/31/2002. OMB 0851-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

Application No./Patent No.: _____ Filed/Issue Date: _____

Entitled: _____

_____, a _____,
 (Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. the assignee of the entire right, title, and interest; or
2. an assignee of less than the entire right, title and interest.
 The extent (by, percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

- A. An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

- B. A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
 The document was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

 Date

 Typed or printed name

 Signature

 Title

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

MANUAL OF PATENT EXAMINING PROCEDURE

Faint, mostly illegible text, likely bleed-through from the reverse side of the page. Some words like "The", "is", "a", "method" are barely visible.

Chapter 400 Representative of Inventor or Owner

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401 U.S. Patent and Trademark Office Cannot Aid in Selection of Attorney

37 CFR 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.

An applicant for patent may file and prosecute his or her own application, and thus act as his or her own representative (*pro se*) before the Office. See 37 CFR 1.31. In presenting (whether by signing, filing, submitting, or later advocating) papers to the Office, a *pro se* applicant is making the certifications under 37 CFR 10.18(b), and may be subject to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b)(2). See 37 CFR 1.4(d)(2). See also MPEP § 410.

If patentable subject matter appears to be disclosed in a *pro se* application and it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications, the examiner may suggest to the applicant that it may be desirable to employ a registered patent attorney or agent. It is suggested that form paragraph 4.10 be incorporated in an Office action if the use of an attorney or agent is considered desirable and if patentable subject matter exists in the application.

¶ 4.10 Employ Services of Attorney or Agent

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Examiner Note:

The examiner should not suggest that applicant employ an attorney or agent if the application appears to contain no patentable subject matter.

402 Power of Attorney

37 CFR 1.34. Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the 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 an 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, he or she is a principal attorney of record in the case. A principal attorney or agent, so appointed, may appoint an associate attorney or agent who shall also then be of record.

Powers of attorney or authorizations of agent naming firms of attorneys or agents filed in patent applications will not be recognized. However, the U.S. Patent and Trademark Office will construe any such powers or authorizations as a direction to consider the address of the firm as the correspondence address for the application.

Powers of attorney and authorizations of agent under 37 CFR 1.34(b) naming one or more registered individuals, or all registered practitioners associated with a Customer Number, may be made. See MPEP § 403 for Customer Number practice.

For a power of attorney or authorization of agent to be valid, the attorney or agent appointed must be registered to practice before the U.S. Patent and Trademark Office in accordance with 37 CFR 10.6. Form PTO/SB/81 may be used to appoint a registered practitioner.

REPRESENTATIVE OF INVENTOR OR OWNER

402

Please type a plus sign (+) inside this box

PTO/SB/81 (02-01)

Approved for use through 10/31/2002. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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POWER OF ATTORNEY OR AUTHORIZATION OF AGENT	Application Number	
	Filing Date	
	First Named Inventor	
	Title	
	Group Art Unit	
	Examiner Name	
	Attorney Docket Number	

I hereby appoint:

Practitioners at Customer Number Place Customer Number Bar Code Label here

OR

Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Please change the correspondence address for the above-identified application to:

The above-mentioned Customer Number.

OR

Practitioners at Customer Number Place Customer Number Bar Code Label here

OR

<input type="checkbox"/> Firm or Individual Name			
Address			
Address			
City	State	Zip	
Country			
Telephone	Fax		

I am the:

Applicant/Inventor.

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).

SIGNATURE of Applicant or Assignee of Record

Name	
Signature	
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 than one signature is required, see below*.

*Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 3 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

In accordance with 37 CFR 1.34(a), a paper filed by a registered patent attorney or agent in an application in which he or she is not of record should include both his or her signature and registration number. Acceptance of papers filed in patent applications and reexamination proceedings by registered attorneys and agents upon a representation that the attorney or agent is authorized to act in a representative capacity is for the purpose of facilitating replies on behalf of applicants in patent applications and, further, to obviate the need for filing powers of attorney or authorizations of agent in individual applications or patents when there has been a change in composition of law firms or corporate patent staffs. Interviews with a registered attorney or agent not of record will, in view of 35 U.S.C. 122, be conducted only on the basis of information and files supplied by the attorney or agent. A person acting in a representative capacity may not sign a power of attorney or a document granting access to an application.

A power of attorney or authorization given to a registered Canadian patent agent, to be valid, must be given by the applicants, all of whom are located in Canada. See 37 CFR 10.6(c).

When an application for patent is filed accompanied by a power of attorney or authorization of agent to a person not registered to practice before the United States Patent and Trademark Office, the Office of Initial Patent Examination will send the official filing receipt directly to the applicant, together with an explanatory letter. A copy of the letter will be sent to the person named in the power or authorization and a copy placed in the file without being given a paper number. The name of the unregistered person will not be placed on either the face of the file or the PALM bib-data sheet and the examiner will communicate only with the applicant directly at the correspondence address specified by the applicant unless and until the applicant appoints a recognized practitioner. An associate power of attorney or authorization from the unregistered person will not be recognized or accepted.

Form paragraph 4.09 may be used to notify applicant that the attorney or agent is not registered.

¶ 4.09 Unregistered Attorney or Agent

An examination of this application reveals that applicant has attempted to appoint an attorney or agent who is not registered to practice before the U.S. Patent and Trademark Office, contrary to the Code of Federal Regulations, 37 CFR 1.31. Therefore, the

appointment is void, *ab initio*. We will not recognize the appointment and all correspondence concerning this application must be signed by: 1) all named applicants (inventors), 2) all the owners of the rights to the invention, or 3) a registered attorney or agent duly appointed by the inventor(s) or the owner(s). Furthermore, all communications from the Office will be addressed to the first named inventor, unless specific instructions to the contrary are supplied by the named inventor(s) or owner(s).

While an applicant may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is, therefore, encouraged to secure the services of a registered patent attorney or agent (i.e., registered to practice before the U.S. Patent and Trademark Office) to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution.

The Office cannot aid you in selecting a registered attorney or agent, however, we do have a publication which lists all the patent attorneys and agents who are registered to practice before the Office. The publication, "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office," may be purchased from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. In addition, applicant may obtain this information: from the USPTO Internet Web Site [<http://www.uspto.gov/>]; by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231; by calling the Office of Enrollment and Discipline at (703) 306-4097; or, through the Patent Assistance Center toll free number, 1(800)786-9199.

Examiner Note:

This form paragraph is to be used ONLY after ensuring that the named representative is not registered with the Office. A PALM inquiry should be first made and if no listing is given, the Office of Enrollment and Discipline should be contacted to determine the current "recognition" status of the individual named by the applicant in a "power of attorney." If the named individual is NOT registered or otherwise recognized by the Office, the correspondence address on the face of the file should be promptly changed to that of the first named inventor unless applicant specifically provides a different "correspondence address." A copy of the Office communication incorporating this form paragraph should also be mailed to the unregistered individual named by the applicant in the "power of attorney." If desired, you may include with your communication, a list of the registered practitioners from applicant's Zip Code copied from the above noted publication which should be available in the TC Director's Office.

See MPEP § 601.03 for change of correspondence address. See MPEP § 201.06(c) for change in the power of attorney in continuation or divisional applications filed under 37 CFR 1.53(b). See MPEP § 403 for the addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number. For a representative of a requester of reexamination, see MPEP § 2213.

37 CFR 10.18. Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

37 CFR 10.18(a) emphasizes that every paper filed by a practitioner must be personally signed by the practitioner, except those required to be signed by the applicant or party. 37 CFR 10.18(b) provides that, by presenting any paper to the Office, the party presenting such paper (whether a practitioner or nonpractitioner) is: (1) certifying that the statements made therein are subject to the declaration clause of 37 CFR 1.68; and (2) making the certifications required for papers filed in a federal court under Rule 11(b) of the Federal Rules of Civil Procedure. See MPEP § 410. 37 CFR 10.18(d) provides that any practitioner violating the provisions of 37 CFR 10.18 may also be subject to disciplinary action (see 37 CFR 10.23(c)(15)), thus clarifying that a practitioner may be subject to disciplinary action in lieu of, or in addition to, the sanctions set forth in 37 CFR 10.18(c) for violations of 37 CFR 10.18. See also 37 CFR 1.4(d)(2).

The certifications in 37 CFR 10.18(b) apply to all papers filed in the Office, including allegations of improper conduct made by a registered practitioner in any Office proceeding.

37 CFR 10.11. Removing names from registers.

(a) Registered attorneys and agents shall notify the Director of any change of address. Any notification to the Director of any change of address shall be separate from any notice of change of address filed in individual applications.

(b) A letter may be addressed to any individual on the register, at the address of which separate notice was last received by the Director, for the purpose of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and the names of individuals so removed will be published in the Official Gazette. The name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in § 1.21(a)(3) of this subchapter.

See also MPEP § 1702.

402.01 Exceptions as to Registration

37 CFR 10.9. Limited recognition in patent cases.

(a) Any individual not registered under § 10.6 may, upon a showing of circumstances which render it necessary or justifiable,

be given limited recognition by the Director to prosecute as attorney or agent a specified application or specified applications, but limited recognition under this paragraph shall not extend further than the application or applications specified.

(b) When registration of a resident alien under paragraphs (a) or (b) of § 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section.

Sometimes in a joint application one of the coinventors gives to the other the power of attorney in the application. Such power will be recognized even though the one to whom it is given is not registered.

If a request for special recognition accompanies the application, the Office of Initial Patent Examination will forward the file to the Director of the Office of Enrollment and Discipline.

402.02 Appointment of Associate Attorney or Agent

The principal attorney or agent may appoint an associate attorney or agent as provided in 37 CFR 1.34. The associate attorney may not appoint another attorney. See also MPEP § 406.

402.05 Revocation

37 CFR 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.

Upon revocation of the power of attorney, appropriate notification is sent by the technical support staff of the Technology Center.

Revocation of the power of the principal attorney revokes powers granted by him or her to other attorneys.

Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (not on the date of ACCEPTANCE).

402.06 Attorney or Agent Withdraws

See 37 CFR 1.36 in MPEP § 402.05. See also 37 CFR 10.40.

In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the Technology Center Director where the application is assigned where appropriate procedure will be followed pertaining to the withdrawal. The **withdrawal is effective when approved** rather than when received.

To expedite the handling of requests for permission to withdraw as attorney or agent, under 37 CFR 1.36, Form PTO/SB/83 may be used. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

The Commissioner of Patents and Trademarks usually requires that there be at least 30 days between approval of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). This is so that the applicant will have sufficient time to obtain other representation or take other action. If a period has been set for reply and the period may be extended without a showing of cause pursuant to 37 CFR 1.136(a) by filing a petition for extension of time and fee, the practitioner will not be required to seek such extension of time for withdrawal to be approved. In such a situation, however, withdrawal will not be approved unless at least 30 days would remain between the date of approval and the last date on which such a petition for extension of time and fee could properly be filed.

For withdrawal during reexamination proceedings, see MPEP § 2223.

Please type a plus sign (+) inside this box

PTO/SB/83 (08-00)

Approved for use through 10/31/2002. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT	Application Number	
	Filing Date	
	First Named Inventor	
	Group Art Unit	
	Examiner Name	
	Attorney Docket Number	

To: Assistant Commissioner for Patents
Washington, DC 20231

I hereby apply to withdraw as attorney or agent for the above identified patent application.

The reasons for this request are:

1. The correspondence address is NOT affected by this withdrawal.

2. Change the correspondence address and direct all future correspondence to:

CORRESPONDENCE ADDRESS

Customer Number Place Customer Number
Bar Code Label here

OR

Firm or Individual Name

Address

Address

City State ZIP

Country

Telephone Fax

This request is enclosed in triplicate.

Name

Signature

Date

NOTE: Withdrawal is effective when approved rather than when received.
Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

402.07 Assignee Can Revoke Power of Attorney of Applicant

The assignee of record of the entire interest can revoke the power of attorney of the applicant unless an "irrevocable" right to prosecute the application had been given as in some government owned applications.

37 CFR 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).

See 37 CFR 1.36 in MPEP § 402.05.

A power of attorney by the assignee of the entire interest revokes all powers given by the applicant and prior assignees if the assignee establishes their right to take action as provided in 37 CFR 3.73(b). See MPEP § 324. Ordinarily, the applicant will still have access to the application (MPEP § 106).

In an application that has been accorded status under 37 CFR 1.47(a), or for which status under 37 CFR 1.47(a) has been requested, a power of attorney given by the inventors who have signed the declara-

tion (available inventors) may be revoked by an assignee of the entire interest of the available inventors. Rights of the assignee to take action may be established as provided in 37 CFR 3.73(b) and MPEP § 324.

402.08 Application in Interference

While an application is involved in an interference, no power of attorney of any kind should be entered in such application by the technical support staff of the Technology Center.

If a power of attorney or revocation is received for an application which is in interference, it should be forwarded to the Service Branch of the Board of Patent Appeals and Interferences because all parties to the interference must be notified.

402.09 International Application

37 CFR 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.

For representation in international applications, see MPEP § 1807.

402.10 Appointment/Revocation by Less Than All Applicants or Owners

Papers giving or revoking a power of attorney in an application generally require signature by all the applicants or owners of the application. Papers revoking a power of attorney in an application (or giving a power of attorney) will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. The petition should be directed to the Office of Petitions. The acceptance of such papers by petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent replies submitted to the Office. See *In re Goldstein*, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). In an application filed under 37 CFR 1.47(a), an assignee of the entire interest of the available inventors who have signed the declaration may appoint or revoke a power of attorney without a petition under 37 CFR 1.182. See MPEP § 402.07. However, in applications accepted under 37 CFR 1.47, such a petition under 37 CFR 1.182 submitted by a previously nonsigning inventor who has now joined in the application will not be granted. See MPEP § 409.03(i). Upon accepting papers appointing and/or revoking a power of attorney that are signed by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent replies. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent replies and the paper number(s) where the split powers of attorney appear. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at least one applicant or owner prosecuting the application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree. Each attorney or agent signing sub-

sequent papers must indicate whom he or she represents.

The following are examples of who must sign replies when there is more than one person responsible for prosecuting the application:

(A) If coinventor A has given a power of attorney and coinventor B has not, replies must be signed by the attorney of A and by coinventor B.

(B) If coinventors A and B have each appointed their own attorney, replies must be signed by both attorneys.

403 Correspondence —With Whom Held

37 CFR 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.

37 CFR 1.33(a) provides for an applicant to supply an address to receive correspondence from the U.S. Patent and Trademark Office so that the Office may direct mail to any address of applicant's selection, such as a corporate patent department, a firm of attorneys or agents, or an individual attorney, agent, or other person.

37 CFR 1.33(a) provides that in a patent application the applicant must specify a correspondence address to which the Office will send notices, letters and other communications relating to the application. The correspondence address must appear either in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with an application filing. Where more than one correspondence address is specified, the Office will determine which one to establish as the correspon-

dence address. This is intended to cover the situation where an application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying 37 CFR 1.63 oath or declaration, or other similar situations. The determination of which of the correspondence addresses to use will be made on a case-by-case basis, considering such factors as the earliest correspondence address submitted, and the first listed correspondence address if conflicting addresses appear in the same declaration.

37 CFR 1.33(a) requests the submission of a daytime telephone number of the party to whom correspondence is to be addressed. While business is to be conducted on the written record (37 CFR 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to writing. The telephone number would be changeable by any party who could change the correspondence address.

37 CFR 1.33(a)(1) provides that any party filing the application and setting forth a correspondence address could later change the correspondence address provided that a 37 CFR 1.63 oath/declaration by any of the inventors has not been submitted. If one joint inventor filed an application, the person who may change the correspondence address would include only the one inventor who filed the application, even if another inventor was identified on the application transmittal letter. If two of three inventors filed the application, the two inventors filing the application would be needed to change the correspondence address. Additionally, any registered practitioner named in the application transmittal letter, or a person who has the authority to act on behalf of the party that will be the assignee (if the application was filed by the party that will be the assignee), could change the correspondence address. A registered practitioner named in a letterhead would not be sufficient, but rather a clear identification of the individual as being a representative would be required. A company (to whom the invention has been assigned, or to whom there is an obligation to assign the invention) who files an application, is permitted to designate the correspondence address, and to change the correspondence address, until such time as a (first) 37 CFR 1.63 oath/declaration is filed. The mere filing of a 37 CFR 1.63 oath/declaration that does not include a correspondence address does not affect any correspondence address

previously established on the filing of the application, or changed per 37 CFR 1.63(a)(1), even if the application was filed by a company that is only a partial assignee. The expression "party that will be the assignee," rather than assignee, is used in that until a declaration is submitted, inventors have only been identified, and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, if the application transmittal letter indicates that the application is being filed on behalf of XYZ company, with an assignment to be filed later, XYZ company would be allowed to change the correspondence address without resort to 37 CFR 3.73(b) until an executed oath or declaration is filed, and with resort to 37 CFR 3.73(b) after the oath or declaration is filed.

Where a correspondence address was set forth or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of a 37 CFR 1.63 oath or declaration), that correspondence address remains in effect upon filing of a 37 CFR 1.63 declaration and can then only be changed pursuant to 37 CFR 1.33(a)(2).

37 CFR 1.33 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney unless some other correspondence address has been given. Double correspondence with an applicant and his or her attorney, or with two representatives, will not be undertaken. See MPEP § 403.01, § 403.02, and § 714.01(d).

If double correspondence is attempted, form paragraph 4.01 should be included in the next Office action.

¶ 4.01 Dual Correspondence

Applicant has appointed an attorney or agent to conduct all business before the Patent and Trademark Office. Double correspondence with an applicant and applicant's attorney or agent will not be undertaken. Accordingly, applicant is required to conduct all future correspondence with this Office through the attorney or agent of record. See 37 CFR 1.33.

Examiner Note:

1. The first time a reply is received directly from applicant, include this paragraph in the Office action and send a copy of the action to the applicant. See MPEP §§ 403 and 714.01.
2. Should applicant file additional replies, do not send copies of subsequent Office actions to the applicant.
3. Status letters from the applicant may be acknowledged in isolated instances.

In a joint application with no attorney or agent, the applicant whose name first appears in the papers

receives the correspondence, unless other instructions are given. All applicants must sign the replies. See MPEP § 714.01(a). If the assignee of the entire interest is prosecuting the application (MPEP § 402.07), the assignee may specify a correspondence address.

37 CFR 1.33(c) relates to which address communications for the patent owner will be sent in reexamination proceedings. See also MPEP § 2224.

Powers of attorney to firms are not recognized by the U.S. Patent and Trademark Office. See MPEP § 204. However, the firm's address will be considered to be the correspondence address. The address should appear as follows:

John Doe (inventor)
In care of Able, Baker, and Charlie (firm)
1234 Jefferson Davis Highway
Arlington, Virginia 22202

See MPEP § 601.03 for change of correspondence address.

See MPEP § 201.06(c) regarding change of correspondence address in continuation or divisional applications filed under 37 CFR 1.53(b).

CUSTOMER NUMBER PRACTICE

A Customer Number (previously a "Payor Number") may be used to:

(A) designate the correspondence address of a patent application by a Customer Number such that the correspondence address for the patent application would be the address associated with the Customer Number;

(B) designate the fee address (37 CFR 1.363) of a patent by a Customer Number such that the fee address for the patent would be the address associated with the Customer Number; and

(C) submit a list of practitioners by Customer Number such that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.

Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number.

Applicant may use either the same or different customer number(s) for the correspondence address, the fee address and/or a list of practitioners. The customer number associated with the correspondence address is the customer number used to obtain access to the Patent Application Information Retrieval (PAIR) system at <http://pair.uspto.gov>. See MPEP § 1730 for additional information regarding PAIR.

The following forms are suggested for use with the Customer Number practice:

(A) the "Request for Customer Number" (PTO/SB/125) to request a Customer Number;

(B) the "Request for Customer Number Data Change" (PTO/SB/124) to request a change in the data (address or list of practitioners) associated with an existing Customer Number;

(C) the "Change of Correspondence Address, Application" (PTO/SB/122) to change the correspondence address of an individual application to the address associated with a Customer Number;

(D) the "Change of Correspondence Address, Patent" (PTO/SB/123) to change the correspondence address of an individual patent to the address associated with a Customer Number; and

(E) the "Correspondence Address Indication Form" (PTO/SB/121) to change the correspondence address of a list of applications or patents to the address associated with a Customer Number.

The Office will also accept requests submitted electronically *via* a computer-readable diskette to:

(A) change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number; and

(B) submit a power of attorney in a list of applications or patents to the registered practitioners associated with the Customer Number.

Such electronic requests must be submitted in the manner set forth in the Notice entitled "Extension of the Payor Number Practice (through "Customer Numbers") to Matters Involving Pending Patent Applications," published in the *Federal Register* at 61 FR 54622, 54623-24 (October 21, 1996), and in the *Official Gazette* at 1191 O. G. 187, 188-89 (October 29, 1996).

The Customer Number practice does not affect the current practice of permitting a patentee to provide a "fee address" for the receipt of maintenance fee correspondence. A patentee will be able to designate a "fee address" for the receipt of maintenance fee correspondence, and a different address for the receipt of all other correspondence. The designation of a "fee address" by reference to a Customer Number will not affect or be affected by the designation of a correspondence address by reference to another Customer Number, in that the Office will send maintenance fee correspondence to the address associated with the Customer Number designated as the "fee address" and will send all other correspondence to the address associated with the Customer Number designated as the correspondence address.

The association of a list of practitioners with a Customer Number will permit an applicant to appoint all of the practitioners associated with the Customer Number merely by reference to the Customer Number in the Power of Attorney (i.e., without individually listing the practitioners in the Power of Attorney). The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant who appointed all of the practitioners associated with such Customer Number. This will avoid the necessity for the filing of additional papers in each patent application affected by a change in the practitioners of the law firm prosecuting the application. The appointment of practitioners associated with a Customer Number will be optional, in that any applicant may continue to individually name those practitioners to represent the applicant in a patent application.

The Customer Number practice does not affect the prohibition against, and does not amount to, an appointment of a law firm (rather than specified practitioners). The Office prohibits an appointment of a specified law firm because the Office cannot ascertain from its records whether a particular practitioner submitting a paper to the Office is associated with the law firm specified in an appointment. The Office will permit an appointment of all of the practitioners associated with a specified Customer Number because the Office can ascertain from its records for the specified

Customer Number whether a particular practitioner is associated with that Customer Number.

As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Due to the prohibition against dual correspondence in an application (37 CFR 1.33(a)), an applicant will be permitted to provide only a single number at a time as the Customer Number for the correspondence address.

Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners, such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration numbers from plural sources.

Although Customer Numbers are designed to designate both a correspondence address and to associate one or more patent attorneys or agents with an application, one Customer Number may be used for the correspondence address, and another Customer Number may be used for the power of attorney.

Applicants are strongly cautioned not to attempt to appoint more than one Customer Number for a particular purpose (e.g., correspondence address) in a single communication, as such action will **not** have a cumulative effect.

The Office has created a box designation for correspondence related to a Customer Number ("Box CN"), and all correspondence related to a Customer Number (e.g., requests for a Customer Number) should be addressed to this box designation.

The following persons are authorized to change the information associated with an established Customer Number: (1) a registered practitioner associated with the Customer Number; and (2) the person who requested the Customer Number (signed the Request for Customer Number, Form PTO/SB/125).

Please type a plus sign (+) inside this box

PTO/SB/121 (10-00)

Approved for use through 10/31/2002. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<p>CORRESPONDENCE ADDRESS INDICATION FORM</p>	<p>Address to: Assistant Commissioner for Patents Box CN Washington, DC 20231</p>
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Please recognize the following address as the correspondence address:

Customer Number → Place Customer Number Bar Code Label here

OR *Type Customer Number here*

Request for Customer Number (PTO/SB/125) submitted herewith.

in the following listed application(s) or patent(s) :

Patent Number (if appropriate)	Application Number	Patent Date (if appropriate)	U.S. Filing Date

Typed or Printed Name		<p><i>(check one)</i></p> <p><input type="checkbox"/> Applicant or Patentee</p> <p><input type="checkbox"/> Assignee of record of the entire interest. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> Attorney or Agent of record</p> <p style="text-align: center;">(Reg. No.)</p>
Signature		
Date		
Address of signer:		

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

*Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

Please type a plus sign (+) inside this box PTO/SB/122 (10-00)
Approved for use through 10/31/2002. OMB 0651-0035
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<p>CHANGE OF CORRESPONDENCE ADDRESS <i>Application</i></p> <p>Address to: Assistant Commissioner for Patents Washington, D.C. 20231</p>	<p>Application Number</p> <hr/> <p>Filing Date</p> <hr/> <p>First Named Inventor</p> <hr/> <p>Group Art Unit</p> <hr/> <p>Examiner Name</p> <hr/> <p>Attorney Docket Number</p> <hr/>
--	---

Please change the Correspondence Address for the above-identified application to:

Customer Number →

Place Customer Number Bar Code Label here

Type Customer Number here

OR

<input type="checkbox"/> Firm or Individual Name			
Address			
Address			
City	State	ZIP	
Country			
Telephone	Fax		

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the :

- Applicant/Inventor.
- Assignee of record of the entire interest. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).
- Attorney or Agent of record.
- Registered practitioner named in the application transmittal letter in an application without an executed oath or declaration. See 37 CFR 1.33(a)(1). Registration Number _____

Typed or Printed Name

Signature

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 than one signature is required, see below.

*Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 3 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box

PTO/SB/123 (10-00)

Approved for use through: 10/31/2002. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<p>CHANGE OF CORRESPONDENCE ADDRESS <i>Patent</i></p> <p>Address to: Assistant Commissioner for Patents Washington, D.C. 20231</p>	Patent Number	
	Issue Date	
	Application Number	
	Filing Date	
	First Named Inventor	

Please change the Correspondence Address for the above-identified patent to:

Customer Number →

Place Customer Number Bar Code Label here

Type Customer Number here

OR

Firm or Individual Name			
Address			
Address			
City	State	ZIP	
Country			
Telephone	Fax		

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

This form will not affect any "fee address" provided for the above-identified patent. To change a "fee address" use the "Fee Address Indication Form" (PTO/SB/47).

I am the :

- Patentee.
- Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).
- Attorney or agent of record.

Typed or Printed Name	
Signature	
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 than one signature is required, see below.

*Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 3 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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

PTO/SB/124A (08-00)
 Approved for use through 10/31/2002. OMB 0651-0035
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h2 style="margin: 0;">Request for Customer Number Data Change</h2>	<p>Address to:</p> <p>Assistant Commissioner for Patents Box CN Washington, DC 20231</p>
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To the Commissioner of Patents and Trademarks:
 Please record the following data changes to **Customer Number:**

Type Customer Number here → Place Customer Number
Bar Code Label here

Please change Correspondence Address to:

Firm or Individual Name			
Address			
Address			
City	State	ZIP	
Country			
Telephone		Fax	

Please **delete** the following practitioner registration number(s) from the Customer Number indicated above:

<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>
<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>
<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>

Please **add** the following practitioner registration number(s) to the Customer Number indicated above:

<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>
<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>	<input style="width: 80px; height: 20px;" type="text"/>

Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto

Request Submitted by:

Firm Name (if applicable)	
Name of Person submitting request	
Signature	
Telephone Number	Date

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

PTO/SB/124B (08-00)

Approved for use through 10/31/2002. OMB 0651-0036

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Request for Customer Number Data Change	Practitioner Registration Number Supplemental Sheet
Page of Pages	

To the Commissioner of Patents and Trademarks:

Please record the following data changes to **Customer Number:**

*Place Customer Number
Bar Code Label here*

Please **delete** the following practitioner registration number(s) from the Customer Number indicated above:

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Date	<input type="checkbox"/> Additional supplemental sheet(s) attached hereto

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.**

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PTO/SB/125A (08-00)

Approved for use through 10/31/2002. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h2 style="margin: 0;">Request for Customer Number</h2>	<p>Address to:</p> <p>Assistant Commissioner for Patents Box CN Washington, DC 20231</p>
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To the Commissioner of Patents and Trademarks:
Please assign a Customer Number to the Correspondence Address indicated below.

Firm or Individual Name			
Address			
Address			
City	State	ZIP	
Country			
Telephone		Fax	

Please associate the following practitioner registration number(s) with the Customer Number assigned to the Correspondence Address cited above.

Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto

Request Submitted by:

Firm Name (if applicable)	
Name of person submitting request	
Signature	
Telephone Number	Date

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.**

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Request for Customer Number	Practitioner Registration Number Supplemental Sheet
Page of Pages	

Please associate the following practitioner registration number(s) with the Customer Number assigned to the Correspondence Address cited on Request for Customer Number form attached.

Firm Name		<input type="checkbox"/> Additional supplemental sheet(s) attached hereto
Date		

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

PATENT APPLICATION FILED WITHOUT CORRESPONDENCE ADDRESS

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53, a filing date is granted to a nonprovisional application for patent filed in the U.S. Patent and Trademark Office, if it includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a). If a nonprovisional application which has been accorded a filing date does not include the appropriate filing fee, or oath or declaration, the applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application. If a provisional application which has been accorded a filing date does not include the appropriate filing fee, or the cover sheet, the applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(l) in order to prevent abandonment of the application.

In order for the Office to so notify the applicant, a correspondence address must also be provided by the applicant. The address may be different from the post office address of the applicant. For example, the address of the applicant's registered attorney or agent may be used as the correspondence address. If the applicant fails to provide the Office with a correspondence address, the Office will be unable to provide the applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) for nonprovisional applications and 37 CFR 1.16(l) for provisional applications. In such a case, the applicant will be considered to have constructive notice as of the filing date that the application must be completed and the applicant will have 2 months from the filing date in which to do so before abandonment occurs.

The periods of time within which the applicant must complete the application may be extended under the provisions of 37 CFR 1.136. Applications which are not completed in a timely manner will be abandoned.

403.01 Correspondence Held With Associate Attorney

Where the attorneys bear relation of principal attorney and associate attorney, the correspondence will be had with the associate attorney unless the principal attorney directs otherwise. *Ex parte Eggan*, 1911 C.D. 213, 172 O.G. 1091 (Comm'r Pat. 1911). The associate attorney may specify or change the correspondence address to which communications about the application are to be directed.

403.02 Two Attorneys for Same Application

If the applicant simultaneously appoints two principal attorneys, he or she should indicate with whom correspondence is to be conducted. If one is a local Washington metropolitan area attorney and the applicant fails to indicate either attorney, correspondence will be conducted with the local attorney.

If, after one attorney is appointed, a second attorney is later appointed without revocation of the power of the first attorney, the name of the second attorney is entered on either the face of the file or the PALM bib-data sheet (*Ex parte Eggan*, 1911 C.D. 213, 172 O.G. 1091 (Comm'r Pat. 1911)), with notation that the Office letters are to be sent to him or her. This applies also to associate attorneys.

404 Conflicting Parties Having Same Attorney

See 37 CFR 10.66.

405 Attorney Not of Record

Papers may be filed in patent applications by registered attorneys or agents not of record under 37 CFR 1.34(a). Filing of such papers is considered to be a representation that the attorney or agent is authorized to act in a representative capacity on behalf of applicant. However, interviews with a registered attorney or agent not of record will be conducted based only on the information and files supplied by the attorney or agent in view of 35 U.S.C. 122. Powers of attorney may not be signed by an attorney or agent not of record.

A change of correspondence address or a document granting access (i.e., a power to inspect) may only be signed by an attorney or agent who is not of record if an executed oath or declaration has not been filed in the application. See 37 CFR 1.33(a) (correspondence address) and 1.14(d)(4)

406 Death of Attorney

The power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by him or her. Thus, a principal attorney may appoint an associate attorney but such a power terminates with that of the principal. The principal attorney may not appoint a "substitute" and any attempt by the principal to appoint a "substitute" attorney whose power is intended to survive his or her own will not be recognized by the Office.

If notification is received from the applicant or assignee of the death of the sole principal attorney and the application is up for action by the examiner, correspondence is held with the applicant or assignee who originally appointed the deceased attorney.

If notification is received from the office of the deceased attorney and the application is up for action, the examiner when preparing the Office action should add form paragraph 4.02.

¶ 4.02 Death of Attorney, Notice Received from Attorney's Office

In view of the notification of the death of the attorney or agent of record, the power of attorney is terminated. A new registered attorney or agent may be appointed.

Examiner Note:

As the power of attorney has been terminated, Office correspondence is sent to the applicant or the assignee who originally appointed the deceased attorney or agent.

If notification of the death of the sole principal attorney is received from the Office of Enrollment and Discipline or some other source, there will be no paper of record in the file wrapper to indicate that the attorney is deceased. Correspondence therefore continues to be held with the office of the deceased attorney but a copy of the Office action is also mailed to the person who originally appointed the attorney. In such an Office action where the application is not ready for allowance, the examiner should add form paragraph 4.03.

¶ 4.03 Death of Attorney, Notice from Other Source

Notice of the death of the attorney or agent of record has come to the attention of this Office. Since the power of attorney is therefore terminated, a copy of this action is being mailed to the [1].

Examiner Note:

In bracket 1, insert --applicant-- or --assignee-- if the assignee originally appointed the deceased attorney or agent.

If notification of the death of the sole principal attorney is received from the Office of Enrollment and Discipline or some other source and the application is ready for allowance, the examiner prepares the application for allowance and writes a letter to the office of the deceased attorney with a copy to the person who originally appointed the deceased attorney including the wording of form paragraph 4.04.

¶ 4.04 Death of Attorney, Application Is Ready for Allowance

Notice of the death of the attorney or agent of record has come to the attention of this Office. Since the power of attorney is thus terminated, and this application is now ready for allowance, the Notice of Allowance will be mailed to the office of the deceased attorney or agent in the absence of a new power of attorney.

Examiner Note:

A copy should also be mailed to the applicant or the assignee who originally appointed the attorney or agent.

Note MPEP § 405.

407 Suspended or Excluded Practitioner

See MPEP § 105.

Form paragraphs 4.06, 4.07, and 4.08 should be used where power of attorney is given to an attorney or agent who has been suspended from practice before the Office.

¶ 4.06 Attorney/Agent Suspended (Sole Practitioner, Sole Inventor)

The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to you as the inventor.

Applicant may, of course, file a new power of attorney in the application to have a registered attorney or agent represent you before the Office. In the absence of an attorney or agent of record, all amendments and other papers filed in the application must be signed: (1) by you; or (2) if there is an assignee of record of an undivided part interest, by you and such assignee; or (3) if there is

an assignee of the entire interest, by such assignee; or (4) by a registered patent attorney or agent, not of record, who acts in a representative capacity under the provisions of 37 CFR 1.34(a). The Office will not hold telephone interviews with or send communications to a registered patent attorney or agent, acting in a representative capacity under 37 CFR 1.34, i.e., who is not of record in the application.

Applicant may obtain a list of registered patent attorneys and agents located in your area by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231, or by calling the Office of Enrollment and Discipline at (703) 306-4097.

Examiner Note:

1. In bracket 1, insert name of suspended or excluded practitioner.
2. In bracket 2, insert either --suspended-- or --excluded--.
3. This form paragraph should be used when a suspended or excluded practitioner is the only practitioner of record and there is only a single inventor. Use form paragraph 4.07 if there are joint inventors.
4. The Office action is to be mailed only to the inventor at his/her current address of record.

¶ 4.07 Attorney/Agent Suspended (Sole Practitioner, Joint Inventors)

The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to the address of the inventor first named in the application.

Applicants may, of course, file a new power of attorney in the application to have a registered attorney or agent represent them before the Office. In the absence of an attorney or agent of record, all amendments and other papers filed in the application must be signed: (1) by all named applicants unless one named applicant has been given a power of attorney to sign on behalf of the remaining applicants, and the power of attorney is of record in the application; or (2) if there is an assignee of record of an undivided part interest, by all named applicants retaining an interest and such assignee; or (3) if there is an assignee of the entire interest, by such assignee; or (4) by a registered patent attorney or agent not of record who acts in a representative capacity under the provisions of 37 CFR 1.34(a). The Office will not hold telephone interviews with or send communications to a registered patent attorney or agent, acting in a representative capacity under 37 CFR 1.34, i.e., who is not of record in the application.

Applicants may obtain a list of registered patent attorneys and agents located in their area by writing to the Commissioner of Patents and Trademarks, Box OED, Washington, DC 20231, or by calling the Office of Enrollment and Discipline at (703) 306-4097.

Examiner Note:

1. In bracket 1, insert the name of the suspended or excluded practitioner.
2. In bracket 2, insert either --suspended-- or --excluded--.
3. This form paragraph should be used when the suspended or excluded practitioner is the only practitioner of record and there

are joint inventors. Use form paragraph 4.06 if there is a single inventor.

4. The Office action is to be mailed only to the inventor first named in the declaration at his or her current post office address of record.

¶ 4.08 Attorney/Agent Suspended (Plural Practitioners)

The present application was filed containing a power of attorney to [1] and [2]. A correspondence address was supplied for [3]. No address was supplied for [4].

[5] was [6] from practice before the Patent and Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice.

As a correspondence address, other than to [7], is not of record, this Office action is being mailed to [8] at his/her last known address as listed on the register of patent attorneys and agents. To ensure that a copy of this Office action is received in a timely manner to allow for a timely reply, a copy of the Office action is being mailed directly to the address of the inventor first named in the declaration or oath. Any reply by applicant(s) should be by way of the remaining practitioner(s) of record and should include a new correspondence address.

Examiner Note:

1. In brackets 1, 3, 5 and 7 insert the name of the suspended or excluded practitioner.
2. In brackets 2, 4 and 8, insert the name of the first named unsuspended (unexcluded) registered practitioner of record.
3. In bracket 6, insert either --suspended-- or --excluded--.
4. This form paragraph should be used when there is at least one registered practitioner still of record who has not been suspended or excluded from practice. Use one of form paragraphs 4.06 or 4.07 if there are no remaining registered attorneys or agents of record.
5. The Office action is to be mailed both to the first named registered attorney or agent of record (who is not suspended or excluded) at the address currently listed in the Attorney's Roster, and to the inventor first named in the declaration at his or her current post office address of record.

408 Telephoning Attorney

Present Office policy places great emphasis on telephone interviews initiated by the examiner. For this reason, it is not necessary for an attorney to request a telephone interview. Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interviews would not be considered effective to advance prosecution. However, it is desirable for an attorney to call the examiner if the attorney feels the call will be beneficial to advance prosecution of the application. See MPEP § 713.01 and § 713.05.

Many attorneys have offices or representatives in the Washington area and it sometimes expedites business to interview them concerning an application. When the examiner believes the progress of the application would be advanced by an interview, he or she may call the attorney in the application by telephone and ask the attorney to come to the Office.

Registered attorneys or agents not of record in a patent application and acting in a representative capacity under 37 CFR 1.34(a) should not be telephoned for restriction requirements, approval of examiner's amendments, or given any information relative to such patent application by telephone unless the telephone number of such attorney or agent appears in a paper signed by the applicant or an attorney or agent of record.

Examiners should place all long distance telephone calls through the FTS (Federal Telecommunications System), even though collect calls may have been authorized by the attorney.

To facilitate any telephone calls that may become necessary, it is strongly recommended that amendments, letters of transmittal, and powers of attorney include the complete telephone number, with area code and extension, of the person with whom the interview should be held, preferably near the signature.

In new applications, the telephone number may appear on the letter of transmittal or in the power of attorney, oath, or declaration, next to the attorney's name and address.

SPECIFIC TELEPHONE INTERVIEW SITUATIONS

For restriction of invention, see MPEP § 812.01.

For multiplicity, see MPEP § 2173.05(n).

409 Death, Legal Incapacity, or Unavailability of Inventor

If the inventor is dead, insane, or otherwise legally incapacitated, refuses to execute an application, or cannot be found, an application may be made by someone other than the inventor, as specified in 37 CFR 1.42-1.47, and 37 CFR 1.423, MPEP § 409.01 - § 409.03(j).

A minor (under age 18) inventor may execute an oath or declaration under 37 CFR 1.63 as long as the person is competent to sign (i.e., understands the doc-

ument that he or she is signing); a legal representative is not required to execute an oath or declaration on the minor's behalf. See 37 CFR 1.63(a)(1).

409.01 Death of Inventor

Unless a power of attorney is coupled with an interest (i.e., an attorney is assignee or part-assignee), the death of the inventor (or one of the joint inventors) terminates the power of attorney given by the deceased inventor. A new power from the heirs, administrators, executors, or assignees is necessary if the deceased inventor is the sole inventor or all powers of attorney in the application have been terminated (but see MPEP § 409.01(f)). See also 37 CFR 1.422.

409.01(a) Prosecution by Administrator or Executor

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.

37 CFR 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.

One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with 37 CFR 1.42.

Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator. The heirs should identify themselves as the legal representative of the deceased inventor in the oath or declaration submitted pursuant to 37 CFR 1.63 and 1.64.

409.01(b) Proof of Authority of Administrator or Executor

The Office no longer requires proof of authority of the legal representative of a deceased or incapacitated

inventor. Although the Office does not require proof of authority to be filed, any person acting as a legal representative of a deceased or incapacitated inventor should ensure that he or she is properly acting in such a capacity.

409.01(c) After Administrator or Executor Has Been Discharged

When an administrator or executor has performed his or her functions and has been discharged and it is desired to make an application for an invention of the deceased, it is necessary for the administrator or executor to take out new letters of administration in order that he or she may file a new application for an invention of the deceased inventor.

409.01(d) Exception in Some Foreign Countries

The terms "Executor" and "Administrator" do not have exact counterparts in all foreign countries, and therefore, those terms must be construed to fit the circumstances of the case. Hence, the person or persons having authority corresponding to that of executor or administrator are permitted to make application as, for example, the heirs in the Federal Republic of Germany where no existing executor or administrator has been or will be appointed.

409.01(e) If Applicant of Assigned Application Dies

When an applicant who has prosecuted an application after assignment, dies, the administrator of the deceased applicant's estate may carry on the prosecution upon filing letters of administration unless and until the assignee intervenes (MPEP § 402.07).

409.01(f) Intervention of Executor Not Compulsory

When an inventor dies after filing an application and executing the oath or declaration required by 37 CFR 1.63, the executor or administrator should intervene, but the allowance of the application will not be withheld nor the application withdrawn from issue if the executor or administrator does not intervene.

This practice is applicable to an application which has been placed in condition for allowance or passed

to issue prior to notification of the death of the inventor. See MPEP § 409.01.

When a joint inventor of a *pro se* application dies after filing the application, the living joint inventor(s) must submit proof that the other joint inventor is dead. Upon submission of such proof, only the signatures of the living joint inventors are required on the papers filed with the USPTO if the legal representative of the deceased inventor does not intervene. If the legal representative of the deceased inventor wishes to intervene, the legal representative must submit an oath or declaration in compliance with 37 CFR 1.63 and 1.64 (e.g., stating that he or she is the legal representative of the deceased inventor and his or her residence, citizenship and post office address). Once the legal representative of the deceased inventor intervenes in the *pro se* application, the signatures of the living joint inventors and the legal representative are required on the papers filed with the USPTO.

409.02 Insanity or Other Legal Incapacity

37 CFR 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.

When an inventor dies prior to the filing of an application and prior to executing the oath or declaration required by 37 CFR 1.63 and no legal representative has been appointed, one must be appointed by a court of competent jurisdiction for the purpose of execution of the oath or declaration of the application.

409.03 Unavailability of Inventor

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.

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.

37 CFR 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).

Application papers submitted pursuant to 37 CFR 1.47 are forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions for a

determination of whether the papers are proper, complete, and acceptable under 37 CFR 1.47 and for a decision on the petition under 37 CFR 1.47 before the application is sent to the Technology Center. Since an application without an oath or declaration executed by all of the inventors may be an incomplete application, an examiner should not mail an Office action in an application without a fully executed oath or declaration under 37 CFR 1.63 unless the application has been accorded status under 37 CFR 1.47 in a written decision on the petition.

