MEMORANDUM

TO: Everyone

FROM: SN

DATE: November 3, 1997

RE: New Rules Effective December 1, 1997
Continuing Applications

SN

The PTO has promulgated many rule revisions which will become effective December 1, 1997. Among these, there is no longer any Rule 60 and no longer any Rule 62, and therefore effective Monday, December 1, 1997, we will no longer be able to file Rule 60 and Rule 62 continuations and divisions, and also no longer be able to file Rule 62 CIPs.

As of Monday, December 1, 1997, all new applications will be filed under Rule 53, which Rule 53 has now been expanded to cover various different kinds of new applications.

What used to be a Rule 62 continuation or division will now be a "continued prosecution application" (CPA) under Rule 53(d). The PTO has an approved form which we will use until we create our own form (which may be either before or after December 1). A copy of this PTO approved form is attached. A CPA will retain the same serial number as the parent application, and we will not receive a new filing receipt. Unlike the old rule 62 practice, we will not be able to file a CIP under rule 62 (we seldom did that anyway).

What was previously a Rule 60 division (or continuation) will now be simply a new application under Rule 53(b). Instead of a new declaration/POA, we will simply use a copy of the old declaration/POA from the parent application. A copy of the PTO approved form for filing such continuing applications (also for use in conjunction with filing entirely new applications) is attached.

If enough people express an interest, we can have a staff meeting on these matters. Otherwise, if you have a question ask Mr. Browdy or me (Mr. Browdy has studied the new rules in detail).

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

PTO/SB/29 (12/97)
Approved for use through 09/30/00. OMB 0651-0032
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.

CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

CHECK BOX, if applicable:

☐ DUPLICATE

Address to:		
Assistant Commissioner for Patents **Box CPA** **Washington, DC 20231**	*Attorney Docket No.*	
	First Named Inventor	
	Express Mail Label No.	
	Total Pages	

This is a request for a ☐ continuation or ☐ divisional application under 37 CFR 1.53(d), (continued prosecution application (CPA)) of prior application number _____/_____, filed on _____, entitled _____.

NOTES

FILING QUALIFICATIONS: *The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b) and filed on or after June 8, 1995, or (2) the national stage of an international application in compliance with 35 U.S.C. 371 and filed on or after June 8, 1995.*

C-I-P NOT PERMITTED: *A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).*

EXPRESS ABANDONMENT OF PRIOR APPLICATION: *The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.*

ACCESS TO PRIOR APPLICATION: *The filing of this CPA 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 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.*

35 U.S.C. 120 STATEMENT: *In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).*

1. ☐ Enter the unentered amendment previously filed on _____ under 37 CFR 1.116 in the prior nonprovisional application.
2. ☐ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53 (d)(4).
   a. ☐ *DELETE* the following inventor(s) named in the prior nonprovisional application:
      .....
      .....
   b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
   a. ☐ PTO-1449
   b. ☐ Copies of IDS Citations

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

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

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 CFR 1.16(c))	-20 =		x $_____ =	$
	INDEPENDENT CLAIMS (37 CFR 1.16(b))	-3 =		x $_____ =	
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			+ $_____ =	
				BASIC FEE (37 CFR 1.16(a))	
				Total of above Calculations =	
	Reduction by 50% for filing by small entity (Note 37 CFR 1.9, 1.27, 1.28).				
				TOTAL =	

6. Small entity status:
   a. ☐ A small entity statement is enclosed.
   b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
   c. ☐ Is no longer claimed.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. _____-_____:
   a. ☐ Fees required under 37 CFR 1.16.
   b. ☐ Fees required under 37 CFR 1.17.
   c. ☐ Fees required under 37 CFR 1.18.
8. ☐ A check in the amount of $_____ is enclosed.
9. ☐ Other: .....
   .....

NOTE: ***The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.***

10. NEW CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *New correspondence address below*

NAME					
ADDRESS					
CITY		*STATE*		*ZIP CODE*	
COUNTRY		*TELEPHONE*		*FAX*	

11. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME	
SIGNATURE	
DATE	

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

PTO/SB/05 (12/97)
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.		*Total Pages*	
First Named Inventor or Application Identifier			
Express Mail Label No.			

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

1. ☐ Fee Transmittal Form *(Submit an original, and a duplicate for fee processing)*
2. ☐ Specification [*Total Pages* ☐] *(preferred arrangement set forth below)*
   - Descriptive title of the Invention
   - Cross References to Related Applications
   - Statement Regarding Fed sponsored R & D
   - Reference to Microfiche Appendix
   - Background of the Invention
   - Brief Summary of the Invention
   - Brief Description of the Drawings *(if filed)*
   - Detailed Description
   - Claim(s)
   - Abstract of the Disclosure
3. ☐ Drawing(s) *(35 USC 113)* [*Total Sheets* ☐]
4. Oath or Declaration [*Total Pages* ☐]
   - a. ☐ Newly executed (original or copy)
   - b. ☐ Copy from a prior application (37 CFR 1.63(d)) *(for continuation/divisional with Box 17 completed)* ***[Note Box 5 below]***
     - i. ☐ DELETION OF INVENTOR(S) Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference *(useable if Box 4b is checked)* The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.
6. ☐ Microfiche Computer Program *(Appendix)*
7. Nucleotide and/or Amino Acid Sequence Submission *(if applicable, all necessary)*
   - a. ☐ Computer Readable Copy
   - b. ☐ Paper Copy (identical to computer copy)
   - c. ☐ Statement verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

8. ☐ Assignment Papers (cover sheet & document(s))
9. ☐ 37 CFR 3.73(b) Statement *(when there is an assignee)* ☐ Power of Attorney
10. ☐ English Translation Document *(if applicable)*
11. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
12. ☐ Preliminary Amendment
13. ☐ Return Receipt Postcard (MPEP 503) *(Should be specifically itemized)*
14. ☐ Small Entity Statement(s) ☐ Statement filed in prior application, Status still proper and desired
15. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
16. ☐ Other: .....

17. If a CONTINUING APPLICATION, *check appropriate box and supply the requisite information:*
☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No: _____/_____

18. CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *Correspondence address below*

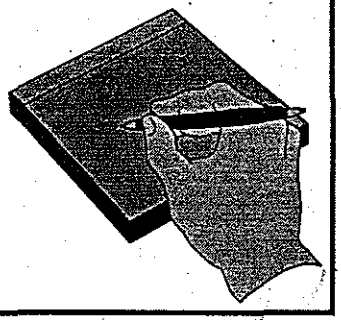
NAME					
ADDRESS					
CITY		*STATE*		*ZIP CODE*	
COUNTRY		*TELEPHONE*		*FAX*	

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, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

N.L

Final Rule: Changes to Patent Practice and Procedure

Robert J. Spar
Director,
Special Program Law Office
Deputy Assistant Commissioner
for Patent Policy & Projects
U.S. Patent & Trademark Office
703 305-9285, bob.spar@uspto.gov



Final Rule: Changes to Patent Practice and Procedure

- Effective Date: *December 1, 1997*
- Published in the Federal Register & OG
  62 Fed. Reg. 53131 (October 10, 1997)
  1203 Off. Gaz. Pat. Office 63 (October 21, 1997)
- Errata: - *62 Fed. Reg. 61235 (November 17, 1997)*
  - *1204 Off. Gaz. Pat. Office 90 (November 25, 1997)*
- Change to § 1.53(d) - Interim Rule:
  – *63 Fed. Reg. 5732 (Feb. 4, 1998)*
  – *1207 Off. Gaz. Pat. Office 83 (Feb.24, 1998)*

Notebook Materials + 2/98 Supplement

1. Changes to Patent Practice and Procedure - Final Rule, Index of Final Rule, Errata Notice, & § 1.53(d) chge
2. Subject Matter Summary I - Highlights
3. Subject Matter Summary II - Condensed
4. Subject Matter Summary III - Detailed
5. Rule-by-Rule Summary IV
6. Training Slides
7. Application Filing Forms
8. Questions and Answers
9. Selected Form Paragraphs for Examiner Use
10. CPA Application Processing Flowchart - Obsolete
11. Reissue/Reexam Amendment Handout

Rev. 8 3

Implementation

General Approach:

Treat papers filed prior to 12/1/1997 in the most favorable way possible for the applicant.

Website: www.uspto.gov

Supplemental Q's & A's, notices

Revised filing forms - now in 2 formats

4

Rule 53(c)
120706 83 2-14-98
for CPA Does not require filing date prior to 6-8-95
applies 12-1-97

Introduction to the Patent Practice and Procedure Changes

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Topic 5. Miscellaneous 36
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Application Filing - 37 C.F.R. § 1.53 Major Changes

Entire rule substantially revised

- All applications will be filed under § 1.53
- Filing under § 1.60 and § 1.62 (FWC) abolished
- Applications similar to § 1.60 filed under §1.53(b)
  - with a copy of the prior oath/dec under § 1.63
  - with the same or fewer inventors - §1.53(b)(1)
- Applications similar to FWCs (§ 1.62) filed as CPAs under § 1.53(d)

Application Filing - 37 C.F.R. § 1.53 Paragraph Overview

- § 1.53(c) Provisional Applications
- § 1.53(d) Continued Prosecution Applications - CPAs
  - Former FWCs (Rule 62)
  - Not for CIPs
- § 1.53(b) Everything else*
  - new applications, with new oath/dec
  - continuation/divisional applications, with copy of oath/dec
  - CIPs, with new oath/dec

  * except PCT applications

Application Filing - 37 C.F.R. § 1.53(b) Dec.'s

Oath and Declaration Requirements

- Only § 1.53(b) filings require an oath/dec
- Oath/dec may be an orig. or copy (§ 1.63(d))
  - copy from a prior application, or
  - newly executed for this application
- Oath/dec need not be submitted on filing (§1.53(f)); must include P.O. address
- Newly executed oath/dec needed for CIP application or a non-continuing application

can be unsigned copy for continuation OR send copy & have new declaration executed

OR Rule 3.73(b) statement — assignee appoints atty.

Application Filing - 37 C.F.R. § 1.53(b) Spec's

Specification Requirements for Cont/Div cases using a copy of the Oath/dec (§ 1.63(d))

- Commandment: May not contain new matter
- "True Copy" requirement of Rule 60 dropped
- May be edited, rearranged, reformatted - whatever
- Examiners' responsibilities concerning the status as a continuing case stay the same

* **Specification should include an incorporation-by-reference of prior application** (to avoid inadvertent loss of subject matter)

include prior entered amendments

Suggest you do as of must date spec — submit marked-up original and statement that there's no new matter.

Do compare document marked up by computer

Application Filing - 37 C.F.R. § 1.53(b) Wreck's

- Cases designated as Rule 60- Treat as § 1.53(b)
- § 1.53(b) is the default home for filing; unless specifically designated as a CPA, a § 371 or a provisional application
- Problem cases will end up under this paragraph

If anything says "CPA" PTO will treat appln as CPA

Application Filing - 37 C.F.R. § 1.53(d) CPAs

Continued Prosecution Applications

- Replace Rule 62 FWC
- Only Basic Requirement
  - Cannot include new matter

Note: Immediate prior application may be filed before, on or after 6/8/95

- See: *63 FR 5732 (2/4/98); 1207 OG 83 (2/24/98)*

Application Filing - 37 C.F.R. § 1.53(d) CPAs (cont)

CPA Application Attributes

- Uses the file jacket and contents of the prior application
- Uses same application number as prior application
- Prior application is expressly abandoned as of filing date of CPA request

PTO will not send letter abandonment for parent

How to Recognize a CPA

- Application File Wrapper:
  (a) Typical Contents Entry -

  _#11_ *Request for CPA* *12/15/98*

  (b) Face of File: "CPA" label



- PALM: "Contents" column of 2952 screen - look for "ACPA"(continuation) or "DCPA" (divisional)
- Form paragraph will be in the first action of CPA
- If Notice of Abandonment is received- CPA was not established!
- Patent will include statement re: CPA & 20 yr. patent term

Application Filing - C.F.R. § 1.53(d)
CPA (cont) 37

CPA Filing

- May be filed by fax (§ 1.6(d)(3)) or hand delivered to group
- Certificate of transmission/mailing under § 1.8 does **not** apply to filing of CPA
- Filing date is date of **receipt** of complete facsimile transmission
- Make and retain fax transmission report for relief by petition under § 1.6(f) if PTO loses fax.

PTO encourages fax filing to avoid Mail Room

→ copy made within 24 hours of transmission

Preliminary amdt should be faxed separate from CPA if filing late at night

Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

- 4 CPA Filing Requirements
  - Request for CPA must be a separate paper
  - Identify prior application number
  - Prior application must be complete
  - Copending with and before payment of issue fee in prior application, unless § 1.313(b)(5) petition granted

no such thing as "conditional CPA"

Application Filing - 37 C.F.R. § 1.53(d) CPA (cont)

CPA Processing in PTO:

Need not pay filing fee - CPA - can pay fee later - surcharge

- Processing will be performed in Group where prior application assigned
- No new filing receipt issued
- As later payment with surcharge is permitted per § 1.53(f), no Office action or interview will be given until filing fees paid

use filing date of parent w/ all CP & papers filed

To file preliminary amdt., file quickly. If you don't have amendment, don't pay filing fee to avoid early action by examiner.

No change in time for filing IDS - 3 mo from date of filing CPA

Application Filing - 37 C.F.R. § 1.53(d)
CPA (cont)

CPA: 35 USC 120 Benefits

- The first sentence of the specification need not, and may not, refer to the prior application.
- The effective filing date is at least the filing date of the parent.

Carry-Over Documents
CPA (cont)

Papers in the prior application that do CARRY OVER to, and will be considered in, a CPA:

- Affidavits/declarations under 37 C.F.R. §§ 1.130-1.132
- Information Disclosure Statements
- Terminal Disclaimers
- Petitions under 37 C.F.R. § 1.48
- Priority claims (foreign and domestic)
- Deposit Account charge authorizations
- Elections
  - unless the CPA is a divisional or indicates otherwise
- Ownership submissions under 37 C.F.R. § 3.73(b)

Carry-Over Documents
CPA (cont)

Papers in the prior application that do **NOT** carry-over to a CPA

- Small Entity Status
  - small entity status must be specifically established in a continuing application, but may be established by payment of the small entity basic filing fee
- Elections
  - where the CPA is a divisional or otherwise indicates that the election in the prior application does not carry over

You must separately determine if small entity status still exists.

Recommend – file paper that small entity status is still desired.

PTO presumes continuation

Application Filing - 37 C.F.R. § 1.41(a)
Inventorship

The executed oath/dec names the inventorship:

- Inventor's name is no longer needed for a filing date
- Executed oath/dec sets the names of the inventors
- If no name of an actual inventor is provided with the application papers, an identifier consisting of alphanumeric characters is requested (e.g., attorney docket number)

Recommend – give PTO the inventorship

You think it will be.

Application Filing - 37 C.F.R. § 1.41(a) Inventorship

Inventorship in provisional application identified in:

- Cover sheet; or in the
- Application papers under § 1.53(c), IF the cover sheet was not filed during pendency of the provisional application; or in a
- Petition under § 1.41(a)(2) for change of names or inventors.

Application Filing Changes: Summary

- 37 C.F.R. § 1.60 and 1.62 eliminated
- 37 C.F.R. § 1.63(d) provides for the use of a copy of the executed oath/declaration from a prior application in a continuation or divisional (filed under 37 C.F.R. § 1.53(b))
  - *Replaces practice under 37 C.F.R. § 1.60*
- 37 C.F.R. § 1.53(d) provides for Continued Prosecution Applications (CPAs)
  - *Replaces practice under 37 C.F.R. § 1.62*

Topic 2:
Deceptive Intent

- 37 C.F.R.§ 1.4 Verification of correspondence
- 37 C.F.R.§ 1.48 & 1.324 Correction of inventorship
- 37 C.F.R.§ 1.171 & 1.175 Reissues.
- 37 C.F.R.§ 3.73(b) Establishing right of assignee to prosecute.
- 37 C.F.R.§ 1.28 Small Entity Status

eliminated request for title report. Identify one error. When case is ready for allowance, file supplemental dec - that any changes made during prosecution were made without deceptive

Deceptive Intent - 37 C.F.R.§ 1.4

37 C.F.R. § 1.4 and 10.18:

- Puts inventors on the same plane as attorneys and agents
- An explicit verification is not required for certain submissions, e.g. small entity statements (§ 1.27), correction of inventorship (§ 1.48), substituted specifications (§ 1.125).
- The verification requirement is retained in certain sections (*e.g.*, 37 C.F.R. § 1.63 oaths, §§ 1.130, 1.131, and 1.132 affidavits).

Deceptive Intent - 37 C.F.R.§ 1.48 & 1.324

Correction of inventorship in applications (§ 1.48) & patents (§ 1.324)

- Eliminated factual showing requirements
- Eliminated diligence requirements
- Narrowed and changed parties who must submit statements
  - 37 C.F.R.§ 1.48: statements required only from inventors to be added to or deleted from application
  - 37 C.F.R.§ 1.324: statements re deceptive intent only required from inventors added or deleted

Deceptive Intent - 37 C.F.R. § 3.73

The assignee's ownership interest is established by filing a statement under 37 C.F.R. § 3.73(b) :

37 C.F.R. § 3.73(b) no longer requires that an assignee

- specifically state that the evidentiary documents have been reviewed, and
- certify that title is in the assignee seeking to take action

Deceptive Intent - 37 C.F.R. § 1.28 (a)(2)

Small Entity Status

The payment of the small entity basic statutory filing fee will be treated as the required reference to a small entity statement in a prior application or in a patent in:

must specifically refer to small entity

- continuing applications, and
- reissue applications

2. Deceptive Intent Issues 27

Topic 3: Appeal Process

- 37 C.F.R. § 1.191 Notice of Appeal
- 37 C.F.R. § 1.193 Examiner's Answer & Reply Brief
- 37 C.F.R. § 1.196 Decision by the Board

Board can reject non-appealed claims
Board can require info. from atty. of reco
or appellant

3. Appeal Process 28

Appeal Process - 37 C.F.R. § 1.193 Examiner's Answer

While § 1.193 precludes New Grounds of rejection in an Examiner's Answer,

IF

1. an amendment under §1.116 is submitted, and
2. advisory action indicates the § 1.116 amendment would be entered for appeal purposes, and which individual rejections in final would be used to reject the new or amended claims,

must be one existing rejection in final

THEN

3. Appeal brief must address the indicated rejections, and
4. Examiner's Answer may include such rejections

Prosecution reopened for new ground(s) of rejection.

Appeal Process - 37 C.F.R. § 1.193

Where prosecution is reopened, under § 1.193(b)(2), appellant must:

- file an appropriate reply to the Office action; or
- request reinstatement of the appeal
  - request must be accompanied by a supplemental appeal brief
- reinstatement option will avoid need for a final Office action when applicant chooses to go back to the Board of Appeals

Appeal Process - 37 C.F.R. § 1.193

- Timely reply brief always entered--§ 1.193(b)(1)
  - New amendments, affidavits, declarations, or exhibits are not entered except as permitted by §§ 1.116 and 1.195.
  - Examiner must:
    - acknowledge and enter the reply brief; or
    - reopen prosecution to respond to the reply brief
- Supplemental examiner's answer not permitted

Caveat - Do not try to give PTO a continuation reply brief - no amendments or new evidence. These require separate papers. If any part of reply brief is not entered reply brief will not be entered

Topic 4: Time to Reply

- 37 C.F.R. § 1.135 Abandonment for failure to reply within time period.
- 37 C.F.R. § 1.136 Extensions of time.
- 37 C.F.R. § 1.137 Revival of abandoned application or lapsed patent.

NO extensions to file a reply brief

Time to Reply - 37 C.F.R. § 1.135(c)

Treatment of bona fide but incomplete replies to non-final Office action.

May be accepted and treated by:

1) Acting on the merits of the reply; or

2) Requiring the omission to be supplied prior to acting on the merits of the reply.

- new extendible time period (not time limit) may be given
- remaining time period if sufficient

Time to Reply - 37 C.F.R. § 1.135(c)

Exception:

- Does **not** apply after a **final** Office action, not even if the omission is:
  - 1) a lack of a signature; or
  - 2) a lack of additional claims fee

- An applicant must supply any omission in a reply to a **final** Office action within the period for reply to the **final** Office action.

Time to Reply - 37 C.F.R. § 1.136

Extensions

- The cap is now five months
- Separate and specific petition for extension is no longer needed.
  - a petition will be construed whenever possible
- Five Months is possible for
  1) one month restrictions
  2) one month periods under § 1.135(c)
  3) appeal briefs (up to 7- not subject to stat. period)

PTO assumes if you file an amendment, you intend to file timely. If authorized to charge fees, PTO will charge fees. Watch deposit account!