A *bona fide* attempt must be made to comply with the provisions of 37 CFR 1.47 at the time the oath or declaration is first submitted. If the oath or declaration, and evidence submitted with the oath or declaration, are not acceptable, the 37 CFR 1.47 applicant will be notified of the reasons why the papers are not acceptable. The 37 CFR 1.47 applicant may request reconsideration and file supplemental evidence in a case where a *bona fide* attempt was made to comply with 37 CFR 1.47 from the outset.

A decision granting a petition under 37 CFR 1.47 does not alter the ownership interest or title of the application. If the nonsigning inventor has not signed an assignment document which has been recorded in the USPTO, then the 37 CFR 1.47 applicant (the company that files the petition under 37 CFR 1.47(b) and establishes proprietary interest in the application) is NOT the assignee of the entire interest of the application.

409.03(a) At Least One Joint Inventor Available

37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, requires all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application."

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a) must meet the following requirements:

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP § 602, § 605.01, and § 1414) and (2) make oath or declara-

tion on behalf of the nonsigning joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

(B) The application must be accompanied by proof that the nonsigning inventor (1) cannot be found or reached after diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(C) The last known address of the nonsigning joint inventor must be stated. See MPEP § 409.03(e).

409.03(b) No Inventor Available

Filing under 37 CFR 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. These provisions allow a "person" with a demonstrated proprietary interest to make application "on behalf of and as agent for" an inventor who "cannot be found or reached after diligent effort" or who refuses to sign the application oath or declaration. The word "person" has been construed by the U.S. Patent and Trademark Office to include juristic entities, such as a corporation. Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b).

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited pursuant to 37 CFR 1.47(b) must meet the following requirements:

(A) The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An

inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

(B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

(C) The application must be accompanied by proof that the inventor (1) cannot be found or reached after a diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(D) The last known address of the inventor must be stated. See MPEP § 409.03(e).

(E) The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. See MPEP § 409.03(f).

(F) The 37 CFR 1.47(b) applicant must prove that the filing of the application is necessary (1) to preserve the rights of the parties or (2) to prevent irreparable damage. See MPEP § 409.03(g).

409.03(c) Legal Representatives of Deceased Inventor Not Available

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. *In re Application Papers Filed September 10, 1954*, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).

409.03(d) Proof of Unavailability or Refusal

INVENTOR CANNOT BE REACHED

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the

37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

409.03(e) Statement of Last Known Address

An application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor.

That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.

409.03(f) Proof of Proprietary Interest

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

(A) the invention has been assigned to the applicant, or

(B) the inventor has agreed in writing to assign the invention to the applicant, or

(C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met,

it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

409.03(g) Proof of Irreparable Damage

Irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.

409.03(h) Processing and Acceptance of a 37 CFR 1.47 Application

A filing date is assigned to an application deposited pursuant to 37 CFR 1.47 provided the requirements of 37 CFR 1.53(b) are met. A filing receipt will be sent to the applicant and the application will be forwarded

to the Office of Petitions, for consideration of the petition filed under 37 CFR 1.47.

When papers deposited pursuant to 37 CFR 1.47 are found acceptable, the Office of Petitions enters a decision to that effect in the file. A notice will be published in the *Official Gazette* identifying the application number, filing date, the title of the invention and the name(s) of the nonsigning inventor(s). The U.S. Patent and Trademark Office will notify the nonsigning inventor(s) or, if the inventor is deceased, the legal representative(s), of the filing of an application under 37 CFR 1.47 by sending a letter to the last known address of the nonsigning inventor(s) or legal representative(s). In a continuation or divisional application filed under 37 CFR 1.53(b) of an application accorded status under 37 CFR 1.47, if a copy of a declaration from a prior application and a copy of a decision according status under 37 CFR 1.47 are filed as permitted by 37 CFR 1.63(d)(3)(i), the notice will not be repeated. See 37 CFR 1.47(c). In addition, the notice is not repeated in continued prosecution applications filed under 37 CFR 1.53(d).

409.03(i) Rights of the Nonsigning Inventor

The nonsigning inventor (also referred to as an "inventor designee") may protest his or her designation as an inventor. The nonsigning inventor is entitled to inspect any paper in the application, order copies thereof at the price set forth in 37 CFR 1.19, and make his or her position of record in the file wrapper of the application. Alternatively, the nonsigning inventor may arrange to do any of the preceding through a registered patent attorney or agent.

While the U.S. Patent and Trademark Office will grant the nonsigning inventor access to the application, *inter partes* proceedings will not be instituted in 37 CFR 1.47 case. *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955). A nonsigning inventor is not entitled to a hearing (*Cogar v. Schuyler*, 464 F.2d 747, 173 USPQ 389 (D.C. Cir. 1972)), and is not entitled to prosecute the application if status under 37 CFR 1.47 has been accorded, or if proprietary interest of the 37 CFR 1.47(b) applicant has been shown to the satisfaction of the U.S. Patent and Trademark Office.

A nonsigning inventor may join in a 37 CFR 1.47 application. To join in the application, the nonsigning inventor must file an appropriate 37 CFR 1.63 oath or

declaration. Even if the nonsigning inventor joins in the application, he or she cannot revoke or give a power of attorney without agreement of the 37 CFR 1.47 applicant.

The rights of a nonsigning inventor are protected by the fact that the patent resulting from an application filed under 37 CFR 1.47(b) and 35 U.S.C. 118 must issue to the inventor, and in an application filed under 37 CFR 1.47(a) and 35 U.S.C. 116, the inventor has the same rights that he or she would have if he or she had joined in the application. *In re Hough*, 108 USPQ 89 (Comm'r Pat. 1955).

If a nonsigning inventor feels that he or she is the sole inventor of an invention claimed in a 37 CFR 1.47 application naming him or her as a joint inventor, the nonsigning inventor may file his or her own application and request that his or her application be placed in interference with the 37 CFR 1.47 application. If the claims in both the nonsigning inventor's application and the 37 CFR 1.47 application are otherwise found allowable, an interference may be declared.

409.03(j) Action Following Acceptance of a 37 CFR 1.47 Application

After an application deposited pursuant to 37 CFR 1.47 is found acceptable by the Office, the examiner will act on the application in the usual manner. Papers filed by an inventor who did not originally join in the application, and papers relating to its 37 CFR 1.47 status, will be placed in the file wrapper.

In the event the previously nonsigning inventor decides to join in the application by filing an executed oath or declaration complying with 37 CFR 1.63, the oath or declaration will be placed in the application file.

When the examiner determines that an application in which a petition under 37 CFR 1.47 has been granted, or either a continued prosecution application (CPA) filed under 37 CFR 1.53(d) or a file wrapper continuing application filed under former 37 CFR 1.62 thereof is allowable, he or she must check the file wrapper or the PALM bib-data sheet to make sure that the phrase "Rule 47" appears under the filing date. If the phrase "Rule 47" does not appear under the filing date, the examiner should write in black ink the phrase "Rule 47" under the filing date. The examiner will then prepare the application for allowance in accordance with MPEP Chapter 1300. It will not be

necessary to forward the application to the Office of Petitions.

A patent granted on an application accepted under 37 CFR 1.47 will have an indication on the face of the patent that the application was filed under 37 CFR 1.47, regardless of whether proper joinder of the previously nonsigning inventor has been made.

An application filed under 37 CFR 1.47 can be published as a Statutory Invention Registration.

410 Representations to the U.S. Patent and Trademark Office

37 CFR 1.4. Nature of correspondence and signature requirements.

(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).

37 CFR 10.18. Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

37 CFR 1.4(d)(2) provides that the presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or nonpractitioner, constitutes a certification under 37 CFR 10.18(b), and that violations of 37 CFR 10.18(b)(2) may subject the party to sanctions under 37 CFR 10.18(c). Thus, by presenting a paper to the Office, the party is making the certifications set forth in 37 CFR 10.18(b), and is subject to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b)(2), regardless of whether the party is a practitioner or nonpractitioner. A practitioner violating 37 CFR 10.18(b) may also be subject to disciplinary action in lieu of or in addition to sanctions under 37 CFR 10.18(c) for violations of 37 CFR 10.18(b).

37 CFR 10.18(b) provides that, by presenting any paper to the USPTO, the party presenting such paper is making two certifications: (1) the first certification is that the statements made therein are subject to the declaration clause of 37 CFR 1.68; (2) the second certification is the certification required for papers filed in a federal court under Rule 11(b) of the Federal Rules of Civil Procedure.

The first certification has permitted the USPTO to eliminate the separate verification requirement previously contained in 37 CFR 1.6, 1.8, 1.10, 1.27, 1.28, 1.47, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.740, 1.804, 1.805, 3.26, and 5.4 for statements of facts by persons who are not registered to practice before the USPTO. As statements submitted to the USPTO by any person are now, by operation of 37 CFR 10.18(b)(1), verified statements, a separate verification requirement is no longer necessary. The USPTO, however, has retained the verification requirement for a statement to be submitted under oath or declaration (37 CFR 1.68) in a number of sections (e.g., 37 CFR 1.63, 1.130, 1.131, 1.132, 1.494(e), 1.495(f), and 5.25).

The second certification is based upon Rule 11(b) of the Federal Rules of Civil Procedure (1993). This provision is promulgated pursuant to the Commissioner's authority under 35 U.S.C. 6(a) to establish regulations for the conduct of proceedings in the USPTO, and is intended to discourage the filing of frivolous papers by practitioners or non-practitioners in the USPTO. Rule 11(b) of the Federal Rules of Civil Procedure provides:

Representations to Court. By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, --

(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;

(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are

likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

Fed. R. Civ. P. 11(b)(1993).

37 CFR 10.18(b)(2) tracks the language of Fed. R. Civ. P. 11(b). The advisory committee notes to Fed. R. Civ. P. 11(b) provide, in part, that:

[Fed. R. Civ. P. 11(b) and (c)] restate the provisions requiring attorneys and *pro se* litigants to conduct a reasonable inquiry into the law and facts before signing pleadings, written motions, and other documents, and prescribing sanctions for violations of these obligations. The [1993] revision in part expands the responsibilities of litigants to the court, while providing greater constraints and flexibility in dealing with infractions of the rule. The rule continues to require litigants to "stop-and-think" before initially making legal or factual contentions. It also, however, emphasizes the duty of candor by subjecting litigants to potential sanctions for insisting upon a position after it is no longer tenable and by generally providing protection against sanctions if they withdraw or correct contentions after a potential violation is called to their attention.

The rule applies only to assertions contained in papers filed with or submitted to the court. It does not cover matters arising for the first time during oral presentations to the court, when counsel may make statements that would not have been made if there had been more time for study and reflection. However, a litigant's obligations with respect to the contents of these papers are not measured solely as of the time they are filed with or submitted to the court, but include reaffirming to the court and advocating positions contained in those pleadings and motions after learning that they cease to have any merit. For example, an attorney who during a pretrial conference insists on a claim or defense should be viewed as "presenting to the court" that contention and would be subject to the obligations of [Rule 11(b)] measured at that time. Similarly, if after a notice of removal is filed, a party urges in federal court the allegations of a pleading filed in state court (whether as claims, defenses, or in disputes regarding removal or remand), it would be viewed as "presenting" -- and hence certifying to the district court under Rule 11 -- those allegations.

The certification with respect to allegations and other factual contentions is revised in recognition that sometimes a litigant may have good reason to believe that a fact is true or false but may need discovery, formal or informal, from opposing parties or third persons to gather and confirm the evidentiary basis for the allegation. Tolerance of factual contentions in initial pleadings by plaintiffs or defen-

dants when specifically identified as made on information and belief does not relieve litigants from the obligation to conduct an appropriate investigation into the facts that is reasonable under the circumstances; it is not a license to join parties, make claims, or present defenses without any factual basis or justification. Moreover, if evidentiary support is not obtained after a reasonable opportunity for further investigation or discovery, the party has a duty under the rule not to persist with that contention. [Rule 11(b)] does not require a formal amendment to pleadings for which evidentiary support is not obtained, but rather calls upon a litigant not thereafter to advocate such claims or defenses.

The certification is that there is (or likely will be) "evidentiary support" for the allegation, not that the party will prevail with respect to its contention regarding the fact. That summary judgment is rendered against a party does not necessarily mean, for purposes of this certification, that it had no evidentiary support for its position. On the other hand, if a party has evidence with respect to a contention that would be sufficient to defeat a motion for summary judgment based thereon, it would have sufficient "evidentiary support" for purposes of Rule 11.

Denials of factual contentions involve somewhat different considerations. Often, of course, a denial is premised upon the existence of evidence contradicting the alleged fact. At other times a denial is permissible because, after an appropriate investigation, a party has no information concerning the matter or, indeed, has a reasonable basis for doubting the credibility of the only evidence relevant to the matter. A party should not deny an allegation it knows to be true; but it is not required, simply because it lacks contradictory evidence, to admit an allegation that it believes is not true.

The changes in [Rule 11(b)(3) and (4)] will serve to equalize the burden of the rule upon plaintiffs and defendants, who under Rule 8(b) are in effect allowed to deny allegations by stating that from their initial investigation they lack sufficient information to form a belief as to the truth of the allegation. If, after further investigation or discovery, a denial is no longer warranted, the defendant should not continue to insist on that denial. While sometimes helpful, formal amendment of the pleadings to withdraw an allegation or denial is not required by [Rule 11(b)].

Arguments for extensions, modifications, or reversals of existing law or for creation of new law do not violate [Rule 11(b)(2)] provided they are "nonfrivolous." This establishes an objective standard, intended to eliminate any "empty-head pure-heart" justification for patently frivolous arguments. However, to the extent to which a litigant has researched the issues and found some support for its theories even in minority opinions, in law review articles, or through consultation with other attorneys

should certainly be taken into account in determining whether [Rule 11(b)(2)] has been violated. Although arguments for a change in law are not required to be specifically so identified, a contention that is so identified should be viewed with greater tolerance under [Rule 11].

Amendments to the Federal Rules of Civil Procedure at 50-53 (1993), reprinted in 146 F.R.D. 401, 584-87. An "inquiry reasonable under the circumstances" requirement of 37 CFR 10.18(b)(2) is identical to that in Fed. R. Civ. P. 11(b). The Federal courts have stated in regard to the "reasonable inquiry" requirement of Fed. R. Civ. P. 11:

In requiring reasonable inquiry before the filing of any pleading in a civil case in federal district court, Rule 11 demands "an objective determination of whether a sanctioned party's conduct was reasonable under the circumstances." In effect it imposes a negligence standard, for negligence is a failure to use reasonable care. The equation between negligence and failure to conduct a reasonable precomplaint inquiry is . . . that "the amount of investigation required by Rule 11 depends on both the time available to investigate and on the probability that more investigation will turn up important evidence; the Rule does not require steps that are not cost-justified."

Hays v. Sony Corp. of Am., 847 F.2d 412, 418, 7 USPQ2d 1043, 1048 (7th Cir. 1988) (citations omitted) (decided prior to the 1993 amendment to Fed. R. Civ. P. 11, but discussing a "reasonable under the circumstances" standard).

37 CFR 1.4(d)(2) and 10.18 do not require a practitioner to advise the client (or third party) providing information of this certification effect (or the sanctions applicable to noncompliance), or question the client (or third party) when such information or instructions are provided. When a practitioner is submitting information (e.g., a statement of fact) from the applicant or a third party, or relying upon information from the applicant or a third party in his/her arguments, the Office will consider a practitioner's "inquiry reasonable under the circumstances" duty under 37 CFR 10.18 met so long as the practitioner has no knowledge of information that is contrary to the information provided by the applicant or third party or would otherwise indicate that the information provided by the applicant or third party was so provided for the purpose of a violation of 37 CFR 10.18 (e.g., was submitted to cause unnecessary delay).

Nevertheless, it is highly advisable for a practitioner to advise a client or third party that any informa-

tion so provided must be reliable and not misleading. The submission by an applicant of misleading or inaccurate statements of facts during the prosecution of applications for patent has resulted in the patents issuing on such applications being held unenforceable. See, e.g., *Refac Int'l Ltd. v. Lotus Development Corp.*, 81 F.3d 1576, 38 USPQ2d 1665 (Fed. Cir. 1996); *Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc.*, 984 F.2d 1182, 25 USPQ2d 1561 (Fed. Cir. 1993); *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 200 USPQ 289 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Ott v. Goodpasture*, 40 USPQ2d 1831 (D.N. Tex. 1996); *Herman v. William Brooks Shoe Co.*, 39 USPQ2d 1773 (S.D.N.Y. 1996); *Golden Valley Microwave Food Inc. v. Weaver Popcorn Co.*, 837 F. Supp. 1444, 24 USPQ2d 1801 (N.D. Ind. 1992), *aff'd*, 11 F.3d 1072 (Fed. Cir. 1993)(table), *cert. denied*, 511 U.S. 1128 (1994). Likewise, false statements by a practitioner in a paper submitted to the Office during the prosecution of an application for patent have resulted in the patent issuing on such application also being held unenforceable. See *General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 30 USPQ2d 1149 (Fed. Cir. 1994)(false statement in a petition to make an application special constitutes inequitable conduct, and renders the patent issuing on such application unenforceable).

An applicant has no duty to conduct a prior art search as a prerequisite to filing an application for patent. See *Nordberg, Inc. v. Telsmith, Inc.*, 82 F.3d 394, 397, 38 USPQ2d 1593, 1595-96 (Fed. Cir. 1996); *FMC Corp. v. Hennessy Indus., Inc.*, 836 F.2d 521, 526 n.6, 5 USPQ2d 1272, 1275-76 n.6 (Fed. Cir. 1987); *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411, 1415, 5 USPQ2d 1112, 1115 (Fed. Cir. 1987); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1362, 220 USPQ 763, 772 (Fed. Cir.), *cert. denied*, 469 U.S. 821, 224 USPQ 520 (1984). Thus, the "inquiry reasonable under the circumstances" requirement of 37 CFR 10.18 does not create any new duty on the part of an applicant for patent to conduct a prior art search. See MPEP § 609; cf. *Judin v. United States*, 110 F.3d 780, 42 USPQ2d 1300 (Fed. Cir. 1997)(the failure to obtain and examine the accused infringing device prior to bringing a civil action for infringement violates the 1983 version of Fed. R. Civ. P. 11). The "inquiry reasonable under the circum-

stances" requirement of 37 CFR 10.18, however, will require an inquiry into the underlying facts and circumstances when a practitioner provides conclusive statements to the Office (e.g., a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional).

37 CFR 10.18(c) specifically provides that violations of 37 CFR 10.18(b)(1) may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom, and that violations of any of 37 CFR 10.18(b)(2)(i) through (iv) are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of:

- (A) holding certain facts to have been established;
- (B) returning papers;
- (C) precluding a party from filing a paper, or presenting or contesting an issue;
- (D) imposing a monetary sanction;
- (E) requiring a terminal disclaimer for the period of the delay; or
- (F) terminating the proceedings in the U.S. Patent and Trademark Office.

The Office has amended 37 CFR 1.4(d)(2) and 10.18 with the objective of discouraging the filing of frivolous or clearly unwarranted correspondence in the Office, not to routinely review correspondence for compliance with 37 CFR 10.18(b)(2) and impose sanctions under 37 CFR 10.18(c).

Where the circumstances of an application or other proceeding warrant a determination of whether there has been a violation of 37 CFR 10.18(b), the file or the application or other proceeding will be forwarded to the Office of Enrollment and Discipline (OED) for a determination of whether there has been a violation of 37 CFR 10.18(b). In the event that OED determines that a provision of 37 CFR 10.18(b) has been violated, the Commissioner, or the Commissioner's designee, will determine what (if any) sanction(s) under 37 CFR 10.18(c) is to be imposed in the application or other proceeding. In addition, if OED determines that a provision of 37 CFR 10.18(b) has been violated by a practitioner, OED will determine whether such practi-

tioner is to be subject to disciplinary action (see 37 CFR 1.4(d)(2) and 10.18(d)). That is, OED will provide a determination of whether there has been a violation of 37 CFR 10.18(b), and if such violation is by a practitioner, whether such practitioner is to be subject to disciplinary action; however, OED will not be responsible for imposing sanctions under 37 CFR 10.18(c) in an application or other proceeding.

37 CFR 10.18(d) provides that any practitioner violating the provisions of this section may also be subject to disciplinary action. 37 CFR 10.18(d) (and the corresponding provision of 37 CFR 1.4(d)(2)) clarifies that a practitioner may be subject to disciplinary action in lieu of, or in addition to, the sanctions set forth in 37 CFR 10.18(c) for violations of 37 CFR 10.18.



MANUAL OF PATENT EXAMINING PROCEDURE

1. The Manual of Patent Examining Procedure (MPEP) is a guide for patent examiners and applicants. It provides detailed instructions on the procedures for examining patent applications, including the requirements for filing, the examination process, and the various types of patent applications. The MPEP is published by the United States Patent and Trademark Office (USPTO) and is available to the public.

2. The MPEP is organized into several parts, each covering a different aspect of the patenting process. Part 1 covers the general requirements for filing a patent application, including the necessary documents and fees. Part 2 covers the examination process, including the search and examination of the application. Part 3 covers the various types of patent applications, including utility, design, and provisional applications. Part 4 covers the procedures for appealing a patent examiner's decision.

3. The MPEP is a constantly evolving document, as the USPTO updates its procedures and requirements over time. It is important for patent examiners and applicants to stay up-to-date with the latest version of the MPEP to ensure compliance with the current rules and regulations.

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501 Papers Received by Office of Initial Patent Examination

37 CFR 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, D.C. 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, D.C. 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, D.C. 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."

37 CFR 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.

In addition to the Office of the Solicitor, as specified in 37 CFR 1.1(a)(3), the Office will now have three separate addresses. The addresses are as follows.

I. FOR PATENT APPLICATIONS AND PATENT-RELATED PAPERS

Correspondence in patent-related matters under the direction of the Assistant Commissioner for Patents should be addressed to:

Assistant Commissioner for Patents
Washington, DC 20231

Such correspondence includes: patent applications, replies to notices of informality, requests for extension of time, notices of appeal to the Board of Patent

Appeals and Interferences (the Board), briefs in support of an appeal to the Board, requests for oral hearing before the Board, extensions of term of patent, requests for publication of Statutory Invention Registration (SIR), requests for reexamination, statutory disclaimers, certificates of correction, petitions to the Assistant Commissioner for Patents, submission of information disclosure statements, petitions to institute a public use proceeding, petitions to revive abandoned patent applications, and other correspondence related to patent applications and patents which is processed by organizations reporting to the Assistant Commissioner for Patents.

II. FOR TRADEMARK APPLICATIONS AND TRADEMARK-RELATED PAPERS

Correspondence in trademark-related matters under the direction of the Assistant Commissioner for Trademarks should be addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Such correspondence includes all trademark applications and other trademark-related mail, except for trademark documents sent to the Assignment Division for recordation, requests for certified and uncertified copies of trademark documents, and filings submitted electronically. See 37 CFR 1.1(a)(2).

III. FOR ALL OTHER CORRESPONDENCE

Unless otherwise specified, correspondence that does not fall into one of the categories designated above should be addressed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Such correspondence includes: communications with the Board of Patent Appeals and Interferences after jurisdiction of the application has been transferred to the Board, patent services including patent copy sales, assignments, library services, requests for lists of patents and SIRs in a subclass, requests for the status of maintenance fee payments, as well as patent practitioner enrollment matters including admission to examination, registration to practice, certificates of

good standing, and financial service matters including establishing a deposit account.

All correspondence with the USPTO, except for communications relating to pending litigation and certain disciplinary proceedings as specified in 37 CFR 1.1(a)(3), may continue to be filed directly at the Customer Service Window located in Room 1B03 of Crystal Plaza 2, 2011 South Clark Place, Arlington, VA.

Trademark-related papers may also be filed at the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, VA. Hand delivery of trademark papers and fees directly to the South Tower Building will expedite processing.

As provided in 37 CFR 1.4(c), matters that are to be considered by different branches or sections of the USPTO must be contained in separate papers. The following form paragraph may be used to notify the applicant of this requirement when the applicant has filed a single paper containing distinct subjects, inquiries, or orders.

¶ 5.01.01 Separate Paper Required

The [1] submitted [2] should have been submitted as a separate paper as required by 37 CFR 1.4(c). The paper has been entered. However, all future correspondence must comply with 37 CFR 1.4.

Examiner Note:

1. In bracket 1, indicate the item required to be separately submitted, such as an affidavit, petition, or other appropriate document.
2. If the applicant is a *pro se* inventor, include a copy of the rule.

Those who correspond with the USPTO are strongly encouraged not to include correspondence which will have to be directed to different areas (e.g., Patents and Trademarks) of the Office in a single envelope. Including multiple papers in a single envelope increases the likelihood that one or more of the papers will be delayed before reaching the appropriate area. Placing the papers in separately addressed envelopes will reduce the number of actions being performed by the USPTO unnecessarily or inappropriately. At the present time, use of the wrong mailing address will not affect the filing date assigned to any application or correspondence received in the USPTO, except as specified in 37 CFR 1.1(a)(3)(iv).

Except for certain mail addressed incorrectly to the Office of the Solicitor, there will be no penalty for addressing a document to the wrong area within the Office, as long as one of the approved addresses is used. Use of the specific addresses listed within 37 CFR 1.1 is strongly encouraged because it will facilitate the process both for the Office and the filer. Accordingly, a new application incorrectly addressed to the Commissioner will be treated the same as if the application was addressed to the specific Assistant Commissioner.

All mailed communications are received by the Incoming-Mail Section of the Office of Initial Patent Examination (OIPE), which opens and distributes all official mail.

Special boxes have been established to allow the forwarding of particular types of mail to appropriate areas of the Office as quickly as possible. A list of these boxes is published weekly in the *Official Gazette*. Only the specified type of document for a particular box should be placed in an envelope addressed to that box.

If any documents other than the specified type identified for each department are addressed to that department, they will be significantly delayed in reaching the appropriate area for which they were intended.

502 Depositing Correspondence

37 CFR 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.

37 CFR 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.

All applications (provisional and nonprovisional) may be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), or they may be deposited in the Office of Initial Patent Examination (OIPE). A continued prosecution application (CPA) filed under 37 CFR 1.53(d), amendments, and other papers may be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), by facsimile (see MPEP § 502.01) or deposited in OIPE. Any correspondence sent to the U.S. Patent and Trademark Office should include the sender's return address and ZIP Code designation.

All correspondence with the Office, except for communications relating to pending litigation and certain disciplinary proceedings as specified in 37 CFR 1.1(a)(3), may be filed directly at the Customer

Service Window at the following address, or delivered by private courier to:

Assistant Commissioner for Patents
[or Commissioner of Patents and Trademarks
or Assistant Commissioner for Trademarks]
USPTO Office of Initial Patent Examination
Crystal Plaza Building 2, Room 1B03
2011 South Clark Place
Arlington, VA 22202

Trademark-related papers may also be filed or delivered by private courier to the "walk-up" window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, VA. Hand delivery of trademark papers and fees directly to the South Tower Building is recommended, to expedite processing.

All correspondence related to a national patent application already filed with the U.S. Patent and Trademark Office must include the identification of the application number or the serial number and the filing date assigned to the application by the Office. Any correspondence not containing the proper identification set forth in 37 CFR 1.5(a) must be sent by the Technology Center (TC) with a signed note to OIPE for return to the sender. Each paper should be inspected to assure that the papers being returned contain either an "Office Date" stamp or a TC date stamp. A minor error in the identification of the application can be corrected by the group provided the correct identification can be quickly discovered. Examples of minor errors are transposed numbers, typographical errors, and listing the parent application number. The failure to give any application number is not a minor error. The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, petitions for extension of time, and other petitions.

Frequently, there are errors in the application number or in the art unit number, or the incoming paper uses the old art unit number where an application has been transferred and acted on by a different art unit.

Where the art unit number is entirely omitted, the routine operations of OIPE must be interrupted solely for the purpose of determining the location of the

application so that the communication can be properly routed. Under these circumstances, the efficiency of OIPE is impaired and the incoming paper is delayed in reaching its proper destination. Where such papers are not essential to compliance with a statutory period or time limit for reply, they may be returned for completion to identify the location of the files.

It would be of great assistance to the Office if *all* incoming papers pertaining to a filed application carried the following items:

- (A) Application number (checked for accuracy, including series code and serial no.).
- (B) Art Unit number (copied from most recent Office communication).
- (C) Filing date.
- (D) Name of the examiner who prepared the most recent Office action.
- (E) Title of invention.
- (F) Confirmation number (see MPEP § 503).

Applicants may be reminded of this provision by including form paragraph 5.01.

¶ 5.01 Proper Heading for Incoming Papers

It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Application number (checked for accuracy, including series code and serial no.).
2. Art Unit number (copied from most recent Office communication).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.
6. Confirmation number (see MPEP § 503).

The Office prefers identifying indicia to be provided on the drawings. If such identifying indicia is provided, it must be placed on the front of each sheet of drawings and centered within the top margin. See 37 CFR 1.84(c). The identifying indicia should include the title of the invention, inventor's name, application number, and confirmation number (see MPEP § 503). If the Office has not yet assigned an application number and confirmation number to the application, the docket number (if any) used by the applicant to track the application should be provided.

When the Office receives formal or substitute drawings for patent applications after the application has been filed, a cover letter identifying the drawings

by application number should accompany them. The application number and other identifying indicia should be placed on each sheet of drawings in accordance with 37 CFR 1.84(c).

It is requested that the submission of additional or supplemental papers on a newly filed application be deferred until an application number has been received. It also would be appreciated if the filing of additional papers relating to an allowed application were deferred until a Notice of Allowance (PTOL-85) is received.

Documents which have no particular time or sequence requirements should be filed in the Office with materials submitted in reply to the statutory or regulatory requirements. Examples are certified copies of foreign documents to support priority in patent applications, changes of power of attorney, or changes in mailing address following first action.

All letters relating to a reexamination proceeding should identify the proceeding involved by patent number and reexamination request control number.

POST ALLOWANCE CORRESPONDENCE

All post allowance correspondence, except for petitions under 37 CFR 1.313(c), should be submitted with the mailing address label provided with the PTOL-85, "Notice of Allowance and Issue Fee Due", or be addressed "Box Issue Fee." Any petition filed under 37 CFR 1.313(c) to withdraw an application from issue after payment of the issue fee should be clearly marked "Petition under 37 CFR 1.313(c)" and be either hand-carried or submitted by facsimile to the Office of Petitions. See MPEP § 1730 for the phone and facsimile numbers for the Office of Petitions.

Any paper filed after receiving the Issue Notification should include the indicated patent number.

Since an allowed application will be issued as a patent within about twelve weeks of payment of the issue fee, all post allowance correspondence should be filed prior to the date of issue fee payment to ensure the papers reach the appropriate USPTO official for consideration before the date the application issues as a patent.

If the above suggestions are adopted, the processing of both new and allowed applications could proceed more efficiently and promptly through the U.S. Patent and Trademark Office.

HAND-DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to a TC. However, the TC will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the TC being asked to receive the paper is responsible for acting on the paper. Only CPAs filed under 37 CFR 1.53(d) may be delivered in person to the TCs. All other patent applications may be delivered in person addressed to the Assistant Commissioner for Patents, USPTO Office of Initial Patent Examination, Crystal Plaza Building 2, Room 1B03, 2011 South Clark Place, Arlington, VA 22202, but not to the TCs.

The receipt accompanying a hand-delivered paper may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), application number, the filing date, and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the TC date stamp. TC personnel receiving a paper will check it against the receipt to make sure that the paper is accurately described on the receipt and that the receipt does not list papers which are not being filed. The receipt will be handed back to the person handdelivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the TC via the Mail Center.

The TC will accept and date stamp a paper, other than an application which is not a CPA, even though the paper is accompanied by a check or the paper contains an authorization to charge a deposit account or a credit card. However, in such instances, the paper will be hand-carried by TC personnel to the Office of Finance for processing and then made an official paper in the file, with the exception of a Credit Card Payment Form (PTO-2038), which is not made of record in the file. See MPEP § 509.

All such papers, together with the cash, checks, Credit Card Payment Forms (PTO-2038) or money orders, shall be hand-carried to the Customer Service

Window, Crystal Plaza Building 2, Room 1B03, 2011 South Clark Dr., Arlington, VA 22202.

“EXPRESS MAIL” SERVICE

There are two types of “Express Mail” delivery offered by the U.S. Postal Service — “Post Office to Addressee” and “Post Office to Post Office.” The only type of service which can be used for “Express Mail” directed to the U.S. Patent and Trademark Office is the “Post Office to Addressee” service of the U.S. Postal Service. 37 CFR 1.10. This service provides for the use of a mailing label which clearly indicates the date on which a particular paper or fee was deposited.

The addresses that should be used for “Express Mail” sent to the U.S. Patent and Trademark Office are set forth in 37 CFR 1.1 (see MPEP § 501).

“Post Office to Post Office” Express Mail *does not* provide for delivery but instead is retained at the postal facility of the addressee for pickup. The Postal Service *does not* notify the addressee that this type of Express Mail has been received and is awaiting pickup. If not picked up, this mail is held for 15 days and then returned to the sender.

Therefore, since the U.S. Patent and Trademark Office does not have resources for picking up any mail, including Express Mail, the “Post Office to Post Office” Express Mail will not reach the U.S. Patent and Trademark Office.

See MPEP § 513 for the use of the Express Mail Mailing procedure of 37 CFR 1.10.

502.01 Correspondence Transmitted by Facsimile

37 CFR 1.6. Receipt of 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.

The date of receipt accorded to any correspondence permitted to be sent by facsimile transmission, including a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or Federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or Federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia. For example, a facsimile transmission to the Office from California starting on a Friday at 8:45 p.m. Pacific time and taking 20 minutes, would be completed at 9:05 p.m. Pacific time. The complete transmission would be received in the Office around 12:05 a.m. Eastern time on Saturday. The receipt date accorded to the correspondence is the date of the following business day, which in this case, would be Monday (assuming that Monday was not a Federal holiday within the District of Columbia).

Note however, that if the Certificate of Transmission is available (for documents not proscribed by 37 CFR 1.8(a)(2)), then the above facsimile may be considered timely filed on Friday if it contains a Certificate of Transmission and is in compliance with 37 CFR 1.8(a)(1)(i)(B) and (ii).

37 CFR 1.6(d) specifies the types of correspondence which may be transmitted by facsimile. These would include CPAs filed under 37 CFR 1.53(d), amendments, declarations, petitions, issue fee transmittals and authorizations to charge deposit accounts. The situations where transmissions by facsimile are prohibited are identified in 37 CFR 1.6(d)(1)-(9). Prohibitions cover situations where originals are required as specified in 37 CFR 1.4(e) and (f), and situations where accepting a facsimile transmission would be unduly burdensome on the Office. As a courtesy, the Office will attempt to notify senders whenever correspondence is sent to the Office by facsimile transmission that falls within one of these prohibitions. Senders are cautioned against submitting correspondence by facsimile transmission which is not permitted under 37 CFR 1.6(d) since such correspondence will not be accorded a receipt date.

An applicant filing a CPA by facsimile transmission must include an authorization to charge the basic filing fee to a deposit account or to a credit card, or the application will be treated under 37 CFR 1.53(f) as having been filed without the basic filing fee (as fees cannot otherwise be transmitted by facsimile).

There is a special receipt procedure for filing a CPA by fax, whereby the Office will fax back a receipt of the CPA filing if applicant submits the Office receipt form along with the CPA filing.

37 CFR 1.6. Receipt of correspondence.

(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.

37 CFR 1.6(f) provides for the situation in which the Office has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. 37 CFR 1.6(f) requires a petition be filed requesting that the CPA be accorded a filing date as of the date the CPA is shown to have been transmitted to and received in the Office. The showing must include, *inter alia*, a copy of the sending unit's report confirming transmission of the application or evidence that came into being after the complete transmission of the application and within one business day of the complete transmission of the application.

The following list itemizes types of correspondence which *may not* be filed by facsimile transmission, and, if submitted by facsimile, will not be accorded a date of receipt:

CORRESPONDENCE RELATIVE TO PATENTS AND PATENT APPLICATIONS WHERE FILING BY FACSIMILE TRANSMISSION IS NOT PERMITTED

(A) A document that is required by statute to be certified;

(B) A national patent application specification and drawing (provisional or nonprovisional) or other correspondence for the purpose of obtaining an application filing date, other than a continued prosecution application filed under 37 CFR 1.53(d);

(C) Drawings submitted under 37 CFR 1.81, 1.83-1.85, 1.152, 1.165, 1.174, or 1.437;

(D) Correspondence in an interference which an Administrative Patent Judge orders to be filed by hand or "Express Mail";

(E) Agreements between parties to an interference under 35 U.S.C. 135(c);

(F) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under 37 CFR 1.621; a transcript of a deposition under 37 CFR 1.676; or of interrogatories, or cross-interrogatories, or an evidentiary record and exhibits under 37 CFR 1.653;

(G) Correspondence to be filed in a patent application subject to a secrecy order under 37 CFR 5.1-5.5 and directly related to the secrecy order content of the application;

(H) An international application for patent;

(I) A copy of the international application and the basic national fee necessary to enter the national stage, as specified in 37 CFR 1.494(b) or 37 CFR 1.495(b);

(J) A request for reexamination under 37 CFR 1.510 or 37 CFR 1.913.

Under 37 CFR 1.6(d)(4), drawings submitted under 37 CFR 1.81, 37 CFR 1.81, 1.83-1.85, 1.152, 1.165, 1.174, or 1.437 may not be filed by facsimile transmission in patent applications. However, applicants may submit by facsimile transmission proposed drawing corrections for approval by the Office.

See MPEP § 1834.01 for a discussion concerning facsimile transmissions in PCT applications.

502.02 Correspondence Signature Requirements

37 CFR 1.4. Nature of correspondence and signature requirements.

(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.

Correspondence filed in the Office, which requires a person's signature, may be an original, or a copy thereof. The word original, as used herein, is defined as correspondence which is personally signed in permanent ink by the person whose signature appears thereon. Where copies of correspondence are acceptable, photocopies or facsimile transmissions may be filed. For example, a photocopy or facsimile transmission of an original of an amendment, declaration (e.g., under 37 CFR 1.63 or 1.67), petition, issue fee transmittal form, authorization to charge a deposit account or a credit card, may be submitted in a patent application. Where copies are permitted, second and further generation copies (i.e., copy of a copy) are acceptable. For example, a client may fax a paper to an attorney and the attorney may then fax the paper to the Office, provided the paper is eligible to be faxed (see MPEP § 502.01). The original, if not submitted to the Office, should be retained as evidence of proper execution in the event that questions arise as to the authenticity of the signature reproduced on the photocopy or facsimile-transmitted correspondence. If a question of authenticity arises, the Office may require submission of the original.

When a document that is required by statute to be certified must be filed (such as a certified copy of a foreign patent application pursuant to 35 U.S.C. 119 or a certified copy of an international application pursuant to 35 U.S.C. 365) a copy of the certification, including a photocopy or facsimile transmission, will not be acceptable. The requirement for an original certification does not apply to certifications such as

required under 37 CFR 1.8 since these certifications are not required by statute.

502.03 Communications via the Internet

The Office published a Patent Internet Usage Policy to

(A) establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the USPTO,

(B) address use of the Internet to conduct interview-like communications and other forms of formal and informal communications,

(C) publish guidelines for locating, retrieving, citing, and properly documenting scientific and technical information sources on the Internet,

(D) inform the public how the USPTO intends to use the Internet, and

(E) establish a flexible Internet policy framework which can be modified, enhanced, and corrected as the USPTO, the public, and customers learn to use, and subsequently integrate, new and emerging Internet technology into existing business infrastructures and everyday activities to improve the patent application, examining, and granting functions.

See *Internet Usage Policy*, 64 F.R. 33056 (June 21, 1999). The Articles of the Patent Internet Usage Policy pertinent to communications via electronic mail are summarized below. See MPEP § 904.02(c) for information pertinent to Internet searching, and MPEP § 707.05(e) for information pertaining to the citation of electronic documents. See also MPEP § 713.04 for recordation of e-mail interviews.

CONFIDENTIALITY OF PROPRIETARY INFORMATION (ARTICLE 4)

If security and confidentiality cannot be attained for a specific use, transaction, or activity, then that specific use, transaction, or activity shall NOT be undertaken/conducted.

All use of the Internet by Patent Organization employees, contractors, and consultants shall be conducted in a manner that ensures compliance with confidentiality requirements in statutes, including 35 U.S.C. 122, and regulations. Where a written authorization is given by the applicant for the USPTO to

communicate with the applicant via Internet e-mail, communications via Internet e-mail may be used.

Backup, archiving, and recovery of information sent or received via the Internet is the responsibility of individual users. The OCIO does not, and will not, as a normal practice, provide backup and recovery services for information produced, retrieved, stored, or transmitted to/from the Internet.

COMMUNICATIONS VIA THE INTERNET AND AUTHORIZATION (ARTICLE 5)

Communications via Internet e-mail are at the discretion of the applicant.

Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application.

The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

A written authorization may be withdrawn by filing a signed paper clearly identifying the original authorization. The following is a sample form which may be used by applicant to withdraw the authorization:

"The authorization given on _____, to the USPTO to communicate with me via the Internet is hereby withdrawn. I understand that the withdrawal is effective when approved rather than when received."

Where a written authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used. In such case, a printed copy of the Internet e-mail communications MUST be given a paper number, entered into the Patent Application Locating and Monitoring System (PALM) and entered in the patent application file. A reply to an Office action may NOT be communicated by applicant to the USPTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a

paper copy will be placed in the appropriate patent application file with an indication that the reply is NOT ENTERED.

USPTO employees are NOT permitted to initiate communications with applicants via Internet e-mail unless there is a written authorization of record in the patent application by the applicant.

All reissue applications are open to public inspection under 37 CFR 1.11(a) and all papers relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to public inspection under 37 CFR 1.11(d). USPTO employees are NOT permitted to initiate communications with applicant in a reissue application or a patentee of a reexamination proceeding via Internet e-mail unless written authorization is given by the applicant or patentee.

AUTHENTICATION OF SENDER BY A PATENT ORGANIZATION RECIPIENT (ARTICLE 6)

The misrepresentation of a sender's identity (i.e., spoofing) is a known risk when using electronic communications. Therefore, Patent Organization users have an obligation to be aware of this risk and conduct their Internet activities in compliance with established procedures.

Internet e-mail must be initiated by a registered practitioner, or an applicant in a pro se application, and sufficient information must be provided to show representative capacity in compliance with 37 CFR 1.34. Examples of such information include the attorney registration number, attorney docket number, and patent application number.

USE OF ELECTRONIC MAIL SERVICES (ARTICLE 7)

Once e-mail correspondence has been received from the applicant, as set forth in Patent Internet Usage Policy Article 4, such correspondence must be responded to appropriately. The Patent Examiner may respond to an applicant's e-mail correspondence by telephone, fax, or other appropriate means.

INTERVIEWS (ARTICLE 8)

Internet e-mail shall NOT be used to conduct an exchange of communications similar to those exchanged during telephone or personal interviews

unless a written authorization has been given under Patent Internet Usage Policy Article 5 to use Internet e-mail. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file, as required by the Federal Records Act, in the same manner as an Examiner Interview Summary Form is entered.

POLICY GUIDANCE AND CLARIFICATIONS (ARTICLE 13)

Within the Patent Organization, any questions regarding Internet usage policy should be directed to the user's immediate supervisor. Non-USPTO personnel should direct their questions to the Office of the Deputy Commissioner for Patent Examination Policy.

502.04 Duplicate copies of Correspondence

37 CFR 1.4. Nature of correspondence and signature requirements.

(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.

When the Office does not require duplicate copies of a paper, the filing of multiple copies may cause a delay in processing by the Office. Accordingly, the Office may discard duplicate copies of correspondence filed in an application or patent file.

503 Application Number and Filing Receipt

37 CFR 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).

Application numbers consisting of a series code and a serial number are assigned by the Office of Initial Patent Examination (OIPE) immediately after mail has been opened.

The following series codes are assigned to the applications identified below:

(A) 01/ - 09/ - for nonprovisional applications (utility, plant, and reissue),

- The 01 series code was used from year 1925 to 1934,

02 - 1935 to 1947,

03 - 1948 to 1959,

04 - 1960 to 1969,

05 - 1970 to 1978,

06 - 1979 to 1986,

07 - 1987 to 1992,

08 - 1993 to 1997, and

09 - 1998 to present;

(B) 29/ - for design applications;

(C) 60/ - for provisional applications; and

(D) 90/ - for reexamination proceedings.

If a self-addressed postcard is submitted with a patent application, that postcard will be provided with both the receipt date and application number prior to returning it to the addressee. The application number identified on such a postcard receipt is merely the preliminary assignment of an application number to the application, and should not be relied upon (e.g., with respect to foreign filings) as necessarily representing the application number assigned to such application. See 37 CFR 1.53(b).

The identifying data on the postcard should include:

(A) applicant's name(s);

(B) title of invention;

(C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawing;

(D) whether oath or declaration is included;

(E) a list of any additional forms included with the application (e.g., application transmittal form, application data sheet, fee transmittal form, and/or provisional application cover sheet); and

(F) amount and manner of paying the fee.

A return postcard should be attached to *each* patent application for which a receipt is desired.

It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).

It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 CFR 1.53(a)).

OIPE mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each application filed which meets the minimum requirements to receive a filing date. The filing receipt includes the application number, filing date, a confirmation number, a suggested class in the U.S. Patent Classification System (see MPEP § 902.01), and the number of an art unit where the application is likely to be examined. The filing receipt also includes other information about the application as applicable, such as continuing data, national stage data, foreign priority data, foreign filing license data, entity status information, and the date the Office anticipates publishing the application under 35 U.S.C. 122(b). The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). The application number officially assigned to an application on the filing receipt may differ from the application number identified on a postcard receipt submitted with such application, and, as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is controlling.

The confirmation number is a four-digit number that is assigned to each newly filed application. The confirmation number, in combination with the application number, is used to verify the accuracy of the application number placed on correspondence filed with the Office to avoid misidentification of an application due to a transposition error in the application number. The confirmation number may be found in the upper left-hand corner of the filing receipt. The confirmation number will also be available through the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>). The Office eventually plans to include the application's confirmation number (in addition to the application number) on all Office actions and notices concerning

the application. The confirmation number must be used when submitting an electronic filing system (EFS) copy of the application for publication to verify that the application number correctly identifies the application for which a copy is being submitted for publication. The Office also recommends that applicants include the application's confirmation number (in addition to the application number) on all correspondence submitted to the Office concerning the application.

A continued prosecution application (CPA) filed under 37 CFR 1.53(d) will be assigned the application number of the prior application for identification purposes.

A nonprovisional application, other than a CPA filed under 37 CFR 1.53(d), is entitled to a filing date as of the date of receipt of the specification, including claims, and any required drawing. See 37 CFR 1.53(b). The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. The oath or declaration and filing fee may be filed later than the remaining application papers, but if so, they must be accompanied by the required surcharge. See 37 CFR 1.53(f). If the oath or declaration, and/or filing fee, and appropriate surcharge are not timely filed, the application will be abandoned.

A provisional application is entitled to a filing date as of the date of receipt of the specification and any required drawing(s). See 37 CFR 1.53(c). A cover sheet (37 CFR 1.51(c)(1)), which may be an application data sheet (37 CFR 1.76) or a cover letter, identifying the application as a provisional application is required to prevent the provisional application from being treated as a nonprovisional application. 37 CFR 1.53(c)(1).

Each application which meets the minimum requirements to receive a filing date is given a filing date. It is important, when referring to application files, to identify them by their filing dates and confirmation numbers as well as by application numbers.

Attorney docket numbers must be limited to a maximum of 12 characters to prevent truncation. The Patent Application Locating and Monitoring (PALM) system data base allows a maximum of 12 characters for the attorney docket numbers. Spaces, slashes, and hyphens will no longer be included in the entered docket number on the official filing receipt. In an

application where CASE or NAVY-CASE appears before the first character in the docket number, only the characters after CASE or NAVY-CASE will be entered on the official filing receipt.

The application papers are placed in a file wrapper and certain data placed thereon by OIPE.

Applications which are entitled to a filing date and are filed, whether by regular mail or "Express Mail" under 37 CFR 1.10, by hand-delivery or otherwise, will not be returned to applicant even if requested. See 37 CFR 1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed, e.g., duplicates of applications already filed. Since 37 CFR 1.26(a) precludes refund of an application filing fee when applicant desires to withdraw an application, any request by applicant not to process or charge an application filing fee because the application was not intended to be filed must be in the form of a petition under 37 CFR 1.183 requesting suspension of the rules to the extent that the filing fee not be processed or charged. Any such petition must include the fee set forth in 37 CFR 1.17(h) and must be accompanied by an express abandonment of the application in accordance with 37 CFR 1.138. In order for such a petition to be granted, it must ordinarily be filed and acted upon prior to the date on which the application filing fee is processed or charged by the Office with regard to the application.

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment,

notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

504 Assignment of Application for Examination

The Office of Initial Patent Examination assigns a nonprovisional application to the art unit to which it appears to belong. Provisional applications will not be examined.

505 "Office Date" Stamp of Receipt

37 CFR 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.

The United States Patent and Trademark Office (Office) stamps papers and fees with the date of their receipt in the Office. The stamp is referred to as the "Office Date" stamp.

When the last day for taking any action or paying any fee in the Office falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the action or the fee is considered timely if the action is taken or the fee is paid on the next succeeding business day.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day 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. See also 37 CFR 1.7(b). 35 U.S.C.

119(e)(3) as amended by Public Law 106-113 applies to any provisional application filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

New patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

If an application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP § 506), the "Office Date" stamp establishes the "filing date." Applications will not be accepted and stamped in the Technology Centers. They must be date stamped in the Mail Room.

506 Completeness of Original Application

37 CFR 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).

INCOMPLETE NONPROVISIONAL APPLICATIONS FILED UNDER 37 CFR 1.53(b)

If the nonprovisional application papers filed under 37 CFR 1.53(b) do not include at least a specification containing a description and at least one claim and a drawing, if necessary under 35 U.S.C. 113 (first sentence), or if the submitted application papers are too informal to be given a filing date, the case is held in the Office of Initial Patent Examination (OIPE) as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

A Notice of Incomplete Application is prepared and mailed by OIPE when nonprovisional application papers filed under 37 CFR 1.53(b) are deemed incomplete under 35 U.S.C. 111(a).

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of a nonprovisional application filed under 37 CFR 1.53(b) necessary to obtain a filing date are:

A specification as prescribed by 35 U.S.C. 112 and 37 CFR 1.71.

A claim as prescribed by 35 U.S.C. 112 and 37 CFR 1.75.

A drawing, if necessary under 35 U.S.C. 113 (first sentence) and 37 CFR 1.81(a).

See 37 CFR 1.53(b).

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts fail to satisfy the requirements set forth above.

For example, if the documents purporting to be a specification are so obviously informal and incoherent that they clearly do not constitute a specification as required by 35 U.S.C. 112 and 37 CFR 1.71, the application is not acceptable for examination and it will not be accorded a filing date until corrections are made. The filing date of the application will be the date the corrections are made.

Filing dates are accorded to nonprovisional applications filed under 37 CFR 1.53(b) submitted without the names of all the inventors, the basic filing fee and/or the oath or declaration. In such cases, a notice is mailed by OIPE requiring that at least the basic filing fee and the oath or declaration (which must include the names of all the inventors) be filed, accompanied by a surcharge (37 CFR 1.16(e)). In addition to the basic filing fee required under 37 CFR 1.16(a), the prescribed filing fee (37 CFR 1.51(b)(4)) may include additional fees for filing more than 3 independent claims (37 CFR 1.16(b)), for filing a total of more than 20 claims (37 CFR 1.16(c)), or for filing a multiple dependent claim (37 CFR 1.16(d)). In those cases where the basic filing fee is paid, but additional fees are required, under 37 CFR 1.16, a notice is mailed by the Technology Center (TC), requiring that the balance of the prescribed fee be paid.

Occasionally, nonprovisional applications filed under 37 CFR 1.53(b) which have already been signed by the inventors contain informal claims that the attorney or agent feels should not be present in the application upon filing. However, since alteration after execution by the inventor and before filing is prohibited, such applications must be filed by the attorney or agent in the form in which they were executed by the inventors. A nonprovisional application filed under 37 CFR 1.53(b) may be filed with a preliminary amendment which is limited to the cancellation of claims. This will diminish the number of claims to be considered for calculation of the filing fee. Any other changes to the application should be the subject of a separate amendment which may be entered after the filing fee has been calculated and the filing date granted. If a preliminary amendment which cancels claims does not accompany the application at the time the application is filed, the notification of insufficient fee will inform the inventor, attorney, or agent of the possibility of correcting the insufficient payment by either (1) paying the additional required fee amount, or (2) filing an amendment which cancels claims so that the remaining claims are covered by the fee submitted upon filing. However, no refund will be made once the fee for claims is properly paid, even though claims are later canceled.

In the past, OIPE has reviewed the claimed subject matter of newly filed nonprovisional applications to determine whether a filing date should be granted. Such applications included those drawn to perpetual motion devices and methods of doing business and applications for reissue signed by assignees or filed more than 2 years after the grant of the patent which appear to contain broadened reissue claims.

Under the current practice, a filing date is normally granted in such cases if the nonprovisional application filed under 37 CFR 1.53(b) is otherwise sufficient and then forwarded to the examiner for consideration and decision during the regular course of examination.

INCOMPLETE PROVISIONAL APPLICATIONS

If the provisional application papers do not include at least a specification containing a description and a drawing, if necessary under 35 U.S.C. 113 (first sentence) or if the submitted application papers are too informal to be given a filing date, the case is held in

OIPE as an incomplete application and the applicant is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

Such incompleteness may consist of the omission of any one of the following parts of an application. The component parts of a provisional application necessary to obtain a filing date are:

A specification as prescribed by 35 U.S.C. 112, first paragraph, and 37 CFR 1.71.

A drawing, if necessary under 35 U.S.C. 113 (first sentence) and 37 CFR 1.81(a).

Even though an application purports to include the component parts necessary to obtain a filing date, the application will still be held to be incomplete and a filing date will be refused if the component parts fail to satisfy the requirements set forth above. For example, if the documents purporting to be a specification are so obviously informal and incoherent that they would clearly not constitute a specification as required by 35 U.S.C. 112, first paragraph, and 37 CFR 1.71, the application would not be acceptable and would not be accorded a filing date until corrections are made. The filing date of the application would be the date the corrections were made. A provisional application will not be examined. However, a provisional application which does not include a cover sheet (37 CFR 1.51(c)(1)), which may be an application data sheet (37 CFR 1.76) or a cover letter, identifying the application as a provisional application, will be treated as a nonprovisional application filed under 37 CFR 1.53(b). See 37 CFR 1.53(c)(1).

NOTE: 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. See 37 CFR 1.53(c).

INFORMAL APPLICATIONS

An application is informal if it is typed on both sides of the paper, or is not permanent, legible, or reproducible. If such informalities are timely corrected, the application is given the filing date on which the original informal papers were filed.

OIPE accords a filing date, as of the date indicated by the "Office Date" stamp (see MPEP § 505), to application papers which include a specification

containing a description and at least one claim (non-provisional applications filed under 37 CFR 1.53(b)), and a drawing, if necessary under 35 U.S.C. 113 (first sentence) but are informal because they do not comply with the rules or notices. In such applications, OIPE prepares a Notice of Informal Application indicating the informality and places it in the file wrapper. The TC mails the letter to applicant. Failure to correct the informality within the specified time results in abandonment of the application.

The letter of transmittal accompanying the filing of continuing applications should include such additional information as the identification by application number of a provisional or parent application, its status, and location (if known) in the U.S. Patent and Trademark Office. The supplying of this information will simplify the processing of these applications.

506.01 Return of Incomplete Application

If a request is made, the parts of an incomplete application which has not been assigned a filing date may be returned by OIPE. They may be used by the applicant as part of a later complete application if the missing parts are later supplied.

506.02 Review of Refusal To Accord Filing Date

The filing date of the provisional or nonprovisional application is the date of receipt in the Office of the application which includes a specification containing description pursuant to 37 CFR 1.71 and at least one claim (required for nonprovisional applications only) pursuant to 37 CFR 1.75, and any drawings required by 37 CFR 1.81(a). See 37 CFR 1.53(b) and (c).

If any of these items are missing, applicant will be notified to file them and the filing date will be the date of receipt of the missing part(s). If the oath or declaration for a nonprovisional application was executed and filed with the application, a supplemental oath or declaration by the inventor is required in some circumstances, e.g., where the missing item is the claim, specification, or a drawing. The supplemental declaration must identify the missing item and indicate, as appropriate, that it accurately claims, describes, or illustrates applicant's invention. See MPEP § 601.01(d)-(g) where the application is filed without

all the pages of the specification, without at least one claim (nonprovisional application), without drawings, or without all the figures of the drawings. An error in or failure to identify inventorship does not raise a filing date issue.

Any review of the refusal to grant a filing date as of the date of deposit of the application would be by way of petition, accompanied by the petition fee (37 CFR 1.17(h)). Petitioner should provide any arguments that he or she has that the items noted were not missing or that a filing date should be assigned in the absence of such items if they are believed to be unnecessary. If petitioner alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

For applications properly filed under 37 CFR 1.10, the filing date is the date that the application was deposited as "Express Mail" in the U.S. Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2). If the proper procedures were not followed, the application will receive a filing date as of the date it was received in the Office. Any review of these matters would be by way of petition, accompanied by the petition fee (37 CFR 1.17(h)), providing whatever arguments and evidence petitioner has that the application is entitled to a filing date as of the date it was deposited as "Express Mail."

Petitions relating to the filing date accorded to patent applications under 37 CFR 1.53 are decided in the Office of the Deputy Commissioner for Patent Examination Policy (See MPEP § 1002.02(b)), with the exception of petitions relating to the filing date accorded to a design application, which are decided by the Director of Technology Center 2900. See MPEP § 1002.02(c)(3).

Any petition under this section should be marked to the attention of the Office of Patent Legal Administration.

507 Drawing Review in the Office of Initial Patent Examination

The Office has revised the drawing review process to implement the eighteen-month publication of

patent applications. Under the revised drawing review process, the Office of Initial Patent Examination (OIPE) will perform an initial review of drawings in new utility and plant patent applications filed on or after November 29, 2000 to see if the drawings can be effectively scanned for publication purposes. Design applications are not published. Therefore, drawings filed in design patent applications (whether filed before, on or after November 29, 2000) will be reviewed but not for publication purposes. The standard of review employed by OIPE is such that most drawings, including those that have been indicated by applicant to be informal drawings, will be accepted.

OIPE inspects the drawings to see if they can be effectively scanned and adequately reproduced. If the drawings are not acceptable, OIPE will object to the drawings and notify applicant that a timely submission of acceptable drawings (e.g., drawings which can be scanned) is required. This initial review process in OIPE is necessary in order to ensure that applications can be timely published.

Under the OIPE review process, OIPE may object to and require corrected drawings within a set time period, if the drawings:

(A) have a line quality that is too light to be reproduced (weight of all lines and letters must be heavy enough to permit adequate reproduction) or text that is illegible (reference characters, sheet numbers, and view numbers must be plain and legible). See 37 CFR 1.84(l) and (p)(1);

(B) have missing lead lines. See 37 CFR 1.84(q). Lead lines are those lines between the reference characters and the details referred to;

(C) contain excessive text or text that is not in English (including, for example, a flow chart that was originally not in English that has been marked up to include the English text). See 37 CFR 1.84(o) and (p)(2) and 37 CFR 1.52(d)(1);

(D) do not have the appropriate margin or are not on the correct size paper. See 37 CFR 1.84(f) and (g). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left size margin of at least 2.5 cm. (1 inch), a right size margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch). The size of the sheets on which drawings are made must be 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);

(E) have more than one figure and each figure is not labeled "Fig." With a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.). See 37 CFR 1.84(u)(1);

(F) include photographs of the claimed invention which are capable of illustration by other medium such as ink drawings, and which are illegible after scanning. See 37 CFR 1.84(b); and

(G) contain color drawings or color photographs, but not a petition to accept color drawings/photographs. Note that the requirement under 37 CFR 1.84(a)(2)(iii) and 37 CFR 1.165(b) for a black and white photocopy of any color drawings/photographs has been waived. See 1246 O.G. 106 (May 22, 2001).

If OIPE objects to the drawings and sends applicant a Notice requiring submission of corrected drawings within a set time period (usually two months), corrected drawings must be filed, in paper, to the mailing address set forth in the Notice, along with any other items required by OIPE, to avoid abandonment of the application. No fee will be necessary for filing corrected drawings which are required by OIPE. Otherwise, in most situations, patent application publications and patents will reflect the quality of the drawings that are included with a patent application on filing unless applicant voluntarily submits better quality drawings as set forth below.

VOLUNTARY SUBMISSION OF REPLACEMENT DRAWINGS FOR PURPOSES OF PATENT APPLICATION PUBLICATION

As noted above, for the vast majority of applications, corrected or new drawings will not be required, and the application will be published with the originally filed drawings. Although the initial submission of high quality drawings is certainly encouraged, the USPTO will not require applicant to submit "formal drawings" for purposes of publication of the application.

REPLACEMENT DRAWINGS SUBMITTED ON PAPER

Applicant may submit replacement drawings within the later of one month from the filing date of

the application, or fourteen months from the earliest filing date for which a benefit is sought under Title 35, United States Code. The replacement paper drawings must be filed in an envelope addressed to Box PGPUB DRAWINGS, Commissioner for Patents, Washington, DC 20231, with a petition under 37 CFR 1.182 requesting entry of the drawings, and the petition fee set forth in 37 CFR 1.17(h). If such replacement drawings are properly and timely submitted, the patent application publication shall include the replacement drawings. Replacement drawings that are received later than this date may still be included in the patent application publication, where practicable, if the USPTO has not started the patent application publication process when the paper drawings and the appropriate fee are received.

Box PGPUB DRAWINGS should only be used for filing replacement drawings for inclusion in a patent application publication. The replacement drawings should be accompanied by a transmittal letter identifying the application to which the replacement drawings are directed and either an authorization to charge the petition fee or other payment of the petition fee. Replacement drawings received in this special box will be scanned and included in the electronic document which will be used for the patent application publication. After the replacement drawings are scanned for the patent application publication, they will be made of record in the application file. Replacement drawings that are not mailed to the special box, or are filed without the appropriate petition fee, or are untimely submitted, will be routed to, and made of record in the application file without scanning and will not be included in the patent application publication. Other papers, such as amendments to the application, amended titles or status inquiries should not be included with the replacement drawings addressed to Box PGPUB DRAWINGS. By including any such other items with the replacement drawings may result in the replacement drawings not being scanned for purposes of the patent application publication. Replacement drawings for unrelated applications must be submitted in separate envelopes to ensure that the replacement drawings are associated with the proper application file prior to publication.

REPLACEMENT DRAWINGS SUBMITTED WITH A SPECIFICATION THROUGH THE ELECTRONIC FILING SYSTEM

Applicant may also submit replacement drawings in electronic form by submitting the drawings with a copy of the application, as amended during prosecution, for publication via the Electronic Filing System (EFS). Pursuant to 37 CFR 1.215(c), the EFS submission must be filed within the later of one month from the filing date of the application, or fourteen months from the earliest filing date for which a benefit is sought under Title 35, United States Code. A paper copy of the replacement drawings must also be filed in the application within the time period noted above. The paper replacement drawings must be placed in an envelope addressed to Box PGPUB DRAWINGS, Commissioner for Patents, Washington DC 20231. Since the replacement drawings was also submitted via EFS, a petition under 37 CFR 1.182 requesting entry of the drawings, and the petition fee set forth in 37 CFR 1.17(h) will not be required with the submission of the paper copy of the replacement drawings. The replacement drawings submitted via EFS should be submitted in accordance with the instructions for EFS submissions. Information on EFS submissions can be obtained at <http://www.uspto.gov/ebc/efs/>. If such paper or EFS replacement drawings are properly and timely submitted, the patent application publication shall include the replacement drawings. Replacement drawings that are received later than this date may be included in the patent application publication, where practicable, if the USPTO has not started the patent application publication process when the EFS replacement drawings are received. See 37 CFR 1.215(c).

508 Distribution

The Scanning Division of the Office of Initial Patent Examination (OIPE) prepares permanent prints made of the drawings of all complete applications and secures the prints in the file wrappers. The nonprovisional applications are then forwarded to the appropriate Technology Center (TC).

When a new or substitute drawing is received in reply to a notice from OIPE, a print is made and placed in the file if the application is still located in OIPE. If a new or substitute drawing is submitted in reply to another type of notice, or after the file has left

OIPE, a drawing print is not made by the Scanning Division.

As to the procedure to be followed when a model is filed, see MPEP § 608.03 and § 608.03(a).

508.01 Papers Sent to Wrong Technology Center (TC)

If drawings, amendments, or other papers are delivered to the wrong TC, the TC to which this application is assigned should be obtained from PALM and be placed on the paper and then forwarded to the appropriate TC. The TC to which the application is assigned as indicated by PALM may be verified by calling the TC as indicated before forwarding the paper.

508.02 Papers Received After Patenting or Abandonment

After an application is patented or abandoned, any incoming communication which is not to become part of the record will be returned to the sender by the Technology Center.

508.03 Unmatched Papers

Unmatched papers for nonprovisional applications within a Technology Center (TC) should be frequently reviewed to determine which should be sent to the Paper Correlating Office (PCO).

Item I below treats the papers in the "Application number too high" category. Items II-VI below are directed to all other unmatched papers not in the "Application number too high" category.

I. UNMATCHED PAPERS IN THE "APPLICATION NUMBER TOO HIGH" CATEGORY

This collection of papers being held by the TC should be reviewed *at least* once a week. Any paper having an application number which clearly should have already been received by the TC should be removed from this collection. Where the TC does not have a corresponding application for any of these papers, inquiry should be made of the Office of Initial Patent Examination (OIPE) to determine the TC of record. If another TC number is indicated, the paper should be forwarded to that TC. If OIPE does not

yield a new TC number for the indicated application number, the paper should be sent to the PCO.

II. UNMATCHED PAPERS HAVING AN APPLICATION NUMBER

It can be assumed that either the TC number or the application number on these papers is incorrect. Inquiry should be made of the OIPE and PALM to determine the TC of record and the procedure set out in paragraph I above followed. An exception to this practice should be made where the paper has thereon the name of an examiner in the TC. In these situations, a careful check of the TC records and files as well as consultation with the indicated examiner should be made to determine the correct application number. If this does not yield a new application number, the paper should be sent to the PCO.

III. UNMATCHED PAPERS RELATING TO APPLICATIONS ABANDONED FROM TC

The application file should be ordered from Files Repository. If the file is not received therefrom, the paper should be forwarded to the PCO.

IV. PAPERS FOR APPLICATIONS WHICH HAVE BEEN SENT TO PUBLISHING DIVISION

All papers for applications which PALM indicates to be located in any of the locations 7400 through 7650 should be forwarded to the Publishing Division.

The instructions of this paragraph (IV) apply to all files in issue including those which have been assigned a patent number and issue date. Papers requiring examiner review and action will be returned to the TC after Publishing Division personnel have matched the paper to the appropriate file.

V. PAPERS FOR APPLICATIONS WHICH HAVE BEEN SENT TO THE FILE INFORMATION UNIT (RECORD ROOM)

If PALM indicates that the application to which a paper relates is in the File Information Unit (Record Room) (location code 9210), the paper should be forwarded to the PCO for response.

VI. UNMATCHED PAPERS FOR APPLICATIONS WHICH ARE KNOWN TO BE PENDING IN THE TC BUT CANNOT BE LOCATED

Generally, these are applications which PALM indicates are present in the TC, but the file is not available. These papers should be retained in the TC for processing.

Each paper sent to the PCO must have a PCO Transmittal Form *stapled* thereto. Each form attached to a paper should be filled out as completely as possible. Transmittal Forms attached to papers of the type described in paragraph I and paragraph II above must have an indication of the information obtained from *both* OIPE and PALM. The PALM information should be inserted in the large space at the bottom of the form. This will help eliminate duplication of effort by PCO personnel. Papers received without transmittal forms or with incompletely filled out transmittal forms may be returned to the originating TC.

508.04 Unlocatable Patent or Application Files

37 CFR 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.

37 CFR 1.251 sets forth a procedure for the reconstruction of the file of a patent application, patent, or any other patent-related proceeding that cannot be located after a reasonable search. The phrase "an application" in 37 CFR 1.251 applies to any type of application (national or international), and regardless of the status (pending or abandoned) of the application

37 CFR 1.251(a) provides that in the event the Office cannot locate the file of an application, patent, or any other patent-related proceeding after a reasonable search, the Office will notify the applicant or patentee and set a time period within which the applicant or patentee must comply with the notice. The applicant or patentee may comply with a notice under 37 CFR 1.251 by providing: (1) a copy of his or her record (if any) of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents); (2) a list of such correspondence; and (3) a statement that the copy is a complete and accurate copy of the applicant's or patentee's record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patent's records (37 CFR 1.251(a)(1)). The applicant or patentee may also comply with a notice under 37 CFR 1.251 by: (1) producing his or her record (if any) of

all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding for the Office to copy (except for U.S. patent documents); and (2) providing a statement that the papers produced by applicant or patentee are applicant's or patentee's complete record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (except for U.S. patent documents), and whether applicant or patentee is aware of any correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding that is not among applicant's or patentee's records (37 CFR 1.251(a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee must comply with a notice under 37 CFR 1.251 by providing a statement that applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (37 CFR 1.251(a)(3)).

According to 37 CFR 1.251(a), if the applicant or patentee possesses all or just some of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply by providing a copy of (or producing) his or her record of all of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding (37 CFR 1.251(a)(1) or (a)(2)). If applicant or patentee does not possess any record of the correspondence between the Office and the applicant or patentee for such application, patent, or other proceeding, the applicant or patentee is to reply with a statement to that effect (37 CFR 1.251(a)(3)).

If an applicant or patentee decides to produce his or her record of the correspondence between the Office and the applicant or patentee for the application, patent, or other proceeding for copying by the Office under 37 CFR 1.251(a)(2) (rather than provide a copy under 37 CFR 1.251(a)(1)), the record should be brought to the Customer Service Center in the Office of Initial Patent Examination (Crystal Plaza 2, 2011 South Clark Place, Arlington, VA 22202).

The Office will set a time period of three months for reply in a notice under 37 CFR 1.251 in an appli-

cation. The time period will be extendable under 37 CFR 1.136(a) (unless the notice indicates otherwise) by three months up to a maximum period for reply of six months in an application. See 35 U.S.C. 133. If, however, an applicant fails to reply to a notice under 37 CFR 1.251 within three months of its mailing date, any patent term adjustment under 35 U.S.C. 154(b) will be reduced by a period equal to the number of days (if any) beginning on the day after the date that is three months after the mailing date of the notice under 37 CFR 1.251 and ending on the date the reply to the notice under 37 CFR 1.251 was filed. See 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). The Office will set a time period of six months for reply in a notice under 37 CFR 1.251 in a patent. The time period will **not** be extendable under 37 CFR 1.136(a) in a patent because 35 U.S.C. 41(a)(8) only authorizes the Office to charge fees for extensions of time in proceedings involving an application.

37 CFR 1.251 generally applies only to situations in which the file of an application or patent (not just certain documents) is unlocatable. When a document is missing from an application, Office practice is to call the applicant's representative and request submission (generally by facsimile) of a copy of the missing document. While the Office will generally treat missing documents in this relatively informal manner (rather than issuing a notice under 37 CFR 1.251), the Office may issue a notice under 37 CFR 1.251 to obtain a copy of a missing document if the Office's informal attempts to obtain a copy of the document are unsuccessful. The notice under 37 CFR 1.251 will include a printout of the contents entries from the Office's PALM system.

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

and the applicant or patentee for the application, patent, or other proceeding.

37 CFR 1.251(b) provides that with regard to a pending application, the **failure** to provide a reply to such a notice within the time period set in the notice will result in **abandonment** of the application. While abandonment (or expiration or lapse) of a patent is not an issue if a patentee fails to timely comply with a notice under 37 CFR 1.251, in such a situation the only certified copy of the patent file that the Office will be able to produce will be a copy of the patent and a copy of the application-as-filed (which may have an adverse impact during attempts to enforce the patent). In addition, if the patent is involved in a proceeding before the Office, the Office may take action under 37 CFR 1.616 or 37 CFR 10.18.

509 Payment of Fees

The latest fee schedule is available by contacting the USPTO at 1-800-PTO(786)-9199 or (703) 308-HELP(4357), or on the USPTO webpage at <http://www.uspto.gov>.

37 CFR 1.22. Fees 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.

37 CFR 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.

37 CFR 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.

Where the Office has notified an applicant, in writing, that a fee is due and has specified a particular dollar amount for that fee, if the applicant timely submits the specified fee amount in response to the notice, the applicant should be considered to have complied with the notice so as to avoid abandonment of the application. If the fee paid by the applicant is insufficient,

either because the notice specified an incorrect dollar amount for the fee or because of a fee increase effective after the mailing of the notice and before payment of the fee by the applicant, the applicant should be notified in writing by the Office of the fee insufficiency and given a new time period in which to submit the remaining balance. The written notification of the fee insufficiency should set forth the reason (*i.e.*, the fee amount indicated by the Office in the earlier notice was incorrect or the fees have increased since the earlier notice was mailed) why applicant is being required to submit an additional fee.

37 CFR 1.22(b) sets forth that fees must be itemized in such a manner that it is clear for which purpose fees are paid. The Office may return fees that are not itemized. The intent of the fee itemization requirement is to encourage a better explanation by applicants of how fees being paid are to be applied by the Office. This will allow Office employees to properly account for the fees being paid by applicants. It should be noted that the language of 37 CFR 1.22 is not intended to create a problem when it is clear what fee is needed. A reference to "filing fee(s)" would be sufficient to cover filing fees of all different types of applications and all types of claims. Further, in a paper submitted on a date later than the actual filing date, the reference to "filing fee(s)" would also be sufficient to cover the surcharge under 37 CFR 1.16, as the surcharge is also required to make the application complete. A reference to "any corresponding fee under 37 CFR 1.16" would be sufficient to cover any fee (*e.g.*, surcharge, excess claims fees) under 37 CFR 1.16. In a petition for an extension of time filed without a specifically itemized fee, but with a general authorization to charge a deposit account, it is clear that a fee for an extension of time is needed and the deposit account should be charged the appropriate extension of time fee.

PAYMENT BY CREDIT CARD

Effective June 5, 2000, 37 CFR 1.23 was amended to permit payment of any patent process fee, trademark process fee, or information product fee by credit card, subject to actual collection of the fee. The Office currently accepts charges to the following credit cards: AMERICAN EXPRESS®, DISCOVER®, MASTER CARD®, and VISA®.

Credit Card Payment Form (PTO-2038) should be used when paying a patent process or trademark process fee (or the fee for an information product) by credit card. The Office will not include the Credit Card Payment Form (PTO-2038) among the records open to public inspection in the file of a patent, trademark registration, or other proceeding. The Office does **not** require customers to use this form when paying a patent process or trademark process fee by credit card. If a customer provides a credit card charge authorization in another form or document (e.g., a communication relating to the patent or trademark), the credit card information may become part of the record of an Office file that is open to public inspection. Thus, failure to use the Credit Card Payment Form (PTO-2038) when submitting a credit card payment may result in your credit card information becoming part of the record of an Office file that is open to public inspection.

Credit card payments by facsimile are permitted, except in situations in which facsimile submission of correspondence is not permitted in 37 CFR 1.6(d).

35 U.S.C. 42(d) and 37 CFR 1.26 (which concern refund of patent and trademark fees) also apply to requests for refund of fees paid by credit card. 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. See 37 CFR 1.26(a).

Any payment of a patent process or trademark process fee by credit card must be in writing (see 37 CFR 1.2); preferably on the Credit Card Payment Form (PTO-2038). If a Credit Card Payment Form or other document authorizing the Office to charge a patent process or trademark process fee to a credit card does not contain the information necessary to charge the fee to the credit card, the customer must submit a revised Credit Card Payment Form or document containing the necessary information. Office employees will **not** accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process or trademark process fee (as opposed to information product or service fees) to a credit card.

PTO-2038 (02-2000)

Approved for use through 01/31/2003. OMB 0651-0043

United States Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**United States Patent & Trademark Office
Credit Card Payment Form
Please Read Instructions before Completing this Form**

Credit Card Information			
Credit Card Type:	Visa	MasterCard	American Express Discover
Credit Card Account #:			
Credit Card Expiration Date:			
Name as it Appears on Credit Card:			
Payment Amount: \$(US Dollars):			
Signature:		Date:	
<p>Refund Policy: The Office may refund a fee paid by mistake or in excess of that required. A 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 (37 CFR 1.26). Refund of a fee paid by credit card will be via credit to the credit card account.</p> <p>Service Charge: There is a 50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR 1.21(m)).</p>			
Credit Card Billing Address			
Street Address 1:			
Street Address 2:			
City:			
State:		Zip/Postal Code :	
Country:			
Daytime Phone #:		Fax #:	
Request and Payment Information			
Description of Request and Payment Information:			
Patent Fee	Patent Maintenance Fee	Trademark Fee	Other Fee
Application No.	Application No.	Serial No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No.		Identify or Describe Mark	

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form, the United States Patent & Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

509.01 Deposit Accounts

37 CFR 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.

An overdrawn account will be immediately suspended and no charges will be accepted against it until a proper balance is restored, together with a payment of \$10 (37 CFR 1.21(b)(1)) to cover the work done by the U.S. Patent and Trademark Office incident to suspending and reinstating the account and dealing with charges which may have been made in the meantime.

If there is an authorization to charge the filing fee to a deposit account which is overdrawn or has insufficient funds, a surcharge (37 CFR 1.16(e)) is required

in addition to payment of the filing fee. Failure to timely pay the filing fee and surcharge will result in abandonment of the application.

It is expected, however, that reasonable precautions will be taken in all cases to avoid overdrafts, and if an account is suspended repeatedly it will be closed.

Similarly, because of the burden placed on the U.S. Patent and Trademark Office incident to the operation of deposit accounts, a charge of \$10 (37 CFR 1.21(b)(1)) will be made for opening each new account.

DEPOSIT ACCOUNT AUTHORIZATIONS

The rules of practice were amended effective Oct. 1, 1982, at 37 CFR 1.25(b) to state that:

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 respect to a particular paper filed.

As provided in 37 CFR 1.311(b), an authorization to charge the issue fee (37 CFR 1.18) to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. 37 CFR 1.25(b) also makes clear that a general authorization made prior to the mailing of a notice of allowance does not apply to issue fees under 37 CFR 1.18.

In addition, a general authorization does not apply to document supply fees under 37 CFR 1.19, such as those required for certified copies, to post issuance fees under 37 CFR 1.20, such as those required for maintenance fees, to miscellaneous fees and charges under 37 CFR 1.21, such as assignment recording fees, or as a basis for a petition, such as a petition for an extension of time (see MPEP § 710.02(e), Extension of Time).

Many applications contain broad language authorizing any additional fees which might have been due to be charged to a deposit account. The U.S. Patent and Trademark Office will interpret such broad authorizations to include authorization to charge to a deposit account fees set forth in 37 CFR 1.16, and 1.17. Fees under 37 CFR 1.19, 1.20, and 1.21 will not be charged as a result of a general authorization under 37 CFR 1.25. Effective November 7, 2000, fees under 37 CFR 1.18 will not be charged as a result of a preauthorization of issue fee payment.

Authorizations to charge fees relating only to a specific paper, the authorization could read "The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. _____." Such authorizations would cover situations in which a check to cover a filing and/or a processing fee under 37 CFR 1.16 and 1.17 was omitted or was for an amount less than the amount required.

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend and may return the fees. As a result, applicants could be subject to further expenses, petitions, etc. in order to have a particular fee charged to a deposit account (which was not charged as intended) or to resubmit a fee(s) due to an ambiguous authorization.

When statutory fees are to be charged to a deposit account, the processing of the application can be facilitated by submitting the applicant's transmittal letter or other correspondence specifying the account to be charged in duplicate. Submission of these documents in duplicate will eliminate the need for the Mail Center to photocopy the document and will thereby reduce the processing time of incoming mail.

37 CFR 1.25(b) further provides that an authorization to charge fees under 37 CFR 1.16 (which relates to national application filing fees) in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492 (which relates to national stage fees). Papers filed for the purpose of entering the national stage under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 that include an authorization to charge fees under 37 CFR 1.16 are treated by the Office as an authorization to charge fees under 37 CFR 1.492 since: (1) timely payment of the appropriate national fee under 37 CFR 1.492 is necessary to avoid abandonment of the application as to the United States; and (2) the basic filing fee under 37 CFR 1.16 is not applicable to such papers or applications.

509.02 Small Entity Status — Definitions

Public Law 97-247, enacted August 27, 1982, provides that effective Oct. 1, 1982, funds available under the Act to the Patent and Trademark Office

shall be used to reduce by 50 per centum the payment of fees under section 41(a) and (b) of title 35, United States Code, by independent inventors and nonprofit organizations as defined in regulations established by the Commissioner of Patents and Trademarks, and by small business concerns as defined in Section 3 of the Small Business Act and by regulations established by the Small Business Administration.

The fees which are reduced include patent application filing fees (37 CFR 1.16), extension of time, revival, and appeal fees (37 CFR 1.17), patent issue fees (37 CFR 1.18), statutory disclaimer fee (37 CFR 1.20(d)), and maintenance fees on patents (37 CFR 1.20). Other fees, established under section 41 (c) or (d) of Title 35, United States Code, are not reduced for small entities since such a reduction is not permitted or authorized by Public Law 97-247.

Fees which are not reduced include petition and processing fees (other than revival), 37 CFR 1.17(h)-(k), document supply fees, 37 CFR 1.19, certificate of correction fees, 37 CFR 1.20(a), request for reexamination fees, 37 CFR 1.20(c), miscellaneous fees and charges, 37 CFR 1.21, and international application fees, 37 CFR 1.445.

Public Law 97-247 gave the Commissioner authority to establish regulations defining independent inventors and nonprofit organizations. The Small Business Administration was given authority to establish the definition of a small business concern. A small entity for purposes of paying reduced fees is defined in 37 CFR 1.27(a) as a person, a small business concern, or a nonprofit organization. The term "person" rather than "independent inventor" is used since individuals who are not inventors but who have received some rights in the invention are intended to be covered by 37 CFR 1.27.

37 CFR 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.

PERSON

37 CFR 1.27(a)(1) defines a person as 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.

SMALL BUSINESS CONCERN

In order to be eligible for reduced patent fees as a "small business concern" under 37 CFR 1.27(a)(2), a business concern must meet the standards set forth in 13 CFR Part 121. Questions relating to standards for a small business concern may be directed to:

Small Business Administration
Size Standards Staff
409 Third Street, S.W.
Washington, DC 20416
(202)205-6618

NONPROFIT ORGANIZATIONS

37 CFR 1.27(a)(3) defines a nonprofit organization by utilizing and interpreting the definition contained in 35 U.S.C. 201(i). The term "university or other institution of higher education" as used in 37 CFR 1.27(a)(3)(ii)(A) means an educational institution which

(A) admits as regular students only persons having a certificate of graduation from a school providing secondary education, or the recognized equivalent of such a certificate,

(B) is legally authorized within the jurisdiction in which it operates to provide a program of education beyond secondary education,

(C) provides an educational program for which it awards a bachelor's degree or provides not less than a 2-year program which is acceptable for full credit toward such a degree,

(D) is a public or other nonprofit institution, and

(E) is accredited by a nationally recognized accrediting agency or association.

The definition of "university or other institution of higher education" as set forth herein essentially follows the definition of "institution of higher education" contained in 20 U.S.C. 1141(a). Institutions which are strictly research facilities, manufacturing facilities, service organizations, etc., are not intended to be included within the term "other institution of higher education" even though such institutions may perform an educational function or publish the results of their work.

Nonprofit organizations also include organizations of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and which are exempt from taxation under 26 U.S.C. 501(a). Organizations described in 26 U.S.C. 501(c)(3) include corporations, and any community chest, fund, or foundation, organized and operated exclusively for religious, charitable, scientific, testing for public safety, literary, or educational purposes, or to foster national or international amateur sports competition (but only if no part of its activities involve the provision of athletic facilities or equipment), or for the prevention of cruelty to children or animals, no part of the net earnings of which inures to the benefit of any private shareholder or individual, no substantial part of the activities of which is carrying on propaganda, or otherwise attempting to influence legislation and which does not participate in, or intervene in (including the publishing or distributing of statements), any political campaign on behalf of any candidate for public office.

LOCATION OF SMALL ENTITY

Small entities may claim reduced fees regardless of the country in which they are located. There is no restriction requiring that the person, small business concern, or nonprofit organization be located in the United States. The same definitions apply to all applicants equally in accordance with the Paris Convention for the Protection of Industrial Property.

RIGHTS IN THE INVENTION AND TRANSFER OF RIGHTS

The "rights in the invention" under 37 CFR 1.27(a)(1), (a)(2)(i), and (a)(3)(i) are the rights in the United States. Rights in the invention include 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. Therefore, for example, status as a small entity is lost by an inventor who has transferred or has an obligation to transfer a shop right to an employer who could not qualify as a small entity.

Individual inventors (37 CFR 1.27(a)(1)), small business concerns (37 CFR 1.27(a)(2)), and nonprofit organizations (37 CFR 1.27(a)(3)) can make an assignment, grant, conveyance, or license of partial rights in the invention to another individual(s), small business concern, or nonprofit organization who could qualify as a person (37 CFR 1.27(a)(1)), small business concern, or nonprofit organization. Under the circumstances described, the individual inventor, small business concern, or nonprofit organization could still qualify for small entity status. However, if the individual inventor, small business concern, or nonprofit organization assigned, granted, conveyed, or licensed, or came under an obligation to assign, grant, convey, or license, any rights to the invention to any individual, small business concern, or nonprofit organization which would not qualify as a small entity (37 CFR 1.27(a)), then the inventor, small business concern, or nonprofit organization would no longer qualify for small entity status.

With regard to transfer of rights in the invention, the rights in question are those in the United States to be covered by an application or patent. Transfer of rights to a Japanese patent, for example, would not affect small entity status if no rights in the United States to a corresponding patent were likewise transferred.

The payment of reduced fees under 35 U.S.C. 41 is limited to those situations in which all of the rights in the invention are owned by small entities, i.e., persons, small business concerns, or nonprofit organizations. To do otherwise would be clearly contrary to the intended purpose of the legislation which contains no indication that fees are to be reduced in circumstances where rights are owned by non-small entities. For example, a non-small entity is not permitted to

transfer patent rights to a small business concern which would pay the reduced fees and grant a license to the entity.

If rights transferred to a non-small entity are later returned to a small entity so that all rights are held by small entities, reduced fees may be claimed.