If examiner does not charge extension fee & examiner's amdt, PTO says case is abandoned

Time to Reply - 37 C.F.R. § 1.137

Abandonment and Revival:

- Removal of one-year cap for filing a petition based on unintentional delay. (37 C.F.R. § 1.137(b))
  - Emphasizes that the entire delay must have been unintentional to preclude intentional delay or abuse of the revival procedure (*e.g.*, submarine patents).
  - Long abandoned applications will receive greater scrutiny – any thing over 3 mos. from date of abandonment or notice of abandonment
- Terminal disclaimer required for all applications not subject to 20 year term

If there is an intent & let it set, that is intentional abandonment

Topic 5: Miscellaneous

- 37 C.F.R. § 1.14(a)(2) Access to file
- 37 C.F.R. § 1.59 Petitions to expunge
- 37 C.F.R. § 1.121 Manner of making amendments
- 37 C.F.R. § 1.125 Substitute specification
- 37 C.F.R. § 1.152 Design patent applications
- 37 C.F.R. § 1.291 Protests by the public against pending applications

Miscellaneous - 37 C.F.R. § 1.121

Manner of Making Amendments

- Applications other than reissues 37 C.F.R. § 1.121(a)
  - (a) (1) - spec
  - (a) (2) - claims
  - (a) (3) - drawings
- Reissue Applications 37 C.F.R. § 1.121(b)
  - (b) (1) - spec
  - (b) (2) - claims
  - (b) (3) - drawings
- Reexaminations 37 C.F.R. § 1.121(c)

Miscellaneous - 37 C.F.R. § 1.121

- No change in substance for applications other than reissues - 37 C.F.R. § 1.121(a)
- Reissue practice made to conform to reexamination - 37 C.F.R. § 1.121(b)
- Disclosure must be amended when required to ensure *substantial* correspondence between the specification (including the claims) and the drawings. 37 C.F.R. §§ 1.121(a)(5), (b)(4), 1.530(d)(7)

need not be exact correspondence between language in spec. & claims

5. Miscellaneous

Summary: Filing of Applications

- All applications under 35 U.S.C. § 111 filed under 37 C.F.R. § 1.53
  - 37 C.F.R. §§ 1.60 and 1.62 eliminated
- Continuations/divisionals may be filed using copy of an oath/dec. from prior application
- P.O. Address must be in oath/dec.
- Names of the inventors not needed for a filing date
  - The inventorship is named in the executed oath/dec.

Rev. 8 Summary

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Summary: Filing of Applications

- Continued Prosecution Application (CPA) under 37 C.F.R. § 1.53(d)
  - Immediate prior application may be filed before, on or after June 8, 1995*
  - No C-I-P permitted
  - Same application number/file jacket as prior application
  - No "first sentence" reference to prior application
    - Front of file jacket will not show CPA continuing data
  - Will be processed entirely by Group
  - **May be filed by facsimile**

*Note: See 63 F.R.5732 (2/4/98); 1207 O.G. 83 (2/24/98)

Summary: Deceptive Intent

- Separate verification requirement eliminated in a number of sections
- Requirements for a reissue oath/dec. simplified
- Requirements for a petition to correct inventorship simplified
- The payment of the small entity filing fee in a continuing or reissue application substitutes for a small entity statement (or reference to the statement in prior application or patent)

Summary: Appeals

- No new ground of rejection in an examiner's answer but permitted to apply individual rejections of final to claims of §1.116 amendment
- Any new ground of rejection on appeal or response to a reply brief must be via reopening of prosecution
  - The applicant may request reinstatement of the appeal in reply to reopening of prosecution
- Reply briefs must be admitted if timely
- Supplemental Examiner's Answer not permitted

Summary: Time Frames

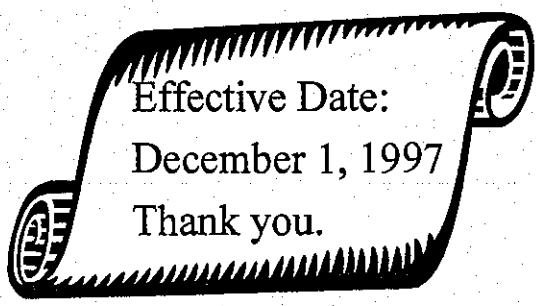
- Applicants may be given an extendible time period to supply an omission to a *bona fide* but incomplete reply to a non-final action
- Extensions for up to five (5) months now permitted under 37 C.F.R. § 1.136(a))
- Fee authorization or fee itself is a constructive petition under 37 C.F.R. § 1.136(a)
- One year filing period requirement for revival based upon unintentional delay (37 C.F.R. § 1.137(b)) eliminated
- Multiple prior art protests permitted if timely

For Further Information Contact:
703 305-9285

Section	Legal Advisor(s)
37 CFR 1.4, 1.33	Robert Bahr
37 CFR 1.6, 1.41, 1.53	John Gonzales/ Fred Silverberg/ Robert Bahr
37 CFR 1.48, 1.324	Hiram Bernstein/ Jay Lucas
37 CFR 1.14, 1.59, 1.63	Karin Tyson/ Jay Lucas
37 CFR 1.104, 1.152	Robert Bahr
37 CFR 1.84, 1.91, 1.121, 1.125	Kenneth Schor/ Larry Anderson
37 CFR 1.135, 1.136, 1.137	Robert Bahr
37 CFR 1.11, 1.171, 1.172, 1.175	Kenneth Schor/ Joe Narcavage
37 CFR 1.191, 1.193, 1.196	Robert Bahr
37 CFR 1.291	John Gonzales/ Fred Silverberg
37 CFR 3.73(b)	Kenneth Schor/ Hiram Bernstein
37 CFR 1.510, 1.530, 1.550	Gerald Dost/ Kenneth Schor

Rev. 8

Final Rule: Changes to the Patent Practice and Procedure



Living with the New Rule Package

Changes to Patent Practice and Procedure Effective 12/1/97

Final Rule, 62 *Fed. Reg.* 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997)
Section 1.53(d) change, 63 *Fed. Reg.* 5732 (Feb. 4, 1998); 1207 Off. Gaz. Pat. Office. 83 (Feb. 24, 1998)

The following suggestions are made so as to avoid problems which we have noticed since the changes to the patent rules went into effect on December 1, 1997.

1. **Application Filing:**

(a) **Use PTO transmittal forms (Rev 2/98)** or modified forms that conform to ours. While applicants are not required to use the Office's application transmittal and fee transmittal forms, and the Office's forms may be modified, our forms contain information that we would like to have and can more easily recognize the presence of when submitted in the organized manner of the form rather than submitted haphazardly on various papers.

(b) **CPA Filing under § 1.53(d)**:

- File a CPA by a Fax transmission of the 2 page CPA Request Transmittal form. §1.6(d)(3).
- Separately Fax any multi-page preliminary amendment. A transmission problem is less likely with the 2 page CPA Request than with a multi-page paper. A preliminary amendment is not a time sensitive document like the filing of a CPA application and the preliminary amendment can come in after the CPA application is filed.
- When Fax filing, print a Fax transmission report within 1 day and save, so relief under § 1.6(f) is possible if Fax is lost by Office.
- **Continuation CPA's are treated as an "amended" case** by examiner so file any desired preliminary amendment with the CPA Request, or soon thereafter to avoid a first action final rejection.
- **CPA** and **Continued Prosecution Application** are unique terms for a (new application) filing only under § 1.53(d) (where parent becomes expressly abandoned), and such terms should NOT be used when a filing under § 1.53(b) is desired, as the presence of one or both such terms will cause the PTO to treat it as a CPA filing under § 1.53(d), and a petition (under § 1.182) will be needed to convert it to a § 1.53(b) filing.
  The petition under 37 CFR 1.182 to convert a properly filed CPA to an application filed under 37 CFR 1.53(b) must be filed expeditiously since the petition will not be granted if the CPA has been processed (and the prior application abandoned) at the time the petition and application file are before the deciding official for a decision on the petition to convert. In such case, applicant's only recourse will be to file a continuing application under § 1.53(b) of the CPA application.
- If a Notice of Abandonment is received on an application that was refiled as a CPA - promptly check on the status of the CPA application with the Office. The Office will not issue a Notice of Abandonment on a prior application where a CPA application has been properly filed even though the effect of the CPA is to expressly abandon the prior application. CPA filing will be acknowledged in the first Office action in the CPA.

Robert J. Spar, Director, Special Program Law office, USPTO March 20, 1998

- Cases formerly filed under former Rule 60 (with a copy of the prior case) should now be filed under § 1.53(b) and NOT as a CPA.

(c) **Inventorship:** Always identify the inventors when filing an application, or as many as are known, even though only an alphanumeric identifier is required. § 1.41(a)(3). If no inventors are set forth on filing the application, and the application is refiled prior to submission of an executed oath or declaration under § 1.63, there will be no inventorship overlap to support a priority claim under 35 U.S.C. 120 and § 1.78, and a petition under § 1.41(a)(2) will be required.

(d) **Small Entity Status:** To obtain small entity status in a continuing (or reissue application) - continue the practice of specifically referring back to the small entity statement in the prior application and stating that small entity status is desired and appropriate in the continuing application. Reliance on payment of a small entity fee, as is permitted to establish status (§ 1.28(a)(2)), should be viewed as a fail safe mechanism rather than as the primary means to establish status. For example, reliance on a general authorization to pay any fees that are due would not, by itself, be sufficient to establish small entity status as only an authorization to pay small entity fees would be sufficient to establish small entity status.

(e) **Filing Continuation or Divisional application under § 1.53(b) using a copy of a declaration from a prior application as permitted by § 1.63(d)(1)(iv):**

(1) Reformat the application and supply a new set of claims rather than submit a copy of prior application and a preliminary amendment. Consider providing a statement of no new matter and a marked-up copy (by hand or word processing compare function) showing changes, particularly for the claims. The marked-up copy of the claims, supplied as an extra paper, will aid the examiner in appreciating the current issues to be examined.

(2) Include a statement of incorporation by reference of the prior application in the application transmittal letter. If a page of the prior application is inadvertently omitted on submission to the Office of the continuing application, the omitted page can be reinserted while retaining the original filing date.

2. Appeals:

(a) While appellant now has the right to file a Reply Brief (no longer limited to new points of argument raised in an Examiner's Answer) DO NOTalso include amendments, or new evidence, in Reply Briefs. Reply Briefs that contain amendments or new evidence may not be considered to be Reply Briefs and may, therefore, be denied entry. As no extensions of time are permitted to the 2 months' period for the filing of a reply brief (§ 1.136(a)(1)(ii)), the non-entered paper probably cannot be stripped of the amendment or new evidence and be timely refiled. Thus, you should submit any amendment/evidence separately from the Reply Brief. This way the Reply Brief will be entered and considered independent of the entry of the amendment or new evidence.

(b) Do not save the "best" arguments until filing of the Reply Brief even though all Reply Briefs must be entered and, therefore, you can get your "best" argument in as the last

word. If the arguments are, in fact, the "best," the examiner may exercise the option of reopening prosecution to respond (§ 1.193(b)(1)). Even if the examiner does not reopen, the Board may remand the application to the examiner for a response to the new "best" arguments.

(c) Even though new grounds of rejection are not permitted in an Examiner's Answer (§ 1.193(a)(2)), an amendment after final rejection (§ 1.116) that is entered will allow an examiner to apply any rejection in the final action against any of the claims so amended on appeal so long as applicant is notified of the rejection in the advisory action.

3. Extension of Time Fees:

(a) Continue to **specifically request an extension of time under § 1.136(a)** rather than rely upon a general authorization to charge fees as provided for in § 1.136(a)(3). There is always a chance that the Office may initially fail to recognize the presence of the general authorization to charge fees depending upon which paper it appears in and where in the paper it has been placed.

(b) Reliance on a constructive petition for extension of time in § 1.136(a)(3) will **not** work to provide copendency for the refiling of a continuing application, except where the refiling is by a CPA. A refiling under § 1.53(b) is not a reply or other paper directed to the prior application as is required by § 1.136(a)(3).

(c) **Deposit accounts may need closer attention.** If general authorizations are more broadly relied upon, such as for extension of time fees, unaccounted for obligations may exhaust the account.

4. Revival: File petitions to revive under § 1.137 (a) or (b) immediately. While the Office has: removed the one year limitation for filing **unintentional** petitions to revive under § 1.137(b), eliminated the statement relating to promptly filing the petition, and has stated that the Office shall not generally question delays where the petition is filed within three months from first notification or within one year of the date of abandonment, you can expect that "unintentional" petitions to revive filed more than 3 months after abandonment will result in a request for an explanation for the delay. Further, impermissible delay may be found in another forum where there is any delay in filing the petition even if the petition was filed under circumstances where the Office would not generally raise an issue of delay.

Further, for cases not subject to 20 year patent term, the later a petition to revive is filed under 37 CFR § 1.137(a) or (b), the longer is the period to be disclaimed, as a Terminal Disclaimer (TD) is now required for a petition filed under 37 CFR § 1.137(a) or (b), and the six (6) month window under (b) has been removed.

QUESTIONS AND ANSWERS (Q&A's) (Revised 3/98)

CHANGES TO PATENT PRACTICE AND PROCEDURE - FINAL RULE
Effective Date: December 1, 1997

Change to § 1.53 (d): *Changes to Continued Prosecution Application Practice*, Interim Rule Notice
Federal Register 63 *Fed. Reg.* 5732 (February 4, 1998).
Official Gazette 1207 *Off. Gaz. Pat. Office* 83 (February 24, 1998).

Errata Notice: *Changes to Patent Practice and Procedure*, Correction
Federal Register 62 *Fed. Reg.* 61235 (November 17, 1997).
Official Gazette 1204 *Off. Gaz. Pat. Office* 90 (November 25, 1997).

The rule package: *Changes to Patent Practice and Procedure*, Final Rule
Federal Register 62 *Fed. Reg.* 53131 (October 10, 1997).
Official Gazette 1203 *Off. Gaz. Pat. Office* 63 (October 21, 1997).

Original Q&A's : 1-149
Revised Q&A's: 15, 16, 24, 28, 31, 32 and 75
New Q&A's: 149-170

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* Pagination may vary due to printer formatting.

QUESTIONS AND ANSWERS (Q&A's) (Revised 3/98)

CHANGES TO PATENT PRACTICE AND PROCEDURE - FINAL RULE
Effective Date: December 1, 1997

Change to § 1.53 (d): ***Changes to Continued Prosecution Application Practice*** **Interim Rule Notice** Federal Register 63 *Fed. Reg.* 5732 (February 4, 1998). Official Gazette 1207 *Off. Gaz. Pat. Office* 83 (February 24, 1998).
Errata Notice: ***Changes to Patent Practice and Procedure*** **Correction** Federal Register 62 *Fed. Reg.* 61235 (November 17, 1997). Official Gazette 1204 *Off. Gaz. Pat. Office* 90 (November 25, 1997).
The rule package: ***Changes to Patent Practice and Procedure*** **Final Rule** Federal Register 62 *Fed. Reg.* 53131 (October 10, 1997). Official Gazette 1203 *Off. Gaz. Pat. Office* 63 (October 21, 1997).

Original Q&A's: 1-149
Revised Q&A's: 15, 16, 24, 28, 31, 32 and 75
New Q&A's: 149-170

NOTE: This is a replacement for the original Q&A's (Q1-Q148), dated October 8, 1997, which were included in the Training and Implementation Guide and were made available to the public through the Internet on the USPTO web site. This replacement includes the original Q&A's, revised Q&A's, and new supplemental Q&A's. The revised answers reflect the amendment of 37 C.F.R. § 1.53(d) to no longer require that a prior application of a Continued Prosecution Application (CPA) be filed on or after June 8, 1995. See Changes to Continued Prosecution Application Practice 63 Fed. Reg. 5732 (February 4, 1998); 1207 Off. Gaz. Pat. Office 83 (February 24, 1998). For convenience, the revised answer of the Q&A follows the corresponding answer of the original Q&A.

I. APPLICATION FILING CHANGES

A. Oath or Declaration - 37 C.F.R. § 1.63

(Q1) If the claims of a continuation or divisional application are directed toward previously unclaimed subject matter in the prior application, can the continuation or divisional application still be filed under 37 C.F.R. § 1.53(b) with a copy of the oath or declaration from the prior application pursuant to 37 C.F.R. § 1.63(d)?

Answer: Yes. A copy of the oath or declaration from the prior application is acceptable under 37 C.F.R. § 1.63(d) to complete the application under 37 C.F.R. § 1.51(b). The Office of Initial Patent Examination (OIPE) will process such a continuation or divisional application using the provided copy of the oath or declaration from the prior application without regard to the claims presented in the continuation or divisional application. OIPE will then forward the application to the appropriate group for examination. It is, however, possible that during examination a supplemental oath or declaration under 37 C.F.R. § 1.67 may be necessary to comply with 35 U.S.C. § 115. (See additional questions regarding 37 C.F.R. § 1.53 below.)

(Q2) A continuation or divisional application is filed with a copy of a declaration from a prior application. However, the specification filed in the continuation or divisional is different from the specification in the prior application to the extent that revisions have been made to clarify the text (editorial changes but not new matter). Is a new declaration required?

Answer: No. A new declaration is not required unless the continuation or divisional application includes new matter relative to the prior application (*i.e.*, the application is in fact a continuation-in-part). See the answer to Question Q3 below for the treatment of an application determined to include new matter relative to the prior application.

(Q3) What if the copy of the declaration submitted for a continuation or divisional application is a copy of a declaration from a prior application, but the specification attached to the declaration is different from that in the prior application in that new matter is included. Will the Office of Initial Patent Examination (OIPE) accept the application under 37 C.F.R. § 1.53(b)?

Answer: Yes. OIPE would not be able to determine if new matter is present in the specification, nor are they the proper party to do so. OIPE will simply accept the application under 37 C.F.R. § 1.53(b). However, if the examiner determines that new matter is present relative to the prior application, the examiner will notify the applicant in an Office action (preferably the first Office action) that a new oath/declaration along with a surcharge is required and that the application should be redesignated as a continuation-in-part (CIP). Applicant will not have complied with the requirements of 35 U.S.C. § 115, unless a new oath/declaration is filed (*i.e.*, a new oath/declaration executing the new specification which was filed in the CIP).

(Q4) 37 C.F.R. § 1.63(d)(iv) provides for the use of a copy of a declaration from a prior application in a new application filed under 37 C.F.R. § 1.53(b). When filing a third continuation under § 1.53(b) in a chain, can a copy of the declaration from the first application be used instead of the copy of the declaration from the second application?

Answer: Generally, the declaration from the second application must be used in filing the third application under the provisions of § 1.63(d). However, where the oath or declaration from the second application is a copy of the first declaration (*e.g.*, the second application was a continuation under former § 1.60), a copy of the declaration from the first application would be acceptable.

(Q5) In submitting a copy of a declaration from a prior application in a continuation under 37 C.F.R. § 1.53(b), as provided for by 37 C.F.R. § 1.63(d)(iv), does it matter if the declaration recites the application number of the prior application as opposed to simply identifying the prior application it was intended to execute by reference to an attached specification?

Answer: No, the copy of the declaration from the prior application may have used either identifier.

(Q6) Applicant has submitted a copy of a declaration from a prior application naming A, B and C

as inventors along with a statement requesting the deletion of inventor C. Should a new declaration be required naming only A and B as inventors?

Answer: No, so long as no other executed declaration was previously filed in the second application. 37 C.F.R. § 1.63(d)(2). (See "Correction of Inventorship" Section for more questions regarding inventorship issues.)

(Q7) Applicant has filed a copy of an oath or declaration from a prior application, which did not include the post office address. (The prior oath or declaration complied with 37 C.F.R. § 1.63 in effect at the time it was filed in the prior application.) However, applicant has provided the post office address elsewhere in the current application papers. Should a new oath or declaration be required?

Answer: No. Where the declaration is a copy of a declaration that complied with 37 C.F.R. § 1.63 when it was executed or filed in a prior application, a new oath or declaration will not be required.

(Q8) Applicant has filed a copy of an oath or declaration from a prior application which is not executed by one inventor and a copy of a decision according status under 37 C.F.R. § 1.47 in the prior application. Should a new oath or declaration executed by the non-signing inventor be required?

Answer: No. 37 C.F.R. § 1.63(d)(3) provides that the filing of a copy of a declaration lacking the signature of one or more inventors in an application accorded status under 37 C.F.R. § 1.47 is acceptable if a copy of the decision according status under § 1.47 is also filed. However, if an oath or declaration signed by the non-signing inventor was filed in the prior application, a copy of the oath or declaration signed by the previously non-signing inventor must be filed in the continuation or divisional application.

(Q9) If a continuation or divisional application under 37 C.F.R. § 1.53(b) is filed using a copy of the oath or declaration from the prior application under 37 C.F.R. § 1.63(d), and if an inventor was added in the prior application pursuant to 37 C.F.R. § 1.48(a), should the applicant file a copy of the oath or declaration originally filed to complete (37 C.F.R. § 1.51) the prior application or a copy of the oath/declaration filed pursuant to 37 C.F.R. § 1.48(a)(2) to add the inventor?

Answer: The continuation or divisional application should be filed with the oath or declaration filed pursuant to 37 C.F.R. § 1.48(a)(2) to add the inventor, regardless of whether the petition under 37 C.F.R. § 1.48(a) was acted on in the prior application.

(Q10) A continuing application is filed under 37 C.F.R. § 1.53(b). The application papers include a copy of the originally signed declaration listing two inventors from the prior nonprovisional application and a transmittal sheet listing one additional inventor over the prior nonprovisional application. A petition for correction of inventorship under 37 C.F.R. § 1.48 to add the additional inventor was filed in the prior nonprovisional application, but was not yet granted. Is the continuing application complete and will the petition, which was not acted upon, now be treated in the new 37 C.F.R. § 1.53(b) application?