The term "license" in the definitions includes non-exclusive as well as exclusive licenses and royalty free as well as royalty generating licenses. Implied licenses to use and resell patented articles purchased from a small entity, however, will not preclude the proper claiming of small entity status. Likewise, an order by an applicant to a firm to build a prototype machine or product for the applicant's own use is not considered to constitute a license for purposes of the definitions.

RIGHTS HELD BY GOVERNMENT ORGANIZATIONS

Also, although the Federal government agencies do not qualify as nonprofit organizations for paying reduced fees under the rules, a license to a Federal agency resulting from a funding agreement with the agency pursuant to 35 U.S.C. 202(c)(4) will not preclude the proper claiming of small entity status. Furthermore, 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 by a person under 37 CFR 1.27(a)(1).

Public Law 96-517 added a new chapter 18 of Title 35 of the United States Code entitled "Patent Rights in Inventions Made With Federal Assistance." Under the provisions of the statute, each funding agreement between a Federal agency and an individual, small business firm, or nonprofit organization must provide, *inter alia*, that ". . . 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 . . ." See 35 U.S.C. 202(c)(4). The Federal agencies do not qualify as nonprofit organizations for paying reduced patent fees under the rules. Applying this construction to the licensing of an invention to a Federal agency by a person, small business concern, or nonprofit organization pursuant to a funding agreement under 35 U.S.C. 202(c)(4) would preclude their qualifying for paying reduced fees. This, however, would frus-

trate the intent of Public Law 97-247 and Public Law 96-517 when taken together.

Government organizations as such, whether domestic or foreign, cannot qualify as nonprofit organizations as defined in 37 CFR 1.27(a)(3). Thus, for example, a government research facility or other government-owned corporation could not qualify. 37 CFR 1.27(a)(3) was based upon 35 U.S.C. 201(i), as established by Public Law 96-517. The limitation to "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))" would by its nature exclude the U.S. government and its agencies and facilities, including research facilities and government corporations. State and foreign governments and governmental agencies and facilities would be similarly excluded. 37 CFR 1.27(a)(3) is not intended to include within the definition of a nonprofit organization government organizations of any kind located in any country. A university or other institution of higher education located in any country would qualify, however, as a "nonprofit organization" under 37 CFR 1.27(a)(3) even though it has some government affiliation since such institutions are specifically included.

A wholly owned subsidiary of a nonprofit organization or of a university is considered a part of the nonprofit organization or university and is not precluded from qualifying for small entity status.

509.03 Claiming Small Entity Status

37 CFR 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.

(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.

37 CFR 1.4. Nature of correspondence and signature requirements.

(d)(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).

37 CFR 10.18. Signature and certificate for correspondence filed in the Patent and Trademark Office.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

In order to establish small entity status for the purpose of paying small entity fees, any party (person, small business concern or nonprofit organization) must make an assertion of entitlement to small entity status in the manner set forth in 37 CFR 1.27(c)(1) or (c)(3), in the application or patent in which such small entity fees are to be paid. Under 37 CFR 1.27, as long as all of the rights remain in small entities, the fees established for a small entity can be paid. This includes circumstances where the rights were divided between a person, a small business concern, and a nonprofit organization, or any combination thereof.

Under 37 CFR 1.4(d)(2), an assertion of entitlement to small entity status, including the mere payment of an exact small entity basic filing fee, inherently contains a certification under 37 CFR 10.18(b). It is not required that an assertion of entitlement to small entity status be filed with each fee paid. Rather, 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. 37 CFR 1.27(g)(1). 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 is no longer appropriate. 37 CFR 1.27(g)(2).

Status as a small entity may be established in a provisional application by complying with 37 CFR 1.27.

Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The filing of an application under 37 CFR 1.53 as a continuation-in-part, continuation or division (including a continued prosecution application under 37 CFR 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.

Submission of a request for continued examination (RCE) under 37 CFR 1.114 does not require a new determination or assertion of entitlement to small entity status since it is not a new application.

I. ASSERTION BY WRITING

Small entity status may be established by the submission of a simple written assertion of entitlement to small entity status. The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. 37 CFR 1.27(c)(1). The written assertion is not required to be presented in any particular form. Written assertions of small entity status or references to small entity fees will be liberally interpreted to represent the required assertion. The written assertion can be made in any paper filed in or with the application and need be no more than a simple sentence or a box checked on an application transmittal letter.

Practitioners may continue to use former USPTO forms or similar forms if they believe such small entity forms serve an educational purpose for their clients.

II. PARTIES WHO CAN ASSERT AND SIGN AN ENTITLEMENT TO SMALL ENTITY STATUS BY WRITING

The parties who can assert entitlement to small entity status by writing include all parties permitted by 37 CFR 1.33(b) to file a paper in an application, including a registered practitioner. 37 CFR 1.27(c)(2)(i). Additionally, one of the individuals identified as an inventor, or a partial assignee, can also sign the written assertion. 37 CFR 1.27(c)(2)(ii) and (iii). By way of example, in the case of three *pro se* inventors for a particular application, one of the three inventors upon filing the application can submit a written assertion of entitlement to small entity status and thereby establish small entity status for the application, (but see paragraph VI. below). Where rights are divided between a person, small business concern, and nonprofit organization, or any combination thereof, only one party is required to assert small entity status. For example, where one of two inventors has assigned his or her rights in the invention, it is sufficient if either of the two inventors or the assignee asserts entitlement to small entity status.

Any inventor is permitted to submit a written assertion of small entity status, including individuals identified as inventors but who are not officially named of record as an executed oath or declaration under 37 CFR 1.63 has not yet been submitted. See 37 CFR 1.41(a)(1). Where an application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(f), the Office will accept the written assertion of an individual who has merely been identified as an inventor on filing of the application (e.g., application transmittal letter) as opposed to having to be named as an inventor by the filing of an executed oath or declaration under 37 CFR 1.63 (37 CFR 1.41(a)(1)). 37 CFR 1.4(d)(2) and 37 CFR 10.18(b) are seen as sufficient basis to permit any individual to provide a written assertion so long as the individual identifies himself or herself as an inventor. An actual inventor who has not been identified as an inventor (e.g., by way of application transmittal letter) or named as an inventor (i.e., executed 37 CFR 1.63 oath or declaration) in the file record may not file a written assertion as to small entity entitlement.

Where an oath or declaration under 37 CFR 1.63 is later filed, any original written assertion as to small entity status (which has been previously appropriately submitted to the Office) will remain unless changed by an appropriate party under 37 CFR 1.27(g)(2). Where a later-filed oath or declaration under 37 CFR 1.63 sets forth an inventive entity that does not include the person who initially was identified as an inventor and who asserted small entity status, small entity status will also remain.

An assignee asserting small entity status is not required to submit a 37 CFR 3.73(b) certification whether the assignee is a partial assignee or an assignee of the entire right, title, and interest, (but see paragraph III. below).

III. PARTIES WHO CAN FILE THE WRITTEN ASSERTION ONCE SIGNED

A distinction exists as to who can file a written assertion of entitlement to small entity status once the written assertion is signed. 37 CFR 1.27(c)(2)(ii) and 37 CFR 1.33(b) permit one of several inventors to file as well as to sign a written assertion. The same is not true for a partial assignee. 37 CFR 1.27(c)(2)(iii). While a partial assignee may sign a written assertion,

the written assertion must be filed by an appropriate party under 37 CFR 1.33(b).

IV. ASSERTION BY PAYMENT OF SMALL ENTITY BASIC FILING OR BASIC NATIONAL FEE

The payment of an exact small entity basic filing (37 CFR 1.16(a), (f), (g), (h), or (k)) or basic national fee (37 CFR 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5)) is also considered to be a sufficient assertion of entitlement to small entity status. 37 CFR 1.27(c)(3). An applicant filing a patent application and paying an exact small entity basic filing or basic national fee automatically establishes small entity status for the application even without any other assertion of small entity status. This is so even if an applicant inadvertently selects the wrong type of small entity basic filing or basic national fee for the application being filed (e.g., the exact small entity basic filing fee for a design application is selected but the application is a utility application). If small entity status was not established when the basic filing or basic national fee was paid, such as by payment of a large entity basic filing or basic national fee, a later claim to small entity status requires a written assertion under 37 CFR 1.27(c)(1). Payment of a small entity fee other than a small entity basic filing or basic national fee (e.g., extension of time fee, or issue fee) without inclusion of a written assertion is not sufficient.

Even though applicants can assert small entity status only by payment of an exact small entity basic filing or basic national fee, the Office encourages applicants to also file a written assertion of small entity status as well as to pay the exact amount of the small entity basic filing or basic national fee. The Office's application transmittal forms include a check box that can be used to submit a written assertion of small entity status. A written assertion will provide small entity status should applicant fail to pay the exact small entity basic filing or basic national fee. The provision providing for small entity status by payment of an exact small entity basic filing or basic national fee is intended to act as a safety net to avoid possible financial loss to inventors or small businesses that qualify for small entity status.

Even though small entity status is accorded where the wrong type of small entity basic filing fee or basic

national fee is selected but the exact amount of the fee is paid, applicant still needs to pay the correct small entity amount for the basic filing or basic national fee where selection of the wrong type of fee results in a deficiency. While an accompanying general authorization to charge any additional fees suffices to pay the balance due of the proper small entity basic filing or basic national fee, specific authorizations to charge fees under 37 CFR 1.17 or extension of time fees do not suffice to pay any balance due of the proper small entity basic filing or basic national fee because they do not actually authorize payment of small entity amounts. If payment is attempted of the proper type of basic filing or basic national fee (applicant correctly identifies the type of fee for the type of application being filed), but the amount of the fee paid is not the exact small entity fee required (an incorrect fee amount is supplied) and a written assertion of small entity status is not present, small entity status will not be accorded. The Office will mail a notice of insufficient basic filing or basic national fee with a surcharge due if an authorization to charge the basic filing or basic national fee is not present. The Office does not consider a basic filing or basic national fee submitted in an amount above the correct fee amount, but below the non-small entity fee amount, as a request to establish small entity status unless an additional written assertion is also present. The submission of a basic filing or basic national fee below the correct fee amount also does not serve to establish small entity status.

Where an application is originally filed by a party, who is in fact a small entity, with an authorization to charge fees (including basic filing or national fees) and there is no indication (assertion) of entitlement to small entity status present, that authorization is not sufficient to establish small entity status unless the authorization is specifically directed to small entity basic filing or basic national fees. The general authorization to charge fees will continue to be acted upon immediately and the full (not small entity) basic filing or basic national fees will be charged. Applicant will have three months under 37 CFR 1.28 to request a refund by asserting entitlement to small entity status. This is so even if the application is a continuing application where small entity status had been established in the prior application.

V. PARTIES WHO CAN ASSERT AND FILE SMALL ENTITY STATUS BY PAYMENT

Where small entity status is sought by way of payment of the basic filing or basic national fee, any party (including a third party), may submit payment, such as by check, and small entity status will be accorded.

VI. CONTINUED OBLIGATIONS FOR THOROUGH INVESTIGATION OF SMALL ENTITY STATUS

While small entity status is not difficult to obtain, it should be clearly understood that applicants need to do a complete and thorough investigation of all facts and circumstances before making a determination of actual entitlement to small entity status. 37 CFR 1.27(f). Where entitlement to small entity status is uncertain, it should not be claimed.

The assertion of small entity status (even by mere payment of the exact small entity basic filing fee) is not appropriate until such an investigation has been completed. For example, where there are three *pro se* inventors, before one of the inventors pays the small entity basic filing or basic national fee to establish small entity status, the single inventor asserting entitlement to small entity status should check with the other two inventors to determine whether small entity status is appropriate.

If small entity status is desired on the basis that the entity is a small business concern, the investigation should include a review of whether the business is a small business concern as defined by section 3 of the Small Business Act (Public Law 85-536 as amended by Public Law 106-50). Review of whether the business concern meets the standards set forth in 13 CFR part 121 to be eligible for reduced patent fees is also appropriate. Additionally, if the business has assigned, granted, conveyed or licensed (or is under an obligation to do so) any rights in the invention to others directly or indirectly, the same review for each other entity would also be appropriate.

Furthermore, once status as a small entity has been established in an application, a new determination of entitlement to small entity status is needed (1) when the issue fee is due and (2) when any maintenance fee is due. It should be appreciated that the costs incurred in appropriately conducting the initial and subsequent investigations may outweigh the benefit of claiming small entity status. For some applicants it may be

desirable to file as a large entity (by not filing a written assertion of small entity status and by submitting large entity fees) rather than undertaking the appropriate investigations which may be both difficult and time-consuming and which may be cost effective only where several applications are involved.

The intent of 37 CFR 1.27 is that the person making the assertion of entitlement to small entity status is the person in a position to know the facts about whether or not status as a small entity can be properly established. That person, thus, has a duty to investigate the circumstances surrounding entitlement to small entity status to the fullest extent. It is important to note that small entity status must not be claimed unless the person or persons can unequivocally make the required self-certification.

The U.S. Patent and Trademark Office does not give advisory opinions as to whether or not a specific individual or organization qualifies as a small entity. In establishing reduced fees for persons, small business concerns, and nonprofit organizations, the Congressional consideration of the legislation which became Public Law 97-247 indicated an intent that the U.S. Patent and Trademark Office rely exclusively on a self-certification that a patent applicant qualifies as an independent inventor (now person), small business concern, or nonprofit organization. In addition, it was also stated during Congressional consideration of the legislation that no additional resources would be required to administer the system whereby fees would be reduced for small entities.

In view of the intent expressed during Congressional consideration of the legislation, it would be inappropriate for the U.S. Patent and Trademark Office to give advisory opinions as to entitlement to small entity status. Accordingly, any individual seeking to establish status as a small entity for purposes of paying the fee in an application or patent must file the assertion required by 37 CFR 1.27 and in so doing is self-certifying entitlement to small entity status.

Consistent with 37 CFR 1.4(d)(2), the payment of a small entity basic filing or national fee constitutes a certification under 37 CFR 10.18(b). Thus, a simple payment of the small entity basic filing or basic national fee, without a specific written assertion, activates the provisions of 37 CFR 1.4(d)(2) and, by that, invokes the self-certification requirement set forth

in 37 CFR 10.18(b), regardless of whether the party is a practitioner or non-practitioner.

VII REMOVAL OF STATUS

Once small entity status is 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. 37 CFR 1.27(g)(1). 37 CFR 1.27(g)(2) requires that notification of any change in status resulting in loss of entitlement to small entity status 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 is no longer appropriate. 37 CFR 1.27(g)(2) also requires that the notification of loss of entitlement to small entity status be in the form of a specific written assertion to that extent, rather than only payment of a large entity fee. For example, when paying the issue fee in an application that has previously been accorded small entity status and the required new determination of continued entitlement to small entity status reveals that status has been lost, applicant should not just simply pay the large issue fee or cross out the recitation of small entity status on the returned copy of the notice of allowance (PTOL-85(b)), but should submit a separate paper requesting removal of small entity status pursuant to 37 CFR 1.27(g)(2).

For correcting errors in small entity status, see paragraph X below.

VIII. IMPROPERLY ESTABLISHING SMALL ENTITY STATUS

37 CFR 1.27(h) indicates that any attempt to fraudulently establish status as a small entity or pay fees as a small entity will be considered as a fraud practiced or attempted on the Office. Applicants should not rely on any oral advice inadvertently given by an Office employee as to entitlement to small entity status. In addition, improperly and with intent to deceive establishing status as a small entity or paying fees as a small entity will be considered as a fraud practiced or attempted on the Office. Normally, the Office will not question a claim to status as a small entity.

IX. REFUNDS BASED ON LATER ESTABLISHMENT OF SMALL ENTITY STATUS

37 CFR 1.28(a). 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.

37 CFR 1.28(a) provides a three-month time period for requesting a refund of a portion of a large entity fee based on later establishment of small entity status. The start date of the three-month refund period of 37 CFR 1.28(a) is the date the full fee has been paid. See 37 CFR 1.28(b)(1). Payment by authorization to charge a deposit account is treated for refund purposes the same as payments by other means (e.g., check or credit card authorizations), with each being treated as paid (for refund purposes) on the date of receipt in the Office as defined by 37 CFR 1.6. Thus, the date of receipt of an authorization to charge fees starts the three-month period for refunds under 37 CFR 1.28(a), not the date of debit of the fee to a deposit account. If a payment is mailed with a Certificate of Mailing under 37 CFR 1.8, the three month period for requesting a refund will start on the actual date of receipt of the payment in the Office, and not the Certificate of Mailing date. If a payment is filed by Express Mail under 37 CFR 1.10, the date of deposit with the United States Postal Service (shown by the "date-in" on the Express Mail mailing label or other official USPS notation) is the date of receipt of the payment by the Office under 37 CFR 1.10(a) and the three month period for requesting a refund starts on the date shown by the "date-in" on the Express Mail mailing label rather than the date when the payment actually reaches the Office.

Request for refunds, along with the assertions under 37 CFR 1.27(c), should be addressed to the Assistant Commissioner for Patents, Washington, DC 20231, and directed to the attention of the Refund Section, Financial Accounting Division, Office of Finance.

X. CORRECTING ERRORS IN SMALL ENTITY STATUS

37 CFR 1.28(c). Refunds when small entity status is later established; how errors in small entity status are excused

(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 non-extendable 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.

37 CFR 1.28(c) provides that if small entity status is established in good faith and the small entity fees are paid in good faith, and it is later discovered that such status as a small entity was established in error or through error the Office was not notified of a change of status, the error will be excused upon compliance with the separate submission and itemization requirements of 37 CFR 1.28(c)(1) and (c)(2), and the deficiency payment requirement of 37 CFR 1.28(c)(2). The deficiency amount owed under 37 CFR 1.28(c) is calculated using the date on which the deficiency was paid in full. See 37 CFR 1.28(b)(2).

37 CFR 1.28(c)(1) requires that a deficiency paper be limited to one application or patent file. Where, for example, the same set of facts has caused errors in payment in more than one application and/or patent file, a separate paper must be submitted in each file for which an error is to be excused.

37 CFR 1.28(c)(2) requires that for each fee that was erroneously paid as a small entity, the deficiencies owed must be paid, and the payment of the deficiencies must be itemized. 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. Where there has been a fee decrease, the deficiency owed is equal to the amount (previously) paid in error, not the difference between the amount (previously) paid in error and the new

lower large entity fee. 37 CFR 1.28(c)(2)(ii) requires the following itemizations: (A) the particular fee involved (e.g., basic filing fee, extension of time fee); (B) the small entity fee amount actually paid and when (for example, distinguishing between two one-month extension of time fees erroneously paid on two different dates); (C) the actual deficiency owed for each fee previously paid in error; and (D) the total deficiency owed (i.e., the sum of the individual deficiencies owed).

Under 37 CFR 1.28(c)(3), the failure to comply with the requirements of 37 CFR 1.28(c)(1) and (c)(2) permits the Office at its option to either charge a processing fee (37 CFR 1.17(i)) to process the paper or require compliance within a one-month non-extendable time period to avoid return of the paper.

Any paper submitted under 37 CFR 1.28(c) is treated as a notification of loss of small entity status under 37 CFR 1.27(g)(2). See 37 CFR 1.28(d).

A maintenance fee improperly paid as a small entity where small entity status has been established but is no longer appropriate will be treated as a matter under 37 CFR 1.28(c) and will not be considered to involve expiration of the patent under 37 CFR 1.378. On the other hand, payment of a maintenance fee in the small entity amount where small entity status has not been established would result in the expiration of the patent under 37 CFR 1.378 unless the full maintenance fee due or a written assertion of small entity status is timely filed.

510 U.S. Patent and Trademark Office Business Hours

The U.S. Patent and Trademark Office working hours are 8:30 a.m. to 5:00 p.m., Monday through Friday, excluding Federal holidays in the District of Columbia. Outside these hours, only U.S. Patent and Trademark Office employees are authorized to be in areas of the U.S. Patent and Trademark Office other than the Public Search Rooms.

The hours for the Patent Search Room are 8:00 a.m. to 8:00 p.m., and the hours for the Trademark Search Room are 8:00 a.m. to 6:00 p.m., Monday through Friday, excluding Federal holidays in the District of Columbia.

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of

their visit. In the Technology Centers (TCs), visitors should inform the TC receptionist of their presence before visiting other areas of the TC.

FILING OF PAPERS DURING UNSCHEDULED CLOSINGS OF THE U.S. PATENT AND TRADEMARK OFFICE

37 CFR 1.9(h) provides that the definition of "Federal holiday within the District of Columbia" includes an official closing of the Office. When the entire U.S. Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides "[t]he 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" to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the U.S. Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4(C)(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the 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, correspondence deposited as Express Mail with the United States Postal Service in accordance with 37 CFR 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).

When the U.S. Patent and Trademark Office is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications.

Information regarding whether or not the Office is officially closed on any particular day may be obtained by calling (703) 308-4357 which transposes to (703) 308-HELP.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day 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. 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999. See also 37 CFR 1.7(b).

New patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited in "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

REGULATIONS FOR THE PUBLIC USE OF RECORDS IN THE PATENT SEARCH ROOM OF THE U.S. PATENT AND TRADEMARK OFFICE

The U.S. Patent and Trademark Office has established procedures and regulations for using the facilities of the Patent Search Room. The procedures for the Search Room include the requirement that users obtain and show, prior to entering the Search Room facilities, a User Pass. This pass can be obtained at the receptionist's desk in the lobby of Crystal Plaza Building 3, 2021 South Clark Place, Arlington, VA. User Passes will be issued to persons not under prohibition from using the search facilities who sign an application form and acknowledge receipt of a copy of the noted regulations. User Passes are nontransferable and are valid until reissue or revocation for cause. Office employees must show their building pass in order to enter the Patent Search Room.

Persons exiting the Search Room will automatically pass electronic sensing equipment designed to detect any marked documents or materials being removed from the Search Room. The sensing equipment is capable of detecting marked documents and materials in briefcases and parcels and under clothing. The equipment does not use X-ray or other high energy

radiation and is, therefore, completely safe and harmless to persons, photographic film, magnetic tape, and electronic or mechanical devices such as wrist watches.

Whenever a marked document is transported past the sensing equipment, U.S. Patent and Trademark Office officials and the security guards will be alerted to the removal of the document. Persons triggering the alarm will be asked to cooperate in identifying the source for the alarm. Failure to cooperate when the alarm is triggered could result in detention of the person, seizure of any briefcase or the like, or other legal measures deemed necessary and appropriate in the specific case.

The regulations for the Search Room are reprinted in a regulation brochure. It is available in the Search Room. In order to maintain an environment conducive to search, the regulations will be strictly enforced.

Although these procedures and regulations may cause some inconvenience, it is hoped that with understanding and cooperation they will result in improvement in search facilities which will benefit all participants in the U.S. patent system.

Persons violating the regulations may be denied the use of the facilities in the Patent Search Room, and may further be subjected to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the U.S. Patent and Trademark Office may be forwarded to the Office of Enrollment and Discipline for appropriate action under 37 CFR Part 10.

USE OF TECHNOLOGY CENTER FACILITIES

The primary function of the U.S. Patent and Trademark Office is the examination of nonprovisional applications for patents and the issuance of valid patents based upon a search and consideration of the best available prior art. This can be accomplished only through maintaining strict search file integrity within the Technology Center (TC) facilities.

Therefore, the regulations appearing below were established for those authorized members of the public using the facilities of the TCs.

Although these regulations may cause some inconvenience, it is believed that with the cooperation and understanding of the public, a more efficient and reliable examination system within the patent examining groups will result.

A copy of the following "Regulations for Users of the Technology Center Search Facilities," is posted in each of the TCs and the Patent Search Room:

REGULATIONS FOR USERS OF THE TECHNOLOGY CENTER SEARCH FACILITIES

(A) TC facilities are defined as those areas in Crystal City (Arlington, VA) where the TCs are located.

(B) The use of the TC facilities for search purposes by members of the public is strictly limited to the search of materials not available in the Patent Search Room or the Scientific and Technical Information Center (STIC) and when it does not conflict with the regular business of U.S. Patent and Trademark personnel and only between the hours of 8:45 a.m. and 4:45 p.m. on regular business days.

(C) Authorized Officials, under these regulations, include Supervisory Patent Examiners and TC Directors.

(D) Under applicable statutes and regulations, including 40 U.S.C. 486(c); 41 CFR Subpart 101-20.3; and appropriate Sections of Department Organization Orders 30-3A and 30-3B of the Department of Commerce, the regulations appearing below are established for those members of the public using the TC Facilities.

(1) All persons using these facilities are subject to the Regulations Governing Conduct on Federal Property, as specified in 41 CFR Subpart 101-20.3.

(2) All posted Official Notices are to be complied with.

(3) A valid User Pass must be prominently displayed when searching in the TC Facilities. User Passes are nontransferable and must be surrendered upon request to authorized officials.

(4) All persons holding User Passes must register with the TC Receptionist, unless otherwise directed, in each TC where they search and must sign a log (e.g., indicating time-in, time-out, name, User Pass number, class(es) and subclass(es) searched).

(5) No patents, records, or other documents of the U.S. Patent and Trademark Office shall be removed from the TC Facilities except by express written authorization by an authorized official in the TC where the material resides. Such authorization will not be given for U.S. patents and other material

readily available through the Scientific and Technical Information Center.

(6) Smoking is not permitted except in designated areas.

(7) No food or beverages in any form are to be consumed except in designated areas.

(8) Loud talking, use of radios, and any other form of activity which may disturb other members of the public or U.S. Patent and Trademark Office personnel are forbidden.

(9) Children brought into the TC Facilities must not be allowed to disturb others.

(10) The presence or use of equipment such as dictation equipment, reproducing machines, typewriters, and photographic equipment is prohibited without prior permission from an authorized official in the TC where the use is intended and then is permitted where its use does not conflict with regulation (8) above.

(11) Patents and other documents must not be removed from their shoes for any reason other than for cursory study thereof while kept in close proximate association with the shoe and must not be moved out of their normal sequence.

(12) All patent shoes must be promptly replaced in their proper location in the shoe case.

(13) All textbooks, journals, and the like must be returned to their proper location.

(14) The reserving of seats and/or working areas is prohibited.

(15) All packages, briefcases, or other personal effects brought into the TC Facilities are subject to search by authorized officials upon request and must be removed when leaving the TC Facilities.

(16) All verbal requests for compliance with these regulations or other posted U.S. Patent and Trademark Office Notices pertaining to activity in the TC Facilities, when made by authorized officials, must be promptly complied with.

(E) Persons violating these regulations may be denied the use of the facilities in the TC and Patent Search Room, and may further be subject to prosecution under the Criminal Code. Additionally, the name of any person violating these regulations who is registered to practice before the U.S. Patent and Trademark Office may be forwarded to the Office of Enrollment and Discipline for appropriate action under 37 CFR Part 10.

If any individual is observed in violation of any of the regulations, immediate compliance should be courteously requested. If a verbal request is not complied with, a note should be made of the individual's name and User's Pass number, if possible (the User's Pass is required to be prominently displayed) and a report of the incident should be made to the Supervisory Patent Examiner, Supervisory Applications Examiner, or other appropriate supervisor who will take further action.

In addition, if any individual in a search area appears to be a stranger and is not wearing a User's Pass, some identification, such as a Building or User's Pass, should be requested. If the individual refuses, notify a supervisor. Consequently, all Office employees are expected to carry their Building Pass with them at all times, especially when searching outside of their assigned TCs.

Supervisors, when aware of violations of the posted regulations, should prepare a memorandum detailing the facts of the incident and forward this memorandum to the Deputy Commissioner for Patent Operations via their TC Director. Supervisory Patent Examiners and TC Directors are authorized to demand surrender of User Passes on-the-spot. If the Supervisory Patent Examiner exercises this function, the TC Director should be immediately notified, followed up by a memorandum as previously set forth.

511 Postal Service Emergency Contingency Plan

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.

37 CFR 1.6. Receipt of letters and papers.

(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.

37 CFR 1.6(e) provides a procedure under which correspondence (papers and fees) which could not be filed on a particular date because of an interruption or emergency in the United States Postal Service which is so designated by the Commissioner, may be promptly filed after the ending of such a designated interruption or emergency and be considered as having been filed on that particular date. Authority for such a practice is found in 35 U.S.C. 21(a), as amended by Public Law 97-247.

The U.S. Patent and Trademark Office is establishing the following contingency plan for filing correspondence in the Office in the event of a designated interruption or emergency in the mail service in the United States. Upon determination by the Commissioner of Patents and Trademarks that such an emergency exists, a notice activating the plan will be issued by the Commissioner. The activating notice will be published in the Wall Street Journal and made available by telephone at area code (703) 308-HELP or toll free 1-800-PTO-9199. Also, certain publications, patent bar groups, and other organizations closely associated with the patent system, will be notified. Termination of the program will be similarly announced. Where the postal emergency is not nationwide, the Commissioner will designate the areas of the United States in which the procedures outlined below will be in effect.

U.S. Department of Commerce District Offices will be designated, on an emergency basis, as receiving stations for filing correspondence in the U.S. Patent and Trademark Office.

Upon determination that an emergency exists, the following procedures may be followed: All correspondence should be enclosed in a sealed envelope addressed to the U.S. Patent and Trademark Office and deposited in one of the District Offices. Such papers will be considered as received in the U.S. Patent and Trademark Office on the day of deposit. The District Office will date stamp each envelope and the accompanying receipt card which completely identifies the deposited papers. The receipt card will be returned to the depositor. Applicants or their

representatives should assure the legibility of the date stamp.

District Office deposits should be limited to checks in payment of issue fees, new application papers wherein priority dates or statutory bars may be involved, amendments where the 6-month statutory period for reply is about to expire, trademark oppositions, Section 8 affidavits, trademark renewals, and to other papers for which the patent and trademark statutes do not provide a remedy for failure to obtain a particular date.

Where papers originate from overseas, it is suggested that the papers be mailed to a registered agent in Canada, with a request that the papers be forwarded by courier to the nearest District Office in the United States.

In regard to pending applications, if the time for taking any action or paying any fee expires during the period that the Commissioner declares to be an emergency, the time will be extended until 1-month after the end of the emergency period, provided that such extension does not exceed the maximum period for reply provided for in the statutes.

Since this extension of time will be automatic, there will be no record in the individual files to indicate that a reply filed during the extended period is in fact timely. In order to provide a complete record, applicants or their representatives should file a paper referring to this notice in each case in which a reply is filed during the extended period.

The addresses of the Department of Commerce District Offices, subject to subsequent changes, are as follows:

ALABAMA

Birmingham

- 950 22nd Street North, Room 707, 35203
- Tel. 205-731-1331.

ALASKA

Anchorage

- 3601 C Street, Suite 700, 99503
- Tel. 907-271-6237.
- 222 West 7th Ave., #23, 99513-7575
- Tel. 907-271-5136

Fairbanks

- 1 Eisele Rd., 99712
- Tel. 907-451-1271.

Juneau

- P.O. Box 21668, 99802-1668
- Tel. 907-586-7221

ARIZONA

Phoenix

- 2901 N. Central Ave., Suite 970, 85012
- Tel. 602-640-2513

Tucson

- 6363 S. Country Club Rd., Suite 151, 85706-5906
- Tel. 520-889-6056

ARKANSAS

Little Rock

- Suite 700, 425 W. Capitol Ave., 72201
- Tel. 501-324-5794

CALIFORNIA

El Monte

- 9660 Flair Drive, Suite 455, 91731
- Tel. 818-435-8636

Fresno

- 390-B Fir Ave., Clovis, 93611, Tel. 209-325-1619

Inland Empire

- 2940 Inland Empire Blvd., Suite 121, Ontario, 91764
- Tel. 909-466-4134

Irvine

- Suite 310, 2601 Main Street, 92714
- Tel. 714-251-9001

La Jolla

- 8604 La Jolla Shores Dr., 92038
- Tel. 619-546-7081

Long Beach

- One World Trade Center, Suite 1670, 90831
- Tel. 562-980-4551.
- 501 W. Ocean Blvd., Suite 4200, 90802-4213
- Tel. 310-980-4001

Los Angeles (Downtown)

- 350 S. Figueroa St., Suite 172, 90071
- Tel. 213-894-8784

Los Angeles (West)

- 11000 Wilshire Blvd., Room 9200, 90024
- Tel. 310-235-7104

Monterey

- Airport Road, Bldg. 4, Room 148, 93943
- Tel. 408-647-4206
- 411 Pacific St., Suite 200, 93940
- Tel. 408-641-9850.

Newport Beach

- Suite 345, 3300 Irvine Ave., 92660
- Tel. 714-660-0144

Novato

- 330 Ignacio Blvd., Suite 102, 94949
- Tel. 415-883-1966

Oakland

- 530 Water St., Suite 740, 94607
- Tel. 510-273-7350

Orange County

- 3300 Irvine Ave., Suite 305, Newport Beach, 92660
- Tel. 714-660-1688

Oxnard

- 300 Esplanade Drive, Suite 2090, 93030
- Tel. 805-981-8150

Sacramento

- 917 7th St., 2nd Floor, 95814
- Tel. 916-498-5155

San Francisco

- 250 Montgomery St., 14th Floor, 94104
- Tel. 415-705-2300.
- 221 Main St., Room 1280, 94105
- Tel. 415-744-3001

Santa Clara

- 5201 Great American Pkwy., # 456, 95054
- Tel. 408-970-4610

San Jose

- Suite 250, 96 N. Third Street, 95112-5119
- Tel. 408-291-4204
- 101 Park Center Plaza, Suite 1001, 95113
- Tel. 408-998-7402

San Diego

- 6363 Greenwich Dr., Suite 230, 92122
- Tel. 619-557-5395

Van Nuys

- 15350 Sherman Way, Suite 300, 91406-4224
- Tel. 818-904-6393

COLORADO

Boulder

- 325 Broadway, 80303
- Tel. 303-497-6431
- Radio Building, Room 5001, 80303
- Tel. 303-497-3237
- 1050 Walnut Street, Suite 220, 80302
- Tel. 303-939-0210

Denver

- 6900 W. Jefferson Ave., 80235-2032
- Tel. 1-303-969-6750
- 1244 Speer Blvd., Room 670, 80204
- Tel. 303-844-4715
- 1625 Broadway, Suite 680, 80202
- Tel. 303-844-6622
- 900 19th Street, Suite 765, 80202
- Tel. 303-312-7650
- 999 18th Street, Suite 735, 80202
- Tel. 303-312-7680

CONNECTICUT

Middletown

- Suite 903, 213 Court St., 06457-3346
- Tel. 860-638-6950

Milford

- 212 Rogers Ave., 06460-6435
- Tel. 203-783-4200

DELAWARE

- 615 Chestnut St., Suite 1501, Philadelphia, PA 19106
- Tel. 215-597-6101

DISTRICT OF COLUMBIA

- 14th St. & Constitution Ave., NW, Room 7620, 20230
- Tel. 202-482-0907

FLORIDA

Clearwater

- 1130 Cleveland St., 34615, Tel. 813-461-0011

Coral Gables

- 1320 S. Dixie Hwy. Room 631, IRE Bldg., 33146-2911
- Tel. 305-666-4612

Fort Lauderdale

- 200 E. Las Olas Blvd., Suite 1260, 33301
- Tel. 305-356-7540

Miami

- P.O. Box 590570, 33159, 5600 Northwest 36th St., Suite 617, 33166
- Tel. 305-526-7425
- 51 S.W. First Ave., Room 1314, Federal Office Bldg., 33130
- Tel. 305-536-5054
- 75 Virginia Beach Dr., 33149-1603
- Tel. 305-361-4284
- 4301 Rickenbacker Causeway, Virginia Key
- Tel. 305-361-4300
- 3401 Northwest 59th St., P.O. Box 020197, 33102-0197
- Tel. 305-526-7100

Orlando

- 200 E. Robinson St., Suite 1270, 32801
- Tel. 407-648-6235

Tallahassee

- The Capitol, Suite 2001, 32399-0001
- Tel. 904-488-6469

St. Petersburg

- 9450 Koger Blvd., 33702
- Tel. 813-893-3141

GEORGIA

Atlanta

- 101 Marietta St. N.W., Suite 3200, 30303-2700
- Tel. 1-404-730-3832
- 401 W. Peachtree St., N.W., Suite 1820, 30308-3510
- Tel. 404-730-3002
- 285 Peachtree Center Ave., NE, Suite 200, 30303-1229
- Tel. 404-657-1900
- 401 West Peachtree St., N.W.,
- Room 1715, The Summit Bldg., 30308
- Tel. 404-730-3300
- 401 West Peachtree St., N.W., Suite 2342, 30308
- Tel. 404-730-2780

Savannah

- 6001 Chatham Center Dr., Suite 100, 31405,

- Tel. 912-652-4204.

HAWAII

Honolulu

- 300 Ala Moana Blvd., Room 4106, P.O. Box 50026, 96850
- Tel. 808-541-1782.
- 300 Ala Moana Blvd. (mail to: NOAA, P.O. Box, Room 4110, Prince Kuhio Federal Bldg., 50027, Honolulu, HI 96850-4493),
- Tel. 808-541-1641
- 2570 Dole St., 96822-2396
- Tel. 808-943-1221

IDAHO

Boise

- 2nd Fl., 700 West State St., 83720
- Tel. 208-334-3857

ILLINOIS

Chicago

- 111 North Canal St., Suite 855, 60606-7204
- Tel. 312-353-7706
- 55 West Monroe St., Suite 2440, 60603
- Tel. 312-353-8045
- 2400 Devon Street, Suite 300, 60018
- Tel. 312-353-6640
- 55 E. Monroe St., Suite 1406, 60603
- Tel. 312-353-0182

Highland Park

- 610 Central Ave., Suite 150, 60035
- Tel. 847-681-8010

Rockford

- 515 North Court St., P.O. Box 1747, 61103
- Tel. 815-987-8123

Westchester

- 2255 Enterprise Dr., Suite 5501, 60154-5800
- Tel. 708-562-1350

Wheaton

- 201 E. Loop Road, 60187, c/o Illinois Institute of Technology, Rice Campus
- Tel. 312-353-4332

INDIANA

Indianapolis

- 11405 N. Pennsylvania St., Suite 106, 46032,
- Tel. 317-582-2300.

Jeffersonville

- 1201 E. 10th St., Room 247, 47132,
- Tel. 1-812-218-3344.
- Personal Census Search Unit, P.O. Box 1545, Jeffersonville, 47131,
- Tel. 812-285-5314.

IOWA

Des Moines

- 210 Walnut St., Room 817, 50309
- Tel. 515-284-4222

KANSAS

Kansas City

- 400 State Ave., Gateway Tower II, Suite 600, 66101-2410
- Tel. 913-551-6728

Wichita

- 151 North Volusia, 67214
- Tel. 316-269-6160

KENTUCKY

Louisville

- 601 W. Broadway, Room 634B, 40202,
- Tel. 502-582-5066

Somerset

- 2292 S. Highway 27, Suite 320, 42501
- Tel. 606-677-6160

LOUISIANA

Delta

- 365 Canal St., Suite 2150, New Orleans, 70130
- Tel. 504-589-6546

Shreveport

- 5210 Hollywood Ave., Annex, 71109
- Tel. 318-676-3064

MAINE

Portland

- c/o Maine International Trade Center
- 511 Congress St., 04101
- Tel. 207-541-7400.

MARYLAND

Baltimore

- 401 East Pratt St., World Trade Center, Suite 2432 21202
- Tel. 410-962-4539

Hagerstown

- 319 East Antietam, Hagerstown Telephone Center, St., FTS
- 301-416-7090

Oxford

- 904 South Morris Ave., Oxford Cooperative Laboratory, 21654
- Tel. 410-226-5193

Silver Spring

- 1315 East West Hwy., 20910
- Tel. 301-713-2259
- 1325 D East West Hwy., 20910
- Tel. 301-713-0684
- NIST Gaithersburg Bldg., 413 Room 114, 20899
- Tel. 301-975-4609

MASSACHUSETTS

Boston

- 2 Copley Place, Suite 301, P.O. Box 9108, 02117-9108,
- Tel. 617-424-0500
- 10 Causeway St., Room 350, 02222
- Tel. 617-565-6030
- 164 Northern Ave., Suite 307, World Trade Center, 02210
- Tel. 617-424-5990
- 10 Causeway St., Room 418, 02222-1041
- Tel. 617-565-6850

Gloucester

- One Blackburn Drive, 01930
- Tel. 508-281-9250

Marlborough

- 100 Granger Blvd., Unit 102, 01752
- Tel. 508-624-6000

Woods Hole

- Northeast Fisheries Center, 02543
- Tel. 617-548-5123

MICHIGAN

Ann Arbor

- 2205 Commonwealth Blvd., 48105-1593
- Tel. 313-668-2244
- 425 S. Main Street, Suite 103, 48104
- Tel. 313-741-2430

Detroit

- 1395 Brewery Park Blvd., P.O. Box 33405 48232-5405
- Tel. 313-259-1158
- 211 W. Fort St., Suite 2220, 48226
- Tel. 313-226-3650

Grand Rapids

- 301 W. Fulton St., Suite 718-S, 49504
- Tel. 616-458-3564

Pontiac

- 250 Elizabeth Lake Road, 48341
- Tel. 248-975-9600

MINNESOTA

Minneapolis

- 110 South 4th St., Room 108, 55401
- Tel. 612-348-1638.

MISSISSIPPI

Mississippi

- 704 East Main St., Raymond, 39154
- Tel. 601-857-0128.

Pascageula

- Mississippi Laboratory, P.O. Box 1207, 39568-1207
- Tel. 601-762-4591.

Stennis Space Center

- Stennis Space Center, SSC, 39529-6000,
- Tel. 610-688-2800.

MISSOURI

Kansas City

- 601 E. 12th St., Room 1736, Federal Bldg., 64106,
- Tel. 816-426-2050
- 601 E. 12th St., Room 635, 64106

- Tel. 816-426-3141

- 601 E. 12th St., Room 1728, Federal Bldg., 64106-2897

- Tel. 816-426-5922

- Bldg. 9, 617 Hardesty St., 65124-3097

- Tel. 816-374-6263

St. Louis

- 8182 Maryland Ave., Suite 303, 63105
- Tel. 314-425-3302

MONTANA

See Boise, Idaho

NEBRASKA

Omaha

- 11135 O St., 68137
- Tel. 402-221-3664

NEVADA

Reno

- 1755 East Plumb Lane, Suite 152, 89502
- Tel. 702-784-5203

NEW HAMPSHIRE

Portsmouth

- 17 New Hampshire Ave., 03801-2838
- Tel. 603-334-6074

NEW JERSEY

Highlands

- James J. Howard Marine Science Center, Bldg. 74
- McGuruder Rd., 07732
- Tel. 908-872-3000.

Newark

- One Gateway Center, 9th Fl., 07102
- Tel. 201-645-4682

Princeton

- Forrestal Campus, Princeton University, P.O. Box 308 08540
- Tel. 609-452-6502

Trenton

- 3131 Princeton Pike, Bldg. #6, Suite 100, 08648
- Tel. 609-989-2100

NEW MEXICO

Sante Fe

- c/o New Mexico Dept. of Economic Development,
P.O. Box 20003, 87504-5003
- Tel. 505-827-0350.

NEW YORK

Bohemia

- 630 Johnson Ave., Airport Corp. Center, 11716
- Tel. 516-244-0100.

Buffalo

- 111 West Huron St., Room 1304, 14202
- Tel. 716-846-5290.