Answer: The continuing application is complete. The inventive entity of the continuing application is set by the copy of the declaration submitted on filing. That is, the names of all the inventors for the application are taken from the copy of the executed declaration. If the one additional inventor listed on the transmittal sheet is an inventor in the continuing application, then a petition for correction of inventorship under 37 C.F.R. § 1.48 must be filed in the continuing application. The petition for correction of inventorship filed in the prior nonprovisional application will *not* be treated in the continuing application since the present filing is a new application and the petition was directed to a different application, one containing a different application number.

To avoid this problem, the continuing application should have been submitted with either a newly executed declaration in compliance with 37 C.F.R. § 1.63, naming as inventors all the inventors named in the prior application and the additional inventor named on the transmittal sheet, or a copy of the declaration submitted with the petition under 37 C.F.R. § 1.48 in the prior application, regardless of whether the petition under § 1.48 was decided in the prior application. (This assumes that the declaration submitted with the petition under 37 C.F.R. § 1.48 names as inventors all the inventors that are/should be named in the continuing application. See also Question Q9)

(Q11) When a copy of an oath or declaration from a prior application is filed in a continuation or division under 37 C.F.R. § 1.53(b), how can the applicant ensure that the copy is matched with the correct application file?

Answer: In addition to a cover letter explaining that the copy of the oath or declaration is for the attached application or for a previously-filed § 1.53(b) application (identified by application number which consists of a two-digit series code and a six-digit serial number--e.g., 08/123,456), an adhesive label may be attached to the front of the copy of the oath or declaration. The label should clearly state that the copy of the oath or declaration is intended for the attached application submitted therewith or for Application No. XX/YYY,YYY. During initial processing, attachments (*e.g.*, a cover letter) to application papers may be separated. Therefore, applicant should not rely solely upon a cover letter. Note: 37 C.F.R. § 1.5(a) states that no correspondence relating to an application should be filed prior to receipt of the application number information from the PTO.

B. Treatment of Applications Filed under Former 37 C.F.R. §§ 1.60 and 1.62 (Now Deleted)

(Q12) How does an applicant file an application that would have been filed under former 37 C.F.R. § 1.60 (Rule 60)?

Answer: File the application papers that would have been a proper filing under 37 C.F.R. § 1.60, with a reference to 37 C.F.R. § 1.53(b) instead of a reference to 37 C.F.R. § 1.60. Any submission of an application including or relying on a copy of an oath or declaration that would have been proper under 37 C.F.R. § 1.60 will be a proper filing under 37 C.F.R. § 1.53(b).

(Q13) How will the PTO process an application that is designated as an application filed under 37 C.F.R. § 1.60 (Rule 60)?

Answer: The PTO will ignore the reference to 37 C.F.R. § 1.60 and the application will be accepted as an application under 37 C.F.R. § 1.53(b) (with a copy of the specification and the oath/declaration under 37 C.F.R. § 1.63(d) of the prior application).

(Q14) Has the safeguard in former 37 C.F.R. § 1.60(b) concerning the filing of an application lacking all of the pages of specification or sheets of drawings of the prior application been retained in 37 C.F.R. § 1.53(b)?

Answer: No. Unlike former 37 C.F.R. § 1.60, the specification and drawings of a continuation or divisional application filed under 37 C.F.R. § 1.53(b) are not limited to a reproduction or "true copy" of the prior application, *i.e.*, the applicant may revise the specification for clarity or contextual purposes *vIs-à-vis* the specification originally filed in the prior application in the manner that an applicant may file a substitute specification (see 37 C.F.R. § 1.125) or amend the drawings of an application so long as it does not result in the introduction of new matter.

Nevertheless, an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. In order to simplify the incorporation by reference of a prior application, the PTO has substantially revised the various standard forms including the Utility, Design or Plant Patent Application transmittal form. If the standard Utility, Design or Plant Patent Application transmittal form is used, applicant may easily incorporate by reference the prior application by checking a box and supplying the necessary information.

(Q15) (revised) How does an applicant file a file wrapper continuation (FWC) application that would have been filed under 37 C.F.R. § 1.62 (Rule 62)?

Original Answer: ~~While it is no longer possible to file a file wrapper continuation (FWC) as 37 C.F.R. § 1.62 has been eliminated, an application may be filed under 37 C.F.R. § 1.53(d) as a continued prosecution application (CPA), provided that the following two conditions are met: (1) the prior (just the immediate prior) application was filed on or after June 8, 1995; and (2) the application is a continuation or divisional (not a continuation-in-part). (Note: In a chain of CPAs, the parent of the first CPA must obviously be filed on or after June 8, 1995.) If these conditions are met, the application may be filed as a CPA under 37 C.F.R. § 1.53(d). If these conditions are not met, the application must be filed with a new specification/drawings/claims under 37 C.F.R. § 1.53(b).~~

Revised Answer: While it is no longer possible to file an FWC as 37 C.F.R. § 1.62 has

been eliminated, an application may be filed under 37 C.F.R. § 1.53(d) as a continued prosecution application (CPA) provided that the application is a continuation or divisional (not a continuation-in-part (CIP)). If a CIP is to be filed, the application must be filed with a new specification/drawings/claims under 37 C.F.R. § 1.53(b).

(Q16) (revised) How will the PTO process a request for a file wrapper continuing (FWC) application filed under 37 C.F.R. § 1.62 (Rule 62)?

Original Answer: ~~If the application meets the two conditions for a CPA under 37 C.F.R. § 1.53(d) stated above [in Q15], the application will automatically be treated as a CPA. If it does not, the application will be treated as an improper application, in which case the applicant will be notified and given an opportunity to file a petition under 37 C.F.R. § 1.53(e) to have the application converted to an application under 37 C.F.R. § 1.53(b).~~

Revised Answer: If the request is for a continuation or divisional, it will be treated as a request for a CPA and accepted. If the request for a FWC indicates that a continuation-in-part (CIP) is being filed, and a preliminary amendment accompanies the request, applicant will be notified that it is an improper application filing and given an opportunity to file a petition under 37 C.F.R. § 1.53(e) to have the application converted to an application under 37 C.F.R. § 1.53(b) without loss of the original filing date.

C. Application Filing Changes (In General) - 37 C.F.R. § 1.53

(Q17) What rule/section must an applicant cite when filing an application, and how will application papers be treated if they do not cite any section?

Answer: A national application may be filed under 35 U.S.C. § 111 or may result from the entry of an international (PCT) application into the national stage after compliance with 35 U.S.C. § 371.

37 C.F.R. § 1.494 and 1.495 provide for entry of an inter national application into the national stage after compliance with 35 U.S.C. § 371. Application papers filed for an international (PCT) application to enter the national stage under 35 U.S.C. § 371 must be clearly identified as such (as papers filed under 35 U.S.C. § 371, 37 C.F.R. § 1.494, or 1.495) or they will be treated as an application under 35 U.S.C. § 111.

37 C.F.R. § 1.53 is the section under which all applications filed under 35 U.S.C. § 111 are now filed.

37 C.F.R. § 1.53(c) is the section under which a *provisional application* filed under 35 U.S.C. § 111(b) is now filed. Unless an application contains a reference to 37 C.F.R. § 1.53(c) or is designated as a provisional application, the application will be treated as an application under 37 C.F.R. § 1.53(b).

37 C.F.R. § 1.53(d) is the section under which a *continued prosecution application* (CPA) is filed. Unless an application (a request) contains a reference to 37 C.F.R. § 1.53(d) or is designated as a continued prosecution application (CPA), the application will be treated as an application under 37 C.F.R. § 1.53(b).

37 C.F.R. § 1.53(b) is the section under which all applications are filed EXCEPT: (1) the result of entry of an international application into the national stage under

35 U.S.C. § 371 and 37 C.F.R. § 1.494 or 1.495; (2) a provisional application under 35 U.S.C. § 111(b) and 37 C.F.R. § 1.53(c); or (3) a continued prosecution application (CPA) under 37 C.F.R. § 1.53(d). Applications under 37 C.F.R. § 1.53(b), as well as continued prosecution applications (CPAs) under 37 C.F.R. § 1.53(d), are applications filed under 35 U.S.C. § 111(a).

37 C.F.R. § 1.53(b) is the "default" application, in that applications that are not (1) the result of the entry of an international application into the national stage after compliance with 35 U.S.C. § 371 and 37 C.F.R. § 1.494 or 1.495, (2) provisional applications under 37 C.F.R. § 1.53(c), or (3) continued prosecution applications (CPAs) under 37 C.F.R. § 1.53(d), are applications under 37 C.F.R. § 1.53(b). Alternatively, application papers that are not designated as: (1) the national stage of an international application (35 U.S.C. § 371, 37 C.F.R. § 1.494, or 37 C.F.R. § 1.495), (2) a provisional application (37 C.F.R. § 1.53(c)), or (3) a continued prosecution application (37 C.F.R. § 1.53(d)), will be treated as an application under 37 C.F.R. § 1.53(b).

(Q18) Must a statement seeking to establish small entity status under 37 C.F.R. § 1.27(a) be verified?

Answer: No. 37 C.F.R. § 1.4(d)(2) has been amended to provide that the presentation to the Office of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under 37 C.F.R. § 10.18(b) and that violations of 37 C.F.R. § 10.18(b)(2) may subject the party to sanctions under 37 C.F.R. § 10.18(c). (See "Continued Prosecution Applications" Section for more questions regarding small entity status.)

(Q19) In order to rely on a small entity status statement in a prior application or patent, what must an applicant do?

Answer: Applicant may rely on a statement filed in the prior application or in the patent to be reissued if:

(1) (a) the nonprovisional application or reissue application includes a reference to the statement filed in the prior application or patent to be reissued (payment of the small entity basic statutory filing fee will be treated as such a reference); ***or***
(b) the nonprovisional application or reissue application includes a copy of the statement filed in the prior application or in the patent to be reissued; ***and***

(2) status as a small entity is still proper and desired. 37 C.F.R. § 1.28(a)(2).

(See "Continued Prosecution Applications" Section for more questions regarding small entity status.)

(Q20) If small entity status was claimed in good faith, but it is later discovered that such status was established in error, will the Office require an explanation how the error in good faith occurred and how and when the error was discovered?

Answer: No. 37 C.F.R. § 1.28(c) merely requires the payment of the deficiency between the fees actually due and the fees paid under small entity status. (See "Continued Prosecution Applications" Section for more questions regarding small entity status.)

(Q21) A new continuation or division application is filed under 37 C.F.R. § 1.53(b). The application papers contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 C.F.R. § 1.47 status in the prior application. Should the Office of Initial Patent Examination (OIPE) forward the newly-filed application to the Office of Petitions?

Answer: Yes. The application should be given a Rule 47 designation on the file jacket and be forwarded to the Office of Petitions before being sent to the Patent Examining groups. The Office of Petitions will inform the non-signing inventor of the filing of the continuation or division and will publish an announcement in the *Official Gazette*.

See also Q149-152

D. Continued Prosecution Applications (CPAs) - 37 C.F.R. § 1.53(d)

1. Basic Concepts

(Q22) Can a continued prosecution application (CPA) under 37 C.F.R. § 1.53(d) be filed based on a prior provisional application?

Answer: No. A CPA can only be filed based on a prior nonprovisional application.

(Q23) Is a proper CPA a complete application under 37 C.F.R. § 1.51(b)?

Answer: Yes. 37 C.F.R. § 1.53(d)(2)(iv) provides that, in addition to the CPA request, the CPA also includes the file jacket and contents of a prior nonprovisional application. If the CPA is proper, the prior nonprovisional application must have been complete under 37 C.F.R. § 1.51(b). Thus, assuming the filing fee is paid in the CPA, the CPA would also include all of the parts required by 37 C.F.R. § 1.51(b) for a complete nonprovisional application.

(Q24) (revised) Can a CPA be filed based on a prior CPA?

Original Answer: ~~Yes. A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 C.F.R. § 1.51(b). Of course, the most recent application in the chain of copending applications which is not a CPA must have been filed on or after June 8, 1995.~~

Revised Answer: Yes. A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 C.F.R. § 1.51(b).

(Q25) Is there any limit to the number of CPA requests that can be filed based on the same prior application?

Answer: No. There is no limit to the number of CPA requests that may be filed in a chain of continuation or divisional applications. Of course, only one CPA may be pending at one time based on the same prior application.

(Q26) Can an applicant file a continuation and a divisional CPA based on the same prior nonprovisional application on the same day?

Answer: No. A CPA uses the file jacket and contents of a prior application to constitute the new CPA papers. Since the file jacket and contents of the prior application may only be used for one CPA at a time, only one of several CPAs filed on the same day may be considered properly filed. Thus, if the examining group receives more than one CPA on the same day based on the same prior application, only one of the requests for a CPA should be assigned a paper number and entered into PALM. If the PTO recognizes (at the time of processing) that a continuation and a divisional CPA are filed on the same day, the continuation should be processed for further examination while the divisional will be treated as improper. The request for a divisional CPA will be placed in the file, but will not be entered. The examiner should notify applicant in the next Office action that only one CPA may be filed on the same day based on the same prior application and that the divisional is improper.

(Q27) How can applicant have the subject matter contained in the improperly deposited divisional CPA examined?

Answer: Applicant can file a new divisional application under 37 C.F.R. § 1.53(b) based upon the newly filed continuation CPA. It is noted that the new divisional application would retain the same effective filing date.

(Q28) (revised) What is the patent term of a patent issuing from a CPA?

Original Answer: ~~The patent term for a CPA is no different than the patent term for any other nonprovisional application which matures into a patent claiming the benefit of the filing date(s) of earlier-filed nonprovisional application(s) under 35 U.S.C. § 120, 121 or 365(c). That is, the patent term would start on the date the patent issues and would expire 20 years from the earliest effective U.S. filing date of the nonprovisional application to which there is a specific reference under 35 U.S.C. § 120, 121 or 365(c).~~

Revised Answer: The patent term for a CPA is no different than the patent term for any other nonprovisional application. For a nonprovisional application which is not a reissue or a design application, the patent term would start on the date the patent issues and would expire 20 years from the earliest effective U.S. filing date of the nonprovisional application to which there is a specific reference under 35 U.S.C. § 120, 121 or 365(c). (Note that the 20-year term applies even for a patent, except a reissue or a design patent, issuing from a CPA of a prior application filed before June 8, 1995. See Supplemental Question and Answer No. Q153 below.) On the other hand, the term of a design patent is defined in 35 U.S.C. § 173 as fourteen (14) years from the date of grant, and the term of a reissue patent is defined in 35 U.S.C. § 251 as the unexpired part of the term of the original patent.

(Q29) Can a CPA be filed based on a prior design application?

Answer: Yes. Of course, the CPA would also be a design application. (See "Design Practice" Section below for more questions relating to design applications.)

(Q30) Can a design application claiming status as a divisional of a prior utility application be filed as a CPA based on the prior utility application by including a preliminary amendment with the CPA canceling the original specification and substituting a design specification?

Answer: No. A CPA based on a prior utility application results in the filing of another utility application. Therefore, any design application claiming status as a divisional of a prior utility application must be filed under 37 C.F.R. § 1.53(b). (See "Design Practice" Section below for more questions relating to design applications.)

(Q31) (revised) Can a CPA be filed based on a prior reissue application?

~~***Original Answer***: Yes. A reissue application is a nonprovisional application. Therefore, a CPA can be filed based on a prior reissue application so long as the prior reissue application was complete as defined in 37 C.F.R. § 1.51(b) and filed on or after June 8, 1995. Of course, the CPA would also be a reissue application subject to the conditions of 35 U.S.C. § 251. (See "Reissue Practice" Section below for more questions relating to reissue applications.)~~

Revised Answer: Yes. A reissue application is a nonprovisional application. Therefore, a CPA can be filed based on a prior reissue application so long as the prior reissue application was complete as defined in 37 C.F.R. § 1.51(b). Of course, the CPA would also be a reissue application subject to the conditions of 35 U.S.C. § 251. (See "Reissue Practice" Section in the original Questions and Answers as well as in the first supplement for more questions relating to reissue applications.)

Original Question and Answer Q32, which is reproduced below, has been deleted.

~~(Q32) Why must an application be filed on or after June 8, 1995 for the applicant to file a CPA of such application to obtain continued prosecution?~~

~~*Answer*: As the CPA practice was not in effect prior to June 8, 1995, no patent issuing from a CPA is entitled to the provisions of 35 U.S.C. § 154(c) (i.e., is entitled to a patent term no less than seventeen years from the issue date of the patent). Nevertheless, the application number of a CPA will be the application number of the prior application, and the filing date indicated on any patent issuing from a CPA will be the filing date of the prior application (or, in a chain of CPAs, the filing date of the application immediately preceding the first CPA in the chain). As such, any patent issuing from a CPA, if the prior application was filed prior to June 8, 1995, would indicate that the filing date of the application for that patent was prior to June 8, 1995. Thus, permitting CPA practice to be applicable in instances in which the prior application was filed prior to June 8, 1995 would confuse the public (and possibly the patentee) into believing that such patent is entitled to the provisions of 35 U.S.C. § 154(c), and for that reason it has not been permitted.~~

(Q33) Can a CPA be based on (**a**) an application in the national stage filed under 35 U.S.C. § 371; and (**b**) an international application designating the United States under 35 U.S.C. § 365(c)?

Answer: (**a**) Yes. 37 C.F.R. § 1.53(d)(1)(i)(B) expressly provides that the prior application of a CPA may be an application in the national stage in compliance with 35 U.S.C. § 371. (**b**) No. 37 C.F.R. § (d)(1)(i) does not provide for the filing of a CPA based on an international application designating the United States under 35 U.S.C. § 365(c). For example, a CPA cannot be based directly on a German patent application. However, the CPA may be based on a prior U.S. application which in turn claims benefit of priority from the German patent application in compliance with 35 U.S.C. § 365(c).

(Q34) If a CPA request is filed without being signed, do I lose my filing date?

Answer: No. The CPA will be accorded a filing date with the unsigned request being placed in the file of the prior nonprovisional application. However, since the request for a CPA is a request to expressly abandon the prior nonprovisional application, the request must be signed. A notice will be mailed setting a one (1) month extendible time period to file a signed duplicate or a ratification of the previously submitted, but unsigned, CPA request.

(Q35) What amendment should be made to the first line of the specification in a CPA to claim the benefit of the prior application?

Answer: None. 37 C.F.R. § 1.53(d)(7) provides, in part, that "[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." Thus, an applicant must *not* amend the specification to provide a specific reference to the prior application or, in a chain of CPA applications, every (prior) CPA assigned the application number identified in the request for CPA (*i.e.*, the non-CPA that is the prior application as to the first CPA in the chain and every CPA in the chain). Any such amendment will be ignored and will not be entered. If, however, the non-CPA that is the prior application as to the first CPA in the chain, in turn, claims the benefit of a prior application or applications under 35 U.S.C. §§ 120, 121, or 365(c) and it does not include a reference back to the prior application(s) in the first sentence of the specification, then an amendment to the first line of the specification will be required.

(Q36) Can a CPA be filed in an application that has been allowed or in which no Office action has been mailed?

Answer: Yes. A CPA may be filed in an application that has been allowed or in which no Office action has been mailed so long as the CPA is filed before the earliest of:
(1) payment of the issue fee on the prior application, unless a petition under § 1.313(b)(5) is granted in the prior application;
(2) abandonment of the prior application; or
(3) termination of proceedings in the prior application.

See also Q153-154

2. Carry-Over Situations

(Q37) Does a terminal disclaimer filed to overcome a double patenting rejection *in the parent application* carry over to a CPA?

> *Answer*: Yes. A terminal disclaimer filed in the parent application to overcome a double patenting rejection carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the *same application number* as the parent application, *i.e.*, the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 C.F.R. § 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA. See MPEP 1490, "Withdrawing a Terminal Disclaimer," subheading entitled A1. Before Issuance of Patent."

(Q38) Does an election made in a prior application carry over to a CPA?

> *Answer*: An election in the prior application carries over to the CPA only if all of the following conditions are met:
> (1) the CPA is designated as a continuation or is not designated at all (*i.e.*, the CPA is *NOT* designated as a divisional);
> (2) there was an express election by the applicant in reply to a restriction requirement in the prior application;
> (3) the CPA presents claim(s) drawn only to invention(s) claimed in the prior application; *and*
> (4) the CPA does not contain an indication that a shift in election is desired. The examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application.

(Q39) What are all the types of papers that automatically carry over from a prior nonprovisional application to a CPA?

> *Answer:* The following types of papers automatically carry over and do not have to be re-filed in order to be effective in a CPA: affidavits/declarations, such as those filed under 37 C.F.R. §§ 1.130, 1.131 and 1.132; information disclosure statements; terminal disclaimers (see Question Q37); petitions under 37 C.F.R. § 1.48 filed, but not acted upon, in the prior application; priority claims based on prior U.S. and foreign applications; submissions establishing ownership under 37 C.F.R. § 3.73(b), provided that ownership has not changed; and general authorizations to charge fees to a deposit account. In addition, an election made in a prior application carries over to the CPA under the circumstances set forth in the answer to Question Q38.