Harlem

- 163 West 125th St., Suite 904, New York, 10027
- Tel. 212-860-6200

Long Island

- 1550 Franklin Ave., Room 207, Mineola, 11501
- Tel. 516-739-1765

New York

- Room 37-130, Jacob J. Javits Federal Office Bldg.,
26 Federal Plaza, 10278-0044
- Tel. 1-212-264-3860
- Room 635, 6 World Trade Center, 10048
- Tel. 212-466-5222
- Room 3720, Jacob J. Javits Federal Office Bldg., 26
Federal Plaza, 10278
- Tel. 212-264-3262

Rochester

- 111 West Huron St., Room 1304, 14604
- Tel. 716-263-6480

Staten Island

- Teleport II, 2 Teleport Drive, 10311
- Tel. 718-370-0070.

Westchester

- 707 West Chester Ave., White Plains, 10604
- Tel. 914-682-6218

NORTH CAROLINA

Asheville

- 151 Patton Ave., 28801-5001, Tel: 704-271-4476

Beaufort

- 101 Pivers Island Rd., 28516-9722,
- Tel. 919-728-8724

Carolinas

- 521 E. Morehead St., Suite 435, Charlotte, 28202
- Tel. 704-333-4886

Charlotte

- 901 Center Park Drive, Suite 106, 28217-2935
- Tel. 704-344-6142

Greensboro

- 400 West Market St., Suite 400, 27401
- Tel. 910-333-5345

NORTH DAKOTA

See Minneapolis, Minnesota

OHIO

Cincinnati

- 36 East 7th St., Suite 2650, 45202
- Tel. 513-684-2944

Cleveland

- 600 Superior Ave., East, Suite 700, 44114
- Tel. 216-522-4750.

Columbus

- 4th Fl., 37 North High St., 43215
- Tel. 614-365-9510.

Toledo

- 300 Madison Ave., 43604, Tel. 419-241-0683

OKLAHOMA

Norman

- 1313 Halley Circle, 73069, Tel. 405-366-0427

Oklahoma City

- 301 Northwest 63rd St., Suite 330, 73116
- Tel. 405-231-5302

Tulsa

- 700 N. Greenwood Ave., Suite 1400, 74106
- Tel. 918-581-7650.

OREGON

Eugene

- 1445 Willamette St., Suite 13
- Tel. 541-465-6575

Portland

- 121 S.W. Salmon St., Suite 242, 97204
- Tel. 503-326-3001.

PENNSYLVANIA

Harrisburg

- 3rd Fl., 417 Walnut St., 17101, Tel. 717-232-0051

Philadelphia

- 1st Fl., 105 South 7th St., 19106-3395

- Tel. 1-215-597-4920

- Independence Square West, Suite 140 South, 19106

- Tel. 215-597-4603

- Suite 1501, 615 Chestnut St., 19106

- Tel. 215-597-6101

- 600 Arch St., Room 10128, Federal Bldg., 19106

- Tel. 215-597-9236

Pittsburgh

- 1000 Liberty Ave., 2002 Federal Bldg., 15222

- Tel. 412-395-5050

Scranton

- 1 Montage Mountain Road, Suite B, Moosic, 18507

- Tel. 717-969-2530.

PUERTO RICO

San Juan

- 525 F.D. Roosevelt Ave., Suite 905, 00918

- Tel. 787-766-5555

RHODE ISLAND

Narragansett

- Narragansett Laboratory

- 28 Tarzwell Dr., 02882

- Tel. 401-782-3210

Providence

- One West Exchange St., 02903

- Tel. 401-528-5104

SOUTH CAROLINA

Charleston

- 81 Mary St., 29403, P.O. Box 975, 29402

- Tel. 803-727-4051

- Charleston Laboratory

- P.O. Box 12607, 29412-9110

- Tel. 803-762-8500

Columbia

- 1835 Assembly St., Suite 172, 29201

- Tel. 803-765-5345

Upstate

- Park Central Office Park, Bldg. 1, Suite 109

- 555 N. Pleasantburg Dr., Greenville, 29607

- Tel. 864-271-1976

SOUTH DAKOTA

Siouxland

- Augustana College,

- 2001 S. Summit Ave., Room SS-29A, Sioux Falls, 57197

- Tel. 605-330-4264

TENNESSEE

Knoxville

- 301 East Church Ave., 37915

- Tel. 423-545-4637

Memphis

- 22 North Front St., Suite 200, 38103

- Tel. 901-544-4137

Nashville

- 404 James Robertson Pkwy., Suite 114, 37219

- Tel. 615-736-5161

TEXAS

Austin

- 903 San Jacinto Blvd., Suite 121, 78701-2450

- Tel. 512-916-5595.

- 1700 Congress, 2nd Fl., 78701

- P.O. Box 12728, 78711

- Tel. 512-916-5939.

Dallas

- 6303 Harry Hines Blvd., Suite 210, 75235-5269

- Tel. 214-640-4400.

- 2050 N. Stemmons Fwy., Suite 170, 75207

- P.O. Box 420069, 75342-0069

- Tel. 214-767-0542.

- 525 Griffin St., Room 622, 75202

- Tel. 214-767-9294

- 1100 Commerce St., Room 7B23, 75242

- Tel. 214-767-8001

Fort Worth

- 819 Taylor St., Room 10A26, 76102-6171

- Tel. 817-334-2668.

- 711 Houston St., 76102

- Tel. 817-212-2673

Galveston

- Galveston Laboratory
- 4700 Ave. G, 77551-5997
- Tel. 409-766-8511.

Houston

- 500 Dallas, Suite 1160, 77002
- Tel. 713-718-3062

San Antonio

- 1222 N. Main, Suite 450, 78212
- Tel. 210-228-9878

UTAH

Salt Lake City

- 324 South State St., Suite 221, 84111
- Tel. 801-524-5116
- 125 S. State St., Room 1210, NOAA Federal Bldg. 84147-1102
- Tel. 801-524-5122

VERMONT

Montpelier

- National Life Bldg., Drawer 20, 05620-0501
- Tel. 802-828-4508

VIRGINIA

Arlington

- 2001 Jefferson Davis Hwy., Room 509, 20231
- Tel. 703-306-3315
- 1213 Jefferson Davis Hwy., Suite 805, 22202
- Tel. 703-603-0301.

Norfolk

- 200 World Trade Center, 23510
- Tel. 804-441-6864.
- 439 W. York St., 23510-1114
- Tel. 804-441-6776.

Northern Virginia

- 1616 N. Fort Meyer Dr., Suite 1300, Arlington, 22209
- Tel. 703-524-2885.

Richmond

- 704 East Franklin St., Suite 550, 23219
- Tel. 804-771-2246.

Springfield

- 381 Elden St., Herndon, 22070
- Tel. 703-487-9300.

Wallops Island

- P.O. Box 39, 23337
- Tel. 804-824-7311

WASHINGTON

Seattle

- 7600 Sand Point Way, N.E., 98115,
 - Tel. 206-526-6026.
 - 101 Stewart St., Suite 500, 98101-1098,
 - Tel. 206-728-5300.
 - Jackson Federal Bldg.
 - 915 Second Ave., Room 1856, 98174
 - Tel. 206-220-7660.
 - 2001 6th Ave., Suite 650, 98121
 - Tel. 206-553-5615.
 - 2725 Montlake Blvd., East, 98112,
 - Tel. 206-860-3200.
 - 1801 Fairview Ave., East 98102
 - Tel. 206-442-7656.
 - 915 Second Ave., Room 3292, Federal Bldg., 98174
 - Tel. 206-220-7970.
- Spokane
- 1020 West Riverside, 99201
 - Tel. 509-353-2625.

WEST VIRGINIA

Charleston

- 405 Capitol St., Suite 807, 25301
- Tel. 304-347-5123.

Wheeling

- 1310 Market St., 2nd Fl., 26003
- Tel. 304-233-7492.

WISCONSIN

Milwaukee

- 517 East Wisconsin Ave., Room 596, 53202
- Tel. 414-297-3473.

WYOMING

Served by:

- 1625 Broadway, Suite 680,
- Denver, Colorado 80202
- Tel. 303-844-6622.

512 Certificate of Mailing or Transmission

37 CFR 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.

A suggested format for a Certificate of Mailing and a Certificate of Transmission under 37 CFR 1.8 to be included with the correspondence is reproduced below.

Certificate of Mailing

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
Washington, DC. 20231

on _____

(Date)

Typed or printed name of person signing this certificate

Signature _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703)____-____)

on _____

(Date)

Typed or printed name of person signing this certificate

Signature _____

¶ 5.02 Format of Certificate of Mailing or Transmission

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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
Washington, D.C. 20231

on _____

(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____, (Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Under 37 CFR 1.8, a person may state on certain papers directed to the Office (exceptions are stated in

37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for reply, the reply in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

The Certificate of Transmission procedure, however, also applies to papers transmitted to the Office from a foreign country provided that the correspondence being transmitted is not prohibited from being transmitted by facsimile and is not otherwise precluded from receiving the benefits under 37 CFR 1.8.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt ("Office Date" Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR 1.192 gives an appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to reply to a final rejection was November 10, 1997, and applicant deposited a Notice of Appeal with fee in the U.S. mail on November 10, 1997, and so certified, that appeal is timely even if it was not received in the U.S. Patent and Trademark Office until November 16, 1997. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was due on January 16, 1998. This is 2 months after the Mail Center date.

37 CFR 1.8(a)(2)(i)(A) specifically refers to a request for a continued prosecution application (CPA) filed under 37 CFR 1.53(d) as a correspondence filed for the purposes of obtaining an application filing date and the procedures and benefit set forth in 37 CFR 1.8(a)(1) are not applicable to a request for a CPA. The date on a certificate of mailing or transmission (37 CFR 1.8(a)) of a CPA is not controlling or even relevant. A CPA filed by facsimile transmission will not be accorded a filing date as of the date on the certificate of transmission unless Office records indicate, or applicant otherwise establishes pursuant to 37 CFR 1.6(f), receipt in the Office of the complete CPA on the date on the certificate of transmission and that

date is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

PROCEDURE BY APPLICANT

(A) The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification. Although not specifically required by 37 CFR 1.8, it is preferred that the certificate be signed by the applicant, assignee, or registered practitioner.

(B) When possible, the certification should appear on a portion of the paper being submitted. However, if there is insufficient space to make the certification on the same paper, the certification should be on a separate sheet securely attached to the paper.

(C) When the certification is presented on a separate sheet, that sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. The required identification should include the application number and filing date of the application as well as the type of paper being filed, e.g., reply to rejection or refusal, Notice of Appeal, etc. An unsigned certification will not be considered acceptable.

Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the connection between the sheet and the paper filed.

If the sheet should become detached from the paper and thereafter not associated with the appropriate file, evidence that this sheet was received in the Office can be supported by submitting a copy of a postcard receipt specifically identifying this sheet and the paper and by submitting a copy of the sheet as originally mailed. Attention is directed to MPEP § 503 relative to the use of postcards as receipts.

(D) In situations wherein the correspondence includes papers for more than one application (e.g., a single envelope containing separate papers responding to Office actions in different applications) or papers for various parts of the Office (e.g., a patent issue fee transmittal form PTOL-85B and an assignment), each paper must have its own certification as a part thereof or attached thereto.

Although Form PTOL-85B, Issue Fee Transmittal Form, may contain a Certificate of Mailing thereon, a separate Certificate of Mailing is required for all papers included with this form, including formal drawings, since papers are separated and flow to different areas of the Office. Checks submitted with the papers do not require a separate certification.

(E) In situations wherein the correspondence includes several papers directed to the same area of the Office for the same application (for example, a proposed reply under 37 CFR 1.116 and a Notice of Appeal), each paper should have its own certification as a part thereof or attached thereto.

(F) For the purposes of 37 CFR 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the U.S. Postal Service.

Alternatively, the correspondence may be submitted with a cover or transmittal letter which itemizes the papers and on which is placed the certificate under 37 CFR 1.8.

USE OF STAMPED CERTIFICATION

Some practitioners place the certification language on the first page of a paper with an inked stamp. Such a practice is encouraged because the certification is not only readily visible but also forms an integral part of the paper.

OFFICE PROCEDURE

A. *Mail Center of the Office of Initial Patent Examination*

The Mail Center of the Office of Initial Patent Examination will continue to date stamp the actual date of receipt of all papers received by mail in the Office. No attempt will be made to retain the envelopes in which the papers are received or to indicate on the papers the postal cancellation date (postmark).

However, the benefits of 37 CFR 1.8 or 37 CFR 1.10 apply only to documents delivered to the Office by the U.S. Postal Service. A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the Office via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS." In those instances where documents

include a Certificate of Mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) but were delivered to the Office by other than the U.S. Postal Service, Mail Center personnel are placing a notice indicating that fact on the correspondence involved to alert Office personnel that the benefits of 37 CFR 1.8 or 37 CFR 1.10 do not apply.

B. Processing Areas

When papers are received in a Technology Center (TC), the date of receipt in the TC is stamped on the papers in accordance with 37 CFR 1.6(a).

The date indicated on the Certificate of Mailing or of Transmission will be used by the Office only to determine if the paper was deposited in the United States Postal Service or transmitted by facsimile within the period for reply. If the paper was actually received in the Office within the period for reply, there is no need to refer to the Certificate. Note however, that 37 CFR 1.6(a)(3) provides that "[c]orrespondence 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."

If, however, the paper was received in the U.S. Patent and Trademark Office after the end of the period for reply, the paper should be inspected to determine if a Certificate of Mailing or of Transmission has been included. Where no such Certificate is found, the paper is untimely since applicant did not reply within the period for reply. This may result in abandonment of the application or other loss of rights.

In those instances where a Certificate of Mailing or of Transmission does appear in the paper or a cover letter thereto, a check should be made to determine whether the indicated date of deposit or transmission is within the period for reply. If the date indicated in the Certificate is after the end of the period for reply, the paper is untimely and no notation of the date need be made. Where the date indicated on the Certificate is within the period for reply, the paper should be considered to be timely filed. A notation should be made

adjacent to the Office stamp indicating the date of receipt ("Office Date" Stamp) which notes the date stated on the Certificate. This notation should be "C of Mail" or "C. of Fax" followed by the date. A paper with a certificate dated November 10, 1997, would be noted next to the "Office Date" Stamp "(C of Mail. 11/10/97)." This notation should also appear on the "Contents" portion of the file wrapper.

If the period set for taking an action in the U.S. Patent and Trademark Office ends on a Saturday, Sunday, or Federal holiday within the District of Columbia (37 CFR 1.7), the action will be considered to be timely if deposited in the United States mail or transmitted by facsimile and certified under 37 CFR 1.8(a) on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

It should be noted that the filing of a paper for the purpose of obtaining a continuation or division application under 37 CFR 1.53(d) and former 37 CFR 1.60 or 1.62 is excluded from the Certificate practice under 37 CFR 1.8(a)(2)(i)(A) since it is considered to be the filing of a national patent application.

Effective November 29, 1999, Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day 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. See also 37 CFR 1.7(b). 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

No benefit will be given to a Certificate of Mailing or Transmission relative to the filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date. However, note that new patent applications filed in accordance with 37 CFR 1.10 will be stamped by the Office with the date of deposit as "Express Mail" with the United States Postal Service. For example, if a new patent application is deposited as "Express Mail" in accordance with 37 CFR 1.10 on a Saturday and the United States Postal Service gives it a date of deposit of Saturday, the Office will accord and stamp the correspondence with the Saturday date. 37 CFR 1.6(a)(2).

All Certificates of Mailing or Transmission filed in applications should be placed in the file wrappers directly below the papers to which they refer.

TC personnel receiving a hand-delivered paper from other than U.S. Postal Service personnel should inspect the paper to ensure that the benefits of 37 CFR 1.8 or "Express Mail" benefits under 37 CFR 1.10 are not accorded in error. If the paper contains a certificate of mailing under 37 CFR 1.8 or "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10), the words "HAND DELIVERED" should be written adjacent to the TC date stamp.

Applicant should be notified in the next Office action when a paper containing a Certificate of Mailing has been denied the benefits under 37 CFR 1.8 or a paper containing an "Express Mail" mailing label (commonly used to comply with 37 CFR 1.10) is denied benefits under 37 CFR 1.10 by including, for example, form paragraph 5.04.

¶ 5.04 Benefit of Certificate of Mailing Denied

The [1] filed [2] is not entitled to the benefits of 37 CFR 1. [3] since it was not deposited with the U. S. Postal Service for delivery to the U.S. Patent and Trademark Office. Therefore, the date of receipt in the U.S. Patent and Trademark Office has been used to determine the timeliness of the paper.

Examiner Note:

1. This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing under 37 CFR 1.8 or requests the benefit of "Express Mail" under 37 CFR 1.10, but the correspondence was not actually deposited with the U. S. Postal Service.
2. In bracket 3, insert --8-- or --10--, as appropriate.

Misuse of a Certificate of Mailing under 37 CFR 1.8 or improperly claiming the benefit of 37 CFR 1.10 which appears to be more than a one-time, inadvertent error should be brought to the attention of the Office of Enrollment and Discipline.

ORIGINAL MAILED PAPER NOT DELIVERED

Paragraphs (b) and (c) of 37 CFR 1.8 concern the situation where a paper containing a Certificate was timely deposited in the U.S. mail or transmitted by facsimile, but never received by the U.S. Patent and Trademark Office. In the TCs, all submissions under these paragraphs should be considered and the sufficiency thereof determined by the TC Director. The statement required by 37 CFR 1.8(b)(3) is no longer required to be verified.

513 Deposit as Express Mail with U.S. Postal Service

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.

37 CFR 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.

37 CFR 1.10. Filing of correspondence 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.

The statutory authority for the granting of a filing date based on the date of deposit for correspondence sent by "Express Mail" and received by the Office is found in section 21(a) of Title 35 of the United States Code.

The specific rule for obtaining a filing date as of the date of deposit in "Express Mail" (rather than the date of receipt at the Office) is 37 CFR 1.10, as revised, effective December 2, 1996.

EFFECTIVE DATE, WEEKENDS & HOLIDAYS

Effective December 2, 1996, 37 CFR 1.6(a)(2) provides that correspondence deposited as "Express Mail" in accordance with 37 CFR 1.10 will be stamped, and, therefore, considered as filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia. 37 CFR 1.10 provides a procedure for assigning the date on which any paper or fee is deposited as "Express Mail" with the United States Postal Service (USPS) as the filing date of the paper or fee in the U.S. Patent and Trademark Office (Office). The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. This holds true for any day that the correspondence may be accepted as "Express Mail" by the USPS, even when the paper or fee is deposited and accepted on a Saturday, Sunday

or Federal holiday within the District of Columbia. For example, if a person files a patent application by "Express Mail" with the USPS on a Saturday in compliance with 37 CFR 1.10, he or she will receive the benefit of the Saturday date, even though the Office is closed on Saturdays and, therefore, the person could not have filed the application by depositing it directly at the Office on that Saturday. See 37 CFR 1.6(a)(1). In those cases where the procedure of 37 CFR 1.10(a) has not been properly followed, e.g., the "date-in" is illegible, the filing date of the correspondence will be the date of actual receipt in the Office. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d) or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

DATE-IN, DIRECT DEPOSIT, "EXPRESS MAIL" BOX RECEPTACLES & LOG BOOKS

The procedure in 37 CFR 1.10(a) requires the use of the "Express Mail Post Office to Addressee" service of the USPS. This service provides for the use of a mailing label on which the USPS clearly indicates the date on which it was deposited. Correspondence sent by the "Express Mail Post Office to Addressee" service is considered filed in the Office on the "date-in" entered by the USPS. The "date-in" on the "Express Mail" mailing label must be completed by the USPS, not by the applicant. For correspondence filed in accordance with 37 CFR 1.10, Office personnel will routinely look to the "Express Mail" mailing label, and stamp the "date-in" or other official USPS notation as the filing date of the correspondence. Accordingly, if the USPS enters the deposit date as its "date-in," the correspondence will receive the deposit date as its filing date. If the USPS deposit date cannot be determined, the correspondence will be accorded the date of receipt in the Office as the filing date. An applicant may file a petition under the conditions specified in 37 CFR 1.10(c), (d), or (e) (discussed below) presenting whatever arguments and evidence that the paper or fee is entitled to a filing date other than the filing date accorded by the Office.

37 CFR 1.10(b) further provides that 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, and that persons dealing indirectly with the employees of the USPS (such as by depositing correspondence 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. On petition, the failure to obtain an "Express Mail" receipt with the "date-in" clearly marked may be considered an omission that could have been avoided by the exercise of due care, as discussed below. While the Office strongly urges direct deposit of "Express Mail" correspondence in order to obtain a legible copy of the "Express Mail" mailing label, parties are not precluded from using "Express Mail" drop boxes, but do so at their own risk.

A paper or fee placed in an "Express Mail" box receptacle after the box has been cleared for the last time on a given day will be considered to be deposited as of the date of receipt ("date-in") indicated on the "Express Mail" mailing label by the Postal Service "Express Mail" acceptance clerk. 37 CFR 1.10(d) permits the Office to correct a USPS "date-in" error when the correspondence is deposited in an "Express Mail" drop box prior to last scheduled pick up of the day, that is, the time clearly marked on the "Express Mail" drop box indicating when the box will be cleared for the last time on the date of deposit. 37 CFR 1.10(d) sets forth the procedures to be followed to be entitled to such a correction.

Parties who do use drop boxes can protect themselves from uncertainty due to illegible mailing labels by routinely maintaining a log of "Express Mail" deposits in which notations are entered by the person who deposited the correspondence as "Express Mail" within one business day after deposit with the USPS. Such evidence could be useful to later support a petition filed under 37 CFR 1.10(c), (d) or (e). Evidence that came into being after deposit and within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

“EXPRESS MAIL” MAILING LABEL NUMBER

Effective December 2, 1996, 37 CFR 1.10(b) no longer requires a certificate of mailing by “Express Mail” or that the “Express Mail” mailing label number be placed on the correspondence prior to mailing. Correspondence deposited with the USPS on or after December 2, 1996, and which is actually received by the Office will not be denied a filing date as of the “date-in” appearing on the “Express Mail” mailing label because the number of the “Express Mail” mailing label was not placed on the correspondence prior to the original mailing. However, if the number of the mailing label did not appear on the correspondence as originally filed, relief will not be granted on petition under 37 CFR 1.10(c) through (e), even if the party who filed the correspondence satisfies the other requirements of 37 CFR 1.10(c), 1.10(d) or 1.10(e). To be effective, the number must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto. In situations wherein the correspondence includes several papers directed to the same application (for example, the specification, drawings, and declaration for a new application), the correspondence may be submitted with a cover or transmittal letter which should itemize the papers. It is not necessary that the number be placed on each page of a particular paper or fee transmittal. Merely placing the number in one prominent location on each separate paper or fee transmittal (or cover sheet or transmittal letter which should itemize the separate papers and fees) will be sufficient.

Since the filing of correspondence under 37 CFR 1.10 without the number of the “Express Mail” mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition. A party’s inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, 2.146(a)(5) or 2.148, nor is such an inadvertent omission considered “unavoidable,” within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where

applicant failed to produce “Express Mail” customer receipt or any other evidence that application was actually deposited with USPS as “Express Mail.”), *aff’d without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); *Nitto Chemical Industry Co., Ltd. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner’s refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an “avoidable” oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.); *Vincent v. Mossinghoff*, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); *Gustafson v. Strange*, 227 USPQ 174 (Comm’r Pat. 1985) (counsel’s unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm’r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

PETITIONS

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Commissioner to accord a filing date as of the date of deposit as “Express Mail.” Briefly, 37 CFR 1.10(c) applies where there is a discrepancy between the filing date accorded by the Office and the “date-in” entered by the USPS on the “Express Mail” mailing label or other official USPS notation; 37 CFR 1.10(d) applies where the “date-in” is incorrectly entered by the USPS; and 37 CFR 1.10(e) applies where correspondence deposited with the USPS as “Express Mail” is not received by the Office.

PETITION TO CORRECT FILING DATE AND DATE-IN DISCREPANCY

37 CFR 1.10(c) sets forth procedures for filing a petition to the Commissioner for a filing date as of the date of deposit with the USPS, where there is a discrepancy between the filing date initially accorded by the Office and the “date-in” entered by the USPS or other official USPS notation. Such a petition should:

(A) be filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing; and

(C) include a true copy of the "Express Mail" mailing label showing the "date-in" or other official notation by the USPS.

PETITION TO CORRECT INCORRECTLY ENTERED DATE-IN

37 CFR 1.10(d) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the actual date of deposit with the USPS, where the "date-in" or other official notation is incorrectly entered by the USPS. Such a petition should:

(A) be 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;

(B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing; and

(C) include a showing that the correspondence was deposited as "Express Mail" prior to the last scheduled pickup on the requested filing date.

The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as "Express Mail." Evidence from the USPS may be the "Express Mail" Corporate Account Mailing Statement. Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

The reason the Office considers correspondence to have been filed as of the date of deposit as "Express

Mail" is that this date has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the "Express Mail" mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."

A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was:

(A) created prior to the deposit of the correspondence as "Express Mail" with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence); or

(B) created more than one business day after the deposit of the correspondence as "Express Mail" (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as "Express Mail").

On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as "Express Mail" within one business day of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).

37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

PETITION FOR CORRESPONDENCE NEVER RECEIVED

37 CFR 1.10(e) sets forth procedures for filing a petition to the Commissioner to accord a filing date as of the date of deposit with the USPS, where correspondence deposited as "Express Mail" is never received by the Office. Such a petition should:

(A) be filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(B) include a showing that the number of the "Express Mail" mailing label was placed on each piece of correspondence prior to the original mailing;

(C) include a true copy of the originally deposited 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" or other official notation entered by the USPS; and

(D) include a statement, signed by the person who deposited the documents as "Express Mail" with the USPS, setting forth the date and time of deposit, and declaring that the copies of the correspondence, "Express Mail" mailing label, and returned postcard receipt accompanying the petition are true copies of the correspondence, mailing label and returned postcard receipt originally mailed or received.

37 CFR 1.10(e) provides for the filing of a petition to accord correspondence a filing date as of the date of deposit with the USPS as "Express Mail" only where the correspondence was mailed with sufficient postage and addressed as set out in 37 CFR 1.1(a). There is no corresponding provision that correspondence be properly addressed and mailed with sufficient postage in 37 CFR 1.10(a), (c) and (d), because these sections apply only to correspondence that is actually received by the Office. Correspondence mailed by "Express Mail" that is actually received by the Office will not be denied a filing date as of the date of deposit as "Express Mail" simply because the correspondence was not mailed with sufficient postage or not addressed as set out in 37 CFR 1.1(a). 37 CFR 1.10(e)(3) provides that if the requested filing date is a date other than the "date-in" on the "Express

Mail" mailing label, the petition should include a showing under 37 CFR 1.10(d)(3), as discussed above, that the correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date. 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost *in toto* (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

ADDITIONAL EVIDENCE MAY BE REQUIRED

37 CFR 1.10(f) provides that the Office may require additional evidence to determine whether the correspondence was deposited as "Express Mail" with the USPS on the date in question.



MANUAL OF PATENT EXAMINING PROCEDURE

The Manual of Patent Examining Procedure (MPEP) is a guide for patent examiners and applicants. It provides detailed instructions on the procedures for examining patent applications, including the requirements for filing, the examination process, and the various actions that can be taken by the examiner and the applicant. The MPEP is published by the United States Patent and Trademark Office (USPTO) and is updated periodically to reflect changes in the law and the Office's procedures.

The MPEP is organized into several parts, each covering a different aspect of the patent examination process. Part 1, "Introduction," provides an overview of the patent system and the role of the USPTO. Part 2, "Filing of Applications," covers the requirements for filing a patent application, including the necessary documents and fees. Part 3, "Examination of Applications," describes the process of examining an application, including the search for prior art, the examination of the claims, and the issuance of an office action. Part 4, "Appeals and Revisions," discusses the various ways in which an applicant can respond to an office action, including filing an appeal, a request for reconsideration, or a motion for reconsideration. Part 5, "Final Actions," covers the final steps of the examination process, including the issuance of a patent or the refusal of an application.

The MPEP is a valuable resource for both patent examiners and applicants. It provides a clear and concise explanation of the complex procedures involved in the patent examination process, and it is essential reading for anyone involved in the process. The MPEP is available in both printed and electronic formats, and it is updated regularly to ensure that it remains current and relevant.

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601 Content of Provisional and Nonprovisional Applications [R-1]

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, includ-

ing 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.

37 CFR 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.

GUIDELINES FOR DRAFTING A NONPROVISIONAL PATENT APPLICATION UNDER 35 U.S.C. 111(a)

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use. See also 37 CFR 1.77 and MPEP § 608.01(a). If an application data sheet (37 CFR 1.76) is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet (see 37 CFR 1.76(b)). If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data

sheet will control except for the naming of the inventors and the citizenship of the inventors. See MPEP § 601.05.

Arrangement and Contents of the Specification

The following order of arrangement is preferable in framing the specification. See also MPEP § 608.01(a). Each of the lettered items should appear in upper case, without underlining or bold type, as section headings:

- (A) Title of the invention. (See MPEP § 606).
- (B) Cross-reference to related applications. (See MPEP § 201.11).
- (C) Statement regarding federally sponsored research or development. (See MPEP § 310).
- (D) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation-by-reference of the material on the compact disc. For computer listings filed on or prior to March 1, 2001, reference to a "Microfiche appendix" (see former 37 CFR 1.96(c) for Microfiche appendix).
- (E) Background of the invention. (See MPEP § 608.01(c)).
 - (1) Field of the invention.
 - (2) Description of related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98.
- (F) Brief summary of the invention. (See MPEP § 608.01(d)).
- (G) Brief description of the several views of the drawing. (See MPEP § 608.01(f)).
- (H) Detailed description of the invention. (See MPEP § 608.01(g)).
- (I) Claim(s) (commencing on a separate sheet). (See MPEP § 608.01(i)-(p)).
- (J) Abstract of the Disclosure (commencing on a separate sheet). (See MPEP § 608.01(b)).
- (K) Drawings. (See MPEP § 608.02).
- (L) Sequence Listing, if on paper (See 37 CFR 1.821 through 1.825).

GUIDELINES FOR DRAFTING A PROVISIONAL APPLICATION UNDER 35 U.S.C. 111(b)

A provisional application should preferably conform to the arrangement guidelines for nonprovisional applications. The specification must, however, com-

ply with the first paragraph of 35 U.S.C. 112 and refer to drawings, where necessary for an understanding of the invention. Unlike an application filed under 35 U.S.C. 111(a), a provisional application does not need claims. Furthermore, no oath or declaration is required. See MPEP § 201.04(b).

A cover sheet providing identifying information is required for a complete provisional application. In accordance with 37 CFR 1.51(c)(1) the cover sheet must state that it is for a provisional application, it must identify and give the residence of the inventor or inventors, and it must give a title of the invention. The cover sheet must also give the name and registration number of the attorney or agent (if applicable), the docket number used by the person filing the application (if applicable) and the correspondence address. If there is a governmental interest, the cover sheet must include a statement as to rights to inventions made under Federally sponsored research and development (See MPEP § 310). 37 CFR 1.51(c)(1)(viii) requires the name of the Government agency and the contract number, if the invention was developed by or while under contract with an agency of the U.S. Government.

Unlike applications filed under 35 U.S.C. 111(a), provisional applications should not include an information disclosure statement. See 37 CFR 1.51(d). Since no substantive examination is made, such statements are unnecessary. The Office will not accept an information disclosure statement in a provisional application. Any such statement received, will be returned or disposed of at the convenience of the Office.

This cover sheet information enables the Office to prepare a proper filing receipt and provides the Office of Initial Patent Examining (OIPE) with most of the information needed to process the provisional application. See MPEP § 201.04(b) for a sample cover sheet.

THE APPLICATION

The parts of the application may be included in a single document.

The paper standard requirements for papers submitted as part of the record of a patent application is covered in MPEP § 608.01 under the heading "Paper Requirement."

Determination of completeness of an application is covered in MPEP § 506 and § 601.01 - § 601.01(g).

The elements of the application are secured together in a file wrapper, bearing appropriate identifying data including the application number and filing date (MPEP § 719).

Note

Provisional applications, MPEP § 201.04(b).

Divisional applications, MPEP § 201.06.

Continuation applications, MPEP § 201.07.

Continued prosecution applications, MPEP § 201.06(d).

Reissue applications, MPEP § 1401.

Design applications, MPEP Chapter 1500.

Plant applications, MPEP Chapter 1600.

Reexamination, MPEP Chapter 2200.

A model, exhibit, or specimen is normally not admitted as part of the application, although it may be required in the prosecution of the application (37 CFR 1.91 and 1.93, MPEP § 608.03).

Copies of an application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e), (f) and (g)).

All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, or in the application data sheet after the title of the invention (see 37 CFR 1.76(b)(3)), for example "Proposed Class 2, subclass 129."

601.01 Complete Application

37 CFR 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).

37 CFR 1.53 relates to application numbers, filing dates, and completion of applications. 37 CFR 1.53(a) indicates that an application number is assigned for identification purposes to any paper which purports to

be an application for a patent, even if the application is incomplete or informal. The remaining sections of 37 CFR 1.53 treat nonprovisional applications filed under 35 U.S.C. 111(a) separately from provisional applications filed under 35 U.S.C. 111(b).

37 CFR 1.53(d) sets forth the filing date requirements for a continued prosecution application (CPA). A CPA is a nonprovisional application which must be filed on or after December 1, 1997. Only a continuation or divisional application (but not a continuation-in-part) may be filed as a CPA. See MPEP § 201.06(d). The CPA practice under 37 CFR 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000.

601.01(a) Nonprovisional Applications Filed Under 35 U.S.C. 111(a)

The procedure for filing a nonprovisional application under 35 U.S.C. 111(a) is set forth in 37 CFR 1.53(b) and 37 CFR 1.53(d). 37 CFR 1.53(b) may be used to file any original, reissue, or substitute nonprovisional application and any continuing application, i.e., continuation, divisional, or continuation-in-part. Under 37 CFR 1.53(b), a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the U.S. Patent and Trademark Office (USPTO). Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.

37 CFR 1.53(d) may be used to file either a continuation or a divisional application (but not a continuation-in-part) of a prior utility or plant nonprovisional application filed before May 29, 2000, or any design application. The prior nonprovisional application must be (A) a utility or plant application filed before May 29, 2000 and is complete as defined by 37 CFR 1.51(b), (B) a design application that is complete as defined by 37 CFR 1.51(b), or (C) the national stage of an international application filed under 35 U.S.C. 363 before May 29, 2000 and is in compliance with 35 U.S.C. 371. Any application filed under 37 CFR 1.53(d) must disclose and claim only subject matter disclosed in the prior nonprovisional application and

must name as inventors the same or less than all of the inventors named in the prior nonprovisional application. Under 37 CFR 1.53(d), the filing date assigned is the date on which a request, on a separate paper, for an application under 37 CFR 1.53(d) is filed. An application filed under 37 CFR 1.53(d) must be filed before the earliest of:

(A) payment of the issue fee on the prior application, unless a petition under 37 CFR 1.313(b)(5) is granted in the prior application;

(B) abandonment of the prior application; or

(C) termination of proceedings on the prior application.

The filing fee for an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d) and the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. However, no amendment may introduce new matter into the disclosure of an application after its filing date.

37 CFR 1.53(e) provides for notifying applicant of any application which is incomplete under 37 CFR 1.53(b) or 37 CFR 1.53(d) and giving the applicant a time period to correct any omission. If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee set forth in 37 CFR 1.21(n) will be retained from any refund of a filing fee.

37 CFR 1.53(f) provides that, where a filing date has been assigned to an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d), the applicant will be notified if a correspondence address has been provided and be given a period of time in which to file the missing fee, oath or declaration, and to pay the surcharge due in order to prevent abandonment of the application. The time period usually set is 2 months from the date of notification by the Patent and Trademark Office. This time period may be extended under 37 CFR 1.136(a).

If the required basic filing fee is not timely paid, or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid during the pendency of the application, the application will be disposed of. The notification under 37 CFR 1.53(f) may be made simultaneously with any notification pursuant to 37 CFR 1.53(e). If no correspondence address is included in the application, applicant has 2 months from the filing date to file the fee, oath or declaration

and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

Copies of an application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e) and (f)). The basic filing fee or the processing and retention fee must be paid in a nonprovisional application, if any claim for benefits under 35 U.S.C. 120, 121, or 365(c) based on that application is made in a subsequently filed copending nonprovisional application. 37 CFR 1.78(a)(1).

37 CFR 1.53(h) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received. 37 CFR 1.53(j) indicates that international applications filed under the Patent Cooperation Treaty which designate the United States of America are considered to have a United States filing date under PCT Article 11(3), except as provided in 35 U.S.C. 102(e), on the date the requirements of PCT Article 11(1) (i) to (iii) are met.

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53(b), a filing date is granted to a nonprovisional application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the U.S. Patent and Trademark Office. If an application which has been accorded a filing date does not include the appropriate filing fee or oath or declaration, applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

Applicants should submit a copy of the notice(s) to file missing parts and the notice(s) of incomplete applications with the reply submitted to the U.S. Patent and Trademark Office. Applicants should also include the application number on all correspondence to the Office. These measures will aid the Office in matching papers to applications, thereby expediting the processing of applications.

In order for the Office to so notify the applicant, a correspondence address must also be provided in the

application. The correspondence address may be different from the mailing (post office) address of the applicant. For example, the address of applicant's registered attorney or agent may be used as the correspondence address. If applicant fails to provide the Office with a correspondence address, the Office will be unable to provide applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e). In such a case, applicant will be considered to have constructive notice as of the filing date that the application must be completed within 2 months from the filing date before abandonment occurs per 37 CFR 1.53(f). This time period may be extended pursuant to 37 CFR 1.136.

The oath or declaration filed in reply to such a notice under 37 CFR 1.53(f) must be executed by the inventors and must identify the specification and any amendment filed with the specification which is intended to be part of the original disclosure. See MPEP § 602. If an amendment is filed with the oath or declaration filed after the filing date of the application, it may be identified in the oath or declaration but may not include new matter. No new matter may be included after the filing date of the application. See MPEP § 608.04(b). If the oath or declaration improperly refers to an amendment containing new matter, a supplemental oath or declaration will be required pursuant to 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under 37 CFR 1.53(b) is filed and is referred to in the original oath or declaration filed with or after the application, it constitutes a part of the original application papers and the question of new matter is not considered. Similarly, if the application papers are altered prior to execution of the oath or declaration and the filing of the application, new matter is not a consideration since the alteration is considered as part of the original disclosure.

An amendment which adds additional disclosure submitted with a request for a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in

order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under former 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b)

A provisional application will be given a filing date in accordance with 37 CFR 1.53(c) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in 37 CFR 1.53(c) parallel the requirements for a nonprovisional application set forth in 37 CFR 1.53(b), except that no claim is required. Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

When the specification or drawing are omitted, 37 CFR 1.53(e) requires that the applicant be notified and given a time period in which to submit the missing element to complete the filing. See MPEP § 601.01(f) and § 601.01(g) for treatment of applications filed without drawings, or filed without all figures of drawings, respectively.

37 CFR 1.53(c)(1) requires all provisional applications be filed with a cover sheet, which may be an application data sheet (37 CFR 1.76) or a cover letter identifying the application as a provisional application. The Office will treat an application as having been filed under paragraph (b), unless the application is clearly identified as a provisional application. A provisional application, which is identified as such, but which does not have a complete cover sheet as required by 37 CFR 1.51(c)(1) will be treated as a provisional application. However, the complete cover sheet and a surcharge will be required to be submitted at a later date in conformance with 37 CFR 1.53(g).

When the provisional application does not have a complete cover sheet or the appropriate fee, the applicant will be notified pursuant to 37 CFR 1.53(g) and given a time period in which to provide the necessary fee or cover sheet and to pay the surcharge as set forth in 37 CFR 1.16(l) in order to avoid abandonment of

the application. The time period will usually be set at 2 months from the date of notification. This time period may be extended under 37 CFR 1.136(a). If the filing fee is not timely paid, the Office may dispose of the provisional application. If no correspondence address has been provided, applicant has 2 months from the filing date to file the basic filing fee, cover sheet, and to pay the surcharge as set forth in 37 CFR 1.16(l) in order to avoid abandonment of the provisional application. Copies of a provisional application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the provisional application has been disposed of (see 37 CFR 1.53(e) and (g)).

The basic filing fee must be paid in a provisional application on filing or within the time period set forth in 37 CFR 1.53(g), and the provisional application must be entitled to a filing date under 37 CFR 1.53(c), if any claim for benefits under 35 U.S.C. 119(e) based on that application is made in a subsequently filed nonprovisional application. 37 CFR 1.78(a)(4).

37 CFR 1.53(e)(2) requires that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in 37 CFR 1.17(h) (see MPEP § 506.02).

601.01(c) Conversion to or from a Provisional Application

CONVERSION FROM A NONPROVISIONAL APPLICATION TO A PROVISIONAL APPLICATION

37 CFR 1.53. Application number, filing date, and completion of application.

(c)(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.

An application filed under 37 CFR 1.53(b) may be converted to a provisional application in accordance with the procedure described in 37 CFR 1.53(c)(2). The procedure requires the filing of a request for conversion and the processing fee set forth in 37 CFR 1.17(q). Filing of the request in the nonprovisional application is required prior to the abandonment of the 37 CFR 1.53(b) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 37 CFR 1.53(b) application, or the filing of a request for a statutory invention registration under 37 CFR 1.293, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under 37 CFR 1.53(b).

CONVERSION FROM A PROVISIONAL APPLICATION TO A NONPROVISIONAL APPLICATION

37 CFR 1.53. Application number, filing date, and completion of application.

(c)(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 nonpro-

visional 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).

An application filed under 37 CFR 1.53(c) may be converted to a nonprovisional application in accordance with the procedure described in 37 CFR 1.53(c)(3). Applicants should carefully consider the patent term consequences of requesting conversion rather than simply filing a nonprovisional application claiming the benefit of the filing date of the provisional application under 35 U.S.C. 119(e). Claiming priority is less expensive and will result in a longer patent term. The procedure requires the filing of a request for the conversion of the provisional application to a nonprovisional application and the fee set forth in 37 CFR 1.17(i) as well as the basic filing fee for the nonprovisional application. In addition, if the provisional application was not filed with an executed oath or declaration and the filing fee for a nonprovisional application, the surcharge set forth in 37 CFR 1.16(e) is required. Filing of the request for conversion in the provisional application is required prior to the abandonment of the provisional application or the expiration of 12 months after the filing date of the 37 CFR 1.53(c) application, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under 37 CFR 1.53(c).

601.01(d) Application Filed Without All Pages of Specification

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the pages of specification are present in the application. If the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least

one drawing figure, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Items" indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification.

The mailing of a "Notice of Omitted Items" will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the page(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the page(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)", file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing. An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within 2 months from the date of the "Notice of Omitted Item(s)," file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the later filing date (37 CFR 1.181(f)).

An applicant willing to accept the application as deposited in the USPTO need not respond to the "Notice of Omitted Items," and the failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the "Notice of Omitted Item(s)" (37 CFR 1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the USPTO. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted page(s). Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

If the application does not contain anything that can be construed as a written description, OIPE will mail a Notice of Incomplete Application (PTO-1123) indicating that the application lacks the specification required by 35 U.S.C. 112. Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), asserting that: (1) the missing specification was submitted; or (2) the application papers as deposited contain an adequate written description under 35 U.S.C. 112. The petition under 37 CFR 1.53(e) must be accompanied by sufficient evidence (37 CFR 1.181(b)) to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in the USPTO of the missing specification). Alternatively, applicant may submit the omitted specification, including at least one claim in a nonprovisional application, accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the specification being submitted and accept the date of such submission as the application filing date.