(Q40) Can claims to an invention previously disclosed in the prior application, but unclaimed, (a) be filed with a request for a CPA and (b) be entitled to examination?

Answer: (a) Yes. (b) Yes. The provisions of 37 C.F.R. § 1.145 do not apply to claims added by an amendment filed prior to the first Office action in a CPA, because a CPA is considered a new application. Of course, the examiner may impose a restriction requirement or an election of species requirement in the CPA under the same conditions as any other new application.

(Q41) Must a CPA request designate the CPA as either a continuation or a divisional?

Answer: No. The rules do not require an applicant to designate a CPA, at the time of filing, as either a continuation or a divisional. However, the Office will presume that the CPA is a continuation in the absence of such a designation. Where a CPA is a continuation, not a divisional, the election made in the prior application carries over to the CPA under the circumstances set forth in the answer to Question Q38.

(Q42) Under what circumstances may the first action following the filing of a CPA be made final?

Answer: The claims of a CPA may be finally rejected in the first Office action in those situations where all claims of the CPA (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. However, it would not be proper to make final a first Office action in a continuing application, including a CPA, where the continuing application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because: (1) new issues were raised that required further consideration and/or search; and/or (2) the issue of new matter was raised. Thus, if the CPA is accompanied by or requests entry of an amendment initially denied entry in the prior application because (1) new issues were raised that required further consideration and/or search and/or (2) the issue of new matter was raised, then the first action following the filing of the CPA will not be made final. If the amendment after final rejection was not denied entry *via* an advisory action, then the examiner's next action following the filing of the CPA may be made final under MPEP 706.07(b).

(See "Small Entity Status" Subsection for questions relating to the carry-over of small entity status in a CPA.)

3. Faxing and Mailing

(Q43) Can a CPA be filed by facsimile?

Answer: Yes. 37 C.F.R. § 1.6 has been amended to permit the acceptance of CPAs by facsimile. This will permit an applicant to file a CPA by facsimile directly to the examining group to which the prior application was assigned. Applicants, however, are cautioned that the provisions of 37 C.F.R. § 1.8 do not apply to the filing of a CPA, so that the filing

date of the CPA will be the date the facsimile submission was completely received in the Office and not the date it was transmitted.

(Q44) Should a CPA be faxed to the Office of Initial Patent Examination (OIPE)?

Answer: No. A CPA will not be processed by OIPE. Therefore, a CPA should be faxed directly to the examining group or art unit to which the prior nonprovisional application is assigned.

(Q45) Is there any procedure in the rules for establishing receipt by the PTO of a CPA filed by facsimile transmission where the PTO has no evidence of receipt of the CPA?

Answer: Yes. 37 C.F.R. § 1.6(f) provides for the situation in which the PTO has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. Section 1.6(f) requires that a showing thereunder include, *inter alia*, a copy of the sending unit's report confirming transmission of the CPA or evidence that came into being after the complete transmission of the CPA and within one business day of the complete transmission of the CPA. Therefore, applicants are advised to retain copies of the sending unit's reports in situations in which such unit is used to transmit a CPA to the Office or otherwise maintain a log book of the transmission of any CPA to the PTO.

(Q46) Do the provisions of 37 C.F.R. § 1.8 apply to a CPA?

Answer: No. A CPA is not correspondence that must be filed in the prior application within a set period of time, but a "new" application that claims the benefit under 35 U.S.C. § 120 and 37 C.F.R. § 1.78 of the prior application. 35 U.S.C. § 120 requires that an application, *inter alia*, be "filed before the patenting or abandonment of or termination of proceedings on the first application." Unlike 37 C.F.R. § 1.10, correspondence filed pursuant to 37 C.F.R. § 1.8 is not accorded a filing date as of its date of deposit with the United States Postal Service (USPS), but is simply considered timely if deposited with the USPS prior to the expiration of the time period for filing such correspondence. Thus, 37 C.F.R. § 1.8, by its terms, does not apply to a CPA. Applicants filing a CPA by facsimile transmission are cautioned that the filing date of a CPA is the date the complete transmission of the CPA *is received in the PTO and not necessarily the date it was transmitted.*

(Q47) Can a CPA mailed by first class mail obtain the benefits of the certificate of mailing practice under 37 C.F.R. § 1.8?

Answer: No. The filing of a request for a CPA is a paper filed for the purpose of obtaining an application filing date and is specifically excluded from the benefits of the rule by 37 C.F.R. § 1.8(a)(2)(i)(A).

(Q48) The PTO mails a final Office action on July 2, 1997 (Wednesday). Applicant submits a petition for three-month extension of time (and the fee) and a CPA request via USPS first class mail under 37 C.F.R. § 1.8 on January 2, 1998 (Friday). However, the PTO does not receive the

petition and the CPA request until January 5, 1998 (Monday). Is the CPA proper?

Answer: No. The petition and the CPA request were not filed until January 5, 1998, which is after the abandonment (midnight on Friday, January 2, 1998) of the prior application. Therefore, the requisite copendency (§ 1.53(d)(1)(ii)(B)) has been lost. Under 37 C.F.R. § 1.8(a)(2)(i)(A), a CPA request is specifically excluded from the benefits of a certificate of mailing under § 1.8.

(Q49) The PTO mails a final Office action on July 2, 1997 (Wednesday). Applicant submits a petition for three-month extension of time (and the fee) and a CPA request via facsimile transmission under 37 C.F.R. § 1.8 at 9:00 PM (PST) on January 2, 1998 (Friday). However, the PTO does not receive the facsimile transmission until 12:01 AM (EST) on January 3, 1998 (Saturday). Is the CPA proper?

Answer: No. The CPA request was not filed until January 5, 1998 (Monday), which is after the abandonment (midnight on Friday, January 2, 1998) of the prior application, because the complete facsimile transmission was not received until January 3, 1998 (Saturday). Under 37 C.F.R. § 1.6(a)(3), correspondence transmitted by facsimile will be stamped with the date on which the complete transmission is received in the Office, unless that date is a Saturday, Sunday, or a 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 a Federal holiday. Therefore, the requisite copendency (§ 1.53(d)(1)(ii)(B)) has been lost. Under 37 C.F.R. § 1.8(a)(2)(i)(A), a CPA request is specifically excluded from the benefits of a certificate of facsimile transmission under § 1.8.

(Q50) Will a CPA mailed by Express Mail under 37 C.F.R. § 1.10 be accorded a filing date as of the date of deposit in Express Mail service?

Answer: Yes. Any patent application, including a CPA, can be filed by Express Mail service under 37 C.F.R. § 1.10. As with any other paper filed by Express Mail service, the Express Mail label number should be placed on the request for a CPA prior to deposit in Express Mail service.

4. Small Entity Status

(Q51) If status as a small entity was properly established in the prior application, is it necessary for applicant to determine his/her entitlement to small entity status at the time a CPA is filed?

Answer: Yes. The filing of a CPA requires a new determination of applicant' s entitlement to small entity status.

(Q52) Does small entity status automatically carry over from the prior application to the CPA?

Answer: No. Status as a small entity must be specifically established in every application in which the status is available and desired. However, in any continuing application, including a CPA, status as a small entity may be established simply by paying the basic

filing fee in the small entity amount. If payment of the basic filing fee in the small entity amount is made, it would not be necessary to file a new statement or a copy of the prior statement. 37 C.F.R. § 1.28(a)(2).

(Q53) If status as a small entity was established in the prior application and a CPA is filed with a general authorization to charge fees to a deposit account, but without indicating that the filing fee is to be charged in the small entity amount, should the filing fee be charged in the large or small entity amount?

Answer: The large entity filing fee should be charged, because small entity status does *not* automatically carry over from the prior application to the CPA.

(See "Application Filing Changes (In General)" Section for more questions regarding small entity status, and "Carry-Over Situations" Subsection for additional questions relating to carry-over situations from a prior application.)

5. Fee Issues

(Q54) Can a CPA be filed without the basic filing fee?

Answer: Yes. If a CPA is filed without the basic filing fee, the appropriate examining group will mail a "Notice to File Missing Parts of Application" setting a time period for paying the basic filing fee and the surcharge set forth in 37 C.F.R. § 1.16(e). Of course, a CPA is not a complete application under 37 C.F.R. § 1.51(b) until the filing fee required under 37 C.F.R. § 1.16 is paid. See also Question Q57.

(Q55) If the prior application contains a general authorization to charge fees to a deposit account, is it still possible to file a CPA without paying the filing fee?

Answer: Yes. Where the applicant desires to file a CPA without paying the filing fee on the filing date of the application, applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application.

(Q56) Should copendency be checked before a deposit account is charged or a check is cashed for the filing fee in a CPA?

Answer: No. It is not necessary to check for continuity before the filing fee is charged to a deposit account or a check for the filing fee is cashed. If continuity is later found to be lacking, the applicant may be able to establish continuity by way of a petition to revive. Under certain circumstances where continuity cannot be established by way of a petition to revive, the application may be accorded a filing date by way of a petition under 37 C.F.R. § 1.53(e) to convert the application to a 37 C.F.R. § 1.53(b) application. If a filing date is never accorded the application, the filing fee which was paid may be refunded, less the $130.00 handling fee set forth in 37 C.F.R. § 1.21(n).

(Q57) Can an examiner's action on the merits be issued or an interview be conducted in a CPA

prior to the payment of the filing fee and any surcharge required by 37 C.F.R. § 1.16(e)?

Answer: No. A CPA will not be placed upon the files for examination until all of its required parts, including the filing fee and surcharge, are received. See 37 C.F.R. § 1.53(h). Instead, where a CPA is filed without the appropriate filing fee, a notice should be mailed by the examining group setting a time period within which the filing fee and surcharge must be filed in order to avoid abandonment of the CPA. Thus, it would be inappropriate to conduct an interview or to issue an action on the merits in the CPA until the notice is mailed and a proper reply filed.

(Q58) Does the prior application of a CPA become abandoned even if the requisite filing fee is not included at the time the CPA request is filed?

Answer: Yes. Payment of the filing fee is irrelevant to the abandonment of the prior application by operation of the filing of a CPA under 37 C.F.R. § 1.53(d).

6. Amendments/Replies in Prior Application

(Q59) Is a CPA request a reply to a final rejection?.

Answer: Under statute and regulation, the filing of a CPA operates to automatically abandon the prior application in favor of the CPA. Thus, a CPA is, strictly speaking, not a reply under 37 C.F.R. § 1.113 to a final rejection, as the filing a CPA will not avoid abandonment of the prior application. An applicant, however, may *effectively* reply to a final rejection and continue prosecution of an application under final rejection by filing a CPA within the time period for reply to the final rejection. That is, the examination of the CPA will begin at the close of prosecution in the prior application (with any amendment directed to be entered by the applicant).

(Q60) Can a CPA be filed in reply to a Notice to File Missing Parts of Application?

Answer: No. 37 C.F.R. § 1.53(d) requires that the prior application of a CPA be complete under 37 C.F.R. § 1.51(b) or be the national stage of a PCT international application in compliance with 35 U.S.C. § 371. Thus, the prior application of a CPA must have included an oath or declaration under 37 C.F.R. § 1.63 and either the basic filing fee or the national fee (for a PCT application). If either an oath or declaration or basic filing fee (or national fee) was required by the Notice to File Missing Parts of Application, they must be filed in the prior application to permit the filing of a CPA of such prior application. If, however, the oath or declaration and basic filing fee (or national fee) was filed in the application (*e.g.*, the Notice to File Missing Parts of Application only required additional claims fees), then applicant may abandoned the application in favor of a CPA.

(Q61) What happens when a CPA is filed with a new specification?

Answer: The new specification will be treated as a substitute specification under 37 C.F.R. § 1.125. However, the applicant must comply with the requirements of 37 C.F.R.

§ 1.125(b) before the substitute specification will be entered into the CPA. (See "Manner of Making Amendments" Section below for additional questions on 37 C.F.R. § 1.125.)

(Q62) May an applicant file an amendment after final with a "conditional" request for a CPA under 37 C.F.R. § 1.53(d) to be effective if the amendment after final is not entered?

Answer: No. Any "conditional" request for a CPA filed as a *separate paper* with an amendment after final in an application will be treated as an unconditional request for a CPA of such application. This will result (by operation of 37 C.F.R. § 1.53(d)(2)(iii)) in the abandonment of such (prior) application, and (if so instructed in the request for a CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. As 37 C.F.R. § 1.53(d) requires that a request for a CPA be on a separate paper, *any request for CPA (whether conditional or not) within an amendment after final for the prior application is an improper request for a continued prosecution application* under 37 C.F.R. § 1.53(d) and will be ignored.

(Q63) An applicant files a single paper (*e.g.*, a transmittal letter) requesting a CPA and includes a request to charge extension of time fees in the prior application. Does this practice violate the "separate paper" requirement of 37 C.F.R. § 1.53(d)(2)?

Answer: No. The CPA is not improper simply because it is combined with a petition for extension of time. The "separate paper" requirement of 37 C.F.R. § 1.53(d)(2) is intended to preclude an applicant from burying a request for a CPA in a paper submitted primarily for another purpose, *e.g.*, within an amendment after final for the prior application.

(Q64) Will an amendment after final filed and refused entry in the prior application automatically be entered in the CPA?

Answer: No. Applicant must file a specific instruction to enter amendment(s) refused entry in the prior application.

(Q65) An after-final amendment under 37 C.F.R. § 1.116 has been filed in an application. Two days later, the applicant decides to file a CPA request. Must the examiner act on the after-final amendment?

Answer: Yes. The examiner must act on the after-final amendment unless the CPA papers have been matched with and entered into the file of the prior application. However, once the CPA is entered, the amendment to the prior application would become moot. If entry of an after-final amendment (not indicated as entered) is desired in a CPA, applicant must include an instruction to enter the after-final amendment in the CPA papers.

(Q66) Is a CPA entitled to a filing date if the issue fee was paid in the prior application after the CPA was filed and the patent issues before the express abandonment under 37 C.F.R. § 1.53(d)(2) is recognized?

Answer: No. While the date of abandonment of the prior application is the filing date of

the CPA under 37 C.F.R. § 1.53(d)(2), the express abandonment of the prior application does not become *effective* until the abandonment is *actually* recognized. Once a patent issues on the prior application, the prior application cannot be expressly abandoned and the PTO cannot recognize the express abandonment, even if the date of abandonment of the prior application would have been prior to the patent issue date. Thus, the request for a CPA is considered improper. The examining group will order a new file jacket (having a new application number) for the CPA paper and notify the applicant of the improper status of the attempted CPA. Applicant must file a petition under 37 C.F.R. § 1.53(e) to convert the attempted CPA to an application under 37 C.F.R. § 1.53(b). Otherwise, the proceedings on the attempted CPA will be terminated.

7. Inventorship Issues

(Q67) In a CPA, how do I delete an inventor that was named in the prior nonprovisional application?

Answer: A statement must accompany the CPA request, at the time of filing, requesting deletion of the name(s) of the person(s) who are not inventors of the invention being claimed in the new application. 37 C.F.R. § 1.53(d)(4).

(Q68) What are the consequences if a CPA request names an inventive entity which is different from the inventive entity in the prior nonprovisional application?

Answer: The inventive entity set forth in the prior nonprovisional application carries over into the CPA *UNLESS* the CPA request names as inventors less than all the inventors named in the prior application and includes on filing the statement required by 37 C.F.R. § 1.53(d)(4). However, the inventive entity in a CPA may be corrected by filing an appropriate petition under 37 C.F.R. § 1.48(a).

(Q69) What happens if the CPA papers include a new oath or declaration naming an inventor not named in the prior application?

Answer: The inventive entity of the CPA will be the same as the inventive entity of the prior application. However, the new oath or declaration will be placed in the application file. Upon review of the application, the examiner will notify the applicant in the first Office action that the inventive entity of the prior application has been carried over into the CPA. If the inventive entity set forth in the new oath or declaration is desired, then a petition under 37 C.F.R. § 1.48 must be filed. No new oath or declaration need be filed with the later-filed petition under 37 C.F.R. § 1.48, since such was submitted on filing.

It should be noted that the filing in a CPA of a new oath or declaration containing an inventive entity different from that set forth in the prior nonprovisional application may result in the claims in the CPA being rejected under 35 U.S.C. § 102(f).

(Q70) A CPA is filed where the transmittal page lists one additional inventor not named in the prior nonprovisional application. A petition for correction of inventorship under 37 C.F.R. § 1.48 was filed in the prior nonprovisional application but was not yet granted. Is the CPA a

proper application and will the petition, which was not acted upon, now be treated in the CPA application?

Answer: Yes, the CPA is a proper application and the petition for correction of inventorship under 37 C.F.R. § 1.48 filed in the prior nonprovisional application will be treated in the CPA. However, until the petition is granted, the CPA will be treated as naming, as inventors, the same inventors named in the prior nonprovisional application. [It should be noted that both the petition and the CPA refer to the same application number. Further, the declaration filed with the petition naming the "Correct" inventorship executes the specification of both the prior nonprovisional and the CPA application (the CPA utilizes the specification from the prior nonprovisional application).]

(Q71) A divisional CPA is based on a prior application which was filed with inventors **A** and **B**. During the prosecution of the prior application, claims drawn to **B**'s contribution were canceled, and consequently **B** was deleted as a named inventor *via* a petition under 37 C.F.R. § 1.48. The divisional CPA is filed with (1) a preliminary amendment canceling claims drawn to **A**'s contribution while adding claims drawn to **B**'s contribution and (2) a request for the deletion of **A** as inventor and the naming of **B** as the sole inventor. Is this a proper CPA?

Answer: Yes. The CPA is considered proper and entitled to a filing date, but with **A** as the sole inventor. Under 37 C.F.R. § 1.53(d), a CPA names, as inventors, the same inventors named in the prior application on the date the CPA was filed, except where the CPA is filed with 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 CPA. *No person may be named as an inventor in a CPA who was not named as an inventor in the prior application on the date the CPA was filed, except by way of a petition under 37 C.F.R. § 1.48.* Since **A** is the sole inventor named in the prior application on the date the CPA is filed, **A** will be considered the sole inventor in the CPA until a petition under 37 C.F.R. § 1.48 is filed and granted in the CPA.

(See "Correction of Inventorship" Section for additional questions relating to inventorship issues.)

See also Q155

8. Recognition of a CPA

(Q72) How will one recognize a CPA by looking at the application file wrapper?

Answer: The CPA status of the application will be indicated on the file jacket in two ways as follows:

(1) by a "Contents" entry listed as "Request for CPA"; and

(2) by a bold **ACPA"** label (approx. 1.5" X 0.75") placed on the front face of the file jacket.

Note that no CPA continuity data will be printed on the PALM data label on the front of the file jacket or on the PALM sheet inside the file.

(Q73) How will a CPA be recognized on a PALM screen?

Answer: By an entry in the "Contents" column of the 2952 screen of:
AACPA" for a Request for a **continuation** CPA; or
ADCPA" for a Request for a **divisional** CPA.
The date indicated in the area to the right of AACPA" or ADCPA" in the "Contents" column will be the filing date of the CPA.

(Q74) How will PALM indicate the abandonment of the prior application in favor of a CPA, and when will the abandonment of the prior application be counted?

Answer: When the CPA request is entered into PALM at the examining group level, an entry of an abandonment, in the manner similar to FWC practice, as AABN3" can be seen in the "Contents" column on the 2952 screen. After entry, the CPA will be forwarded to the examiner, who will then be able to work on the application. The abandonment of the prior application will be counted when the PALM data are entered.

E. CPA Practice *versus* 37 C.F.R. § 1.129(a) or 37 C.F.R. § 1.62 FWC Practice

(Q75) (revised) Are the attributes of a CPA the same as a submission under 37 C.F.R. § 1.129(a) or an application filed under former 37 C.F.R. § 1.62?

Original Answer: ~~No. While a CPA shares some common attributes with a submission under 37 C.F.R. § 1.129(a) as well as an application filed under 37 C.F.R. § 1.62, it is also distinctly different from each. For example, under former 37 C.F.R. § 1.62, new matter could be introduced in the new 37 C.F.R. § 1.62 application, if filed as a continuation-in-part (CIP). By contrast, 37 C.F.R. § 1.53(d) does not permit the introduction of new matter. Furthermore, a member of the public may be permitted to access a pending 37 C.F.R. § 1.62 application, if an application in the file wrapper was abandoned and referenced in a U.S. patent. However, a member of the public will not be permitted to access a pending CPA where the only basis for public access is that an application in the file wrapper is abandoned and referenced in a U.S. patent. Finally, unlike a submission under 37 C.F.R. § 1.129(a), a CPA must be based on a prior application filed on or after June 8, 1995, and there is no limit to the number of CPA requests.~~

Revised Answer: No. While a CPA shares some common attributes with a submission under 37 C.F.R. § 1.129(a) as well as an application filed under 37 C.F.R. § 1.62, it is also distinctly different from each. For example, under former 37 C.F.R. § 1.62, new matter could be introduced in the new 37 C.F.R. § 1.62 application, if filed as a continuation-in-part (CIP). By contrast, 37 C.F.R. § 1.53(d) does not permit the introduction of new matter. Furthermore, a member of the public may be permitted to access a pending 37 C.F.R. § 1.62 application, if an application in the file wrapper was abandoned and referenced in a U.S. patent. However, a member of the public will not be permitted to access a pending CPA where the only basis for public access is that an application in the file wrapper is abandoned and referenced in a U.S. patent. Finally, unlike a submission under 37 C.F.R. § 1.129(a), there is no limit to the number of CPA requests.