Original claims form part of the original disclosure and provide their own written description. See *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). As such, an application that contains at least one claim, but does not contain anything which can be construed as a written description of such claim(s), would be unusual.

In instances in which a "Notice of Incomplete Application" has been mailed, further action by applicant is necessary for the application to be accorded a filing date. As such, the application will be retained in OIPE to await such action. Unless applicant either completes the application or files a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), within the period set in the "Notice of Incomplete Application," the application will be processed as an incomplete application under 37 CFR 1.53(e).

In instances in which a "Notice of Omitted Items" has been mailed, the application will be retained in OIPE for a period of 2 months from the mailing date of "Notice of Omitted Items" to permit applicant to either: (1) establish prior receipt in the USPTO of the page(s) or drawing(s) at issue; or (2) promptly submit the omitted page(s) or drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. As an applicant may, but is

not required to, reply to such a "Notice of Omitted Items," extensions of time under 37 CFR 1.136 will not be applicable to this 2-month time period.

Unless applicant timely files a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the required petition fee, the application will maintain the filing date as of the date of deposit of the application papers in the USPTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate Technology Center for examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the "Notice of Omitted Item(s)" may be dismissed as untimely. 37 CFR 1.181(f). Under the adopted procedure, the USPTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted page(s) or drawing(s) in a nonprovisional application and request the date of such submission as the application filing date as: (1) according the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and (2) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

The submission of omitted page(s) or drawing(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under

37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) with any omitted page(s) or drawing(s), which is a cost effective alternative in instances in which a nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

APPLICATION LOCATED IN A TECHNOLOGY CENTER

If it is discovered that an application, located in a Technology Center (TC), was filed without all of the page(s) of the specification, and a Notice of Omitted Items has not been mailed by OIPE, the examiner should review the application to determine whether the application is entitled to a filing date. An application is entitled to a filing date if the application contains something that can be construed as a written description, at least one drawing figure (if necessary under 35 U.S.C. 113, first sentence), and at least one claim.

Application Entitled to a Filing Date

If the application is entitled to a filing date, the examiner should notify applicant of the omission in the next Office action and require applicant to do one of the following:

(A) accept the application, as filed, without all of the page(s) of the specification;

(B) file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the omitted page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the date of submission of the omitted page(s) as the application filing date; or

(C) file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h) alleging that the page(s) indicated as omitted was in fact deposited with the USPTO with the application papers, including any and all evidence supporting the allegation. See MPEP § 503. The petition fee will be refunded if

it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing.

If applicant is willing to accept the application, as filed, without all of the page(s) of the application (item A above), an amendment of the specification is required to renumber the pages of the application consecutively and to cancel any incomplete sentences caused by the absence of the omitted page(s). The amendment should be submitted in response to the Office action.

Any petition filed in accordance with item B or C above should be filed with the TC. The TC will match the petition with the application file and forward the application file with the petition to the Office of Petitions, along with a brief explanation as to the page(s) of the specification that has been omitted on filing, for consideration of the petition in due course.

Application NOT Entitled to a Filing Date

If upon review of the application, the examiner determines that the application is NOT entitled to a filing date, the examiner should forward the application to OIPE for mailing of a "Notice of Incomplete Application."

601.01(e) Nonprovisional Application Filed Without At Least One Claim

35 U.S.C. 111(a)(2) requires that an application for patent include, *inter alia*, "a specification as prescribed by section 112 of this title," and 35 U.S.C. 111(a)(4) provides that 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." 35 U.S.C. 112, first paragraph, provides, in part, that "[t]he specification shall contain a written description of the invention," and 35 U.S.C. 112, second paragraph, provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Also, the Court of Appeals for the Federal Circuit stated in *Litton Systems, Inc. v. Whirlpool Corp.*:

Both statute, 35 U.S.C. 111 [(a)], and federal regulations, 37 CFR 1.51 [(b)], make clear the requirement that an

application for a patent *must* include . . . a specification and claims. . . . The omission of any *one* of these component parts makes a patent application incomplete and thus not entitled to a filing date.

728 F.2d 1423, 1437, 221 USPQ 97, 105 (Fed. Cir. 1984)(citing *Gearon v. United States*, 121 F. Supp 652, 654, 101 USPQ 460, 461 (Ct. Cl. 1954), *cert. denied*, 348 U.S. 942, 104 USPQ 409 (1955))(emphasis in the original).

Therefore, in an application filed under 35 U.S.C. 111(a), a claim is a statutory requirement for accord- ing a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that “[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

If a nonprovisional application does not contain at least one claim, or is accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claim(s), a “Notice of Incomplete Application” will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. See *Baxter Int’l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1333, 47 USPQ2d 1225, 1234 (Fed. Cir. 1998); *In re Mattson*, 208 USPQ 168 (Comm’r Pat. 1980). An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

As 37 CFR 1.53(c)(2) permits the conversion of an application filed under 35 U.S.C. 111(a) to an application under 35 U.S.C. 111(b), an applicant in an application, other than for a design patent, filed under 35 U.S.C. 111(a) on or after June 8, 1995, without at least one claim has the alternative of filing a petition under 37 CFR 1.53(c)(2) to convert such application into an application under 35 U.S.C. 111(b), which does not require a claim to be entitled to its date of deposit as a filing date. Such a petition, however, must be filed prior to the expiration of 12 months after the date of

deposit of the application under 35 U.S.C. 111(a), and comply with the other requirements of 37 CFR 1.53(c)(2). See MPEP § 601.01(c).

The treatment of an application subsequent to the mailing of a “Notice of Incomplete Application” is discussed in MPEP § 601.01(d).

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113 of this title” and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the “filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 113 (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.”

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications. Other situations in which drawings are usually not considered necessary for the understanding of the invention under 35 U.S.C. 113 (first sentence) are:

(A) *Coated articles or products*: where the invention resides solely in coating or impregnating a conventional sheet (e.g., paper or cloth, or an article of known and conventional character with a particular composition), unless significant details of structure or arrangement are involved in the article claims;

(B) *Articles made from a particular material or composition*: where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims;

(C) *Laminated structures*: where the claimed invention involves only laminations of sheets (and

coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims; or

(D) *Articles, apparatus, or systems where sole distinguishing feature is presence of a particular material*: where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims, for example:

(1) A hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

(2) Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular material.

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO. The application will be returned to the Office of Initial Patent Examination (OIPE) for mailing of a "Notice of Incomplete Application."

If a nonprovisional application does not have at least one claim directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, or a provisional application does not have at least some disclosure directed to the subject matter discussed above for

which a drawing is usually not considered essential for a filing date, and is filed without drawings, OIPE will mail a "Notice of Incomplete Application" indicating that the application lacks drawings and that 35 U.S.C. 113 (first sentence) requires a drawing where necessary for the understanding of the subject matter sought to be patented.

Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), asserting that (1) the drawing(s) at issue was submitted, or (2) the drawing(s) is not necessary under 35 U.S.C. 113 (first sentence) for a filing date. The petition must be accompanied by sufficient evidence to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in the USPTO of the drawing(s) at issue). Alternatively, applicant may submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to the drawing(s) being submitted and accept the date of such submission as the application filing date.

In design applications, OIPE will mail a "Notice of Incomplete Application" indicating that the application lacks the drawings required under 35 U.S.C. 113 (first sentence). The applicant may: (1) promptly file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), asserting that the missing drawing(s) was submitted; or (2) promptly submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 and accept the date of such submission as the application filing date. 37 CFR 1.153(a) provides that the claim in a design application "shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described." As such, petitions under 37 CFR 1.53(e) asserting that drawings are unnecessary under 35 U.S.C. 113 (first sentence) for a filing date in a design application will not be found persuasive.

The treatment of an application subsequent to the mailing of a "Notice of Incomplete Application" is discussed in MPEP § 601.01(d).

601.01(g) Applications Filed Without All Figures of Drawings

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the

specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification.

The mailing of a "Notice of Omitted Item(s)" will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)," file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must, within 2 months from the date of the "Notice of Omitted Item(s)," file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the later filing date (37 CFR 1.181(f)).

An applicant willing to accept the application as deposited in the USPTO need not respond to the "Notice of Omitted Item(s)," and the failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the required petition fee as discussed above within 2 months of the date of the "Notice of Omitted Item(s)" (37 CFR 1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the USPTO. Amendment of the specification is required in a nonprovisional application to cancel all

references to the omitted drawing, both in the brief and detailed descriptions of the drawings and including any reference numerals shown only in the omitted drawings. In addition, a separate letter is required in a nonprovisional application to renumber the drawing figures consecutively (showing the proposed changes in red ink), if necessary, and amendment of the specification is required to correct the references to the drawing figures to correspond with any relabeled drawing figures, both in the brief and detailed descriptions of the drawings. Such amendment and correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

The treatment of an application subsequent to the mailing of a "Notice of Omitted Item(s)" is discussed in MPEP § 601.01(d).

Applications are often filed with drawings with several views of the invention where the views are labeled using a number-letter combination, e.g., Fig. 1A, Fig. 1B, and Fig. 1C. OIPE will not mail a "Notice of Omitted Item(s)" if a figure which is referred to in the specification by a particular number cannot be located among the drawings, if the drawings include at least one figure labeled with that particular number in combination with a letter. For example, if the drawings show Figures 1A, 1B, and 1C and the brief description of the drawings refers only to Figure 1, this is an error in the specification which must be corrected, rather than an application filed without all figures of drawings.

APPLICATION LOCATED IN A TECHNOLOGY CENTER

If it is discovered that an application, located in a Technology Center (TC), was filed without all of the drawing figure(s) referred to in the specification, and a Notice of Omitted Items has not been mailed by the OIPE, the examiner should review the application to determine whether the application is entitled to a filing date. An application is entitled to a filing date if the application contains something that can be construed as a written description, at least one drawing figure (if necessary under 35 U.S.C. 113, first sentence), and at least one claim.

Application Entitled to a Filing Date

If the application is entitled to a filing date, the examiner should notify applicant of the omission in the next Office action and require applicant to do one of the following:

(A) accept the application, as filed, without all of the drawing figure(s) referred to in the specification;

(B) file any omitted drawing figure(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the omitted drawing figure(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the date of submission of the omitted drawing figure(s) as the application filing date; or

(C) file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(h) alleging that the drawing figure(s) indicated as omitted was in fact deposited with the USPTO with the application papers, including any and all evidence supporting the allegation. See MPEP § 503. The petition fee will be refunded if it is determined that the drawing figure(s) was in fact received by the USPTO with the application papers deposited on filing.

If applicant is willing to accept the application, as filed, without all of the drawing figure(s) referred to in the application (item A above), applicant is required to submit (1) an amendment to the specification canceling all references to the omitted drawing figure(s) including any reference numerals shown only in the omitted drawing figure(s), (2) a separate letter renumbering the drawing figure(s) submitted on filing consecutively, accompanied by a copy of drawing figure(s) showing the proposed changes in red ink, and (3) a further amendment to the specification correcting references to drawing figure(s) to correspond with the relabeled drawing figure(s), both in the brief and detailed descriptions of the drawings. The amend-

ment and the separate letter should be submitted in response to the Office action.

Any petition filed in accordance with item B or C above should be filed with the TC. The TC will match the petition with the application file and forward the application file with the petition to the Office of Petitions, along with a brief explanation as to the drawing figure(s) that has been omitted on filing, for consideration of the petition in due course.

Application NOT Entitled to a Filing Date

If upon review of the application, the examiner determines that the application is NOT entitled to a filing date because the application does not contain any drawing figure, and at least one drawing figure is necessary under 35 U.S.C 113, first sentence, the examiner should forward the application to OIPE for mailing of a "Notice of Incomplete Application."

601.01(h) Forms

The Office of Initial Patent Examination (OIPE) is no longer using pre-printed forms and is instead using individualized notices generated by a computer to notify applicants of defects.

601.02 Power of Attorney or Authorization of Agent

The attorney's or agent's full mailing (post office) address (including ZIP Code) must be given in every power of attorney or authority of agent. The telephone and fax numbers of the attorney or agent should also be included in the power. The prompt delivery of communications will thereby be facilitated.

A power of attorney or authorization of agent may be incorporated in the oath or declaration form with the power of attorney or authorization of agent given by inventors. Otherwise, a separate power of attorney or authorization of agent (e.g., PTO/SI) should be used. (See MPEP § 402.)

Please type a plus sign (+) inside this box

PTO/SB/81 (02-01)

Approved for use through 10/31/2002. OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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	First Named Inventor	
	Title	
	Group Art Unit	
	Examiner Name	
	Attorney Docket Number	

I hereby appoint:

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Telephone Fax

I am the:

Applicant/Inventor.

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).

SIGNATURE of Applicant or Assignee of Record

Name	
Signature	
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 than one signature is required, see below*.

*Total of forms are submitted.

Burden Hour Statement: This form is estimated to take 3 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

601.03 Change of Correspondence Address

37 CFR 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).

37 CFR 1.33(a) provides that the application must specify a correspondence address to which the Office will send notice, letters, and other communications relating to an application. The correspondence address must either be in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with the application filing. Where more than one correspondence address is specified, the Office will determine which one to

establish as the correspondence address. This is intended to cover the situation where an unexecuted application is submitted with multiple addresses, such as one correspondence address being given in the application transmittal letter, and a different one in an accompanying unexecuted 37 CFR 1.63 declaration, or other similar situations. The Office will determine which of the different addresses to use as the correspondence address on a case-by-case basis.

The submission of a daytime telephone number of the party to whom correspondence is to be addressed is requested pursuant to 37 CFR 1.33(a). While business is to be conducted on the written record (37 CFR 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to a writing. Any party who could change the correspondence address could also change the telephone number.

37 CFR 1.33(a)(1) provides that the party filing the application and setting forth a correspondence address may later change the correspondence address provided that an executed oath or declaration under 37 CFR 1.63 by any of the inventors has not been filed. If a registered attorney or agent filed the application, any other registered practitioners named in the transmittal letter may change the correspondence address. A registered practitioner named in a letterhead would not be considered as being named in the transmittal letter for purposes of changing the correspondence address. A clear identification of the individual as a representative would be required. If an application is filed by a company to whom the invention has been assigned or to whom there is an obligation to assign the invention, a person who has the authority to act on behalf of the company may 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 pursuant to 37 CFR 1.33(a)(1). The filing of an executed oath or declaration that does not include a correspondence address does not affect any correspondence address previously established on filing of the application, or changed pursuant to 37 CFR 1.33(a)(1).

Where a correspondence address has been established on filing of the application or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of an executed oath or declaration under 37 CFR 1.63

the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under 37 CFR 1.63 and can only be subsequently changed pursuant to 37 CFR 1.33(a)(2). Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by (A) a registered attorney or agent of record appointed in compliance with 37 CFR 1.34(b), (B) an assignee as provided for under 37 CFR 3.73(b), or (C) all of the applicants (37 CFR 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 37 CFR 3.71. See 37 CFR 1.33(a)(2).

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See MPEP § 403 for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02.

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in

the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR 1.63(d)(4).

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

The obligation (see 37 CFR 10.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

601.04 National Stage Requirements of the United States as a Designated Office

See MPEP Chapter 1800, especially MPEP § 1893.01 for requirements for entry into the national stage before the Designated Office or Elected Office under the Patent Cooperation Treaty (PCT).

601.05 Bibliographic Information - Application Data Sheet (ADS)

37 CFR 1.76. Application Data Sheet

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be voluntarily submitted 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).

37 CFR 1.76 provides for the voluntary inclusion of an application data sheet in provisional and nonprovisional applications. A guide to preparing an application data sheet (Patent Application Bibliographic Data Entry Format) can be found on the U.S. Patent and Trademark Office (Office) Web site at "<http://www.uspto.gov>" by clicking on "Patents" in the "Applications" column, click on "PrintEFS." In addition to an authorizing guide in two formats, there are also instructions for downloading the new PrintEFS software, and frequently asked questions about this software.

An application data sheet is a sheet or set of sheets containing bibliographic data, which is arranged in a format specified by the Office. When an application data sheet is provided in a provisional or nonprovisional application, the application data sheet

part of the provisional or nonprovisional application. While the use of an application data sheet is optional, the Office prefers its use to help facilitate the electronic capturing of this important data. The data that is suggested to be supplied by way of an application data sheet can also be provided elsewhere in the application papers, but it is to applicant's advantage to submit the data via an application data sheet. To help ensure that the Office can, in fact, electronically capture the data, the Office specifies a particular format to be used. The Office does not, however, provide an application data sheet paper form. Electronic capture of the information from the application data sheet coupled with automated entry into Office records is quicker and more accurate than the current practice of manually extracting the information from numerous documents in the application file.

Applicants benefit from their use of application data sheets as the Office will electronically capture the data provided by application data sheets and, in return, provide applicants with more accurate filing receipts and published applications. Electronic capture of the application data sheet information by scanning occurs at the same time that the application papers are scanned during initial processing. Accordingly, for applicant to obtain the maximum benefit from use of an application data sheet, it should be submitted with the application when it is filed. Application data sheets or supplemental application data sheets submitted after the application is filed will have their information captured by operators manually keying in the information from the application data sheets or supplemental application data sheets.

Bibliographic data under 37 CFR 1.76(a) includes: (1) applicant information; (2) correspondence information; (3) application information; (4) representative information; (5) domestic priority information; (6) foreign priority information; and (7) assignee information. The naming of the inventors and the setting forth of the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 (as is required by 35 U.S.C 115) even if this information is provided in the application data sheet.

Applicant information includes the name, residence, mailing address, and citizenship of each applicant (37 CFR 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 (37 CFR 1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor. The "mailing address" is the address where applicant customarily receives mail.

Correspondence information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see 37 CFR 1.33(a)).

Application information includes the title of the invention, a suggested classification by class and subclass, the Technology Center (TC) 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, and the type of application (e.g., utility, plant, design, reissue, provisional). Application information also includes whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to 37 CFR 5.2(c). For plant applications, application information also includes the Latin name of the genus and the species of the plant claimed, as well as the variety denomination.

Although the submission of the information related to a suggested classification and TC is desired for both provisional and nonprovisional applications, the Office will not be bound to follow such information if submitted, as the Office will continue to follow its present procedures for classifying and assigning new applications. Similarly for the suggested drawing figure, the Office may decide to print another figure on the front page of any patent issuing from the application.

Application information also includes information about provisional applications, particularly their class and subclass, and the TC. Provisional applications are not examined or even processed (e.g., having a class and subclass assigned or being forwarded to a TC). Even though provisional applications are not examined, the TC and the class and subclass, if known to applicants, would be of benefit to the Office in giving an indication of where nonprovisional applications may be eventually received in the Office and their technologies so that the Office will be better able to plan for future workloads.

602.01 Oath Cannot Be Amended

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper such as an application data sheet (see 37 CFR 1.76 and MPEP § 601.05) and a new oath or declaration is not necessary. See 37 CFR 1.63(c)(1) and (c)(2).

For example, if the oath does not set forth evidence that the notary was acting within his or her jurisdiction at the time he or she administered the oath, a certificate of the notary that the oath was taken within his or her jurisdiction will correct the deficiency. See MPEP § 602 and § 604.02.

Applicant may be so advised by using form paragraph 6.03.

¶ 6.03 Oath, Declaration Cannot Be Amended

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

1. This form paragraph is intended primarily for use in *pro se* applications.
2. Use form paragraph 6.05 and one or more of form paragraphs 6.05.01 to 6.05.20 for a defective oath or declaration in a case where there is a power of attorney.
3. Some corrections may be made by an application data sheet. If the error is correctable by an application data sheet, applicant should be informed of the requirements of an application data sheet. See 37 CFR 1.76 and MPEP § 601.05.

¶ 6.05.16 Non-Initialed/Non-Dated Alterations

Non-initialed and/or non - dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

602.02 New Oath or Substitute for Original

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the application number and the date of filing. Any one of the combinations of information identified in MPEP § 601.01(a) as acceptable for an oath or declaration filed after the filing date may be used.

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but each oath or declaration names all of the inventors and the two taken together give all the required data, no further oath or declaration is needed.

602.03 Defective Oath or Declaration

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that the same be remedied. Applicant may be informed of deficiencies in the declaration or oath by form paragraphs 6.05 and 6.05.01 - 6.05.20.

The following form paragraph 6.05 must be used to introduce one or more of Form Paragraphs 6.05.01 - 6.05.20, which explain errors in the oath or declaration. One or more of the following form paragraphs may be used to notify applicant of the objections to the oath or declaration due to a missing "reviewed and understands" statement, "original and first" statement, duty to disclose statement, or if the oath or declaration is not in permanent ink. See MPEP § 602 for defects in the execution of the oath or declaration, failure to properly reference to an earlier foreign application, a missing sole or joint designation, or a failure to properly identify the application papers. See MPEP § 602.04 for a defective foreign executed oath and MPEP § 602.04(a) for an oath with an improperly attached ribbon.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

CFR 1.63 or 37 CFR 1.67). Supplemental application data sheets should indicate the information that is being supplemented, and therefore they need not contain information previously supplied that has not changed. See 37 CFR 1.76(c)(2). Submission of a supplemental application data sheet containing all the information previously supplied as well as new or updated information without identifying the changes would be harder for the Office to process as the supplemental application data sheets will not be scanned but captured manually.

Resolution of inconsistent information supplied by both an application data sheet and the oath or declaration under 37 CFR 1.63, or 37 CFR 1.67 are addressed in 37 CFR 1.76(d). 37 CFR 1.76(d)(1) provides that the latest submitted information will govern notwithstanding whether supplied by an application data sheet or by an oath or declaration under 37 CFR 1.63, or 37 CFR 1.67. 37 CFR 1.76(d)(2) provides that the information in the application data sheet will govern when the inconsistent information is supplied at the same time by a 37 CFR 1.63 or 37 CFR 1.67 oath or declaration. This is because the application data sheet (and not the oath or declaration) is intended as the means by which applicants will provide most information to the Office that will be captured by scanning to avoid manual input of data. It is inefficient for the Office to check two documents, the application data sheet and the oath/declaration, for the same piece of information, or to automatically correct the data when the information in the oath or declaration is inconsistent with the application data sheet. In the small number of instances where an oath or declaration under 37 CFR 1.63 or 37 CFR 1.67 has more accurate information than a concurrently supplied application data sheet (37 CFR 1.76(d)(2)), a supplemental application data sheet should be submitted to conform the information presented by the application data sheets with the correct information in the oath or declaration (37 CFR 1.76(d)(1)).

If an application is filed with an application data sheet improperly identifying the residence of one of the inventors, inventor B, and an executed 37 CFR 1.63 declaration setting forth the correct but different residence of inventor B, the Office will capture the residence of inventor B found in the application data sheet as the residence of B, and include that information in the filing receipt. If applicant desires correc-

tion of the residence, applicant should submit a supplemental application data sheet under 37 CFR 1.76(c), with the name of inventor B and the corrected residence for inventor B.

Pursuant to 37 CFR 1.76(d)(3), the oath or declaration under 37 CFR 1.63 or 37 CFR 1.67 governs inconsistencies with the application data sheet in the naming of inventors and setting forth their citizenship. If different inventors are listed in the application data sheet than are named in the oath or declaration for the application, the inventors named in the oath or declaration are considered to be the inventors named in the patent application. See 37 CFR 1.76(d)(3). Any change in the inventorship set forth in the oath or declaration under 37 CFR 1.63 must be by way of petition under 37 CFR 1.48(a) notwithstanding identification of the correct inventive entity in an application data sheet or supplemental application data sheet. Similarly, if the oath or declaration under 37 CFR 1.63 incorrectly sets forth the citizenship of one of the inventors, that inventor must submit a supplemental oath or declaration under 37 CFR 1.67 with the correct citizenship notwithstanding the correct identification of the citizenship in an application data sheet or supplemental application data sheet.

The Office will rely upon information supplied in the application data sheet over an oath or declaration to electronically capture the data even where the type of information supplied (citizenship, inventorship) is governed by the oath or declaration according to statute (35 U.S.C. 115) or other rule (37 CFR 1.41(a)(1)). Where the oath or declaration under 37 CFR 1.63 or 37 CFR 1.67 contains the correct information regarding inventors or their citizenship and the application data sheet does not, even though the oath or declaration governs pursuant to 37 CFR 1.76(d)(3), the information in the application data sheet must be corrected by submission of a request that the Office recapture the information and a supplemental application data sheet or a letter pursuant to 37 CFR 1.33(b) showing the correct information.

If an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed 37 CFR 1.63 declaration setting forth a different incorrect citizenship of inventor B, the Office will capture the citizenship of inventor B found in the application data sheet. Applicant, however, must submit a supplemental oath or declara-

602.04(a) Foreign Executed Oath Is Ribbed to Other Application Papers

37 CFR 1.66. Officers authorized to administer oaths.

(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 ribbed 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.

Where the papers are not properly ribbed, use form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.14.

¶ 6.05.14 No Ribbon Properly Attached

It does not have a ribbon properly attached.

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

U.S. ACCESSION TO HAGUE CONVENTION ABOLISHING THE REQUIREMENT OF LEGALIZATION FOR FOREIGN PUBLIC DOCUMENTS

On Oct. 15, 1981, the Hague "Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries as parties to the Convention. Subsequently, additional countries have become parties to the Convention. The Convention applies to any document submitted to the United States Patent and Trademark Office for filing or recording, which is sworn to or acknowledged by a notary public in any one of the member countries. The Convention abolishes the certification of the authority of the notary public in a member country by a diplomatic or consular officer of the United States and substitutes certification by a special certificate, or

apostille, executed by an officer of the member country. Accordingly, the Office will accept for filing or recording a document sworn to or acknowledged before a notary public in a member country if the document bears, or has appended to it, an apostille certifying the notary's authority. The requirement for a diplomatic or consular certificate, specified in 37 CFR 1.66, will not apply to a document sworn to or acknowledged before a notary public in a member country if an apostille is used.

The member countries that are parties to the Convention are:

Andorra, Angola¹, Anguilla, Antigua and Barbuda, Argentina, Armenia², Aruba, Australia, Austria, Bahamas, Barbados, Belarus², Belgium, Belize, Bermuda, Bosnia-Herzegovina³, Botswana, British Antarctic Territory, British Virgin Islands, Brunei, Cayman Islands, Comoros Islands (formerly Moroni)¹, Croatia³, Cyprus, Djibouti (formerly Affars and Issas)¹, Dominica¹, El Salvador, Falkland Islands, Fiji, Finland, France, French Guiana, French Polynesia, Guadeloupe, Germany, Gibraltar, Greece, Grenada¹, Guernsey (Bailiwick of), Hong Kong, Hungary, Isle of Man, Israel, Italy, Japan, Jersey (Bailiwick of), Kiribati (formerly Gilbert Islands)¹, Latvia, Lesotho, Liechtenstein, Luxembourg, Macedonia³, Malawi, Malta, Marshall Islands, Martinique, Mauritius, Mexico, Montserrat, Mozambique¹, Netherlands, Netherlands Antilles (Curacao, Bonaire, St. Martin, St. Eustatius and Saba), New Caledonia, Norway, Panama, Portugal, Reunion, Russian Federation², St. Christopher (Kitts) and Nevis, St. Georgia and South Sandwich Islands, St. Helena, St. Lucia, St. Pierre and Miquelon, St. Vincent and the Grenadines, San Marino, Seychelles, Slovenia³, Solomon Islands (formerly British Solomon Islands)¹, South Africa, Spain, Suriname, Swaziland, Switzerland, Tonga, Turkey, Turks and Caicos, Tuvalu (formerly Ellice Islands)¹, United Kingdom, United States, Vanuatu (formerly New Hebrides)¹, Wallis and Futuna.¹²³

The Convention prescribes the following form for the apostille:

¹This country achieved independence. No declaration has been made on the continuation in force of the Convention.

Secrecy Order in Parent Appl.?

If plant patent app.,

Latin name of genus and species of plant claimed:

Representative Information

Registration Number One:

Registration Number Two:

[Repeat for extra registration numbers]

Domestic Priority Information

This application is a: [Continuation of]

Application One:

Filing Date:

which is a:

Application Two:

Filing Date:

[repeat as necessary]

Foreign Application Information

Foreign Application One:

Filing Date:

Country:

Priority Claimed: [Yes or No]

Assignee Information

Name of assignee:

Address Line One:

Address Line Two:

City:

State or Province:

Country:

Postal or Zip Code:

602 Original Oath or Declaration

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).

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.

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).

37 CFR 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

matter relative to the prior application, the examiner should so notify the applicant in the next Office action. The examiner should also (1) require a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(e); and (2) indicate that the application should be redesignated as a continuation-in-part.

A continuation or divisional application of a prior application accorded status under 37 CFR 1.47 will be accorded status under 37 CFR 1.47 if a copy of the decision according 37 CFR 1.47 status in the prior application is filed in the continuation or divisional application, unless an oath or declaration signed by all of the inventors is included upon filing the continuation or divisional application. An oath or declaration in an application accorded status under 37 CFR 1.47 is generally not signed by all of the inventors. Accordingly, if a copy of an oath or declaration of a prior application is submitted in a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration omits the signature of one or more inventors, the Office of Initial Patent Examination (OIPE) should send a "Notice to File Missing Parts" requiring the signature of the nonsigning inventor, unless a copy of the decision according status under 37 CFR 1.47 is also included at the time of filing of the continuation or divisional application. If OIPE mails such a Notice, a copy of the decision according status under 37 CFR 1.47, together with a surcharge under 37 CFR 1.16(e) for its late filing, will be an acceptable reply to the Notice. Alternatively, applicant may submit an oath or declaration signed by the previously nonsigning inventor together with the surcharge set forth in 37 CFR 1.16(e) in reply to the Notice.

If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under 37 CFR 1.53(b), the continuation or divisional application may either be filed (1) with a copy of an oath or declaration from a prior application and a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application (see 37 CFR 1.63(d)), or (2) a newly executed oath or declaration naming the correct inventive entity. If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under 37 CFR 1.53(d), the request for filing the continuation or divisional appli-

cation must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application (see 37 CFR 1.53(d)(4)).

A continuation or divisional application filed under 37 CFR 1.53(b) of a prior application in which a petition (or request) under 37 CFR 1.48 to add an inventor was filed should be filed with a copy of the executed declaration naming the correct inventive entity from the prior application or a newly executed declaration naming the correct inventive entity. A copy of any decision under 37 CFR 1.48 from the prior application is not required to be filed in the continuation or divisional application.

602.06 Non-English Oath or Declaration

37 CFR 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.

37 CFR 1.69 requires that oaths and declarations be in a language which is understood by the individual making the oath or declaration, i.e., a language which the individual comprehends. If the individual comprehends the English language, he or she should preferably use it. If the individual cannot comprehend the English language, any oath or declaration must be in a language which the individual can comprehend. If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him or her so that he or she is able to understand them.

The Office will accept a single non-English language oath or declaration where there are joint inven-

Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required to be supported, evidenced, established, or proved by sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1]If executed without the United States:

"I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature)."

[2]If executed within the United States its territories, possessions, or commonwealths:

"I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature)."

A 37 CFR 1.68 declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration. It must, however, since it is an integral part of the application, be maintained together therewith.

By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent and Trademark Office."

The filing of a written declaration is acceptable in lieu of an original application oath that is informal.

The following form paragraphs may be used to notify applicant that the oath or declaration is defective because it was not properly executed.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.01 Improper Execution

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.17 Declaration Clause Omitted

The clause regarding "willful false statements ..." required by 37 CFR 1.68 has been omitted.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

EARLIER FOREIGN APPLICATIONS

Oaths and declarations must make reference to any foreign application for patent (or inventor's certificate) for which priority is claimed and any foreign application filed prior to the filing date of an application on which priority is claimed, unless such information is included in an application data sheet. See 37 CFR 1.63(c)(2).

If all foreign applications have been filed within 12 months of the U.S. filing date, applicant is required only to recite the first such foreign application of which priority is claimed, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed prior to the application on which priority is claimed. It is required to give the foreign application number and name of the country or office in which filed, as well as the filing date of the first filed foreign application.

If the information regarding the foreign application has not been included in an application data sheet, or in an oath or declaration, form paragraphs 6.05 and 6.05.08 may be used to notify applicant that the oath or declaration is defective because the prior foreign application has not been identified.

¶ 6.05.08 Identification of Foreign Applications Omitted

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 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.

sheet under 37 CFR 1.76 containing only a change in inventor B's mailing address.

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a). If there are no joint inventor(s), then the party with sufficient proprietary interest must sign the supplemental declaration on behalf of the nonsigning inventor. See MPEP § 409.03(b).

A new oath may be required by using form paragraph 6.06.

¶ 6.06 New Oath for Subject Matter Not Originally Claimed

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP § 608.01(d) and 1302, and 37 CFR 1.73.

603.01 Supplemental Oath or Declaration Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 F. 158 (2d Cir. 1921), many supplemental oaths and declarations covering the claims in the application have been filed after the applications were allowed. Such oaths and declarations may be filed as a matter of right and when received they will be placed in the file by the Office of Patent Publication, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under 37 CFR 1.312, since they make no change in the wording of the papers on file. See MPEP § 714.16.

604 Administration or Execution of Oath

37 CFR 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.

See MPEP § 602.04(a) for foreign executed oath.

604.01 Seal

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his or her 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, except as noted in MPEP § 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the examiner should require proof of authority. Depending on the jurisdiction, the seal may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

See also MPEP § 602.04(a) on foreign executed oath and seal. In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina, and Virginia.

(D) title of the invention which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the USPTO is the application which the inventor(s) executed by signing the oath or declaration.

Form paragraphs 6.05 and 6.05.20 may be used to notify applicant that the oath or declaration is defective because the specification has not been adequately identified.

¶ 6.05.20 Specification Not Identified

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

Any specification that is filed attached to an oath or declaration on a date later than the application filing date will not be compared with the specification submitted on filing. Absent any statement(s) to the contrary, the "attached" specification will be presumed to be a copy of the specification and any amendments thereto, which were filed in the USPTO in order to obtain a filing date for the application.

Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under 37 CFR 1.183 accompanied by a petition fee (37 CFR 1.17(h)).

Further an oath or declaration attached to a cover letter referencing an incorrect application may not become associated with the correct application and, therefore, could result in the abandonment of the correct application.

Supplemental oaths or declarations in accordance with 37 CFR 1.67 will be required in applications in which the oaths or declarations are not in compliance with the other requirements of 37 CFR 1.63 but contain sufficient information to identify the specifications to which they apply as detailed above.

See MPEP § 1896 for the identification requirements for a declaration filed in a U.S. national stage application filed under 35 U.S.C. 371.

COPIES OF OATHS OR DECLARATIONS ARE ACCEPTABLE

A copy, such as a photocopy or facsimile transmission, of an originally executed oath or declaration is acceptable and may be filed (see MPEP § 502.01). 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 U.S. Patent and Trademark Office may require submission of the original. See 37 CFR 1.4(d)(1)(ii).

Note

See MPEP § 602.03 for other defects in the oath or declaration.

When the oath is made in a foreign country not a member of the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. See 37 CFR 1.66, MPEP § 604. This proof may be through an intermediary, e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

604.04(a) Consul – Omission of Certificate

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer of the United States and whose authority is not authenticated or accompanied with an apostille certifying the notary's authority (see MPEP § 602.04(a)), the application is nevertheless accepted for purposes of examination. The examiner, in the first Office action, should note this informality and require authentication of the oath by an appropriate diplomatic or consular officer, the filing of proper apostille, or a declaration (37 CFR 1.68).

Form paragraph 6.08 may be used to notify applicant.

¶ 6.08 Consul-Omission of Certificate

The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. If, however, authentication of the original oath is desired, applicant should request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent and Trademark Office. See MPEP §§ 602.01 and 602.02.

At the time of the next Office action, the request for return of the oath, together with the application file and the copy of the oath, is submitted to the Technology Center (TC) Director. If the request is approved

by the TC Director, the oath will be returned to the applicant by the TC. A copy of the original oath will be retained in the file.

604.06 By Attorney in Application

The language of 37 CFR 1.66 and 35 U.S.C. 115 is such that an attorney in the application is not barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his or her authority and jurisdiction and will not knowingly jeopardize his or her client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action is to require a new oath or declaration and refer the file to the Office of Enrollment and Discipline. (*Riegger v. Beierl*, 1910 C.D. 12, 150 O.G. 826 (Comm'r Pat. 1910)). See 37 CFR 1.66 and MPEP § 604.

605 Applicant

37 CFR 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.

PTO/SB/01 (03-01)
 Approved for use through 10/31/2002. OMB 0651-0032
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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DECLARATION — Utility or Design Patent Application

Direct all correspondence to: <input type="checkbox"/> Customer Number or Bar Code Label <input style="width: 100px; height: 20px;" type="text"/>				OR <input type="checkbox"/> Correspondence address below			
Name							
Address							
City			State		ZIP		
Country		Telephone			Fax		
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.							
NAME OF SOLE OR FIRST INVENTOR:				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])				Family Name or Surname			
Inventor's Signature					Date		
Residence: City		State	Country		Citizenship		
Mailing Address							
City		State		ZIP	Country		
NAME OF SECOND INVENTOR:				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])				Family Name or Surname			
Inventor's Signature					Date		
Residence: City		State	Country		Citizenship		
Mailing Address							
City		State		ZIP	Country		
<input type="checkbox"/> Additional inventors are being named on the _____ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto.							

605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant, in a nonprovisional application, to state his or her citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement, but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

Form paragraphs 6.05 and 6.05.03 may be used to notify applicant that the applicant's citizenship is omitted.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.03 Citizenship Omitted

It does not identify the citizenship of each inventor.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05

605.02 Applicant's Residence

Applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with 37 CFR 1.63 unless it is included in an application data sheet (37 CFR 1.76). In the case of an applicant who is in one of the U.S. Armed Services, a statement to that effect is sufficient as to residence. For change of residence, see MPEP § 719.02(b). Applicant's residence must be included on the cover sheet for a provisional application unless it is included in an application data sheet (37 CFR 1.76).

If the residence is not included in the executed oath or declaration filed under 37 CFR 1.63, the Office of Initial Patent Examination (OIPE) will normally so indicate on a form PTO-152, "Notice of Informal Application," so as to require the submission of the

residence information within a set period for reply. If the examiner notes that the residence has not been included in the oath or declaration or in an application data sheet, form paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.02 should be used.

¶ 6.05.02 Residence Omitted

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or a supplemental oath declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

605.03 Applicant's Mailing or Post Office Address

Each applicant's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. Applicant's mailing address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the mailing address. The mailing address should include the ZIP Code designation. Since the term "post office address" as previously used in 37 CFR 1.63 may be confusing, effective November 7, 2000, 37 CFR 1.63 was amended to use the term "mailing address" instead.

The object of requiring each applicant's mailing address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

If an oath or declaration was filed prior to December 1, 1997 and the post office address was incomplete or omitted from the oath or declaration, attachment form PTO-152, "Notice of Informal Application" or form paragraph 6.09.01 may be used to notify applicant of the deficiency of the post office address.

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.05 "Reviewed and Understands" Statement Omitted

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.06 Original and First Omitted

It does not 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.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.07 Duty To Disclose Omitted

It does not 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 37 CFR 1.56.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.15 Not in Permanent Ink

The [1] is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).

Examiner Note:

1. In bracket 1, insert either signature or oath/declaration.
2. This paragraph must be preceded by form paragraph 6.05.
3. If other portions of the disclosure are not in permanent ink, use form paragraph 6.32.

When an application is otherwise ready for issue, an examiner with full signatory authority may waive the following minor deficiencies:

Minor deficiencies in the body of the oath or declaration where the deficiencies are self-evidently cured in the rest of the oath or declaration, as in an oath or declaration of plural inventors couched in plural terms except for use of "sole inventors" is asserted. *In re Searles*, 422 F.2d 431, 437, 164 USPQ 623, 628 (CCPA 1970).

If the above is waived, the examiner with full signatory authority should write in the margin of the declaration or oath a notation such as "Reference to the sole inventor rather than joint inventors waived; Application ready for issue." and his or her initials and the date.

Of course, requirements of the statute, e.g., that the applicant state his or her citizenship or believes himself or herself to be the original and first inventor or that the oath be administered before a person authorized to administer oaths or that a declaration pursuant to 35 U.S.C. 25 or 28 U.S.C. 1746 contain the language required therein, cannot be waived.

If the defect cannot be waived, form paragraph 6.46 should be used when the application is allowable.

¶ 6.46 Application Allowed, Substitute Declaration Needed

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth [1]. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability" (PTO-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely file the substitute declaration (or oath) will result in ABANDONMENT of the application. The transmittal letter accompanying the declaration (or oath) should indicate the following in the upper right hand corner: Issue Batch Number, date of the "Notice of Allowance" (PTOL-85), and application number.

Examiner Note:

In the bracket, insert appropriate information, e.g., --in this communication--, --in the Office action mailed _____--, or --in the PTO-152 attached to Paper No. _____--.

602.04 Foreign Executed Oath

An oath executed in a foreign country must be properly authenticated. See 37 CFR 1.66 and MPEP § 604.

Where the authority of the foreign officer is not certified, form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.13 may be used.

¶ 6.05.13 Authority of Foreign Officer Not Certified

It does not include an apostille, a consular certificate, or the position of authority of the officer signing an apostille or consular certificate, see 37 CFR 1.66(a).

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

Treaty (PCT) which designates the United States and thereby has the effect of a regularly filed United States national application, except as provided in 35 U.S.C. 102(e), are somewhat different than the provisions of 35 U.S.C. 111. The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.497.

37 CFR 1.52(c)(1) states that “[a]ny 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.” 37 CFR 1.52(c)(2) states that after the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by 37 CFR 1.121. An application submitted through the electronic filing system (EFS) may include scanned images of a declaration executed by the inventor. The reformatting of an application in submitting the specification of the application using EFS, is not an “alteration of the application papers” requiring a substitute oath or declaration. It is acceptable to print out a copy of the specification prepared using traditional word processing software for the inventor to review as he or she signs the oath or declaration, and then cut and paste from the electronic document to prepare the EFS version of the specification and to submit a scanned copy of the declaration with the EFS submission.

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant. This provision should particularly be brought to the attention of foreign applicants by their United States counsel since the United States law and practice in this area may differ from that in other countries.

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether noninitialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. Form paragraph 6.02.01 may be used to call noninitialed and/or nondated alterations to applicant's attention.

¶ 6.02.01 Non-Initialed and/or Non-Dated Alterations in Application Papers

The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required.

The signing and execution by the applicant of oaths or declarations in certain continuation or divisional applications may be omitted. See MPEP § 201.06, § 201.07, and § 602.05(a).

For the signature on a reply, see MPEP § 714.01(a) to § 714.01(d).

EXECUTION OF OATH OR DECLARATION ON BEHALF OF INVENTOR

The oath or declaration required by 35 U.S.C. 115 must be signed by all of the actual inventors, except under limited circumstances. 35 U.S.C. 116 provides that joint inventors can sign on behalf of an inventor who cannot be reached or refuses to join. See MPEP § 409.03(a). 35 U.S.C. 117 provides that the legal representative of a deceased or incapacitated inventor can sign on behalf of the inventor. If a legal representative executes an oath or declaration on behalf of a deceased inventor, the legal representative must state that the person is a legal representative and provide the citizenship, residence, and mailing address of the legal representative. See 37 CFR 1.64, MPEP § 409.01 and § 409.02. 35 U.S.C. 118 provides that a party with proprietary interest in the invention claimed in an application can sign on behalf of the inventor, if the inventor cannot be reached or refuses to join in the filing of the application. See MPEP § 409.03(b) and § 409.03(f). The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so. *Opinion of Hon. Edward Bates*, 10 Op. Atty. Gen. 137 (1861). See also *Staeger v.*

Model of Certificate

The certificate will be in the form of a square with sides at least 9 centimeters long.