(Q76) Under 37 C.F.R. § 1.62(f) (now obsolete), the filing of a FWC was construed to include a waiver of secrecy by the applicant under 35 U.S.C. § 122. Does a similar waiver apply to the filing of a CPA?

Answer: Yes. 37 C.F.R. § 1.53(d)(6) specifically states that a waiver of secrecy applies in a CPA. The waiver of secrecy is retained so that if an individual has a power to inspect or is otherwise entitled to access to one application in the file jacket of the CPA, the Office may release the entire file wrapper to that individual.

(Q77) Will an information disclosure statement (IDS) filed in a prior application be automatically considered in a CPA? Is this different than existing 37 C.F.R. § 1.129(a) practice or the practice under former 37 C.F.R. § 1.62?

Answer: In a CPA, all information disclosure statements filed in the prior application that comply with the content requirements of 37 C.F.R. § 1.98 will automatically be considered by the examiner. No resubmission or request that the previously submitted information be considered in the CPA is required. Thus, a previously filed IDS, which complied with the content requirements of 37 C.F.R. § 1.98 but not with the timing requirements of 37 C.F.R. § 1.97 and was, as a result, NOT considered in the prior application, must be considered by the examiner when preparing the first Office action in the CPA. This is the existing practice under 37 C.F.R. § 1.129(a), but is different from the prior practice involving a 37 C.F.R. § 1.62 application wherein, in order to ensure consideration of information submitted in compliance with the content requirements of 37 C.F.R. § 1.98 which had not been considered in a parent application, applicant had to either specifically request that the previously submitted information be considered in the 37 C.F.R. § 1.62 application or applicant had to resubmit the information in compliance with the requirements of 37 C.F.R. §§ 1.97 and 1.98.

II. CORRECTION OF INVENTORSHIP - 37 C.F.R. §§ 1.41, 1.48, 1.324

(Q78) How does an applicant change the inventorship named in the original application papers filed under 37 C.F.R. § 1.53(b) without an executed oath or declaration (37 C.F.R. § 1.53(f)) to the inventorship named in the later-filed oath or declaration pursuant to 37 C.F.R. § 1.48(f)?

Answer: The inventorship may be corrected by filing the executed oath or declaration. The inventorship is (automatically) changed merely by filing the executed oath or declaration. 37 C.F.R. § 1.48(f) is not a provision under which an applicant may or must petition to correct the inventorship in an application. 37 C.F.R. § 1.48(f) simply states the effect that the subsequent filing of an executed oath or declaration will have, without further action by the applicant, pursuant to 37 C.F.R. § 1.41(a) in an application filed without an executed oath or declaration (37 C.F.R. § 1.53(f)) in the event the executed oath or declaration names a different inventorship than that set forth in the original application papers. Where an application is filed without an oath or declaration, the subsequent filing of an executed oath or declaration will act *automatically* to set forth the persons named in the executed oath or declaration as the inventors (37 C.F.R. § 1.48(f)). That is, any difference in the persons named as inventors between the original application

papers and an executed oath or declaration subsequently filed to complete the application will *automatically* be resolved in favor of the subsequently filed executed oath or declaration.

(Q79) If an executed oath or declaration subsequently filed to complete the application names inventors different from the persons set forth in the original application papers, will a new filing receipt reflecting the inventorship set forth in the executed oath or declaration be issued?

Answer: No. A new filing receipt will not be issued unless the applicant also files a request for a corrected filing receipt and the fee set forth in 37 C.F.R. § 1.19(h). It has been PTO practice to issue a filing receipt at the time a filing date is granted. This practice will be maintained under the new rules, even where the inventors have not been named at the time the filing date is granted. If applicants desire an initial filing receipt with the correct inventors identified, they should identify the correct inventors at the time the application is initially filed. This will preclude the need for a corrected filing receipt, which would be available only upon request and payment of the requisite fee. For these reasons, applicants are encouraged to identify the correct inventive entity at the time an application is initially filed.

(Q80) Must a petition under 37 C.F.R. § 1.41(a) to correct the inventorship in an application be accompanied by a petition under 37 C.F.R. § 1.137 to revive the application?

Answer: No. The petition practice set forth in 37 C.F.R. § 1.41(a) is applicable only where an application: (1) became abandoned prior to the filing of an executed oath or declaration; and (2) does not set forth the inventors in the original application papers. Note that this petition practice is applicable only when an application became abandoned prior to the filing of an executed oath or declaration.

(Q81) What are my options if I need to correct the inventorship in an application or in a patent?

Answer: The options for an application are: (1) refiling the application with the correct inventive entity without need to resort to a petition; (2) filing a petition under 37 C.F.R. § 1.48 in a non-reissue application; or (3) in a reissue application, filing another reissue oath or declaration (37 C.F.R. §§ 1.171 and 1.175).

The options for a patent are: (1) filing a petition under 37 C.F.R. § 1.324; (2) filing a reissue application (37 C.F.R. §§ 1.171 and 1.175); or (3) obtaining a court order (35 U.S.C. § 256).

(Q82) As the diligence requirement for filing petitions under 37 C.F.R. § 1.48 has been removed, can I file a petition to correct inventorship at any time prior to issue?

Answer: No. Petitions under 37 C.F.R. § 1.48 filed after final rejection or allowance are still subject to the timeliness requirements under 37 C.F.R. § 1.116 or § 1.312.

(Q83) If I need to change the inventorship in an application where an executed oath/declaration has not been submitted on filing, do I need to do this by petition or refiling of the application?

Answer: Neither. 37 C.F.R. § 1.48(f) will operate *automatically* to change the inventorship when an executed oath/declaration is later submitted during the pendency of the application along with the surcharge for the delayed submission of the oath/declaration.

(Q84) Will the changes to the rules with respect to deceptive intent apply only to applications filed after the effective date of the rule?

Answer: No. The changes to the rules with respect to deceptive intent will apply not only to applications filed after the effective date of the rule, but also to earlier-filed applications that are pending on the effective date of the rule. (See " Reissue Practice" Section for a question relating to the sufficiency of a reissue oath or declaration.)

III. CONFIDENTIALITY OF APPLICATIONS - 37 C.F.R. § 1.14

(Q85) Which *abandoned* applications may be released to the public without a power to inspect or a granted petition for access?

Answer: An abandoned application that is in the file jacket of a pending application under 37 C.F.R. § 1.53(d) (*i.e.*, a CPA) may *not* be released to a requester without a power to inspect or a granted petition for access, unless the requester is the applicant or assignee. *Abandoned* applications (other than those inside a CPA) which may be released to the public are as follows:

1. abandoned applications which are referred to in the text of a U.S. patent;
2. abandoned applications which are referred to in an application (either in the prosecution history or in the text of the application) that is open to public inspection (for example, a patent file, a reissue, an abandoned application that claims priority under 35 U.S.C. § 120 to an application that has issued as a patent, an abandoned application that is referred to in the text of a patent or in an application that is open to public inspection);
3. abandoned applications which claim the benefit of an application that is open to public inspection - that is, one that claims § 120 priority to, or is a child application of, an application that is open to public inspection (the PALM 2962 transaction can be used to determine continuity data); or
4. abandoned applications which have been laid open by the applicant.

(Q86) If an application is referred to in the text of a patent, can access to the application be given to a member of the public who is not the applicant?

Answer: Maybe. If the application is *pending*, then the pending application should *not* be released without a petition decision granting access to the member of the public or a power to inspect. If the application is *abandoned*, then 37 C.F.R. § 1.14(a)(3)(iv)(A) permits the member of the public to obtain access to or copies of the abandoned application, except if it is in the file of a CPA.

(Q87) What if the *pending* application is incorporated by reference in the patent?

Answer: As long as the application is *pending*, then the pending application file should *not* be released without a petition decision granting access to the member of the public or a power to inspect. However, 37 C.F.R. § 1.14(a)(2) provides that a member of the public may obtain a copy of an application-as-filed where the application is incorporated by reference in a U.S. patent. The member of the public should contact Certification Division to order a copy of the application as originally filed. The order may be faxed to Certification Division at (703) 308-9759 and paid by PTO deposit account, VISA, or MasterCard.

(Q88) May a member of the public obtain access to a pending CPA of an abandoned application which is either referred to in the text of a patent (37 C.F.R. § 1.14(a)(3)(iv)(A)) or in an application that is open to public inspection (37 C.F.R. § 1.14(a)(3)(iv)(A)) (for example, a patent file, a reissue, etc.)?

Answer: No, access is not possible in the absence of a granted petition for access under 37 C.F.R. § 1.14(e)(1). 37 C.F.R. § 1.14(a)(3)(iv) provides that a member of the public is entitled to certain abandoned applications, but not if the application is in the file jacket of a pending application under 37 C.F.R. § 1.53(d) (*i.e.*, in a pending CPA). The waiver of secrecy provided by 37 C.F.R. § 1.53(d)(6) does not operate to make the pending CPA available for inspection to a requester other than an applicant or assignee, unless the requester has a power to inspect one or more of the applications in the file. Providing public access to pending applications is undesirable (from the perspective of the applicant as well as the Office) because it can interfere with the prosecution of the application by permitting the application to be removed from the examiner's desk. Accordingly, the rule does not provide for public access to pending CPAs, even if an application within the file of the CPA is abandoned and referred to in a U.S. patent or an application that is open to public inspection.

IV. MANNER OF MAKING AMENDMENTS - 37 C.F.R. §§ 1.121, 1.125 (See also "Reissue Practice" Section)

(Q89) Do the revisions to 37 C.F.R. § 1.121 change the amendment practice with respect to nonprovisional, non-reissue applications?

Answer: No. Substantive changes have not been made with respect to amendment practice in nonprovisional, non-reissue applications. (See "Reissue Practice" Section for changes to amendment practice in reissue applications.)

(Q90) How do amendments to nonprovisional, non-reissue applications differ from those of reissue applications?

Answer: In comparing amendment practice to the specification for non-reissue and reissue applications, all amendments in the reissue application are to be made relative to (*i.e.*, *vis-*

à-vis) the patent specification and drawings in effect as of the date of the filing of the reissue application. Changes are shown using underlining and bracketing relative to the patent specification. In addition, the entire paragraph of disclosure with the changes and the entire claim with the changes must be presented in making the amendment. On the other hand, amendments in a non-reissue application are to be made relative to prior amendments (with underlining and bracketing in a reproduced claim reflecting changes made relative to the prior amendment), and insertions and deletions can be made without reproducing the entire paragraph of disclosure or the entire claim. Further (for a non-reissue application), in amending the text of the disclosure other than the claims, changes are not shown by underlining and bracketing, even where a paragraph of disclosure is reproduced. (See "Reissue Practice" Section for questions relating to amendment practice in reissue applications.)

(Q91) Can an amendment of a claim of a nonprovisional, non-reissue application be made by requesting the Office to "hand-enter" changes of five words or less?

Answer: Yes. In *non-reissue* applications, such a request would still be permitted under 37 C.F.R. § 1.121(a)(2)(i)(B). However, a request to " Hand-enter" changes of five words or less in a *reissue application* will no longer be permitted. (See " Reissue Practice" Section for questions relating to amendment practice in reissue applications.)

(Q92) In nonprovisional, non-reissue applications, how does the manner of making amendments to the specification differ from the manner of making amendments to the claims?

Answer: The answer is found in 37 C.F.R. § 1.121(a), which relates to amendments in non-provisional applications other than reissue applications. Paragraph (a)(1) relates to the manner of making amendments in the specification other than in the claims. Paragraph (a)(1)(i) requires the precise point in the specification to be indicated where an addition is to be inserted. Paragraph (a)(1)(ii) requires the precise point in the specification to be indicated where a deletion is to be made. This should be compared to addition or cancellation of material from the patent specification in a reissue application (paragraph (b)(1)(ii)) or in a reexamination proceeding (§ 1.530(d)(1)(ii), *e.g.*, by way of a copy of the rewritten material). An amendment containing deletions mixed with additions will be treated according to both paragraphs (a)(1)(i) and (a)(1)(ii). In contrast to amendments to the claims, amendments to the specification (additions or deletions) do <u>not</u> require markings, only identification of an insertion point. However, where the changes made are not readily apparent, the examiner may request the applicant to provide an explanation of the changes or a marked up copy showing the changes made. Paragraph (a)(1)(iii) provides that to reinstate matter previously deleted it must be reinstated by a new amendment inserting the matter. In regard to amendment of claims, Paragraph (a)(2) of § 1.121 relates to the manner of making amendments in the claims of a non -reissue application. Paragraph (a)(2)(i) permits amendment by instructions to the Office for a deletion, paragraph (a)(2)(i)(A), or for an addition limited to five words in any one claim, paragraph (a)(2)(i)(B). The ability to provide directions to the Office for the handwritten deletion of five words or less for each claim does not encompass deletion of equations, charts or other non-word material. Paragraph (a)(2)(ii) sets forth that a claim may be

amended by a direction to cancel the claim or by rewriting the claim with markings showing material to be added and deleted. Additionally, previously rewritten claims are required to be so marked and not to have interlineations showing amendment(s) previous to the one currently being submitted.

(Q93) In nonprovisional, non-reissue applications, how do applicants make amendments to the drawings?

Answer: 37 C.F.R. § 1.121(a)(3) clarifies that amendments to the original application drawings for non-reissue applications are not permitted and are to be made by way of a substitute sheet for each original drawing sheet that is to be amended. The paragraph contains material from canceled § 1.115. Amendments to the original application drawings are not permitted. Any change to the application drawings must be by way of a substitute sheet of drawings for each sheet changed submitted in compliance with § 1.84. Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(Q94) In nonprovisional, non-reissue applications, can the examiner require an amendment to the disclosure to require *complete* correspondence between the specification, claims and drawings?

Answer: No. 37 C.F.R. § 1.121(a)(5) merely requires " Substantial correspondence" in the specification, the claims and the drawings.

(Q95) With respect to nonprovisional, non-reissue applications, did the Office implement the proposal to require all previous amendments be presented when there is any amendment to the claims?

Answer: No. *Proposed* paragraphs (b)(2)(iv) and (v) of 37 C.F.R. § 1.121, relating to a requirement for submission of all amendments be presented as of the date when any amendment to the claims is made and to the failure to submit a copy of any added claim would be construed as a direction to cancel that claim, were not implemented.

(Q96) Where an applicant intends to make numerous amendments to the specification (excluding the claims) of a non-reissue application, can the applicant file a substitute specification under 37 C.F.R. § 1.125 to effect the changes to the specification?

Answer: Yes. In order to file a substitute specification (excluding the claims) in compliance with 37 C.F.R. § 1.125 in a non-reissue application, applicant must: (1) submit a clean copy of the substitute specification with the changes already made; (2) file a statement that the substitute specification does not introduce new matter; and (3) provide a marked-up copy of the specification indicating the changes made relative to the previous specification. The substitute specification may be filed as a matter of right at any time up to the payment of the issue fee. In preparing the marked-up copy, applicant may conveniently use the "Compare document" option (or equivalent thereof) available in many word processing programs--*i.e.*, the changes may be indicated by *any reasonable*

indicia such as "redlining/strikeouts" or "bracketing/underlining." It must be emphasized, however, that the provisions of § 1.125 do *not* apply to the claims. Furthermore, § 1.125(d) makes it clear that a substitute specification under § 1.125 is not permitted in reissue applications or reexamination proceedings. (See "Continued Prosecution Applications" Section for a question relating to a CPA filed with a new specification.)

V. TIME-TO-REPLY CHANGES - 37 C.F.R. §§ 1.135, 1.136

(Q97) What difference does it make that a "time period" rather than a "time limit" is given under amended 37 C.F.R. § 1.135(c)?

Answer: Under former 37 C.F.R. § 1.135(c), the failure to complete the reply to an Office action within the specified time limit resulted in the application being considered as retroactively abandoned *as of the expiration date* for reply to such Office action (not as of the expiration date of the specified time limit), since the reply filed was non-responsive and not timely completed. This had adverse effects, especially when the applicant sought to file a continuing application within the specified time limit rather than complete the reply (as the failure to complete the reply to an Office action within the specified time limit resulted in the application being considered abandoned *as of the expiration date* for reply to such Office action and copendency would not be present for the continuing application).

Under 37 C.F.R. § 1.135(c) as amended, an examiner is authorized to consider a reply that is not fully responsive to a non-final Office action adequate to avoid abandonment for failure to timely reply to such Office action. Specifically, amended 37 C.F.R. § 1.135(c) authorizes an examiner to treat a reply that is not fully responsive to a *non-final Office action* by: (1) considering the reply as being responsive to the last Office action and acting on the reply; (2) giving the applicant a new time period for reply to supply the omission; or (3) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 C.F.R. § 1.136(a)) to avoid abandonment. The treatment to be given to the reply depends upon: (1) the seriousness of the deficiency; and (2) whether the reply is a *bona fide* attempt to reply. When applicant is given a new time period to supply the omission, applicant may, within the new time period, together with any extensions under § 1.136(a), supply the omission, file any reply under 37 C.F.R. § 1.111, and/or file a continuing application as applicant determines to be appropriate. Of course, applicant is required to supply the omission within the new time period, including extensions under § 1.136(a), to avoid abandonment upon expiration of the new time period. The application is considered to be pending during this new time period for reply given under § 1.135(c), or any extensions thereof obtained under § 1.136(a), and it will not be considered to be abandoned if the omission is not corrected, until the new time period, including any extensions, expires.

(Q98) Does the practice set forth in 37 C.F.R. § 1.135(c) apply to an application after final or under appeal?

Answer: No. 37 C.F.R. § 1.135(c), by its terms, is limited to a *bona fide*, but incomplete, reply to a "non-final Office action." Where submission after final Office action or appeal (*e.g.*, an amendment under 37 C.F.R. § 1.116) does not place the application in condition for allowance, the period for reply under 37 C.F.R. § 1.113 continues to run until a reply under 37 C.F.R. § 1.113 (*i.e.*, a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (*e.g.*, whether the amendment raises new issues or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 C.F.R. § 1.121) is immaterial.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner's amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the final Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution in an otherwise allowable application under *Ex parte Quayle*, 1935 Dec. Comm'r Pat. 11 (1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 C.F.R. § 1.113.

(Q99) 37 C.F.R. § 1.136(a) no longer requires that a petition for an extension of time be accompanied by a reply. What will happen if a petition for an extension of time is not accompanied by a reply?

Answer: The period for reply (and thus the pendency of the application) will be extended, but the application will become abandoned as of the end of the so-extended period in the absence of a timely reply. This change to 37 C.F.R. § 1.136(a) simply codified a change in practice by which applicants were permitted to extend the period for reply under 37 C.F.R. § 1.136(a) solely to extend the pendency of the application (to establish copendency with a continuing application), notwithstanding that former 37 C.F.R. § 1.136(a) required that a petition thereunder include a response or reply.

(Q100) 37 C.F.R. § 1.136(a) has been amended to permit extensions of time up to five months.. In view of the statutory limit in 35 U.S.C. § 133, would such an extension be applicable to any reply other than to a requirement for restriction or election of species?

Answer: In addition to its applicability in situations in which a Office action sets a one-month shortened statutory period for reply (*e.g.*, periods given under 37 C.F.R. § 1.135(c) to correct a previously filed reply), it is also applicable to non-statutory periods for reply. For example, the two-month period in 37 C.F.R. § 1.192(a) for filing an appeal brief is not a statutory period for reply under 35 U.S.C. § 133. Thus, the two-month period in 37 C.F.R. § 1.192(a) may be extended by five months (up to seven months) under 37 C.F.R. § 1.136(a). In addition, the two-month period in 37 C.F.R. § 1.137 is also not a statutory period (as such an application is not a pending application), and it may be extended by five months (up to seven months) under 37 C.F.R. § 1.136(a).

(Q101) An applicant files a CPA within six months of the last Office action in the prior application, but after the shortened statutory period for reply set by the Office action has expired. No petition or fee for extension of time accompanied the CPA request. Will a general authorization to charge fees to a deposit account in the prior application be effective to extend the period for reply in the prior application?

Answer: Yes. While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application (see Question Q59), a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (*i.e.*, expressly abandon) the prior application. Thus, it will be considered a "reply" for purposes of 37 C.F.R. § 1.136(a)(3). As a result, under 37 C.F.R. § 1.136(a)(3), an authorization in the prior application to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees to a deposit account will be treated as a constructive petition for an extension of time in the prior application for the purpose of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

(Q102) An applicant files a continuation application under 37 C.F.R. § 1.53(b) within six months of the last Office action in the prior application, but after the shortened statutory period for reply set by the Office action has expired. No petition or fee for extension of time was filed in the prior application. Will a general authorization to charge fees to a deposit account in the prior application be effective to extend the period for reply in the prior application so as to have copendency with the continuation application?

Answer: No. Under 37 C.F.R. § 1.136(a)(3), an authorization to charge all required fees, fees under 37 C.F.R. § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future **reply** requiring a petition for an extension of time for its timely submission. A continuing application under 37 C.F.R. § 1.53(b) is a new application which is assigned a new application number and filing date and is placed in a new file jacket maintained separately from the file of the prior application. It is not a paper directed or placed in the file of the prior application and is not a "reply" to the last Office action in the prior application. Thus, either a reply or a petition for an extension of time is required to be filed as a separate paper in the prior application.

(Q103) Since 37 C.F.R. § 1.136(a)(3) provides that a general authorization to charge all fees is a constructive extension of time, is there any reason to file a petition under 37 C.F.R. § 1.136(a) in an application where an extension of time is needed?

Answer: Yes. 37 C.F.R. § 1.136(a)(3) was adopted as a "safety" net for applicants to avoid a potential loss of patent rights for applicants who inadvertently omitted a petition. Reliance upon a general authorization to charge all fees as a constructive petition for extension of time may result in processing delays if the application is not promptly recognized as one in which the applicant has filed such a general authorization. Thus, the

submission of a written petition for any desired extension of time in reply to the Office action for which the extension was requested is *strongly* recommended.

See also Q156-160

VI. APPEAL PROCESS CHANGES - 37 C.F.R. §§ 1.191-1.197

(Q104) If a notice of appeal is not signed or does not identify the appealed claims, should the examiner issue a Notice of Defective Appeal or Brief (Form PTO-461)?

Answer: No. 37 C.F.R. § 1.191 has been amended to no longer require that a notice of appeal be signed or that it identify the appealed claims. These two requirements are deleted because they are redundant to the requirements set forth in § 1.192. Under § 1.192, the appeal brief must be signed, which will effectively ratify the unsigned notice of appeal. In addition, § 1.192 requires an appeal brief to identify the claims on appeal.

(Q105) Can a new ground of rejection be included in an examiner's answer?

Answer: No. A new ground of rejection shall not be permitted in an examiner' s answer. However, if: (1) an amendment under 37 C.F.R. § 1.116 proposes to add or amend one or more claims; (2) appellant was advised that the § 1.116 amendment would be entered for appeal purposes; and (3) appellant was advised how one or more *individual* rejections set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then: (4) the appeal brief must address the rejection(s) of the added or amended claim(s); and (5) the examiner's answer may include the rejection(s) of the added or amended claim(s). The filing of a § 1.116 amendment represents appellant' s consent that any appeal may proceed on the added or amended claim(s).

(Q106) Will reopening of prosecution require any type of supervisory approval?

Answer: Yes. Under MPEP 1002.02(d) and 1208.01, approval from the Supervisory Patent Examiner is required for the entry of a new ground of rejection after reopening of prosecution, and such approval must be indicated in both copies of the Office action. However, the Office action (after reopening of prosecution) containing the new ground of rejection may be made final if the new ground of rejection was (1) necessitated by amendment or if it was (2) based on information presented in an information disclosure statement under 37 C.F.R. § 1.97(c) where no certification has been filed.

(Q107) What happens if an information disclosure statement (IDS) is submitted together with or after the filing of an appeal brief?

Answer: Where an information disclosure statement is submitted together with or after the filing of an appeal brief, the provisions of 37 C.F.R. § 1.97(d) apply. Under § 1.97(d), the information disclosure statement must be considered provided that (1) a statement as specified in § 1.97(e), (2) a petition requesting consideration, and (3) the petition fee under § 1.17(i) are included. If a new rejection must be made based on

information provided in a proper information disclosure statement, prosecution must be reopened.

(Q108) Can the examiner refuse entry of a reply brief if the examiner 's answer did not contain any new points of argument?

Answer: No. Appellant is entitled to entry of a timely reply brief, regardless of whether the examiner's answer raises new points of argument. 37 C.F.R. § 1.193(b)(1).

(Q109) Can the examiner respond to a reply brief?

Answer: A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such a supplemental examiner's answer. 37 C.F.R. § 1.193(b)(1). If a response to the reply brief is necessary and the Board has not remanded the application pursuant to 37 C.F.R. § 1.193(b)(1), prosecution must be reopened. Otherwise, the examiner must acknowledge receipt and entry of the reply brief.

(Q110) Should the examiner provide written notification to appellant that a reply brief has been entered and considered?

Answer: Yes. The examiner must notify appellant of the entry and consideration of the reply brief by using Form Paragraph 12-47 on Form PTOL-90.

(Q111) Can a new reference be cited in an examiner' s answer?

Answer: No. MPEP 1208.01. The citation of a new reference would invite needless controversies as to whether a new ground of rejection has been entered. Even if the reference is cited to support the rejection in a minor capacity, there is no excuse for omitting it from the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

(Q112) Does former 37 C.F.R. § 1.193(a), or 37 C.F.R. § 1.193(a) as amended, control whether an examiner's answer may include a new ground of rejection?

Answer: The rule in effect on the mail date of the examiner's answer controls. After the effective date of the new rules, an examiner 's answer may not include a new ground of rejection. Note, however, Question Q105 which describes the practice permitted if a 37 C.F.R. § 1.116 amendment has been entered for appeal purposes.

(Q113) Does the prohibition in 37 C.F.R. § 1.193(a)(2) against a new ground of rejection in an examiner's answer also prohibit an examiner from shifting positions between the final rejection and an examiner's answer?

Answer: While § 1.193(a) prohibits a new ground of rejection in an examiner's answer, it does not prohibit the examiner from expanding upon a ground of rejection set forth in the action being appealed. However, the examiner cannot change the basic thrust of the

rejection in an examiner's answer without raising a genuine issue as to whether a new ground of rejection has been entered. See MPEP 1208.01.

(Q114) Does former 37 C.F.R. § 1.193(b), or 37 C.F.R. § 1.193(b) as amended, control whether an examiner may refuse entry of a reply brief?

Answer: While the filing date of a paper normally controls (*i.e.*, the rule in effect on the date of the filing of the paper should be applied), in this circumstance, the rule in effect on the mail date of the communication refusing entry of the reply brief controls whether the examiner may refuse entry of the reply brief, assuming that such refusal was proper under former 37 C.F.R. § 1.193(b).

(Q115) What is appellant's proper course of action following reopening of prosecution after an appeal brief or reply brief has been filed?

Answer: Appellant may: (i) file a reply under 37 C.F.R. § 1.111 (if the Office action was non-final) or 37 C.F.R. § 1.113 (if the Office action is final); or (ii) file a request for reinstatement of the appeal by submitting such a request together with a supplemental brief. 37 C.F.R. § 1.193(b)(2).

(Q116) Is a previously filed appeal brief automatically incorporated into a supplemental appeal brief?

Answer: Yes. The preparation of a thorough and well reasoned examiner's answer would necessarily entail a consideration of the entire record, including any previously filed appeal brief. Thus, an examiner will not be subject to any additional burden. In the supplemental appeal brief, however, appellant should identify all previously-raised issues and/or arguments which are still considered to be relevant. If appellant does not identify such issues and/or arguments, the examiner's answer may include a clarification as may be appropriate.

(Q117) Can a new amendment, new affidavit (37 C.F.R. § 1.130, 1.131, or 1.132), or other new evidence be included in a request for reinstatement of appeal under 37 C.F.R. § 1.193(b)(2)?

Answer: No. New amendments, new affidavits or other new evidence are *NOT* permitted if reinstatement of the appeal is requested. 37 C.F.R. § 1.193(b)(2).

(Q118) May a new amendment, new affidavit, or other new evidence be filed in or with a reply brief?

Answer: No. The brief on appeal (including a reply brief) may not *include* new amendments, new affidavits, or other new evidence. A new amendment, new affidavit, or other new evidence submitted in an application on appeal must be submitted in a paper separate from the appeal or reply brief. See MPEP 1206. Entry of a new amendment, new affidavit, or other new evidence submitted (as a separate paper) in an application on appeal is not a matter of right, even if filed with a timely reply brief under 37 C.F.R.

§ 1.193(b). The entry of an amendment submitted in an application on appeal continues to be governed by 37 C.F.R. § 1.116, and the entry of an affidavit or other evidence submitted in an application on appeal continues to be governed by 37 C.F.R. § 1.195.

(Q119) Is an appellant entitled to a refund of the notice of appeal fee if the examiner reopens prosecution after a notice of appeal has been filed?

Answer: No. However, the fee may be applied to a future appeal in the same application.

See also Q161

VII. REISSUE PRACTICE - 37 C.F.R. §§ 1.171, 1.172, and 1.175

(Q120) Does an applicant still have to request and pay for a title report when filing a reissue application?

Answer: No. A record of the ownership (assignment) of the patent rights is established in the reissue application through the filing of a statement evidencing ownership under 37 C.F.R. § 3.73(b), as required by '1.172.

(Q121) Should the statement under 37 C.F.R. § 3.73(b) establishing ownership of the patent and the consent of assignee be submitted at the time of filing of the reissue application?

Answer: Yes, if the patent is assigned. However, if the consent of all assignees (to the filing of the reissue) and the statement establishing ownership are not submitted at the time of filing, a "Notice to File Missing Parts of Application" will be sent to applicant requiring that the documents be submitted within a prescribed time period along with a surcharge, in order to avoid abandonment of the application.

(Q122) Is it required that specific forms be used for parts of the reissue application?

Answer: No. However, an applicant is less likely to overlook or omit required elements if the forms are used. Reissue Transmittal Form PTO/SB/50, which includes a filing checklist, should be used and should accompany the reissue application papers.

(Q123) Will a reissue application be accorded a filing date if accompanied by an unsigned oath or declaration or an improperly executed oath or declaration?

Answer: Yes. However, a "Notice to File Missing Parts of Application" will be sent notifying applicant of the filing deficiency and setting a time period for proper reply in order to avoid abandonment of the application. 37 C.F.R. § 1.175(d) provides for the submission of a reissue oath or declaration under 37 C.F.R. § 1.53(f).

(Q124) How specific must an applicant be in the reissue oath/declaration in describing "at least one error" for supporting the reissue under the requirements of amended 37 C.F.R. § 1.175?

Answer: The nature of the error must be described as, *e.g.*, claiming more or less than applicant had a right to (such as changing "holding means" to A[holding means] bracket"), seeking to perfect a claim for foreign priority, correction of a defective specification, *etc.* The particular error described here must be one which is substantive, *i.e.*, one which renders the original patent wholly or partly inoperative or invalid. However, a description of how the error arose need not and should not be included. Changes of a minor nature should not be described as the error supporting the reissue.

(Q125) If a reissue amendment is filed *before* December 1, 1997, the effective date of the final rule, but an Office action in response to the amendment is not mailed until *after* December 1, 1997, which version (former or amended) of 37 C.F.R. '1.121(b) controls?

Answer: The amendment will be treated under *either* the amended (final) rule or the former rule, whichever is more advantageous to the applicant, if the Office action (in response to the amendment) is mailed after December 1, 1997. If the examiner 's action is mailed before December 1, 1997, the examiner will apply the former rule.

(Q126) Must an applicant provide an explanation of support for each amendment made in a reissue application?

Answer: Yes, except for amendments which are clearly editorial in nature, in which case the applicant may simply explain in the remarks that the amendment is merely making an editorial change (see also Question Q128). 37 C.F.R. §'1.121(b)(2)(iii) requires that an explanation of the support in the disclosure for each amendment (non-editorial) be provided with comments on pages separate from the pages containing the amendments. Failure to do so may result in the amendment being considered non-responsive.

(Q127) What is the nature of the amendatory changes (non-editorial) for which support must be set forth under 37 C.F.R. § 1.121(b)(2)(iii) in reissue amendments?

Answer: It does not matter whether the non-editorial changes made by amendment in reissue applications are additions to the claims or deletions of subject matter from the claims. For both types of change, an explanation of the support for the changes must be made on a separate page from the actual amendment, *i.e.*, in the "Remarks." If an applicant has added material to a claim, its basis in the disclosure must be pointed out. Likewise, if applicant has deleted material from a claim, an explanation of the support for the deletion must be pointed out. Both additions and deletions can sometimes result in findings of new matter. See, *e.g.*, In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984), where it was held that the omission of a limitation introduced new matter.

(Q128) In reissue applications, if applicant simply makes editorial changes, does support need to be shown for such changes in the disclosure? What if terms are used which do not have explicit support?

Answer: When it is clear that the amendment simply involves an editorial change and does not add material for which support in the disclosure is required, the remarks section of the

reply may simply explain that the amendment is merely an editorial change. When the amendment uses terms that find no explicit support in the specification, the reply must set forth where the specification provides, at least implicitly, support for the amendment as required under 35 U.S.C. §§ 112 and 251. Obviously, an amendment that does not find either explicit or at least implicit support in the specification as required under the above relevant statutes is not permitted.

(Note that the points raised in Questions Q126-128 are similarly applicable to reexamination proceedings by analogy.)

(Q129) Must every amendment submission include a total rewriting of all of the claims pending in the reissue application?

Answer: No. However, 37 C.F.R. § 1.121(b)(2)(ii) requires that each amendment submission include the *status* of every claim of the reissue application, whether pending or canceled, including the claims of the original patent. If any claims are being amended, the entire text of these claims must be rewritten.

(Q130) Will Office policy require examiner's amendments in reissue applications to conform to the requirement that the entire claim be rewritten?

Answer: Yes. Once approval has been obtained from applicant for changes to the claims, examiners are expected to follow the rule (37 C.F.R. § 121(b)(2)(i)(A)) with respect to rewriting the entire claim in an examiner's amendment in a reissue application. However, examiners should encourage applicants to fax or hand-carry copies of the rewritten claims to the examining group where they will be quickly processed and the case passed to issue. The requirement for rewriting the entire amended claim was intended to ease the administrative burden on the Office. In satisfying this requirement, the applicant is only slightly inconvenienced because it is likely that the text of the claims is available to applicant in electronic format on a word processor. On the other hand, the examiner most likely does not have the electronic version of the claims, and the total rewriting of the claims by the examiner increases the chances and probability for error. Thus, the examiner should encourage the applicant to rewrite the claims with the needed changes.

(Q131) Is an oath or declaration filed *before* December 1, 1997, the effective date of the final rule, evaluated under the *amended* 37 C.F.R. § 1.175 of the final rule if the Office action is mailed after December 1, 1997?

Answer: Yes. Even though the reissue oath or declaration was filed prior to the effective date of the new rules, the oath or declaration is reviewed *under the amended version of § 1.175*. Thus, the examiner should review the oath or declaration to see if there is:

- A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid-
  - by reason of a defective specification or drawing, or
  - by reason of the patentee claiming more or less than patentee had the right to claim in the patent.

- A statement of one error which can be relied upon to support the reissue application.
- A statement that all errors which are being corrected in the reissue application (up to the time of filing of the oath or declaration) arose without any deceptive intention on the part of the applicant.
- Compliance with 37 C.F.R. § 1.63.

Any information in addition to this should not be evaluated and should not be commented upon by the examiner. Accordingly, the identification of more than one error and the description of how the errors arose and were discovered are irrelevant and will not be commented upon by the examiner.

Where the examiner issues an Office action *prior* to December 1, 1997, the oath or declaration is reviewed under the existing rule--*i.e.*, the rule in effect prior to December 1, 1997. If the oath or declaration is found to be acceptable under the existing rule, then the examiner will allow the application accordingly. If the oath or declaration is not acceptable under the existing rule, however, the examiner should either: (1) delay the Office action until December 1, 1997, if possible; or (2) suspend prosecution (with a notification to applicant) until December 1, 1997.

Where rejections other than under existing § 1.175 can be made, the § 1.175 issues can be indicated as being held in abeyance in view of the change in § 1.175 which will become effective on December 1, 1997. Thus, there would be no need to delay the Office action or suspend prosecution in such a situation.

(Q132) Should a reissue applicant await a notification of allowable subject matter of the reissue application before submitting a supplemental oath/declaration?

Answer: Yes. When the application is in condition for allowance except for the filing of a supplemental reissue oath or declaration as required by 37 C.F.R. § 1.175(b)(1), the examiner will make a telephone call to the attorney informing him/her that a supplemental oath/declaration covering any changes (errors) corrected since the filing of the original (or last) oath/declaration is needed. If applicant is unwilling or otherwise unable to promptly file a supplemental oath/declaration, the examiner will issue an Office action rejecting the claims under 35 U.S.C. § 251, with an indication that the rejection may be overcome by filing a supplemental oath or declaration in compliance with 37 C.F.R. § 1.175(b)(1).

(Q133) May the examiner use a *Quayle* action to notify a reissue applicant that a supplemental oath or declaration pursuant to 37 C.F.R. § 1.175(b)(1) is needed before a notice of allowability can be issued?

Answer: No. Applicant's failure to submit the required supplemental oath or declaration in compliance with § 1.175(b)(1) would trigger a *rejection* under 35 U.S.C. § 251. Since the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213, is limited to situations where the only outstanding issues are formal objections, a *Quayle* action cannot be used to communicate the requirement for a supplemental oath or declaration under § 1.175(b)(1).

(See "Continued Prosecution Applications" Section for a question as to whether a reissue CPA

may be based on a prior reissue application.)

See also Q162-166

VIII. DESIGN PRACTICE - 37 C.F.R. §§ 1.152, 1.154

(Q134) Is it necessary for a design application to contain all the elements set forth in 37 C.F.R. § 1.154(a)?

> *Answer:* No. The language A...the elements of the design application, if applicable, should appear..." in the rule indicates that there is no *per se* requirement that a design application must contain all the elements set forth in 37 C.F.R. § 1.154(a).

(Q135) Is a brief description of the nature and intended use of the article in which the design is embodied a *necessary* component of the preamble of an application?

> *Answer:* No. The language "should" indicates that the presence of this brief description is not *per se* mandatory. However, such a brief description in the preamble is encouraged as it may aid the examiner in the examination of the claimed design. Where such a brief description is necessary, the failure to include it may result in a rejection under 35 U.S.C. § 112, second paragraph. See Form Paragraph 15-21-01 and 15-56. The applicant may overcome such a rejection by submitting the information in a separate paper.

(Q136) Would the filing of black and white drawings constitute new matter in violation of 35 U.S.C. § 112, first paragraph, if the original application contained only color drawings and there is no disclaimer (either in the specification or drawings) with respect to the color?

> *Answer:* Yes. 37 C.F.R. § 1.152(b)(1). Any detail shown in the drawings or photographs deposited with the original application constitutes an integral part of the disclosed and claimed design.

(Q137) What types of details in the drawings or photographs are covered by 37 C.F.R. § 1.152(b)?

> *Answer:* Any detail shown in the drawings or photographs are covered, unless there is a specific disclaimer in the original application papers.

(See "Continued Prosecution Applications" Section for a question relating to a CPA based on a prior design application.)

IX. PETITIONS TO REVIVE AN ABANDONED APPLICATION - 37 C.F.R. § 1.137

(Q138) Can an applicant file a petition under 37 C.F.R. § 1.137(b) and revive an application that has been abandoned for a long time?

> *Answer:* 37 C.F.R. § 1.137(b) permits the revival of an abandoned application without

regard to the period of abandonment, so long as the entire delay was "unintentional." Thus, the mere fact that an application has been abandoned for a long time does not preclude its revival under 37 C.F.R. § 1.137(b). 37 C.F.R. § 1.137(b), however, does require that the entire delay have been "unintentional," which will preclude revival in those situations in which the applicant was aware of the abandonment but decided (for whatever reason) not to seek revival of the application.

(Q139) If an application became abandoned prior to the effective date of the change to 37 C.F.R. § 1.137, does former 37 C.F.R. § 1.137(c), or 37 C.F.R. § 1.137(c) as amended, control whether the applicant must file a terminal disclaimer under 37 C.F.R. § 1.137(c)?

Answer: The change to 37 C.F.R. § 1.137 (including 37 C.F.R. § 1.137(c)) applies to all petitions under 37 C.F.R. § 1.137 filed on or after its effective date. Unless the petition under 37 C.F.R. § 1.137 was filed *prior to* the effective date of the change to 37 C.F.R. § 1.137, 37 C.F.R. § 1.137(c) as amended controls whether a terminal disclaimer under 37 C.F.R. § 1.137(c) is required.

(Q140) If an adverse decision (*e.g.*, a dismissal or denial) has been rendered on a petition under 37 C.F.R. § 1.137(a) or (b), can the applicant file a petition under 37 C.F.R. § 1.137(b) and revive the application in light of the elimination of the one year filing period in 37 C.F.R. § 1.137(b)?

Answer: An applicant may file a renewed petition under 37 C.F.R. § 1.137(b) to revive the application, *so long as such a petition is filed within the period set forth in 37 C.F.R. § 1.137(d) for requesting reconsideration of an adverse decision on a petition under 37 C.F.R. § 1.137.* The elimination of the one year filing period in 37 C.F.R. § 1.137(b) notwithstanding, any applicant filing a petition under 37 C.F.R. § 1.137 outside the period set in 37 C.F.R. § 1.137(d) for seeking reconsideration of a prior adverse decision on petition under 37 C.F.R. § 1.137 is considered to have acquiesced in the abandonment of the application. Obviously, if an adverse decision on a petition under 37 C.F.R. § 1.137 is based in whole or in part upon a finding of intentional delay, the elimination of the one year filing period in 37 C.F.R. § 1.137(b) cannot result in a favorable decision on any renewed petition under 37 C.F.R. § 1.137(b), regardless of whether the renewed petition is timely under 37 C.F.R. § 1.137(d).