APOSTILLE	
(Convention de La Haye du Oct. 5, 1961)	
1. Country	
This public document	
2. has been signed by	
3. acting in the capacity of	
4. bears the seal/stamp of	
Certified	
5. at	
6. the	
7. by	
8. No.	
9. Seal/stamp:	10. Signature:

Note that a declaration in lieu of application oath (37 CFR 1.68) need not be ribboned to the other papers. It must, however, be maintained together therewith.

602.05 Oath or Declaration — Date of Execution

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale (that is when the date of execution is more than 3 months prior to the filing date of the application) or where the date of execution has been omitted. However, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56.

602.05(a) Oath or Declaration in Continuation and Divisional Applications

A continuation or divisional application filed under 37 CFR 1.53(b) (other than a continuation-in-part (CIP)) may be filed with a copy of the oath or declaration from the prior nonprovisional application. See 37 CFR 1.63(d)(1)(iv).

A copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application even if the oath or declaration identifies the application number of the prior application. However, if such a copy of the oath or declaration is filed after the filing date of the continuation or divisional application and an application number has been assigned to the continuation or divisional application (see 37 CFR 1.5(a)), the cover letter accompanying the oath or declaration should identify the application number of the continuation or divisional application. The cover letter should also indicate that the oath or declaration submitted is a copy of the oath or declaration from a prior application to avoid the oath or declaration being incorrectly matched with the prior application file. Furthermore, applicant should also label the copy of the oath or declaration with the application number of the continuation or divisional application in the event that the cover letter is separated from the copy of the oath or declaration.

A copy of the oath or declaration from a prior nonprovisional application may be filed in a continuation or divisional application even if the specification for the continuation or divisional application is different from that of the prior application, in that revisions have been made to clarify the text to incorporate amendments made in the prior application, or to make other changes provided the changes do not constitute new matter relative to the prior application. See 37 CFR 1.52(c)(3). If the examiner determines that the continuation or divisional application contains new

²On September 4, 1991, the Union of Soviet Socialist Republics (USSR) deposited an instrument of accession to the Convention. The Convention was to have entered into force for the USSR on April 1, 1992. Prior to that date, the USSR dissolved. Three members of the Newly Independent States (NIS), the Russian Federation, the Belarus Republic and Armenia have informed the depositary for the Convention that the Convention applies in those jurisdiction. It is not clear whether other NIS countries are applying the Convention. Even if other NIS countries were to consider the Convention to apply, it may not be operational. Each jurisdiction must designate an authority competent to issue the Convention certificate (apostille) before the Convention can be operational.

³Former Yugoslavia was a party to the Convention. Slovenia, Macedonia, Bosnia-Herzegovina and Croatia have informed the depositary that they consider the Convention to apply and have designated a competent authority to issue the Convention certificate (apostille).

605.04(e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr.," in connection with his or her signature. The title will not appear in the printed patent.

**605.04(f) Signature on Joint Applications
- Order of Names**

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration.

In those instances where the joint applicants file separate oaths or declarations, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing.

605.04(g) Correction of Inventorship

When the Office is notified of a typographical or transliteration error in the spelling of an inventor's name, or a petition is granted approving a correction or a change in the order of the names of the inventors, or inventors are added or deleted under 37 CFR 1.48, the change should be noted in red ink in the left margin of the original oath or declaration. The notation should read "See Paper No. ____ for inventorship changes." The application (other than 09/ series applications) should be sent to the Office of Initial Patent Examination (OIPE) for correction on the file wrapper label and the PALM database regarding the

inventorship. A brief explanation on an "Application Division Data Base Routing Slip" (available from the Technology Center (TC) technical support staff) should accompany the application file to OIPE. For 09/ series applications, the examiner should have the TC's technical support staff enter the correction in the PALM database and print a new PALM bib-data sheet, which will then be placed in the file wrapper.

**605.05 Administrator, Executor, or
Other Legal Representative**

In an application filed by a legal representative of the inventor, the specification should not be written in the first person.

For prosecution by administrator or executor, see MPEP § 409.01(a).

For prosecution by heirs, see MPEP § 409.01(a) and § 409.01(d).

For prosecution by representative of legally incapacitated inventor, see MPEP § 409.02.

For prosecution by other than inventor, see MPEP § 409.03.

605.07 Joint Inventors*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.

35 U.S.C. 116, as amended by Public Law 98-622, recognizes the realities of modern team research. A research project may include many inventions. Some inventions may have contributions made by individuals who are not involved in other, related inventions.

35 U.S.C. 116 allows inventors to apply for a patent jointly even though

(A) they did not physically work together or at the same time,

(B) each did not make the same type or amount of contribution, or

(C) each did not make a contribution to the subject matter of every claim of the patent.

tors, of which only some understand English but all understand the non-English language of the oath or declaration.

602.07 Oath or Declaration Filed in United States as a Designated Office

See MPEP § 1893.01.

603 Supplemental Oath or Declaration

37 CFR 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 on an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration on 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]

37 CFR 1.67 requires in the supplemental oath or declaration substantially all the data called for in 37 CFR 1.63 for the original oath or declaration. As to the purpose to be served by the supplemental oath or declaration, the examiner should bear in mind that it cannot be availed of to introduce new matter into an application.

Deficiencies or inaccuracies in an oath or declaration may be corrected by a supplemental oath or declaration. The supplemental oath or declaration must (1) identify the entire inventive entity, and (2) be signed by all the inventors when the correction relates to all the inventors or applicants (37 CFR 1.42, 1.43, or 1.47), or by only those inventor(s) or applicants (37 CFR 1.42, 1.43, or 1.47) to whom the corrections relates. See 37 CFR 1.67(a). A deficiency or inaccuracy relating to information required by 37 CFR 1.63(c) may also be corrected with an application data sheet (37 CFR 1.67(a)(3)). The following examples illustrate how certain deficiencies or inaccuracies in an oath or declaration may be corrected:

Example 1: An application was filed with a declaration under 37 CFR 1.63 executed by inventors A, B, and C. If it is later determined that the citizenship of inventor C was in error, a supplemental declaration identifying inventors A, B, and C may be signed by inventor C alone correcting C's citizenship.

Example 2: An application was filed with a declaration under 37 CFR 1.63 executed by inventors A, B, and C. If it is later determined that the duty to disclose clause was omitted, a supplemental declaration identifying inventors A, B, and C must be signed by inventors A, B, and C. If separate declarations had been executed by each of the inventors and the duty to disclose clause had been omitted only in the declaration by inventor B, then only inventor B would need to execute a supplemental declaration identifying the entire inventive entity.

Example 3: An application was filed with a declaration under 37 CFR 1.63 executed by inventors A, and B, and the legal representative of deceased inventor C. It is later determined that an error was made in the citizenship of deceased inventor C. A supplemental declaration identifying A, B, and C as the inventors would be required to be signed by the legal representative of deceased inventor C alone correcting C's citizenship.

Example 4: An application was filed with a declaration under 37 CFR 1.63 executed by inventors A and B. If it is later determined that an error exists in the mailing address of inventor B, the mailing address of inventor B may be corrected by a supplemental declaration identifying the entire inventive entity and signed by inventor B alone, or an application data

application if the elected invention was not the invention of all the originally named inventors.

(G) The amendment to 35 U.S.C. 116 increases the likelihood that different claims of an application or patent may have different dates of invention; when necessary the Office or court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

Pending nonprovisional applications will be permitted to be amended by complying with 37 CFR 1.48 to add claims to inventions by inventors not named when the application was filed as long as such inventions were disclosed in the application as filed since 37 CFR 1.48 permits correction of inventorship where the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the person being added as an inventor. This is specially covered in 37 CFR 1.48(c).

Under 35 U.S.C. 116, an examiner may reject claims under 35 U.S.C. 102(f) only in circumstances where a named inventor is not the inventor of at least one claim in the application; no rejection under 35 U.S.C. 102(f) is appropriate if a named inventor made a contribution to the invention defined in any claim of the application.

Under 35 U.S.C. 116, considered in conjunction with 35 U.S.C. 103(c), a rejection may be appropriate under 35 U.S.C. 102(f)/103 where the subject matter, i.e., prior art, and the claimed invention were not owned by, or subject to an obligation of assignment to, the same person at the time the invention was made.

Applicants are responsible for correcting, and are required to correct, the inventorship in compliance with 37 CFR 1.48 when the application is amended to change the claims so that one (or more) of the named inventors is no longer an inventor of the subject matter of a claim remaining in the application.

In requiring restriction in an application filed by joint inventors, the examiner should remind applicants of the necessity to correct the inventorship pursuant to 37 CFR 1.48 if an invention is elected and the claims to the invention of one or more inventors are canceled.

The examiner should not inquire of the patent applicant concerning the inventors and the invention

dates for the subject matter of the various claims until *it becomes necessary* to do so in order to properly examine the application.

If an application is filed with joint inventors, the examiner should assume that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, unless there is evidence to the contrary. If inventors of subject matter, not commonly owned at the time of the later invention, file a joint application, applicants have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made in order that the examiner may consider the applicability of 35 U.S.C. 102(e)/103, 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103. The examiner should assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure. It should be pointed out that 35 U.S.C. 119(a) benefit may be claimed to any foreign application as long as the U.S. named inventor was the inventor of the foreign application invention and 35 U.S.C. 119(a)-(d) requirements are met. Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, the U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the foreign applications provided all the requirements of 35 U.S.C. 119(a)-(d) are met. One of the conditions for benefit under 35 U.S.C. 119(a) is that the foreign application must be for "the same invention" as the application in the United States. Therefore, a claim in the U.S. application which relies on the combination of prior foreign applications may not be entitled to the benefit under 35 U.S.C. 119(a) if the subject matter of the claim is not sufficiently disclosed in the prior foreign application. *Cf. Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997). For example:

If foreign applicant A invents X and files a foreign application; foreign applicant B invents Y and files separate foreign application. A+B combine inventions X+Y and A and B are proper joint inventors under 35 U.S.C. 116 and file U.S. application to X+Y. The U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the foreign applications provided the requirements of 35 U.S.C. 119(a)-(d) are met.

¶ 6.06 New Oath for Subject Matter Not Originally Claimed

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP § 608.01(d) and 1302, and 37 CFR 1.73.

¶ 6.05.11 Notary Signature

It does not include the notary's signature, or the notary's signature is in the wrong place.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.12 Notary Seal and Venue Omitted

It does not include the notary's seal and venue.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

604.02 Venue

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on the oath. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given either in the venue or in the body of the jurat. Otherwise, a new oath or declaration, or a certificate of the notary that the oath was taken within his or her jurisdiction, must be required. *Ex parte Delavoye*, 1906 C.D. 320, 124 O.G. 626 (Comm'r Pat. 1906); *Ex parte Irwin*, 1928 C.D. 13, 367 O.G. 701 (Comm'r Pat. 1928).

Form paragraph 6.07 may be used where the venue is not shown.

¶ 6.07 Lack of Venue

The oath lacks the statement of venue. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by application number and filing date, or a cer-

tificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Where the seal and venue differ, applicant should be notified by using the "Notice of Informal Application" form.

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

- (A) All judge advocates of the Army and Air Force;
- (B) All law specialists;
- (C) All summary courts-martial;
- (D) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;
- (E) All commanding officers of the Navy and Coast Guard;
- (F) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and
- (G) All other persons designated by regulations of the armed forces or by statute.
- (H) The signature without seal of any such person acting as notary, together with the title of his office, shall be *prima facie* evidence of his authority.

604.04 Consul

On Oct. 15, 1981, the "Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries as parties to the Convention. Subsequently, additional countries have become parties to the conventions. See MPEP § 604.04(a).

panied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive thereto and the practice set forth in MPEP § 714.03 will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim or adds to the number of claims referred to in a multiple dependent claim, and the replacement of a claim by a claim of the same type, unless it is a multiple dependent claim which refers to more prior claims, do not require any additional fees.

For purposes of determining the fee due the U.S. Patent and Trademark Office, a claim will be treated as dependent if it contains reference to one or more other claims in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact, is not a proper dependent claim, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, nonelected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

An amendment canceling claims accompanying the papers constituting the application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a response to a Notice To File Missing Parts of Application that required the filing fees, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice To File Missing Parts of Application. No refund will be made for claims being

canceled in the response that have already been paid for.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment. However, unentered claims will not be counted when calculating the fee due in subsequent amendments.

Amendments affecting the claims cannot serve as the basis for granting any refund.

See MPEP § 1415 for reissue application fees.

607.02 Returnability of Fees

35 U.S.C. 42. Patent and Trademark Office funding

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

37 CFR 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 reexami-

(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.

37 CFR 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.

37 CFR 1.41 and 37 CFR 1.53 were amended effective December 1, 1997, to remove the requirement that the name(s) of the inventor(s) be identified in the application papers in order to accord the application a filing date. 37 CFR 1.41(a)(1) now defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63, except as provided for in 37 CFR 1.53(d)(4) and 37 CFR 1.63(d). The oath or declaration may be filed on the filing date of the application or on a later date. If an oath or declaration is not filed during the pen-

dency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to 37 CFR 1.53(b), unless an applicant files a paper under 37 CFR 1.41(a)(i) accompanied by the processing fee set forth in 37 CFR 1.17(i) supplying or changing the name or names of the inventor or inventors.

The name, residence, and citizenship of each person believed to be an actual inventor should be provided as an application identifier when application papers under 37 CFR 1.53(b) are filed without an oath or declaration, or application papers under 37 CFR 1.53(c) are filed without a cover sheet. See 37 CFR 1.41(a)(3). Naming the individuals known to be inventors or the persons believed to be the inventors may enable the Office to identify the application, if applicant does not know the application number. Where no inventor(s) is known and applicant cannot name a person believed to be an inventor on filing, the Office requests that an alphanumeric identifier be submitted for the application. The use of very short identifiers should be avoided to prevent confusion. Without supplying at least a unique identifying name the Office may have no ability or only a delayed ability to match any papers submitted after filing of the application and before issuance of an identifying application number with the application file. Any identifier used that is not an inventor's name should be specific, alphanumeric characters of reasonable length, and should be presented in such a manner that it is clear to application processing personnel what the identifier is and where it is to be found. Failure to apprise the Office of an application identifier such as the names of the inventors or the alphanumeric identifier being used may result in applicants having to resubmit papers that could not be matched with the application and proof of the earlier receipt of such papers where submission was time dependent.

For correction of inventorship, see MPEP § 201.03.

This section concerns filing by the actual inventor. If the application is filed by another, see MPEP § 409.03.

For assignments of application by inventor, see MPEP § 301. For an inventor who is dead or insane, see MPEP § 409.

ple, in the following types of situations: (1) a deposit account charged for an extension of time pursuant to 37 CFR 1.136(a)(3) as a result of there being a prior general authorization in the application; or (2) a deposit account charged for the outstanding balance of a fee as a result of an insufficient fee submitted with an authorization to charge the deposit account for any additional fees that are due. In these situations, the party providing the charge authorization is not in a position to know the exact amount by which the deposit account will be charged until the date of the deposit account statement indicating the amount of the charge. Therefore, the two-year time period set forth in 37 CFR 1.26(b) does not begin until the date of the deposit account statement indicating the amount of the charge.

LATER ESTABLISHMENT OF SMALL ENTITY STATUS

Effective November 7, 2000, 37 CFR 1.28(a) was amended to provide a three-month period (instead of the former two-month period) for requesting a refund based on later establishment of small entity status. As the Office now treats the receipt date of a deposit account charge authorization as the fee payment date (for refund purposes), any request for a refund under 37 CFR 1.28(a) must be made within three months from the date the charge authorization is received in the Office.

608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which protection is sought. All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. See also 37 CFR 1.121, subsections (a)(6) and (b)(2)(iii) and MPEP § 608.04.

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in

that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

The examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

For design application practice, see MPEP § 1504.

608.01 Specification

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.

37 CFR 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(o). The content of the notice must be limited to only those elements required 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.

¶ 6.09.01 Post Office Address Omitted, Residence Given

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Examiner Note:

1. This form paragraph should only be used where the Post Office address has been omitted in an oath or declaration filed prior to December 1, 1997. Use form paragraphs 6.05 and 6.05.19 if the oath or declaration was filed on or after December 1, 1997.
2. If both the post office address and residence are incomplete, not uniform or omitted, use form paragraphs 6.05 and 6.05.02.

Oaths or declarations filed on or after December 1, 1997 must include the mailing or post office address of each inventor. Effective November 7, 2000 the mailing address of each inventor may be provided in an application data sheet. See 37 CFR 1.63(c) and 37 CFR 1.76. In an application filed before November 29, 2000, the Office of Initial Patent Examination (OIPE) will normally indicate the omission of an inventor's mailing address on attachment form PTO-152, "Notice of Informal Application," requiring a new oath or declaration when the form is sent out with an Office action. For utility and plant applications filed on or after November 29, 2000, applicant's mailing address may be needed for any patent application publication. If the mailing address of any inventor has been omitted, OIPE will notify applicant of the omission and require the omitted mailing address in response to the notice. If the examiner notes that the mailing or post office address has not been included in an oath or declaration filed on or after December 1, 1997, other than a copy of an oath or declaration from a prior application which complied with 37 CFR 1.63 at the time that it was originally filed, and the mailing address is not provided in an application data sheet, form paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.19 may be used to notify applicant that the mailing or post office address has been omitted from the oath or declaration.

¶ 6.05.19 Mailing or Post Office Address Omitted

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

605.04(a) Applicant's Signature and Name**37 CFR 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.

EXECUTION OF OATHS OR DECLARATIONS OF PATENT APPLICATIONS

United States patent applications which have not been prepared and executed in accordance with the requirements of Title 35 of the United States Code and Title 37 of the Code of Federal Regulations may be abandoned. Although the statute and the rules have been in existence for many years, the Office continues to receive a number of applications which have been improperly executed and/or filed. Since the improper execution and/or filing of patent applications can ultimately result in a loss of rights, it is appropriate to emphasize the importance of proper execution and filing.

There is no requirement that a signature be made in any particular manner. See MPEP § 605.04(d). If applicant signs his or her name using non-English characters, then such a signature will be accepted.

It is improper for an applicant to sign an oath or declaration which is not attached to or does not identify a specification and/or claims.

Attached does not necessarily mean that all the papers must be literally fastened. It is sufficient that the specification, including the claims, and the oath or declaration are physically located together at the time of execution. Physical connection is not required. Copies of declarations are accepted. See MPEP § 502.01 and § 502.02.

The provisions of 35 U.S.C. 363 for filing an international application under the Patent Cooperation

ted 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.

Commissioner of Patents and Trademarks, 189 USPQ 272 (D.D.C. 1976) and *In re Striker*, 182 USPQ 507 (PTO Solicitor 1973) (In each case, an oath or declaration signed by the attorney on behalf of the inventor was defective because the attorney did not have a proprietary interest in the invention.)

605.04(b) One Full Given Name Required

37 CFR 1.63(a)(2) requires that each inventor be identified by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial in the oath or declaration. For example, if the applicant's full name is "John Paul Doe," either "John P. Doe" or "J. Paul Doe" is acceptable.

Form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.18 may be used to notify applicant that the oath or declaration is defective because the full given name of each inventor has not been adequately stated.

¶ 6.05.18 Full Given Name Is Not Set Forth

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

In an application where the name is typewritten with a *middle name* or *initial*, but the signature is without such middle name or initial, the typewritten version of the name will be used. Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee. The petition should be directed to the attention of the Office of Petitions. Upon granting of the petition, the application should be sent to the Office of Initial Patent Examination (OIPE) for correction of its records, unless the application is an application with an application data sheet (e.g., an 09/ series application), in which case the Office of Petitions should correct the Office computer records and print a new bibliographic data sheet. If the application is assigned, it will be forwarded by OIPE or the Office of Petitions to the Assignment Division for a change in the assignment record.

When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The U.S. Patent and Trademark Office should simply be notified of the error and reference to the notification paper will be made on the previously filed oath or declaration by the Office.

When any correction or change is effected, the file should be sent to OIPE for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. ___ for inventorship changes." See MPEP §§ 201.03 and 605.04(g).

605.04(c) Inventor Changes Name

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. The petition should be directed to the attention of the Office of Petitions. The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

If the petition is granted, the application should be sent to the Office of Initial Patent Examination (OIPE) for change of name on the file wrapper and in the PALM database, unless the application is an 09/ series application, in which case the application should be sent to the assigned Technology Center (TC) for correction to the PALM bib-data sheet by the TC's technical support staff. If the application is assigned, applicant should submit a corrected assignment document along with a cover sheet and the recording fee as set forth in 37 CFR 1.21(h) to the Assignment Division for a change in the assignment record.

605.04(d) Applicant Unable to Write

If the applicant is unable to write, his or her mark as affixed to the oath or declaration must be attested to by a witness. In the case of the oath, the notary's signature to the jurat is sufficient to authenticate the mark.

All application papers (specification, including claims, abstract, any drawings, oath or declaration, and other papers), and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper. The claim or claims must commence on a separate sheet (37 CFR 1.75(h)) and the abstract must commence on a separate sheet (37 CFR 1.72(b)).

All application papers which are to become a part of the permanent record of the U.S. Patent and Trademark Office must be on sheets of paper which are the same size and are 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). See 37 CFR 1.52(a)(1) and 37 CFR 1.84(f). Each sheet, other than the drawings, must include 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). No holes should be made in the sheets as submitted.

Applicants must make every effort to file patent applications in a form that is clear and reproducible. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See 37 CFR 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification required by the Office. See also MPEP § 608.01(q). All papers which are to become a part of the permanent records of the U.S. Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, nonshiny, durable, and white paper. Typed, mimeographed, xeroprinted, multigraphed or nonsmearing carbon copy forms of reproduction are acceptable.

Where an application is filed with papers that do not comply with 37 CFR 1.52, the Office of Initial Patent Examination will mail a "Notice to File Corrected Application Papers" (PTO 1660) indicating the deficiency and setting a time period within which the applicant must correct the deficiencies to avoid abandonment. The failure to submit application papers in compliance with 37 CFR 1.52 does not effect the grant of a filing date, and original application papers that do not comply with 37 CFR 1.52 will be retained in the application file as the original disclosure of the

invention. The USPTO will not return papers simply because they do not comply with 37 CFR 1.52.

Legibility includes ability to be photocopied and photomicrographed so that suitable reprints can be made and ability to be electronically reproduced by use of digital imaging and optical character recognition. This requires a high contrast, with black lines and a white background. Gray lines and/or a gray background sharply reduce photo reproduction quality. Legibility of some application papers may become impaired due to abrasion or aging of the printed material during examination and ordinary handling of the file. It may be necessary to require that legible and permanent copies be furnished at later stages after filing, particularly when preparing for issue.

Some of the patent application papers received by the U.S. Patent and Trademark Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

The paper used must have a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy, 37 CFR 1.52(a)(1)(iv). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant by use of Form paragraph 6.32 that it will be necessary for applicant to order a copy of the specification and claims to be made by the U.S. Patent and Trademark Office at the applicant's expense for incorporation in the file. It is not necessary to return this copy to applicant for signature.

¶ 6.32 Application on Easily Erasable Paper or Erasable Ink

The application papers are objected to because they are not a permanent copy as required by 37 CFR 1.52(a)(1)(iv). Reference is made to [1].

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the U.S. Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP § 608.01.

Examiner Note:

In the bracket, identify: 1) all of the specification; 2) certain pages of the specification; 3) particular claim(s); 4) the oath or declaration; 5) etc.

Items (A) and (B) adopt the rationale stated in decisions such as *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967).

Item (C) adopts the rationale of cases such as *SAB Industrie AB v. Bendix Corp.*, 199 USPQ 95 (E.D. Va. 1978).

With regard to item (A), see *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co.*, 973 F.2d 911, 916-17, 23 USPQ 2d 1921, 1925-26 (Fed. Cir. 1992) (some quantum of collaboration or connection is required in order for persons to be "joint" inventors under 35 U.S.C. 116, and thus individuals who are completely ignorant of what each other has done until years after their individual independent efforts cannot be considered joint inventors).

Like other patent applications, jointly filed applications are subject to the requirements of 35 U.S.C. 121 that an application be directed to only a single invention. If more than one invention is included in the application, the examiner may require the application to be restricted to one of the inventions. In such a case, a "divisional" application complying with 35 U.S.C. 120 would be entitled to the benefit of the earlier filing date of the original application.

It is possible that different claims of an application or patent may have different dates of inventions even though the patent covers only one independent and distinct invention within the meaning of 35 U.S.C. 121. When necessary, the U.S. Patent and Trademark Office or a court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

GUIDELINES

37 CFR 1.45. Joint inventors.

- (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.

Since provisional applications may be filed without claims, 37 CFR 1.45(c) states that each inventor named in a joint provisional application must have made a contribution to the subject matter disclosed in the application.

The significant features resulting from the amendments to 35 U.S.C. 116 by Public Law 98-622 are the following:

(A) The joint inventors do not have to separately "sign the application," but only need apply for the patent jointly and make the required oath or declaration by signing the same; this is a clarification, but not a change in current practice.

(B) Inventors may apply for a patent jointly even though "they did not work together or at the same time," thereby clarifying (a) that it is not necessary that the inventors physically work together on a project, and (b) that one inventor may "take a step at one time, the other an approach at different times." (*Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967)).

(C) Inventors may apply for a patent jointly even though "each did not make the same type or amount of contribution," thereby clarifying the "fact that each of the inventors play a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem." (*Monsanto Co. v. Kamp*, 269 F. Supp. at 824, 154 USPQ at 262.

(D) Inventors may apply for a patent jointly even though "each did not make a contribution to the subject matter of every claim of the patent."

(E) Inventors may apply for a patent jointly as long as each inventor made a contribution, i.e., was an inventor or joint inventor, of the subject matter of at least one claim of the patent; there is no requirement that all the inventors be joint inventors of the subject matter of any one claim.

(F) If an application by joint inventors includes more than one independent and distinct invention, restriction may be required with the possible result of a necessity to change the inventorship named in the

FILING OF NON-ENGLISH LANGUAGE APPLICATIONS

37 CFR 1.52. *Language, Paper, Writing, Margins, Compact Disc Specifications.*

(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.

The U.S. Patent and Trademark Office will accord a filing date to an application meeting the requirements of 35 U.S.C. 111(a), or a provisional application in accordance with 35 U.S.C. 111(b), even though some or all of the application papers, including the written description and the claims, is in a language other than English and hence does not comply with 37 CFR 1.52.

An English translation of the non-English language papers, a statement that the translation is accurate, the filing fee, the oath or declaration (if necessary) and fee set forth in 37 CFR 1.17(i) should either accompany the nonprovisional application papers or be filed in the Office within the time set by the Office. If a provisional application is filed in a language other than English, an English translation of the non-English language provisional application will not be required in the provisional application. Rather, the English translation of the non-English language provisional application and a statement that the translation is accurate must be submitted in any nonprovisional application claiming benefit of the non-English language provisional application (see 37 CFR 1.78(a)(5)).

A subsequently filed English translation must contain the complete identifying data for the application

in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the original application papers be accompanied by a cover letter and a self-addressed return postcard, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether oath or declaration was filed and (e) amount and manner of paying the filing fee.

The translation must be a literal translation and must be accompanied by a statement that the translation is accurate. The translation must also be accompanied by a signed request from the applicant, his or her attorney or agent, asking that the English translation be used as the copy for examination purposes in the Office. If the English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. In the event the English translation is not timely filed in the Office, the application will be regarded as abandoned.

It should be recognized that this practice is intended for emergency situations to prevent loss of valuable rights and should not be routinely used for filing applications. There are at least two reasons why this should not be used on a routine basis. First, there are obvious dangers to applicant and the public if he or she fails to obtain a correct literal translation. Second, the filing of a large number of applications under the procedure will create significant administrative burdens on the Office.

ILLUSTRATIONS IN THE SPECIFICATION

Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 CFR 1.58(a), which permits tables, chemical and mathematical formulas in the specification in lieu of formal drawings. The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 CFR 1.81 when an application contains graphs in the specification.

The specification, including any claims, may contain chemical formulas and mathematical equations, but may not contain drawings or flow diagrams. The

606 Title of Invention

37 CFR 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.

The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet (see 37 CFR 1.76). The title should be brief but technically accurate and descriptive and should contain fewer than 500 characters. Inasmuch as the words "improved," "improvement of," and "improvement in" are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office's computer records, and when any patent issues.

606.01 Examiner May Require Change in Title

Where the title is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. Form paragraphs 6.11 and 6.11.01 may be used.

¶ 6.11 Title of Invention Is Not Descriptive

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Examiner Note:

If a change in the title of the invention is being suggested by the examiner, follow with form paragraph 6.11.01.

¶ 6.11.01 Title of Invention, Suggested Change

The following title is suggested: "[1]"

This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the examiner may, at the time of allowance, change the title by examiner's amendment. If

the change in the title is the only change being made by the examiner at the time of allowance, a separate examiner's amendment need not be prepared. The examiner is to indicate the change in the title on the file label (or bib-data sheet in 09/ series applications) using BLACK ink and place his or her initials and the date in the margin. When the Technology Center (TC) technical support staff prepares the application for issue and sees that the title has been changed, the TC technical support staff will make the required change in Patent Application Locating and Monitoring system (PALM). PALM automatically will put "(AMENDED)" next to the new title. The new title along with "(AMENDED)" will be printed on the notice of allowance and issue fee due form, thereby notifying applicant of the amended title.

607 Filing Fee

Patent application filing fees are set in accordance with 35 U.S.C. 41 and are listed in 37 CFR 1.16.

See MPEP § 608.01(n) for multiple dependent claims.

When filing a nonprovisional application, a basic fee entitles applicant to present 20 claims including not more than 3 claims in independent form. If claims in excess of the above are included at the time of filing, an additional fee is required for each independent claim in excess of three, and a fee is required for each claim in excess of 20 claims (whether independent or dependent). Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers, 37 CFR 1.75(c), and a separate fee is required in each application containing a proper multiple dependent claim. For an improper multiple dependent claim, the fee charged is that charged for a single dependent claim.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required.

The Office of Initial Patent Examination (OIPE) has been authorized to accept all applications, otherwise acceptable, if the basic fee is submitted, and to require payment of the deficiency within a stated period upon notification of the deficiency.

Amendments before the first action, or not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accom-

(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.

For design patent specification, see MPEP § 1503.01.

For plant patent specification, see MPEP § 1605.

For reissue patent specification, see MPEP § 1411.

The following order of arrangement of specification elements is preferable in framing the nonprovisional specification and, except for the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading. It is recommended that provisional applications follow the same general format, although claims are not required. If an application data sheet (37 CFR 1.76) is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet (see 37 CFR 1.176(b)). If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors. See MPEP § 601.05.

- (A) Title of the Invention.
- (B) Cross-References to Related Applications.
- (C) Statement Regarding Federally Sponsored Research or Development.
- (D) Reference to a "Sequential Listing," a table, or a computer program listing appendix submitted on a compact disc (See 37 CFR 1.52(e)(5).)
- (E) Background of the Invention.
 - (1) Field of the Invention.

(2) Description of the related art including information disclosed under 37 CFR 1.97 and 1.98.

- (F) Brief Summary of the Invention.
- (G) Brief Description of the Several Views of the Drawings.
- (H) Detailed Description of the Invention.
- (I) Claim or Claims.
- (J) Abstract of the Disclosure.
- (K) Drawings.
- (L) "Sequence Listing," if on paper (See 37 CFR 1.821-1.825).

Applicant (typically a *pro se*) may be advised of the proper arrangement by using Form Paragraph 6.01 or 6.02.

¶ 6.01 Arrangement of Specification

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underling or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
 - (f) Brief Summary of the Invention.
 - (g) Brief Description of the Several Views of the Drawing(s).
 - (h) Detailed Description of the Invention.
 - (i) Claim or Claims (commencing on a separate sheet).
 - (j) Abstract of the Disclosure (commencing on a separate sheet).
 - (k) Drawings.
 - (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

Examiner Note:

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications.

¶ 6.02 Content of Specification

Content of Specification

nation 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.

Under 35 U.S.C. 42(d) and 37 CFR 1.26, the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm' r Pat. 1943) (the statutory authorization for the refund of fees under the "by mistake" clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action "by mistake" (e.g., files an application or maintains a patent in force "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 41(d).

37 CFR 1.26(a) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

All questions pertaining to the return of fees are referred to the Refunds Section of the Receipts Division of the Office of Finance. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases. Such questions may also be treated, to the extent appropriate, in decisions on petition decided by various U.S. Patent and Trademark Office officials.

MANNER OF MAKING A REFUND

Effective November 7, 2000, 37 CFR 1.26(a) was amended to authorize the Office to obtain the banking information necessary for making refunds by electronic funds transfer, or obtain the deposit account information to make the refund to the deposit account. If a party paying a fee or requesting a refund does not instruct the refund to be credited to a deposit account, the Office will attempt to make the refund by electronic fund transfer. The Office may (1) use the banking information on a payment instrument (e.g., a personal check) to refund an amount paid by the payment instrument in excess of that required, or (2) in other situations, require the banking information necessary for electronic funds transfer or require instruc-

tions to credit a deposit account. If it is not cost effective to require the banking information, the Office may obtain the deposit account information or simply issue any refund by treasury check.

37 CFR 1.26(a) further provides that 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. The Office will not refund a fee paid by credit card by treasury check, electronic funds transfer, or credit to a deposit account.

TIME PERIOD FOR REQUESTING A REFUND

Any request for a refund which is not based upon subsequent entitlement to small entity status (see 37 CFR 1.28(a)) must be filed within the two-year non-extendable time limit set forth in 37 CFR 1.26(b).

FEES PAID BY DEPOSIT ACCOUNT

Effective November 7, 2000, the Office no longer treats authorizations to charge a deposit account as being received by the Office on the date the deposit account is actually debited for purposes of refund payments under 37 CFR 1.26 and 37 CFR 1.28. Payment by authorization to charge a deposit account will be treated for refund purposes the same as payments by other means (e.g., check or credit card charge authorization), with each being treated as paid on the date of receipt in the Office as defined by 37 CFR 1.6. Accordingly, the time period for requesting a refund of any fee paid by a deposit account begins on the date the charge authorization is received in the Office. For refund purposes: where a 37 CFR 1.8 certificate is used, the refund period will begin on the date of actual receipt (not the 37 CFR 1.8 date of mailing); where Express Mail under 37 CFR 1.10 is used, the "date-in" on the Express Mail label will control (not the actual date of receipt by the Office). The use of payment receipt date for refund purposes has no effect on the certificate of mailing practice under 37 CFR 1.8 for making a timely reply to an Office action.

Notwithstanding the foregoing, if the Office charges a deposit account by an amount other than an amount specifically indicated on the charge authorization, 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 must include a copy of that deposit account statement. This provision of 37 CFR 1.26(b) applies, for exam-

185 USPQ 152, 154 (CCPA 1975)), it would ordinarily be preferable that the applicant make the necessary changes to the abstract to bring it into compliance with the guidelines. See Form Paragraphs 6.13-6.16 (below).

Replies to such actions requiring either a new abstract or amendment to bring the abstract into compliance with the guidelines should be treated under 37 CFR 1.111(b) practice like any other formal matter. Any submission of a new abstract or amendment to an existing abstract should be carefully reviewed for introduction of new matter, 35 U.S.C. 132, MPEP § 608.04.

Upon passing the application to issue, the examiner should make certain that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines. The abstract shall be changed by the examiner's amendment in those instances where deemed necessary. This authority and responsibility of the examiner shall not be abridged by the desirability of having the applicant make the necessary corrections. For example, if the application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by examiner's amendment rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions.

Under current practice, in all instances where the application contains an abstract when sent to issue, the abstract will be printed on the patent.

GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

Background

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, 37 CFR 1.72(b).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

The abstract is not intended nor designated for use in interpreting the scope or meaning of the claims, 37 CFR 1.72(b).

Content

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

(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 anyone 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.

The specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention pertains to make and use the same. See 35 U.S.C. 112 and 37 CFR 1.71. If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01.

The specification does not require a date.

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be canceled. See 37 CFR 1.78 and MPEP § 202.01.

As the specification is never returned to applicant under any circumstances, the applicant should retain a line for line copy thereof, each line, preferably, having been consecutively numbered on each page. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

Form paragraph 7.29 may be used where the disclosure contains minor informalities.

¶ 7.29 *Disclosure Objected to, Minor Informalities*

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is required.

Examiner Note:

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology, numbering of elements, etc., which should be corrected. See form paragraphs 6.28 to 6.32 for specific informalities.

Form paragraphs 6.29-6.31 should be used where appropriate.

¶ 6.29 *Specification, Spacing of Lines*

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application

papers with lines double spaced on good quality paper are required.

¶ 6.30 *Numerous Errors in Specification*

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: [1].

¶ 6.31 *Lengthy Specification, Jumbo Application*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examiner Note:

This paragraph is applicable in so-called "Jumbo Applications" (more than 20 pages, exclusive of claims).

PAPER REQUIREMENTS

37 CFR 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 pre-printed information on forms provided by the Office, or to the copy of the patent submit-

¶ 6.13 Abstract Objected To: Minor Informalities

The abstract of the disclosure is objected to because [1]. Correction is required. See MPEP § 608.01(b).

Examiner Note:

In bracket 1, indicate the informalities that should be corrected. Use this paragraph for minor informalities such as the inclusion of legal phraseology, undue length, etc.

¶ 6.14 Abstract of the Disclosure: Content

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of an apparatus should not be included in the abstract.

Examiner Note:

See form paragraph 6.16.

¶ 6.15 Abstract of the Disclosure: Chemical Cases

Applicant is reminded of the proper content of an abstract of the disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

¶ 6.16 Abstract of the Disclosure: Language

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Examiner Note:

See also form paragraph 6.14.

¶ 6.16.01 Abstract of the Disclosure: Placement

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Examiner Note:

This paragraph should only be used for applications filed on or after September 23, 1996.

608.01(c) Background of the Invention

The Background of the Invention ordinarily comprises two parts:

(1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) **Description of the related art** including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

608.01(d) Brief Summary of Invention

37 CFR 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

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

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

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

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

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

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

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

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

applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

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

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

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

37 CFR 1.58. 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.

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. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced.

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), auto-radiographs, 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.

608.01(g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. Every

feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01.

For completeness, see MPEP § 608.01(p).

USE OF SYMBOL "Phi" IN PATENT APPLICATION

The Greek letter "Phi" has long been used as a symbol in equations in all technical disciplines. It further has special uses which include the indication of an electrical phase or clocking signal as well as an angular measurement. The recognized symbols for the upper and lower case Greek Phi characters, however, do not appear on most typewriters. This apparently has led to the use of a symbol composed by first striking a zero key and then backspacing and striking the "cancel" or "slash" key to result in an approximation of accepted symbols for the Greek character Phi. In other instances, the symbol is composed using the upper or lower case letter "O" with the "cancel" or "slash" superimposed thereon by backspacing, or it is simply handwritten in a variety of styles. These expedients result in confusion because of the variety of type sizes and styles available on modern typewriters.

In recent years, the growth of data processing has seen the increasing use of this symbol ("O") as the standard representation of zero. The "slashed" or "canceled" zero is used to indicate zero and avoid confusion with the upper case letter "O" in both text and drawings.

Thus, when the symbol "Ø" in one of its many variations, as discussed above, appears in patent applications being prepared for printing, confusion as to the intended meaning of the symbol arises. Those (such as examiners, attorneys, and applicants) working in the art can usually determine the intended meaning of this symbol because of their knowledge of the subject matter involved, but editors preparing these applications for printing have no such specialized knowledge and confusion arises as to which symbol to print. The result, at the very least, is delay until the intended meaning of the symbol can be ascertained.

Since the Office does not have the resources to conduct a technical editorial review of each application before printing, and in order to eliminate the problem

See *In re Benson*, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959). Reproductions prepared by heat-sensitive, hectographic, or spirit duplication processes are also not satisfactory.

ALTERATION OF APPLICATION PAPERS

37 CFR 1.52(c) relating to interlineations and other alterations is strictly enforced. See *In re Swanberg*, 129 USPQ 364 (Comm'r Pat. 1960). See also MPEP § 605.04(a).

CERTIFIED COPIES OF AN APPLICATION-AS-FILED

If an application-as-filed does not meet the sheet size/margin and quality requirements of 37 CFR 1.52 and 1.84(f) and (g), certified copies of such application may be illegible and/or ineffective as priority documents. When an applicant requests that the USPTO provide a certified copy of an application-as-filed and pays the fee set forth in 37 CFR 1.19(b)(1), the USPTO will make a copy of the application-as-filed from the records in the Patent Image Capturing System (PICS) database (or the microfilm database). If papers submitted in the application-as-filed are not legible, certified copies of the application as originally filed will not be legible.

The USPTO performs exception processing when scanning application papers that do not comply with the sheet size/margin and quality requirements. If papers submitted in the application-as-filed (including any transmittal letter or cover sheet) do not meet the sheet size requirement of 37 CFR 1.52 and 1.84(f) (e.g., the papers are legal size (8 1/2 by 14 inches)), the USPTO must reduce such papers to be able to image-scan the entire application and record it in the PICS database. In addition, if papers submitted in the application-as-filed do not meet the quality requirements of 37 CFR 1.52 (e.g., the papers are shiny or non-white), the USPTO will attempt to enhance such papers before scanning to make the resulting electronic record in the PICS database more readable. However, if exception processing is required to make the PICS copy, certified copies of the application as originally filed may not be legible.

If application papers are filed that do not meet sheet size/margin and quality requirements, the

USPTO will require the applicant to file substitute papers that do comply with the requirements of 37 CFR 1.52 and 1.84(f) and (g). The substitute papers submitted in reply to the above-mentioned requirement will provide the USPTO with an image- and OCR-scannable copy of the application for printing the application as a patent. However, the USPTO will not treat application papers submitted after the filing date of an application as the original disclosure of the application for making a certified copy of the application-as-filed or any other purpose. That is, even if an applicant subsequently files substitute application papers that comply with 37 CFR 1.52 and then requests that the USPTO provide a certified copy of an application-as-filed, paying the fee set forth in 37 CFR 1.19(b)(1), the USPTO will still make a copy of the application-as-filed from the records in the PICS (or microfilm) database, and this database will not include the subsequently filed substitute papers.

If the certified copy of an application produced from the PICS (or microfilm) database is illegible, the applicant may pay the fee set forth in 37 CFR 1.19(b)(2) and request that the USPTO obtain the application file and produce a certified copy of the application by photocopying the application-as-filed as contained in the application file. The special handling required to produce a certified copy of the application from the papers in the application file will also cause a delay in when a certified copy is available.

USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

The initials S.I. stand for "Le Système International d'Unités," the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

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.

For numbering of claims, see MPEP § 608.01(j).

For form of claims, see MPEP § 608.01(m).

For dependent claims, see MPEP § 608.01(n).

For examination of claims, see MPEP § 706.

For claims in excess of fee, see MPEP § 714.10.

608.01(j) Numbering of Claims

37 CFR 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.

In a single claim case, the claim is not numbered.

Form paragraph 6.17 may be used to notify applicant.

¶ 6.17 Numbering of Claims, 37 CFR 1.126

The numbering of claims is not accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim [1] been renumbered [2].

Examiner Note:

1. In bracket 1, insert appropriate claim number(s) and --has-- or -- have --.
2. In bracket 2, insert correct claim number(s) and --, respectively -- if more than one claim is involved.

608.01(k) Statutory Requirement of Claims

35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he or she regards as his or her invention. The portion of the application in which he or she does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

608.01(l) Original Claims

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.