X. MISCELLANEOUS ISSUES

(Q141) Does the change to 37 C.F.R. § 3.73(b), making it applicable to an assignee of a part interest as well as an assignee of the entire right, title, and interest, now permit assignees of a part interest to conduct the prosecution of an application?

Answer: No, the change to 37 C.F.R. § 3.73(b) does not permit assignees of a part interest to conduct prosecution of the application, unless 37 C.F.R. § 1.47 applies. 37 C.F.R. § 3.71 continues to provide that only an assignee of the *entire* right, title, and interest in an application is entitled to conduct the prosecution of an application. 37 C.F.R. § 3.73(b) was amended to apply to an assignee of a part interest, as well as an

assignee of the entire right, title, and interest, because an assignee of a part interest may be required to take action in an application that does *not* amount to conducting the prosecution of the application. (See, *e.g.*, 37 C.F.R. § 1.172.) When an application for a patent is filed by one or more inventors on behalf of another or by a person showing at least a proprietary interest, the inventor(s) or person filing the application is considered a Rule 47 applicant and may conduct the prosecution of the application. 37 C.F.R. § 1.33(b)(4). Accordingly, an assignee of a Rule 47 applicant may also take action, even without an assignment of the entire interest in the application.

(Q142) An assignee seeks to take action by submitting a document which is signed by the assignee or by a person authorized to act on behalf of the assignee. Under 37 C.F.R. § 3.73(b), is it necessary that the document refer to evidentiary documents showing that ownership is in the assignee?

Answer: Yes, the document being submitted must refer to evidentiary documents showing that ownership is in the assignee. Ownership is established by submitting, in the Office file related to the matter in which action is sought to be taken, a statement specifying (*e.g.*, reel and frame number) where documentary evidence of a chain of title from the original owner to the assignee is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee, as shown in the power of attorney. For example, the following would comply with 37 C.F.R. § 3.73(b): papers filed in an application include a power of attorney, which is signed by the president of the company and which states that the company is the owner, and a letter, which is signed by the appointed attorney authorized to act on behalf of the assignee and which refers to the evidentiary documents showing that title is in the company (*e.g.*, by specifying the reel and frame number of the recorded assignment document).

(Q143) Do the changes to 37 C.F.R. §§ 1.6, 1.8, 1.10, 1.27, 1.28, 1.48, 1.52, 1.55, 1.69, 1.102, 1.125, 1.137, 1.377, 1.378, 1.804, 3.26, and 5.4 mean that statements thereunder are no longer subject to 18 U.S.C. § 1001?

Answer: No. Any statement submitted by anyone (practitioner or non-practitioner) to the PTO in a matter covered by 37 C.F.R. § 1.4(d) is subject to 18 U.S.C. § 1001 by operation of 37 C.F.R. § 1.4(d)(2) and 10.18(b)(1).

(Q144) What does the phrase "formed after an inquiry reasonable under the circumstances" in 37 C.F.R. § 10.18(b)(2) mean?

Answer: The phrase "formed after an inquiry reasonable under the circumstances" is taken from the 1993 amendment to Rule 11(b) of the Federal Rules of Civil Procedure. A discussion of the "inquiry reasonable under the circumstances" requirement Fed. R. Civ. P. 11(b) may be found in the advisory committee notes to the 1993 amendment to the Federal Rules of Civil Procedure. See Amendments to the Federal Rules of Civil Procedure at 50-53 (1993), *reprinted in* 146 F.R.D. 401, 584-87.

(Q145) Does 37 C.F.R. § 1.4(d)(2) and 10.18(b) require that a practitioner: (1) conduct a prior

art search prior to filing an application; (2) question the veracity or accuracy of a party giving the practitioner information or a statement of facts; or (3) inform the party giving the practitioner information or a statement of the certification effect of 37 C.F.R. § 10.18(b)?

Answer: No, these actions are not mandatory so long as the practitioner has no knowledge of information that is contrary to the information or statements provided by the party or would otherwise indicate that the information provided by the party was so provided for the purpose of a violation of 37 C.F.R. § 10.18(b). It is, however, highly advisable for a practitioner to conduct a prior art search prior to filing an application and to advise a client (or third party) of the certification effect of 37 C.F.R. § 10.18(b).

(Q146) What is the difference between the meaning of "reply" and "response" in a patent application?

Answer: There is no difference between the meaning of "Reply" and "Response" in an application. The term "Reply" is used throughout the rules for consistency with the language of 37 C.F.R. § 1.111. In reexamination, the reply is filed after a patent owner 's statement, while a response is filed during the examination phase of the proceeding.

(Q147) Has first action final practice been eliminated?

Answer: No. The Notice of Proposed Rulemaking proposed to eliminate first action final practice as the *quid pro quo* for streamlining after final practice. The proposal to streamline after final practice received overwhelming opposition. Thus, the PTO did not eliminate first action final practice or streamline after final practice.

(Q148) If there is an outstanding objection/rejection at the time the new rules become effective, but the objection/rejection is no longer valid under the new rules, can applicant simply direct the examiner to the relevant section(s) of the new rules in the reply to the Office action?

Answer: Yes, if the language of the section(s) of the new rules makes it absolutely clear that the objection/rejection is no longer valid. It is recommended, however, that applicant provide a brief explanation along with the citation of the relevant section(s) of the new rules, as there may be a genuine issue in the proper interpretation of the rules.

See also Q167-170

NEW SUPPLEMENTAL QUESTIONS AND ANSWERS

Application Filing Changes *(Continued from Q21)*

(Q149) An application was filed prior to December 1, 1997 without an *executed* oath or declaration under 37 C.F.R. § 1.63, but a specific inventive entity was named in the application transmittal letter or in an accompanying *unexecuted* oath or declaration.

Part I – Can applicant simply submit an *executed* § 1.63 oath or declaration which names

a different inventive entity on or after December 1, 1997 (without a petition under 37 C.F.R. § 1.48(a) to correct the inventorship as was the practice prior to December 1, 1997)?

Answer: Yes. An *executed* oath or declaration submitted on or after December 1, 1997 will automatically act (without the need for a petition under § 1.48(a)) under 37 C.F.R. § 1.48(f) to establish the initial inventorship of an application even if the application was filed prior to December 1, 1997 with a different inventorship, so long as it is the first filing of an *executed* oath or declaration in the application.

Part II -- If the *executed* declaration, which names a different inventive entity, was submitted *prior to* December 1, 1997, would a § 1.48(a) petition still be needed to correct the inventorship if the application is not reviewed until on or after December 1, 1997?

Answer: Yes. Where the first filed *executed* oath or declaration under § 1.63 was submitted prior to December 1, 1997, and it sets forth an inventorship that is different from the inventorship set forth in the initial application papers, a petition under § 1.48(a) to correct the inventorship will be required, even if the application is not taken up for action until on or after December 1, 1997. This would be true even if the first filed declaration is found to be defective, such as in failing to provide the citizenship of the inventors or the "reviewed and understands" clause.

(Q150) Do the changes to 37 C.F.R. §§ 1.41 and 1.53 mean that the applicant(s)/inventor(s) need not be named on filing in a PCT international application?

Answer: No. 37 C.F.R. §§ 1.421 and 1.431 (not 37 C.F.R. §§ 1.41 and 1.53) control the filing date and applicant naming requirements for an international application. 37 C.F.R. § 1.431(b)(3)(iii) requires that an international application contain the "name of the applicant, as prescribed" to be accorded an international filing date, and no change was made to this provision. Thus, the PTO did not eliminate the requirement that an international application, *inter alia*, name the inventor(s) to be entitled to a filing date. In addition, where a national application resulted from an international application entering the national stage under 35 U.S.C. § 371, the naming of the inventors carries over from the international stage.

(Q151) Where a national application resulted from an international application entering the national stage under 35 U.S.C. § 371, will 37 C.F.R. § 1.48(f)(1) operate to " automatically" correct inventorship when the inventorship set forth in the oath or declaration differs from the inventorship specified during the international stage.

Answer: No. 37 C.F.R. § 1.48(f)(1), by its terms, applies only to a nonprovisional application filed under 37 C.F.R. § 1.53(b). A national application resulting from an international application entering the national stage under 35 U.S.C. § 371 is not an application filed under 37 C.F.R. § 1.53(b), but an application that has entered that national stage under 37 C.F.R. § 1.494 or 1.495.

(See also the question(s) under "Inventorship Issues" below.)

(Q152) What is the reason for not providing a place on the Utility (PTO/SB/05), Design (PTO/SB/18) and Plant (PTO/SB/19) Patent Application Transmittal forms to indicate fees being transmitted with an application, like the Continued Prosecution Application (CPA) Request form (PTO/SB/29), which has an area to indicate the fees being transmitted with the CPA?

Answer: The CPA Request form (PTO/SB/29) is designed to be a complete, self-contained submission of a CPA under 37 C.F.R. § 1.53(d), whereas the Utility, Design and Plant Patent Application Transmittal forms are designed to be a "transmittal" form for an application and other related papers (*e.g.*, the specification and drawings) submitted for an application under 37 C.F.R. § 1.53(b). Thus, the CPA Request form (PTO/SB/29) has an area that may be used to indicate the fees being transmitted with the CPA, while the Utility (PTO/SB/05) Design (PTO/SB/18) and Plant (PTO/SB/19) Patent Application Transmittal forms have a Box 1 that may be checked to indicate that the standard Fee Transmittal Form (PTO/SB/17) is included with the application being submitted under 37 C.F.R. § 1.53(b).

Continued Prosecution Applications (CPAs) *(Continued from Q36)*

(Q153) Has the PTO considered further amending 37 C.F.R. § 1.53(d) to permit the filing of a CPA based on a prior application which was filed before June 8, 1995?

Answer: Yes. The PTO has amended § 1.53(d)(1)(i) to eliminate the requirement that the prior application of a CPA must be filed on or after June 8, 1995. See 63 Fed. Reg. 5732 (February 4, 1998); 1207 Off. Gaz. Pat. Office 83 (February 24, 1998).

The PTO has decided to include a statement on the face page of the patent, except a reissue or a design patent, issuing from a CPA that: (1) the patent issued from a CPA under § 1.53(d); and (2) the patent is subject to the twenty-year term provisions of 35 U.S.C. § 154(a)(2). This statement will make it clear what statutory patent term provisions are applicable, and there should not be any confusion as would have occurred if one only looked at the filing date printed on the patent. (Note: The term of a design patent is defined as 14 years from the date of grant under 35 U.S.C. § 173, and the term of a reissue patent is defined in 35 U.S.C. § 251 as the unexpired part of the term of the original patent.)

(Q154) Will an amendment after final filed in the prior application *automatically* be entered in the CPA if the advisory action in response to the amendment after final in the prior application indicates that it will be entered upon the filing of an appeal?

Answer: No, unless a notice of appeal (and appeal fee) was filed in the prior application, in which event, the amendment will be entered if it has not already been entered. Thus, if applicant did not file a notice of appeal and an appeal fee in the prior application, applicant must file a specific instruction to enter such amendment after final if applicant desires that the amendment after final in the prior application be entered in the CPA.

Inventorship Issues *(Continued from Q71)*

(Q155) A 37 C.F.R. § 1.48(a) petition (to add or delete an inventor) has been dismissed in an Office action mailed prior to December 1, 1997 for failure of the petition to meet all the requirements of then § 1.48(a).

Part I -- In submitting a reply on or after December 1, 1997, must petitioner comply with the requirements of the former rule and supply the deficiencies noted in the Office action, or may petitioner reply to the Office action based on the requirements under revised § 1.48(a) effective December 1, 1997?

> *Answer*: Petitioner may choose whether to comply with the requirements set forth in the Office action and have the petition decided based on the former rule even though the last reply in support of the original petition is submitted on or after December 1, 1997. Alternatively, petitioner may elect to reply to the Office action based on the requirements of the revised rule. It should be noted, however, that while the requirement under the former rule for a showing of facts and circumstances has been simplified under the revised rule to a statement of lack of deceptive intent, the parties required to submit a statement have also been changed. Thus, while the former rule required a statement from *all the original named inventors*, the revised rule requires a statement from *those being added or deleted*. Accordingly, in the case of an inventor being added, a (showing of facts and circumstances) statement from the added inventor would not have been required/submitted with the original petition whereas, to proceed under the revised rule, a statement (of lack of deceptive intent) from the added inventor would now be required. Of course, an oath/declaration pursuant to 37 C.F.R. § 1.63 from all the actual inventors must also be submitted as the requirement for it has not been changed.

Part II -- What if the reply had been submitted prior to December 1, 1997 and is still deficient under the former rule, but the 37 C.F.R. § 1.48(a) petition papers as a whole would be adequate under the revised rule?

> *Answer*: If the examiner acts on the reply on or after December 1, 1997, the examiner may treat the original petition and subsequent papers filed in support thereof under the revised § 1.48(a) and grant the petition.

Time-to-Reply Changes *(Continued from Q103)*

(Q156) A Notice to File Missing Parts of Application (e.g., requiring the filing fee or an executed 37 C.F.R. § 1.63 oath or declaration) sets a two month period for reply. Is a five month extension of time to reply to the Notice available under revised 37 C.F.R. § 1.136(a) that would, in effect, allow seven months for a reply to the Notice?

> *Answer*: Yes. The time period set by a Notice to File Missing Parts is not identified on the Notice as a "statutory period" subject to 35 U.S.C. § 133. Thus, extensions of time of up to 5 months under revised 37 C.F.R. § 1.136(a) followed by additional time under 37 C.F.R. § 1.136(b), when appropriate, are now permitted. This is consistent with the practice we have been following under former 37 C.F.R. § 1.136. This prior practice is

recognized in M.P.E.P. § 201.03, which discusses applications filed under 37 C.F.R. § 1.53(b)(1), and states that a two month period set forth in the Notice to File Missing Parts of Application may be supplemented by four months under (former) § 1.136(a), with additional time under § 1.136(b) available when warranted. The example in the parenthesis of this section of the M.P.E.P. will be revised to reflect the five months now available rather than the four months previously permitted under former § 1.136(a).

(Q157) An incomplete, but *bona fide* reply to a non-final Office action is filed prior to December 1, 1997, and acted on by the examiner on or after December 1, 1997. Should the examiner set a one-month time limit (which is not extendible) or a one-month extendible time period under new rule 37 C.F.R. § 1.135(c)?

Answer: Since the examiner's letter will be mailed on or after December 1, 1997, the examiner should follow the procedure set forth in 37 C.F.R. § 1.135(c), as amended on December 1, 1997, and set a one-month time period (which period is extendible under 37 C.F.R. § 1.136(a)).

(Q158) Can a general authorization to charge fees required under 37 C.F.R. § 1.17 to a deposit account filed prior to December 1, 1997 be construed as a constructive petition for an extension of time under 37 C.F.R. § 1.136(a)(3) in order to make a reply filed in the fourth month on or after December 1, 1997 timely?

Answer: Yes. The fee set forth in 37 C.F.R. § 1.17(a)(1) for an extension for reply within the first month should be charged.

(Q159) Can a general authorization to charge fees required under 37 C.F.R. § 1.17 to a deposit account filed prior to December 1, 1997 be construed as a constructive petition for an extension of time under 37 C.F.R. § 1.136(a)(3) in order to make a reply filed prior to December 1, 1997 timely?

Answer: Yes, provided that December 1, 1997 falls within the extendible period for reply. Extensions of time can be submitted after a reply is made so long as the extension is filed within the extendible period for reply. In a situation where a reply is submitted prior to December 1, 1997, as of December 1, 1997, any general authorization of record will act as a constructive petition for an extension of time and, therefore, would make the earlier submitted reply timely so long as December 1, 1997 is within the maximum extendible period for reply. The extension fee that should be charged is the extension fee required for a petition for an extension of time filed on December 1, 1997. For example, if a rejection was mailed on June 16, 1997, setting a 3-month shortened statutory period for reply and a reply was filed on October 24, 1997 without the necessary petition for an extension of time (note: applicant should have been notified *as soon as possible* that a petition for an extension of time is needed), any general authorization of record on December 1, 1997 will act as a constructive petition for an extension of time. Applicant will be notified that the fee set forth in 37 C.F.R. § 1.17(a)(3) for an extension of time for reply within the third month has been charged since the earliest date that the general authorization can be considered as a constructive petition for an extension of time under

the rules is December 1, 1997.

(Q160) The answer to Q56 states that it is not necessary to check for continuity before the filing fee of a Continued Prosecution Application (CPA) is charged to a deposit account or a check for the filing fee is cashed. Isn't this statement inconsistent with the answer to Q101, which suggests that a general authorization to charge fees to a deposit account in the prior application will be effective to extend the period for filing a CPA in the prior application-- *i.e.*, that the PTO will check for continuity and charge any necessary extension fee?

> *Answer*: No. Q56 merely states that the financial transaction for the CPA filing fee may be completed prior to any substantive determination as to whether copendency exists. If it is later (subsequent to the financial transaction for the CPA filing fee) determined that a petition for an extension of time and fee are required in the prior application to maintain copendency, the PTO will charge the necessary extension of time fee, provided that there is a petition for an extension of time, such as a general authorization to charge fees in the prior application. If there is no petition for an extension of time and fee, but there is still time to file such a petition and fee, the PTO will notify applicant that the petition and fee are needed to maintain copendency. If the time period for filing a petition for an extension of time and fee has expired, the PTO will notify applicant that the prior application has been abandoned and will then await a possible petition to revive the prior application.

Appeal Process Changes *(Continued from Q119)*

(Q161) An examiner reopens prosecution after a first appeal brief has been filed.

Part I -- Will appellant need to pay a second notice of appeal fee or a second appeal brief fee when a second appeal results from the reopening of prosecution?

> *Answer*: No. Where the Board of Patent Appeals and Interferences (BPAI) has not rendered a substantive decision on the merits in the first appeal, neither a second notice of appeal fee nor a second appeal brief fee will be required.

Part II -- Is the answer to Part I dependent upon whether appellant elects to continue prosecution before the examiner or requests reinstatement of the appeal under 37 C.F.R. § 1.193(b)(2)(ii)?

> *Answer*: No. Whether appellant elects to continue prosecution or requests reinstatement of the appeal will not affect the need to file a second fee. No additional appeal fee or appeal brief fee shall be due where no BPAI decision has been rendered.

Reissue Practice *(Continued from Q133)*

(Q162) If all errors specifically identified in the initial reissue oath or declaration are, because of amendments during prosecution, no longer being corrected in the reissue application, does the reissue application lose the benefit of its filing date?

Answer: No. The filing date is retained. However, a supplemental reissue oath or declaration must be submitted which does identify a correctable error that is currently present in the reissue application, and it may also cover any other changes made during prosecution of the reissue application.

(Q163) How specific must a reissue oath/declaration be in "stating at least one error" in order to comply with requirements of revised 37 C.F.R. § 1.175, effective 12/1/97?

Answer: It is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent "wholly or partly inoperative or invalid." The corresponding corrective action which has been taken to "fix" the original patent need not be identified in the oath/declaration.

If the initial reissue oath/declaration "states at least one error" in the original patent, and, *in addition*, proposes the specific corrective action (or the "fix") to be taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

(Q164) What are the criteria for requiring a supplemental reissue oath/declaration with respect to the errors corrected in a reissue application and when should the supplemental reissue oath/declaration be required? (*How* the supplemental reissue oath/declaration is required by the examiner is addressed in the next question.)

Answer: (A) A supplemental reissue oath/declaration will be required ***in reply to the Office action*** in each of the following two fact situations.

1) The initial oath/declaration is insufficient because it fails to identify *any appropriate error* upon which reissue can be based. The oath/declaration does identify one or more errors, but none of the identified errors are appropriate for reissue. A supplemental oath/declaration is needed in reply to the Office action to provide at least one error appropriate for reissue. (Note: In accordance with 35 U.S.C. § 251, the error upon which a reissue is based must be one which causes the original patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he [or she] had a right to claim in the patent." Thus, an error under 35 U.S.C. § 251 does not exist where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error--*i.e.*, a Certificate of Correction type error. These Certificate of Correction type errors do not provide a basis for reissue, although they may also be included in a reissue application where an appropriate error is also present. This discussion of "error" will be included in the next version of the Manual of Patent Examining Procedure at Section 1402.)

2) There is no statement of an error *at all* in the initial oath/declaration in the case. A supplemental oath/declaration is needed in reply to the Office action to identify at least one appropriate error to be relied upon as the basis for reissue.

(B) A supplemental reissue oath/declaration will be required ***prior to allowance*** in each of the following two fact situations.

3) The initial oath(s)/declaration(s) of record *do*es properly identify one or more errors (as being the basis for reissue); however, because of changes or amendments made

during prosecution, ***there is no identified error that is being relied upon any longer***. A supplemental oath/declaration will be needed to identify at least one error *currently* being relied upon as the basis for reissue ***and*** to cover all other errors corrected which are not covered by the initial oath/declaration. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the initial oath(s)/declaration(s) is/are no longer being corrected.