608.01(m) Form of Claims

The claim or claims must commence on a separate sheet and should appear after the detailed description of the invention. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the Technology Center (TC) technical support staff. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). 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, 37 CFR 1.75(i).

description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112.

See MPEP § 601.01(d) for treatment of applications filed without all pages of the specification.

Hyperlinks and Other Forms of Browser-Executable Code in the Specification

Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in a patent application. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "<>" and http:// followed by a URL address. When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent (or is published as a patent application publication) and the patent document is placed on the USPTO web page, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another web page identified by the URL, if it exists, which could be a commercial web site. USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites.

If hyperlinks and/or other forms of browser-executable code are embedded in the text of the patent application, examiners should object to the specification and indicate to applicants that the embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion. This requirement does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See MPEP § 608.01(p), paragraph I regarding incorporation by reference. Where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of 35 U.S.C. 112, first para-

graph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.

Note that nucleotide and/or amino acid sequence data placed between the symbols "<>" are not considered to be hyperlinks and/or browser-executable code and therefore should not be objected to as being an improper incorporation by reference (see 37 CFR 1.821 – 1.825).

¶ 7.29.04 Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Examiner Note:

1. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "<>" and http:// followed by a URL address. Nucleotide and/or amino acid sequence data placed between the symbols "<>" are not considered to be hyperlinks and/or browser-executable code.
2. If the application attempts to incorporate essential subject matter into the patent application by reference to a hyperlink and/or other form of browser-executable code, see MPEP § 608.01.
3. The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

608.01(a) Arrangement of Application

37 CFR 1.77. Arrangement of application elements.

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

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

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

- (1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc

(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.

Since the reply filed on [3] appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to submit an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)**

Examiner Note:

1. In brackets 1 and 3, insert the filing date of the reply.
2. In bracket 2, insert the reason for non-compliance, e.g., failure to provide a clean copy of an amended claim, failure to provide a marked up version of the amended claim.

608.01(n) Dependent Claims

I. MULTIPLE DEPENDENT CLAIMS

37 CFR 1.75. *Claim(s)*.

(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.

Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

The second paragraph of 35 U.S.C. 112 has been revised in view of the multiple dependent claim practice introduced by the Patent Cooperation Treaty. Thus 35 U.S.C. 112 authorizes multiple dependent claims in applications filed on and after January 24, 1978, as long as they are in the alternative form (e.g., "A machine according to claims 3 or 4, further comprising ---"). Cumulative claiming (e.g., "A machine according to claims 3 and 4, further comprising ---") is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8" is improper. 35 U.S.C. 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using form paragraph 7.45.

(a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words and may not contain more than 500 characters.

(b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c) Statement Regarding Federally Sponsored Research or Development: See MPEP § 310.

(d) Reference to a "Microfiche Appendix": See 37 CFR 1.96(c) and MPEP § 608.05, if the application was filed before March 1, 2001. The total number of microfiche and the total number of frames should be specified. Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation by reference of the material on the compact disc.

(e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the

specification should refer to another patent or readily available publication which adequately describes the subject matter.

(i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on a separate sheet (37 CFR 1.52(b)). 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. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

(j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.

(k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.

(l) Sequence Listing, if on paper: See 37 CFR 1.821-1.825.

Examiner Note:

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications.

608.01(b) Abstract of the Disclosure

37 CFR 1.72. Title and abstract.

(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.

The Office of Initial Patent Examination (OIPE) will review all applications filed under 35 U.S.C. 111(a) for compliance with 37 CFR 1.72 and will require an abstract, if one has not been filed. In all other applications which lack an abstract, the examiner in the first Office action should require the submission of an abstract directed to the technical disclosure in the specification. See Form Paragraph 6.12 (below). Applicants may use either "Abstract" or "Abstract of the Disclosure" as a heading.

If the abstract contained in the application does not comply with the guidelines, the examiner should point out the defect to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, and require compliance with the guidelines. Since the abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 U.S.C. 112 (*In re Armbruster*, 512 F.2d 676, 678-79,

C. Restriction Practice

For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim. Also, some embodiments of a multiple dependent claim may be held withdrawn while other embodiments are considered on their merits.

D. Handling of Multiple Dependent Claims by the Office of Initial Patent Examination

The Office of Initial Patent Examination (OIPE) is responsible for verifying whether multiple dependent claims filed with the application are in proper alternative form, that they depend only upon prior independent or single dependent claims and also for calculating the amount of the filing fee. A new form, PTO-1360, has been designed to be used in conjunction with the current fee calculation form PTO-875.

E. Handling of Multiple Dependent Claims by the Technology Center Technical Support Staff

The Technology Center (TC) technical support staff is responsible for verifying compliance with the statute and rules of multiple dependent claims added by amendment and for calculating the amount of any additional fees required. This calculation should be performed on form PTO-1360.

There is no need for a TC technical support staff to check the accuracy of the initial filing fee since this has already been verified by the Office of Initial Patent Examination when granting the filing date.

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the

amended claims. The applicant, or his or her attorney or agent, should be contacted to pay the additional fee. Where a letter is written in an insufficient fee situation, a copy of the multiple dependent claim fee calculation, form PTO-1360, should be included for applicant's information.

Where the TC technical support staff notes that the reference to the prior claims is improper in an added or amended multiple dependent claim, a notation should be made in the left margin next to the claim itself and the number 1, which is inserted in the "Dep. Claim" column of that amendment on form PTO-1360, should be circled in order to call this matter to the examiner's attention.

F. Handling of Multiple Dependent Claims by the Examiner

Public Law 94-131, the implementing legislation for the Patent Cooperation Treaty amended 35 U.S.C. 112 to state that "a claim in dependent form shall contain a reference to a claim *previously set forth*." The requirement to refer to a previous claim had existed only in 37 CFR 1.75(c) before.

The following procedures are to be followed by examiners when faced with claims which refer to numerically succeeding claims:

If any series of dependent claims contains a claim with an improper reference to a numerically following claim which cannot be understood, the claim referring to a following claim should normally be objected to and not treated on the merits.

However, in situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, all claims should be examined on the merits and no objection as to form need be made. In such cases, the examiner will renumber the claims into proper order at the time the application is allowed. (See Example B, below.)

Any unusual problems should be brought to the supervisor's attention.

Language and Format

The abstract must commence on a separate sheet, preferably following the claims, under the heading "Abstract of the Disclosure." Form paragraph 6.16.01 (below) may be used if the abstract does not commence on a separate sheet. Note that the abstract for a national stage application filed under 35 U.S.C. 371 may be found on the front page of the Patent Cooperation Treaty publication (i.e., pamphlet). See MPEP § 1893.03(e).

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 25 lines of text. Abstracts exceeding 25 lines of text should be checked to see that it does not exceed 150 words in length since the space provided for the abstract on the computer tape by the printer is limited. If the abstract cannot be placed on the computer tape because of its excessive length, the application will be returned to the examiner for preparation of a shorter abstract. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "This disclosure concerns," "The disclosure defined by this invention," "This disclosure describes," etc.

Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant's contribution to the art are most important in the preparation of the abstract. The review of the abstract for compliance with these guidelines, with any necessary editing and revision on allowance of the application, is the responsibility of the examiner.

Sample Abstracts

(1) A heart valve which has an annular valve body defining an orifice and a plurality of struts forming

a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

(2) A method for sealing whereby heat is applied to seal, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. The bond is formed immediately after heating within a period of time for any one surface point less than the total time of exposure to heated air of that point. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

(3) Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 75°C under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

¶ 6.12 Abstract Missing (Background)

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Examiner Note:

For *pro se* applicant, consider form paragraphs 6.14 to 6.16.

form in the file wrapper. If there are multiple dependent claims in the application, the total number of independent and dependent claims for fee purposes will be calculated on form PTO-1360 and the total number of claims and number of independent claims is then placed on form PTO-875 for final fee calculation purposes.

2. Calculation of Fees

(a) Proper Multiple Dependent Claim

35 U.S.C. 41(a), provides that claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.

(b) Improper Multiple Dependent Claim

If none of the multiple dependent claims is proper, the multiple dependent claim fee set forth in 37 CFR 1.16(d) will not be required. However, the multiple dependent claim fee is required if at least one multiple dependent claim is proper.

If any multiple dependent claim is improper, OIPE may indicate that fact by placing an encircled numeral "1" in the "Dep. Claims" column of form PTO-1360. The fee for any improper multiple dependent claim, whether it is defective for either not being in the alternative form or for being directly or indirectly dependent on a prior multiple dependent claim, will only be one, since only an objection to the form of such a claim will normally be made. This procedure also greatly simplifies the calculation of fees. Any claim depending from an improper multiple dependent claim will also be considered to be improper and be counted as one dependent claim.

(c) Fee calculation example

Claim No.	Ind.	Dep.
1. Independent	1	
2. Dependent on claim 1		1
3. Dependent on claim 2		1
4. Dependent on claim 2 or 3		2
5. Dependent on claim 4		2
6. Dependent on claim 5		2
7. Dependent on claim 4, 5 or 6		①
8. Dependent on claim 7		①
9. Independent	1	
10. Dependent on claim 1 or 9		2
11. Dependent on claims 1 and 9		①
Total	2	13

i) Comments On Fee Calculation Example

Claim 1 — This is an independent claim; therefore, a numeral "1" is placed opposite claim number 1 in the "Ind." column.

Claim 2 — Since this is a claim dependent on a single independent claim, a numeral "1" is placed opposite claim number 2 of the "Dep." column.

Claim 3 — Claim 3 is also a single dependent claim, so a numeral "1" is placed in the "Dep." column.

Claim 4 — Claim 4 is a proper multiple dependent claim. It refers directly to two claims in the alternative, namely, claim 2 or 3. Therefore, a numeral "2" to indicate direct reference to two claims is placed in the "Dep." column opposite claim number 4.

Claim 5 — This claim is a singularly dependent claim depending from a multiple dependent claim. For fee calculation purposes, such a claim is counted as being that number of claims to which direct reference is made in the multiple dependent claim from which it depends. In this case, the multiple dependent claim number 4 it depends from counts as 2 claims; therefore, claim 5 also counts as 2 claims. Accordingly, a numeral "2" is placed opposite claim number 5 in the "Dep." column.

Claim 6 — Claim 6 depends indirectly from a multiple dependent claim 4. Since claim 4 counts as 2 claims, claim 6 also counts as 2 dependent claims. Consequently, a numeral "2" is placed in the "Dep." column after claim 6.

Claim 7 — This claim is a multiple dependent claim since it refers to claims 4, 5, or 6. However, as

should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one application as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly on point as applicable exclusively to the case at hand.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, MPEP § 1302.

608.01(e) Reservation Clauses Not Permitted

37 CFR 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.

608.01(f) Brief Description of Drawings

37 CFR 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).

The Office of Initial Patent Examination (OIPE) will review the specification, including the brief description, to determine whether all of the figures of drawings described in the specification are present. If the specification describes a figure which is not present in the drawings, the application will be treated as an application filed without all figures of drawings in accordance with MPEP § 601.01(g), unless the application lacks any drawings, in which case the application will be treated as an application filed without drawings in accordance with MPEP § 601.01(f).

The examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used. If a figure contains several parts, for example, figure 1A, 1B, and 1C, the figure may be described as figure 1. If only figure 1A is described in the brief description, the examiner should object to the brief description, and require applicant to either add a brief description of figure 1B and 1C or describe the figure as "figure 1."

The specification must contain or be amended to contain proper reference to the existence of drawings executed in color as required by 37 CFR 1.84.

37 CFR 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

III. INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be

a proper dependent claim if the product might be made in other ways.

IV. CLAIM FORM AND ARRANGEMENT

A singular dependent claim 2 could read as follows:

2. The product of claim 1 in which

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent claim." It should be kept in mind that a dependent claim may refer back to any preceding independent claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant's sequence should not be changed. See MPEP § 608.01(j). Applicant may be so advised by using form paragraph 6.18.

¶ 6.18 Series of Singular Dependent Claims

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim. Accordingly, the numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

V. REJECTION AND OBJECTION

If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be objected to rather than rejected, if it is otherwise allowable.

Form paragraph 7.43 can be used to state the objection.

of printing delays associated with the usage of these symbols, any question about the intended symbol will be resolved by the editorial staff of the Office of Patent Publication by printing the symbol Ø whenever that symbol is used by the applicant. Any Certificate of Correction necessitated by the above practice will be at the patentee's expense (37 CFR 1.323) because the intended symbol was not accurately presented by the Greek upper or lower case Phi letters in the patent application.

608.01(h) Mode of Operation of Invention

The best mode contemplated by the inventor of carrying out his or her invention must be set forth in the description. See 35 U.S.C. 112. There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980).

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 USPQ2d 1737, 1742 (Fed. Cir. 1987); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974); *In re Gay*, 309 F.2d 708, 135 USPQ 311 (CCPA 1962). See 35 U.S.C. 112 and 37 CFR 1.71(b).

If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application

was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.

Patents have been held invalid in cases where the patentee did not disclose the best mode known to him or her. See *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 8 USPQ2d 1692 (Fed. Cir. 1988); *Spectra-Physics, Inc. v. Coherent, Inc.*, 821 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987).

For completeness, see MPEP § 608.01(p) and § 2165 to § 2165.04.

608.01(i) Claims

37 CFR 1.75. Claims

(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

I. INCORPORATION BY REFERENCE

The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Commissioner has elected to exercise that discretion. Section A provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section B provides guidance for incorporation by reference in benefit applications; i.e., those domestic (35 U.S.C. 120) or foreign (35 U.S.C. 119(a)) applications relied on to establish an earlier effective filing date.

A. Review of Applications Which Are To Issue as Patents.

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application, subject to the conditions set forth below.

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application.

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional

patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications however, hyperlinks and/or other forms of browser executable code cannot be incorporated by reference. See MPEP § 608.01. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Application No. _____ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103).

1. Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be canceled by amendment and may be substituted by reference to a U.S. patent or an earlier filed pending U.S. application. The amendment must be accompanied by an affidavit or declaration signed by the applicant, or a practitioner representing the applicant, stating that the material canceled from the application is the same material that has been incorporated by reference.

If an application as filed incorporates essential material by reference to a U.S. patent or a pending and commonly owned U.S. application, applicant may be required prior to examination to furnish the Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application.

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive. All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable. Where separate species are claimed, the claims of like species should be grouped together where possible. Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art, see MPEP § 706.03.

The following form paragraphs may be used to object to the form of the claims.

¶ 6.18.01 *Claims: Placement*

The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

Examiner Note:

This paragraph should only be used for applications filed on or after September 23, 1996.

¶ 7.29.01 *Claims Objected to, Minor Informalities*

Claim[1] objected to because of the following informalities: [2]. Appropriate correction is required.

Examiner Note:

1. Use this form paragraph to point out minor informalities such as spelling errors, inconsistent terminology, etc., which should be corrected.
2. If the informalities render the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under 35 U.S.C. 112, second paragraph.

¶ 7.29.02 *Claims Objected to, Reference Characters Not Enclosed Within Parentheses*

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Examiner Note:

1. Use of this paragraph is optional. You may instead choose to correct the error yourself at time of allowance by informal examiner's amendment.
2. If the lack of parentheses renders the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under 35 U.S.C. 112, second paragraph.

¶ 7.29.03 *Claims Objected to, Spacing of Lines*

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Amendments to the claims must be in compliance with 37 CFR 1.121(c). Form paragraphs 6.33 and 6.34 may be used to inform applicant of nonentry of amendments to the claims.

¶ 6.33 *Amendment to the Claims, 37 CFR 1.121*

The amendment to the claims filed on [1] does not comply with the requirements of 37 CFR 1.121(c) because [2]. Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

- (c) Claims.

reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The same policy concern does not apply where the sole purpose for which an applicant relies on an earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application, is not critical in the case of a "benefit" application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by the first paragraph of 35 U.S.C. 112 so that benefit may be accorded. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

For problems arising from the designation of materials by trademarks and trade names, see MPEP § 608.01(v).

608.01(q) Substitute or Rewritten Specification

37 CFR 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.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form paragraph 6.28 may be used where the specification is in faulty English.

¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

37 CFR 1.125(a) applies to a substitute specification required by the Office. 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.

¶ 7.45 Improper Multiple Dependent Claims

Claim [1] objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim [2]. See MPEP § 608.01(n). Accordingly, the claim [3] not been further treated on the merits.

Examiner Note:

1. In bracket 2, insert --should refer to other claims in the alternative only--, and/or, --cannot depend from any other multiple dependent claim--.
2. Use this paragraph rather than 35 U.S.C. 112, fifth paragraph.
3. In bracket 3, insert --has-- or --s have--.

Assume each claim example given below is from a different application.

A. *Acceptable Multiple Dependent Claim Wording*

Claim 5. A gadget according to claims 3 or 4, further comprising ---

Claim 5. A gadget as in any one of the preceding claims, in which ---

Claim 5. A gadget as in any one of claims 1, 2, and 3, in which ---

Claim 3. A gadget as in either claim 1 or claim 2, further comprising ---

Claim 4. A gadget as in claim 2 or 3, further comprising ---

Claim 16. A gadget as in claims 1, 7, 12, or 15, further comprising ---

Claim 5. A gadget as in any of the preceding claims, in which ---

Claim 8. A gadget as in one of claims 4-7, in which ---

Claim 5. A gadget as in any preceding claim, in which ---

Claim 10. A gadget as in any of claims 1-3 or 7-9, in which ---

Claim 11. A gadget as in any one of claims 1, 2, or 7-10 inclusive, in which ---

B. *Unacceptable Multiple Dependent Claim Wording*

1. *Claim Does Not Refer Back in the Alternative Only*

Claim 5. A gadget according to claim 3 and 4, further comprising ---

Claim 9. A gadget according to claims 1-3, in which ---

Claim 9. A gadget as in claims 1 or 2 and 7 or 8, which ---

Claim 6. A gadget as in the preceding claims in which ---

Claim 6. A gadget as in claims 1, 2, 3, 4 and/or 5, in which ---

Claim 10. A gadget as in claims 1-3 or 7-9, in which ---

2. *Claim Does Not Refer to a Preceding Claim*

Claim 3. A gadget as in any of the following claims, in which ---

Claim 5. A gadget as in either claim 6 or claim 8, in which ---

3. *Reference to Two Sets of Claims to Different Features*

Claim 9. A gadget as in claim 1 or 4 made by the process of claims 5, 6, 7, or 8, in which ---

4. *Reference Back to Another Multiple Dependent Claim*

Claim 8. A gadget as in claim 5 (claim 5 is a multiple dependent claim) or claim 7, in which ---

35 U.S.C. 112 indicates that the limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately. Thus, a multiple dependent claim, as such, does not contain all the limitations of all the alternative claims to which it refers, but rather contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration. Hence, a multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.

See MPEP § 714.20 regarding entry of amendments which include an unacceptable substitute specification.

For new matter in amendment, see MPEP § 608.04.

For application prepared for issue, see MPEP § 1302.02.

608.01(r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, *per se*.

608.01(s) Restoration of Canceled Matter

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. 37 CFR 1.121(b)(4). 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. 37 CFR 1.121(c)(2). See MPEP § 714.24.

608.01(t) Use in Subsequent Application

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. 37 CFR 1.79; MPEP § 608.01(e).

No part of a specification can normally be transferred to another application. Drawings may be transferred to another application only upon the granting of a petition filed under the provisions of 37 CFR 1.182. See MPEP § 608.02(i).

608.01(u) Use of Formerly Filed Incomplete Application

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See MPEP § 506 and § 506.01.

608.01(v) Trademarks and Names Used in Trade

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

Trademark: a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application.

TRADEMARKS

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes

Example A

(Claims 4 and 6 should be objected to as not being understood and should not be treated on the merits.)

1. Independent
2. Dependent on claim 5
3. Dependent on claim 2
4. "... as in any preceding claim"
5. Independent
6. Dependent on claim 4

Example B

Note: Parenthetical numerals represent the claim numbering for issue should all claims be allowed.

(All claims should be examined.)

1. (1) Independent
2. (5) Dependent on claim 5 (4)
3. (2) Dependent on claim 1 (1)
4. (3) Dependent on claim 3 (2)
5. (4) Dependent on either claim 1 (1) or claim 3 (2)

The following practice is followed by patent examiners when making reference to a dependent claim either singular or multiple:

(A) When identifying a singular dependent claim which does not include a reference to a multiple dependent claim, either directly or indirectly, reference should be made only to the number of the dependent claim.

(B) When identifying the embodiments included within a multiple dependent claim, or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, each embodiment should be identified by using the number of the claims involved, starting with the highest, *to the extent necessary* to specifically identify each embodiment.

(C) When all embodiments included within a multiple dependent claim or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, are subject to a common rejection, objection, or requirement, reference may be made only to the number of the dependent claim.

The following table illustrates the current practice where each embodiment of each claim must be treated on an individual basis:

Claim No.	Claim dependency	Identification	
		All claims	Approved practice
1	Independent	1	1
2	Depends from 1	2/1	2
3	Depends from 2	3/2/1	3
4	Depends from 2 or 3	4/2/1 4/3/2/1	4/2 4/3
5	Depends from 3	5/3/2/1	5
6	Depends from 2, 3, or 5	6/2/1 6/3/2/1 6/5/3/2/1	6/2 6/3 6/5
7	Depends from 6	7/6/2/1 7/6/3/2/1 7/6/5/3/2/1	7/6/2 7/6/3 7/6/5

When all embodiments in a multiple dependent claim situation (claims 4, 6, and 7 above) are subject to a common rejection, objection, or requirements, reference may be made to the number of the individual dependent claim only. For example, if 4/2 and 4/3 were subject to a common ground of rejection, reference should be made only to claim 4 in the statement of that rejection.

The provisions of 35 U.S.C. 132 require that each Office action make it explicitly clear what rejection, objection and/or requirement is applied to each claim embodiment.

G Fees for Multiple Dependent Claims**1. Use of Form PTO-1360**

To assist in the computation of the fees for multiple dependent claims, a separate "Multiple Dependent Claim Fee Calculation Sheet," form PTO-1360, has been designed for use with the current "Patent Application Fee Determination Record," form PTO-875. Form PTO-1360 will be placed in the file wrapper by the Office of Initial Patent Examination (OIPE) where multiple dependent claims are in the application as filed. If multiple dependent claims are not included upon filing, but are later added by amendment, the examining group technical support staff will place the

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 anyone 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.

37 CFR 1.84. Standards for drawings

(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.

The U.S. Patent and Trademark Office will permit the inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, which discloses material on which copyright or mask work protection has previously been established, under the following conditions:

(A) The copyright or mask work notice must be placed adjacent to the copyright or mask work material. Therefore, the notice may appear at any appropriate portion of the patent application disclosure, including the drawing. However, if appearing in the drawing, the notice must comply with 37 CFR 1.84(s). If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under 37 CFR 1.84.

(B) The content of the notice must be limited to only those elements required 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.

(C) Inclusion of a copyright or mask work notice will be permitted only if the following authorization in 37 CFR 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

erably as the first paragraph) of the specification to be printed for the patent:

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 disclosure, as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(D) Inclusion of a copyright or mask work notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR 1.312 have been satisfied.

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the U.S. Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C) above does not include the specific language "(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records, ..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181.

608.02 Drawing

35 U.S.C. 113. Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter 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 Commissioner 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.

can be seen by looking at the "2" in the "Dep." column opposite claim 4, claim 7 depends from a multiple dependent claim. This practice is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Following the procedure for calculating fees for improper multiple dependent claims, a numeral "1" is placed in the "Dep." column with a circle drawn around it to alert the examiner that the claim is improper.

Claim 8 — Claim 8 is improper since it depends from an improper claim. If the base claim is in error, this error cannot be corrected by adding additional claims depending therefrom. Therefore, a numeral "1" with a circle around it is placed in the "Dep." column.

Claim 9 — Here again we have an independent claim which is always indicated with a numeral "1" in the "Ind." column opposite the claim number.

Claim 10 — This claim refers to two independent claims in the alternative. A numeral "2" is, therefore, placed in the "Dep." column opposite claim 10.

Claim 11 — Claim 11 is a dependent claim which refers to two claims in the conjunctive ("1" and "9") rather than in the alternative ("1" or "9"). This form is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Accordingly, since claim 11 is improper, an encircled number "1" is placed in the "Dep." column opposite Claim 11.

ii) Calculation of Fee in Fee Example

After the number of "Ind." and "Dep." claims are noted on form PTO-1360, each column is added. In this example, there are 2 independent claims and 13 dependent claims or a total of 15 claims. The number of independent and total claims can then be placed on form PTO-875 and the fee calculated.

II. TREATMENT OF IMPROPER DEPENDENT CLAIMS

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. The initial acceptance of a claim as a dependent claim does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but

which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be *anceled* as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee.

Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.

Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36.

¶ 7.36 Objection, 37 CFR 1.75(c), Improper Dependent Claim

Claim [1] objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. [2].

Examiner Note:

1. In bracket 2, insert an explanation of what is in the claim and why it does not constitute a further limitation.
2. Note *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) for situations where a method claim is considered to be properly dependent upon a parent apparatus claim and should not be objected to or rejected under 35 U.S.C. 112, fourth paragraph. See also MPEP § 608.01(n), "Infringement Test" for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is *not* whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

(D) at least one claim directed to a laminated article or product (i.e., a laminated article of known and conventional character (e.g., a table)); or

(E) at least one claim directed to an article, apparatus, or system where the sole distinguishing feature is the presence of a particular material (e.g., a hydraulic system using a particular hydraulic fluid, or a conventional packaged suture using a particular material).

For a more complete explanation about when a drawing is required, see MPEP § 601.01(f). For applications submitted without all of the drawings described in the specification, see MPEP § 601.01(g).

If an examiner determines that a filing date should not have been granted in an application because it does not contain drawings, the matter should be brought to the attention of the supervisory patent examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to OIPE with a typed, signed, and dated memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

HANDLING OF DRAWING REQUIREMENTS UNDER THE SECOND SENTENCE OF 35 U.S.C. 113 - ILLUSTRATION SUBSEQUENTLY REQUIRED

35 U.S.C.113 addresses the situation wherein a drawing is not necessary for the understanding of the invention, but the subject matter sought to be patented admits of illustration by a drawing and the applicant has not furnished a drawing. The lack of a drawing in this situation does not render the application incomplete but rather is treated as an informality. A filing date will be accorded with the original presentation of the papers, despite the absence of drawings. The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under 37 CFR 1.81(c) or 37 CFR 1.83(c). In requiring such a drawing, the examiner should clearly indicate that the requirement is made under 37 CFR 1.81(c) or 37 CFR 1.83(c) and be careful not to state that he or she is doing so "because it is necessary for the understanding of the invention," as that might give rise to an erroneous impression as to the completeness of the application as filed. Examiners making such requirements are to specifically require, as a part of the applicant's next

reply, at least an ink sketch or permanent print of any drawing proposed in reply to the requirement, even though no allowable subject matter is yet indicated. This will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See 37 CFR 1.121 and 37 CFR 1.81(d). One of the following form paragraphs may be used to require a drawing:

¶ 6.23 Subject Matter Admits of Illustration

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Examiner Note:

When requiring drawings before examination use form paragraph 6.23.01 with a PTOL-90 or PTO-90C form as a cover sheet.

¶ 6.23.01 Subject Matter Admits of Illustration (No Examination of Claims)

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

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

Examiner Note:

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

Applicant should also amend the specification accordingly to reference to the new illustration at the time of submission of the proposed drawing(s). This may obviate further correspondence where an amendment places the application in condition for allowance.

DRAWING STANDARDS

37 CFR 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

¶ 7.43 *Objection to Claims, Allowable Subject Matter*

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

608.01(o) Basis for Claim Terminology in Description

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

The specification should be objected to if it does not provide proper antecedent basis for the claims by using form paragraph 7.44.

¶ 7.44 *Claimed Subject Matter Not in Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: [1]

608.01(p) Completeness

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in MPEP § 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications.

For "Guidelines For Examination Of Applications For Compliance With The Utility Requirement of 35 U.S.C. 101," see MPEP § 2107.

For "General Principles Governing Utility Rejections," see MPEP § 2107.01.

For a discussion of the utility requirement under 35 U.S.C. 112, first paragraph, in drug cases, see MPEP § 2107.03 and § 2164.06(a).

For "Procedural Considerations Related to Rejections for Lack of Utility," see MPEP § 2107.02.

For "Special Considerations for Asserted Therapeutic or Pharmacological Utilities," see MPEP § 2107.03.

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

However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required.

Prior to allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has been published or issued as a patent. If the referenced application has been published or issued as a patent, the examiner shall enter the U.S. Patent Application Publication No. or the U.S. Patent No. of the referenced application in the specification of the referencing application (see MPEP § 1302.04). If the referenced application has not been published or issued as a patent, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.

2. Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the reference. In such a case, the applicant will be required to amend the specification to include the material incorporated by reference. The following form paragraphs may be used.

¶ 6.19 Incorporation by Reference, Foreign Patent or Application

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

¶ 6.19.01 Improper Incorporation by Reference, General

The attempt to incorporate subject matter into this application by reference to [1] is improper because [2].

Examiner Note:

1. In bracket 1, identify the document such as an application or patent number or other identification.

2. In bracket 2, give reason why it is improper.

The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Reliance on a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See *In re Fried*, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date. *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

B. Review of Applications Which Are Relied on To Establish an Earlier Effective Filing Date.

The limitations on the material which may be incorporated by reference in U.S. patent applications which are to issue as U.S. patents do not apply to applications relied on only to establish an earlier effective filing date under 35 U.S.C. 119 or 35 U.S.C. 120. Neither 35 U.S.C. 119(a) nor 35 U.S.C. 120 places any restrictions or limitations as to how the claimed invention must be disclosed in the earlier application to comply with 35 U.S.C. 112, first paragraph. Accordingly, an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document. See *Ex parte Maziere*, 27 USPQ2d 1705, 1706-07 (Bd. Pat. App. & Inter. 1993).

The reason for incorporation by reference practice with respect to applications which are to issue as U.S. patents is to provide the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by

For examples of proper drawings, in addition to selected rules of practice related to patent drawings and interpretations of those rules, see the "Guide for the Preparation of Patent Drawings" which is available from the Superintendent of Documents (see MPEP Introduction).

For information regarding certified copies of an application-as-filed which does not meet the sheet size/margin and quality requirements of 37 CFR 1.52, 1.84(f), and 1.84(g), see MPEP § 608.01.

For design patent drawings, 37 CFR 1.152, see MPEP § 1503.02.

For plant patent drawings, 37 CFR 1.165, see MPEP § 1606.

For reissue application drawings, see MPEP § 1413.

For correction of drawings, see MPEP § 608.02(p). For prints, preparation and distribution, see MPEP § 508 and § 608.02(m). For prints, return of drawings, see MPEP § 608.02(y).

For pencil notations of classification and name or initials of assistant examiner to be placed on drawings, see MPEP § 719.03.

The filing of a divisional or continuation application under the provisions of 37 CFR 1.53(b) (unexecuted application) does not obviate the need for acceptable drawings. See MPEP § 608.02(b).

See MPEP § 601.01(f) for treatment of applications filed without drawings and MPEP § 601.01(g) for treatment of applications filed without all figures of drawings.

DEFINITIONS

A number of different terms are used when referring to drawings in patent applications. The following definitions are used in this Manual.

Original drawings: The drawing submitted with the application when filed.

Substitute drawing: A drawing filed later than the filing date of an application. Usually submitted to replace an original informal drawing.

Acceptable drawing: A drawing that is acceptable for publication of the application or issuance of the patent.

Corrected drawing: A drawing that includes corrections of informalities and proposed changes approved by the examiner.

Informal drawing: A drawing which does not comply with the form requirements of 37 CFR 1.84. Drawings may be informal because they are not on the proper size sheets, the quality of the lines is poor, or for other reasons such as the size of reference elements. Informal drawings could be acceptable for the purposes of publication and examination. An objection will generally only be made to an informal drawing if the Office is unable to reproduce the drawing or the contents of the drawing are unacceptable to the examiner.

Drawing print: This term is used for the white paper print prepared by the Scanning Division of the Office of Initial Patent Examination (OIPE) of all original drawings. The drawing prints contain the application number near the left-hand margin. Drawing prints should be placed on the top on the right-hand flap of the application file wrapper.

Interference print: This term is used to designate the copy prepared of the original drawings filed in file cabinets separate from the file wrappers and are used to make interference searches.

Plan: This term is used to illustrate the top view.

Elevation: This term is used to illustrate views showing the height of objects.

BLACK AND WHITE PHOTOGRAPHS

37 CFR 1.84. Standards for drawings.

(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), auto-radiographs, 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.

Photographs or photomicrographs (not photolithographs or other reproductions of photographs made by

Form paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

¶ 6.28.01 Substitute Specification Required by Examiner

A substitute specification [1] the claims is required pursuant to 37 CFR 1.125(a) because [2].

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Examiner Note:

1. In bracket 1, insert either -- excluding-- or -- including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.
4. See also form paragraph 13.01 for partial rewritten specification.
5. 37 CFR 1.125(b) provides applicants with the right of entry of substitute specifications, under the conditions set forth in the section, in applications other than reissue applications (37 CFR 1.125(d)) that have not been required by the examiner.

37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the applicant. A substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by (1) a statement that the substitute specification includes no new matter, and (2) a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown under 37 CFR 1.125(b)(2). 37 CFR 1.125(b). The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of 37 CFR 1.125(b) are satisfied.

37 CFR 1.125(c) requires a substitute specification filed under 37 CFR 1.125(a) or (b) 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 37 CFR 1.121(b)(1).

A substitute specification filed under 37 CFR 1.125(b) must be accompanied by a statement indicating that no new matter was included. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(d).

A substitute specification which complies with 37 CFR 1.125 should normally be entered. The examiner should write "Enter" or "OK to Enter" and his or her initials in ink in the left margin of the first page of the substitute specification. A substitute specification which is denied entry should be so marked.

Form paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under 37 CFR 1.125(b) has not been entered.

¶ 6.28.02 Substitute Specification Filed Under 37 CFR 1.125(b) Not Entered.

The substitute specification filed [1] has not been entered because it does not conform to 37 CFR 1.125(b) because: [2]

Examiner Note:

1. In bracket 2, insert statement of why the substitute specification is improper, for example:
 - the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--;
 - a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--;
 - a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--; or,
 - the substitute specification has been filed:
 - in a reissue application or in a reexamination proceeding, 37 CFR 1.125(d)-, or
 - after payment of the issue fee-, or
 - containing claims (to be amended)- --.

application. Until the renewed petition is granted, the examiner must object to the color drawings or color photographs as being improper.

In light of the substantial administrative and economic burden associated with printing a utility patent with color drawings or color photographs, the patent copies which are printed at issuance of the patent will depict the drawings in black and white only. However, a set of color drawings or color photographs will be attached to the Letters Patent. Moreover, copies of the patent with color drawings or color photographs attached thereto will be provided by the U.S. Patent and Trademark Office upon special request and payment of the fee necessary to recover the actual costs associated therewith.

Accordingly, the petition must also be accompanied by a proposed amendment to insert the following language as the first paragraph in the portion of the specification containing a 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 U.S. Patent and Trademark Office upon request and payment of the necessary fee.

If color drawings or color photographs have been filed, but the required petition has not, form paragraph 6.24.01 may be used to notify applicant that a petition is needed.

¶ 6.24.01 *Color Photographs and Color Drawings, Petition Required*

Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) or (b)(2) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for acceptance of the color photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(i), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Examiner Note:

1. This form paragraph should be used after form paragraph 6.24 only if the application contains color photographs or color drawings as the drawings required by 37 CFR 1.81.

2. Do not use this form paragraph for black and white photographs. The requirement of 37 CFR 1.84(b)(1) for a petition, petition fee, and three sets of black and white photographs has been waived. For black and white photographs, there is no requirement for a petition or petition fee, and only one set of photographs is required. See 1213 O.G. 108 (Aug. 4, 1998) and 1211 O.G. 34 (June 9, 1999).

It is anticipated that such a petition will be granted only when the U.S. Patent and Trademark Office has determined that a color drawing or color photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

It is emphasized that a decision to grant the petition should not be regarded as an indication that color drawings or color photographs are necessary to comply with a statutory requirement. In this latter respect, clearly it is desirable to file any desired color drawings or color photographs as part of the original application papers in order to avoid issues concerning statutory defects (e.g., lack of enablement under 35 U.S.C. 112 or new matter under 35 U.S.C. 132). The filing of the petition, however, may be deferred until acceptable formal drawings are required by the examiner.

DRAWING SYMBOLS

37 CFR 1.84(n) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate, subject to approval by the Office. Also, suitable legends may be used, or may be required, in proper cases. For examples of suitable symbols and legends, see the "Guide for the Preparation of Patent Drawings" available from the Superintendent of Documents (see MPEP Introduction).

The publications listed below have been reviewed by the Office and the symbols therein are considered to be generally acceptable in patent drawings. Although the Office will not "approve" all of the listed symbols as a group because their use and clarity must be decided on a case-by-case basis, these publications may be used as guides when selecting graphic symbols. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941).

The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. *In re Metcalfe*, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969).

Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks.

Form paragraph 6.20 may be used.

¶ 6.20 Trademarks and Their Use

The use of the trademark [1] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected

and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note:

Capitalize each letter of the word in the bracket or include a proper trademark symbol, such as TM or © following the word.

The examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type", e.g., "Band-Aid type bandage."

In the event that the proprietary trademark is a "symbol or device" depicted in a drawing, either the brief description of the drawing or the detailed description of the drawing should specify that the "symbol or device" is a registered trademark of Company X.

The owner of a trademark may be identified in the specification.

Technology Center Directors should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See Appendix I for a partial listing of trademarks and the particular goods to which they apply.

INCLUSION OF COPYRIGHT OR MASK WORK NOTICE IN PATENTS

37 CFR 1.71. Detailed description and specification of the invention

(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:

These publications are available from the American National Standards Institute Inc., 11 West 42nd Street, New York, New York 10036.

The publications reviewed are the following:

Y32.2-1970 Graphic Symbols for Electrical & Electronics Diagrams

Y32.10-1967 (R1994) Graphic Symbols for Fluid Power Diagrams

Y32.11-1961 (R1993) Graphic for Process Flow Diagrams in the Petroleum & Chemical Industries

Y32.14-1962 Graphic Symbols for Logic Diagrams

Z32.2.3-1949 (R1994) Graphical Symbols for Pipe Fittings, Valves and Piping

Z32.2.4-1949 (R1953) Graphic Symbols for Heating, Ventilating & Air Conditioning

Z32.2.6-1950 (R1993) Graphic Symbols for Heat-Power Apparatus

The following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional features is very helpful in making prior art searches.

37 CFR 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, flow sheets 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.

DRAWING REQUIREMENTS

The first sentence of 35 U.S.C. 113 requires a drawing to be submitted upon filing where such drawing is necessary for the understanding of the invention. In this situation, the lack of a drawing renders the application incomplete and, as such, the application cannot be given a filing date until the drawing is received. The second sentence of 35 U.S.C. 113 addresses the situation wherein a drawing is not necessary for the understanding of the invention, but the subject matter sought to be patented admits of illustration and no drawing was submitted on filing. The lack of a drawing in this situation does not render the application incomplete but rather is treated as an informality. The examiner should require such drawings in almost all such instances. Such drawings could be required during the initial processing of the application but do not have to be furnished at the time the application is filed. The applicant is given at least 2 months from the date of the letter requiring drawings to submit the drawing(s).

RECEIPT OF DRAWING AFTER THE FILING DATE

If the examiner discovers new matter in a substitute or additional drawing, the drawing should not be entered. The drawing should be objected to as con-

taining new matter. A new drawing without such new matter may be required if the examiner determines that a drawing is needed under 37 CFR 1.81 or 37 CFR 1.83. The examiner's decision would be reviewable by filing a petition under 37 CFR 1.181. The Technology Center (TC) Director would decide such a petition.

HANDLING OF DRAWING REQUIREMENTS UNDER THE FIRST SENTENCE OF 35 U.S.C. 113

The Office of Initial Patent Examination (OIPE) will make the initial decision in all new applications as to whether a drawing is "necessary" under the first sentence of 35 U.S.C. 113. A drawing will be considered necessary under the first sentence of 35 U.S.C. 113 in all applications where the drawing is referred to in the specification and one or more figures have been omitted.

The determination under 35 U.S.C. 113 (first sentence) as to when a drawing is necessary will be handled in OIPE in accordance with the following procedure. OIPE will make the initial determination as to whether drawings are required for the understanding of the subject matter of the invention. When no drawings are included in the application as filed and drawings are required, the application is treated as incomplete and the applicant is so informed by OIPE. A filing date will not be granted and applicant will be notified to complete the application (37 CFR 1.53(e)). If a drawing is later furnished, a filing date may be granted as of the date of receipt of such drawing.

An OIPE formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains:

(A) at least one process claim including the term "process" or "method" in its introductory phrase;

(B) at least one composition claim including the term "composition," "compound," "mixture" or "pharmaceutical" in its introductory phrase;

(C) at least one claim directed to a coated article or product or to an article or product made from a particular material or composition (i.e., an article of known and conventional character (e.g., a table), coated with or made of a particular composition (e.g., a specified polymer such as polyvinyl-chloride));

using screens) printed on sensitized paper are acceptable as final drawings, in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings, e.g., 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, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

Photographs submitted in lieu of ink drawings must comply with 37 CFR 1.84(b). There is no requirement for a petition or petition fee, and only one set of photographs is required. See 1213 O.G. 108 (Aug. 4, 1998) and 1211 O.G. 34 (June 9, 1998) and 37 CFR 1.84(b)(1).

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth with a white tint. Note that photographs filed on or after October 1, 2001 may no longer be mounted on Bristol Board. See 37 CFR 1.84(e) and 1246 O.G. 106 (May 22, 2001). If several photographs are used to make one sheet of drawings, the photographs must be contained (i.e., developed) on a single sheet.

See MPEP § 1503.02 for discussion of photographs used in design patent applications.

COLOR DRAWINGS OR COLOR PHOTOGRAPHS

37 CFR 1.84. Standards for drawings.

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications:

(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.

(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.

Limited use of color drawings in utility patent applications is provided for in 37 CFR 1.84(a)(2) and (b)(2). Unless a petition is filed and granted, color drawings or color photographs will not be accepted in a utility or design patent application. The examiner must object to the color drawings or color photographs as being improper and require applicant either to cancel the drawings or to provide substitute black and white drawings.

Under 37 CFR 1.84(a)(2) and (b)(2), the applicant must file a petition with fee requesting acceptance of the color drawings or color photographs. Three sets of color drawings or color photographs must also be submitted (37 CFR 1.84(a)(2)(ii)). However, the requirement of 37 CFR 1.84(a)(2)(iii) for a black and white photocopy of the color drawings or color photographs has been waived. See 1246 O.G. 106 (May 22, 2001). The petition is decided by a Supervisory Patent Examiner. See MPEP § 1002.02(d).

Where color drawings or color photographs are filed in a continuing application, applicant must renew the petition under 37 CFR 1.84(a)(2) and (b)(2) even though a similar petition was filed in the prior

(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), auto-radiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystal-line 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

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.

Drawings on paper are acceptable as long as they are in compliance with 37 CFR 1.84. Corrections thereto must be made in the form of replacement sheets since the Office does not release drawings for correction. See 37 CFR 1.85.

Good quality copies made on office copiers are acceptable if the lines are uniformly thick, black, and solid. Facsimile copies of drawings however, are not acceptable (37 CFR 1.6(d)(4)).

Drawings are currently accepted in two different size formats. It is, however, required that all drawings in a particular application be the same size for ease of handling and reproduction.