4) The initial oath(s)/declaration(s) of record *do*es properly identify one or more errors (as being the basis for reissue); however, because of changes or amendments made during prosecution, *further errors are* corrected in the patent (*i.e.*, errors which render the original patent wholly or partly inoperative or invalid and which are not covered by the initial oath/declaration). A supplemental oath/declaration will be needed to cover all other errors corrected which are not covered by the initial oath/declaration. This supplemental oath/declaration must state that all errors *not covered by the original oath/declaration* arose without any deceptive intention on the part of the applicant. 37 C.F.R. § 1.175(b)(1).

(Q165) How and when should the examiner take action to obtain submission of the supplemental oath/declaration in the previous question?

Answer: As soon as a deficiency requiring a supplemental oath/declaration is noted, the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. § 251. To support the rejection, the examiner must point out why the oath/declaration failed to comply with 37 C.F.R. § 1.175 (*i.e.*, the nature of the lack of compliance with 37 C.F.R. § 1.175).

Form Paragraphs 14.01-14.01.05, 14.05.02 and 14.14 have been provided for use by the examiner in making the rejection under 35 U.S.C. § 251 and in pointing out why the oath/declaration fails to comply with 37 C.F.R. § 1.175.

Whether the supplemental oath/declaration must be submitted in reply to the Office action or if it can be deferred until the application is otherwise in condition for allowance is as follows:

(A) The supplemental reissue oath/declaration will be required to be submitted *in reply to a non-final Office action* only when a proper statement of error *was not provided in the initial reissue oath(s)/declaration(s)*. In this situation, the Office action containing the rejection under 35 U.S.C. § 251 should clearly indicate that a supplemental oath/declaration must be submitted *in reply to the Office action*. This supplemental oath/declaration is needed in order to have an oath/declaration present in the application which provides a proper statement of at least one error. Note that it is necessary to have an oath/declaration stating at least one error appropriate for reissue present in the reissue application, at least initially, in order to commence the examination process as the Office does *not* examine "no defect" reissues.

(B) The supplemental reissue oath/declaration will be required but may be deferred until *prior to allowance* when a proper statement of error *was set forth in the initial reissue oath(s)/declaration(s)*. In this situation, the Office action containing the rejection under 35 U.S.C. § 251 should point out that:

-submission of a supplemental reissue oath/declaration which obviates this rejection under 35 U.S.C. § 251 can, at applicant's option, be deferred until the application

is otherwise in condition for allowance, and

-applicant need only request that submission of the supplemental reissue oath/ declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

If applicant requests deferral of the supplemental oath/declaration submission, the examiner, in the next Office action, should (1) acknowledge applicant's request for deferral, (2) not repeat the § 251 rejection, and (3) indicate that a supplemental oath/declaration will be required at the conclusion of prosecution (prior to allowance) in order to fully comply (1) with § 1.175(b)(1), *i.e.*, provide a statement that all errors corrected (changes made) not covered by the initial oath/declaration arose without any deceptive intention on the part of the applicant, or (2) with § 1.175 (c), *i.e.*, provide a statement identifying another error being corrected, only if needed.

NOTE: When the application is placed in condition for allowance (except for the need for a supplemental oath/declaration), the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines to or cannot promptly submit the oath/declaration, the examiner should issue a *final* Office action (final rejection) setting forth the above-described rejection under 35 U.S.C. § 251 as the only rejection in the case.

If the reply which placed the application in condition for allowance was a reply to a final rejection, the examiner should issue another final rejection (stating the rejection of the insufficient oath/declaration under 35 U.S.C. § 251, and withdrawing the previous final rejection), and any amendment included within the reply should be entered. No advisory action should be issued in this instance.

(Q166) How should an applicant presently reply to *an Office action issued before December 1, 1997*, which included a rejection based on a reissue oath/declaration found to be defective as to 37 C.F.R. § 1.175 criteria in effect at the time (prior to December 1, 1997)?

Answer: Even though the reissue oath/declaration was filed prior to the December 1, 1997 effective date and the Office action also issued before the effective date, the oath or declaration will be reviewed by the examiner *under the new, amended version of § 1.175* which is presently in effect.

Accordingly, applicant should review the oath(s)/declaration(s) of record to ensure that it/they contain(s):

(1) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid-

(a) by reason of a defective specification or drawing, or

(b) by reason of the patentee claiming more or less than patentee had the right to claim in the patent.

(2) A statement of (at least) one error which can be relied upon to support the reissue application.

(3) A statement that all errors which are being corrected in the reissue application (up to the time of filing of the oath or declaration) arose without any deceptive intention on the part of the applicant.

(4) The information and statements required for compliance with 37 C.F.R. § 1.63.

If the oath/declaration contains all of the above elements (1) through (4), applicant should so indicate in the reply to the Office action, and then request that the oath/declaration be reevaluated based upon the *amended version of § 1.175* in effect on or after December 1, 1997. Such would be fully responsive to the Office action rejection of the claims based upon a defective reissue oath/declaration under 35 U.S.C. § 251 (which oath/declaration failed to comply with 37 C.F.R. § 1.175).

If the oath/declaration does not contain all of the above elements (1) through (4), applicant should submit, with the reply to the Office action, a supplemental oath/declaration providing the missing elements. In the reply, it should be pointed out how the missing elements have been provided, and then it should be requested that the oath/declaration be reevaluated based upon the *amended version of § 1.175* in effect on or after December 1, 1997. This would constitute a full reply to the Office action rejection of the claims based upon a defective reissue oath/declaration under 35 U.S.C. § 251.

It should be noted that any information as to the error contained in the reissue oath(s)/declaration(s) other than the above elements (1) through (4) will not be evaluated nor commented upon by the examiner. Accordingly, any issue as to the identification of more than one error and/or the description of how the errors arose and were discovered *should not be addressed* in the reply to the Office action, despite the fact that the examiner might have raised such an issue in the Office action issued before December 1, 1997.

Miscellaneous Issues *(Continued from Q148)*

(Q167) How do the time periods in 37 C.F.R. § 1.97 apply to a CPA?

Answer: The filing date of the CPA request is the filing date of the CPA under 37 C.F.R. § 1.97(b)(1). The mailing date of the first Office action subsequent to the filing date of the CPA request is the mailing date of the first Office action on the merits under 37 C.F.R. § 1.97(b)(3). The mailing date of a final action (37 C.F.R. § 1.113) subsequent to the filing date of the CPA request is the mailing date of a final action under 37 C.F.R. § 1.97(c)(1). The mailing date of a notice of allowance (37 C.F.R. § 1.311) subsequent to the filing date of the CPA request is the mailing date of a notice of allowance under 37 C.F.R. § 1.97(c)(2).

(Q168) Various forms, such as the CPA Request form (PTO/SB/29), have been made available to the public on the PTO Web site. Is the use of the PTO forms mandatory?

Answer: No. While the PTO forms are preferred because they encourage applicants to provide all the necessary information and are readily recognizable by PTO personnel, thereby resulting in expedited processing, applicant may use his or her version of the forms. Applicant's forms may be the same as, similar to, or very different from, the PTO forms, so long as they do not cause applicant to be non-compliant with the rules.

(Q169) The PTO previously stated that it is unnecessary to file a reply under 37 C.F.R. § 1.111 or 1.113 with a petition under 37 C.F.R. § 1.136 or 1.137 in the situation in which an extension of time or revival is sought solely for purposes of copendency with a continuing application. *See Requirement for a Response Under 37 CFR 1.136 and 1.137 Where a Continuing Application is*

Being Filed; *Official Gazette Notice*, 1031 *Off. Gaz. Pat. Office* 11 (June 14, 1983). If a CPA (or any continuing application) is not a reply under 37 C.F.R. § 1.111 or 1.113 (see Q59, Q101, and Q102), must an applicant also file a reply under 37 C.F.R. § 1.111 or 1.113 with a petition for an extension of time under 37 C.F.R. § 1.136 or a petition to revive under 37 C.F.R. § 1.137?

Answer: No. An applicant need not file a reply under 37 C.F.R. § 1.111 or 1.113 with a petition for an extension of time under 37 C.F.R. § 1.136 or a petition to revive under 37 C.F.R. § 1.137 in the situation in which the extension of time or revival is sought solely for purposes of copendency with a continuing application (including a CPA).

In 1983, each of 37 C.F.R. § 1.136 and 1.137 required a "response" (now "reply") as a condition of obtaining an extension of time or revival of an application abandoned for failure to prosecute. Because the preparation of a reply was considered a waste of resources in the situation in which the extension of time or revival is sought solely for purposes of copendency with a continuing application, the Office, in essence, waived this requirement of 37 C.F.R. § 1.136 and 1.137 when an extension of time or revival was sought solely for purposes of copendency with a continuing application.

The above-mentioned June 14, 1983 *Official Gazette Notice* has been superseded by the December 1997 amendment to 37 C.F.R. § 1.136 and the September 1993 amendment to 37 C.F.R. § 1.137. 37 C.F.R. § 1.137 was amended in September of 1993 to expressly provide that, in an application abandoned for failure to prosecute, the filing of a continuing application would meet the response/reply requirement. *See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents*; Final Rule Notice, 58 *Fed. Reg.* 44277 (August 20, 1993), 1154 *Off. Gaz. Pat. Office* 35 (September 14, 1993). 37 C.F.R. § 1.137 as amended on December 1, 1997 continues to provide that, in a nonprovisional application abandoned for failure to prosecute, the filing of a continuing application will meet the reply requirement. In addition, 37 C.F.R. § 1.136 as amended on December 1, 1997 finally eliminates its requirement that a petition thereunder for an extension of time include a response or reply, and simply provides that the failure to timely file a reply will result in abandonment of the application. That is, 37 C.F.R. § 1.136 now provides that a reply need not be filed to simply extend the period for reply to an Office action, but a reply must be filed to avoid abandonment of the application for failure to timely reply to the Office action.

Therefore, while a CPA (or any continuing application) is not a reply within the meaning of 37 C.F.R. § 1.111 or 1.113, 37 C.F.R. § 1.136 does not require that a petition thereunder include a reply to effect an extension of the period for reply to an Office action, and 37 C.F.R. § 1.137 does not require that a petition thereunder include a reply, in a nonprovisional application abandoned for failure to prosecute, so long as the application is to be revived solely for purposes of copendency with a continuing application (which may be a CPA).

(Q170) 37 C.F.R. § 1.378(c), which provides for the reinstatement of expired patents on the basis of an unintentional delay in payment of a maintenance fee, includes a twenty-four month filing period requirement while 37 C.F.R. § 1.137(b), which provides for, *inter alia*, the revival of a lapsed patent, does not contain a filing period requirement. Can a patentee avoid the twenty-four month filing period requirement in 37 C.F.R. § 1.378 by filing a petition under 37 C.F.R. § 1.137(b) to accept an unintentionally delayed maintenance fee payment and reinstate the patent?

Answer: No. While patents that expire for failure to timely pay a maintenance fee are often incorrectly referred to as "lapsed" patents, a patent "*expires*" (not "lapses") at the end of the six month grace period in 35 U.S.C. § 41(b) when the patentee fails to timely pay a maintenance fee. *See* 35 U.S.C. § 41(b). A *lapsed* patent, on the other hand, only occurs when: (1) an applicant timely pays the sum specified in the Notice of Allowance; (2) the sum specified in the Notice of Allowance is less than the issue fee (*e.g.*, due to a patent fee increase) such that there is a balance of the issue fee due; (3) the Office notifies the applicant/patentee that there is a balance of the issue fee due; and (4) the applicant/patentee fails to pay the balance of the issue fee within the three month period specified in 35 U.S.C. § 151, ¶ 3. *Since a patent does not "lapse" within the meaning of 35 U.S.C. § 151 and 37 C.F.R. § 1.137 when a maintenance fee is not timely paid*, a patentee cannot "end-run" the twenty-four month filing period requirement in 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378 by filing a petition under 37 C.F.R. § 1.137(b).

Revised March, 1998

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

PTO/SB/05 (2/98)
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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.

UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 C.F.R. § 1.53(b))

Attorney Docket No.	
First Inventor or Application Identifier	
Title	
Express Mail Label No.	

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

1. ☐ * Fee Transmittal Form *(e.g., PTO/SB/17)*
(Submit an original and a duplicate for fee processing)
2. ☐ Specification [*Total Pages* ☐]
(preferred arrangement set forth below)
   - Descriptive title of the Invention
   - Cross References to Related Applications
   - Statement Regarding Fed sponsored R & D
   - Reference to Microfiche Appendix
   - Background of the Invention
   - Brief Summary of the Invention
   - Brief Description of the Drawings *(if filed)*
   - Detailed Description
   - Claim(s)
   - Abstract of the Disclosure
3. ☐ Drawing(s) *(35 U.S.C. 113)* [*Total Sheets* ☐]
4. Oath or Declaration [*Total Pages* ☐]
   a. ☐ Newly executed (original or copy)
   b. ☐ Copy from a prior application (37 C.F.R. § 1.63(d))
   (for continuation/divisional with Box 17 completed)
   [Note Box 5 below]
      i. ☐ DELETION OF INVENTOR(S)
      Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. §§ 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference *(useable if Box 4b is checked)*
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered to be part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

ADDRESS TO: **Assistant Commissioner for Patents**
Box Patent Application
Washington, DC 20231

6. ☐ Microfiche Computer Program *(Appendix)*
7. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
   a. ☐ Computer Readable Copy
   b. ☐ Paper Copy (identical to computer copy)
   c. ☐ Statement verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

8. ☐ Assignment Papers (cover sheet & document(s))
9. ☐ 37 C.F.R.§3.73(b) Statement *(when there is an assignee)* ☐ Power of Attorney
10. ☐ English Translation Document *(if applicable)*
11. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
12. ☐ Preliminary Amendment
13. ☐ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
14. ☐ * Small Entity Statement(s) *(PTO/SB/09-12)* ☐ Statement filed in prior application, Status still proper and desired
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☐ Other: .....
.....

**** NOTE FOR ITEMS 1 & 14: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).***

17. **If a CONTINUING APPLICATION,** *check appropriate box, and supply the requisite information below and in a preliminary amendment:*
☐ Continuation ☐ Divisional ☐ Continuation-in-part (CIP) of prior application No: _____/_____

Prior application information: Examiner _____ *Group / Art Unit:* _____

18. CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *Correspondence address below*

Name					
Address					
City		*State*		*Zip Code*	
Country		*Telephone*		*Fax*	

Name (Print/Type)		*Registration No. (Attorney/Agent)*	
Signature		*Date*	

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

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FEE TRANSMITTAL

Patent fees are subject to annual revision on October 1.
These are the fees effective October 1, 1997.
Small Entity payments must be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12.
See 37 C.F.R. §§ 1.27 and 1.28.

TOTAL AMOUNT OF PAYMENT ($)

Complete if Known	
Application Number	
Filing Date	
First Named Inventor	
Examiner Name	
Group / Art Unit	
Attorney Docket No.	

METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number
Deposit Account Name

☐ Charge Any Additional Fee Required Under 37 C.F.R. §§ 1.16 and 1.17

☐ Charge the Issue Fee Set In 37 C.F.R. § 1.18 at the Mailing of the Notice of Allowance

2. ☐ Payment Enclosed:
☐ Check ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
101	790	201	395	Utility filing fee	
106	330	206	165	Design filing fee	
107	540	207	270	Plant filing fee	
108	790	208	395	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

	Extra Claims		Fee from below	Fee Paid
Total Claims		-20** =	X	=
Independent Claims		- 3** =	X	=
Multiple Dependent				=

**or number previously paid, if greater; For Reissues, see below

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
103	22	203	11	Claims in excess of 20
102	82	202	41	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	82	209	41	** Reissue independent claims over original patent
110	22	210	11	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	950	217	475	Extension for reply within third month	
118	1,510	218	755	Extension for reply within fourth month	
128	2,080	228	1,030	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,320	241	660	Petition to revive - unintentional	
142	1,320	242	660	Utility issue fee (or reissue)	
143	450	243	225	Design issue fee	
144	670	244	335	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	240	126	240	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	790	246	395	Filing a submission after final rejection (37 CFR 1.129(a))	
149	790	249	395	For each additional invention to be examined (37 CFR 1.129(b))	

Other fee (specify) _____

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($)

SUBMITTED BY				Complete (if applicable)	
Typed or Printed Name				Reg. Number	
Signature		Date		Deposit Account User ID	

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DESIGN PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 C.F.R. § 1.53(b))

Attorney Docket No.	
First Inventor or Application Identifier	
Title	
Express Mail Label No.	

ADDRESS TO:

Assistant Commissioner for Patents
Box Design
Washington, DC 20231

DESIGN V. UTILITY: *A "design patent" protects an article's ornamental appearance (e.g., the way an article looks) (35 U.S.C. 171), while a "utility patent" protects the way an article is used and works (35 U.S.C. 101). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both a design and a utility patent may be obtained on an article if invention rasides both in its ornamental appearance and its utility. For more information see MPEP 1502.01.*

APPLICATION ELEMENTS

See MPEP chapter 1500 concerning design patent application contents.

1. ☐ * Fee Transmittal Form *(e.g., PTO/SB/17)*
   (Submit an original, and a duplicate for fee processing)
2. ☐ Specification [*Total Pages* ☐]
   (preferred arrangement set forth below, MPEP 1503.01)
   - Preamble
   - Cross References to Related Applications
   - Statement Regarding Fed sponsored R & D
   - Description of the figure(s) of Drawings
   - Description, if any
   - Claim (only one (1) claim permitted, MPEP 1503.03)
3. ☐ Drawing(s) *(37 C.F.R. §1.152)* [*Total Sheets* ☐]
4. Oath or Declaration [*Total Pages* ☐]
   a. ☐ Newly executed (original or copy)
   b. ☐ Copy from a prior application (37 C.F.R. § 1.63(d))
   (for continuation/divisional with Box 15 completed)
   [Note Box 5 below]
   i. ☐ DELETION OF INVENTOR(S)
   Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. §§ 1.63(d)(2) and 1.33(b).
5. ☐ Incorporation By Reference *(useable if Box 4b is checked)*
   The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered to be part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

ACCOMPANYING APPLICATION PARTS

6. ☐ Assignment Papers (cover sheet & document(s))
7. ☐ 37 C.F.R. §3.73(b) Statement ☐ Power of Attorney
   (when there is an assignee)
8. ☐ English Translation Document *(if applicable)*
9. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
10. ☐ Preliminary Amendment
11. ☐ Return Receipt Postcard (MPEP 503)
    (Should be specifically itemized)
12. ☐ * Small Entity Statement(s) *(PTO/SB/09-12)* ☐ Statement filed in prior application, Status still proper and desired
13. ☐ Certified Copy of Priority Document(s)
    (if foreign priority is claimed)
14. ☐ Other: .....
    .....
    .....
    .....
    .....

NOTE FOR ITEMS 1 & 12: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).

15. If a CONTINUING APPLICATION, *check appropriate box, and supply the requisite information below and in a preliminary amendment:*

☐ Continuation ☐ Divisional of prior application No: _____/_____

Prior application information: *Examiner* _____ *Group / Art Unit:* _____

16. CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *Correspondence address below*

Name					
Address					
City		*State*		*Zip Code*	
Country		*Telephone*		*Fax*	

Name (Print/Type)		*Registration No. (Attorney/Agent)*	
Signature		*Date*	

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PLANT PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 C.F.R. § 1.53(b))

Attorney Docket No.	
First Inventor or Application Identifier	
Title	
Express Mail Label No.	

ADDRESS TO: **Assistant Commissioner for Patents**
Box Patent Application
Washington, DC 20231

APPLICATION ELEMENTS

See MPEP chapters 600 & 1600 concerning plant patent application contents.

1. ☐ * Fee Transmittal Form *(e.g., PTO/SB/17)*
(Submit an original, and a duplicate for fee processing)

2. ☐ Specification [*Total Pages* ☐]
(2 copies required - 37 C.F.R. § 1.163(b)
(preferred arrangement set forth below)
- Descriptive title of the Invention (with Plant's name)
- Cross References to Related Applications
- Statement Regarding Fed sponsored R & D
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings
- Detailed Botanical Description
- Claim (only one (1) permitted MPEP 1605)
- Abstract of the Disclosure

3. ☐ Color drawing(s) [*Total Sheets* ☐]
(2 copies required - 37 C.F.R. § 1.165(b))

4. Oath or Declaration [*Total Pages* ☐]
   a. ☐ Newly executed (original or copy)
   b. ☐ Copy from a prior application (37 C.F.R. § 1.63(d))
(for continuation/divisional with Box 16 completed)
[Note Box 5 below]
      i. ☐ DELETION OF INVENTOR(S)
Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. §§ 1.63(d)(2) and 1.33(b).

5. ☐ Incorporation By Reference *(useable if Box 4b is checked)*
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered to be part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

ACCOMPANYING APPLICATION PARTS

6. ☐ Plant Color Coding Sheet
7. ☐ Assignment Papers (cover sheet & document(s))
8. ☐ 37 C.F.R. §3.73(b) Statement *(when there is an assignee)* ☐ Power of Attorney
9. ☐ English Translation Document *(if applicable)*
10. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
11. ☐ Preliminary Amendment
12. ☐ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
13. ☐ * Small Entity Statement(s) *(PTO/SB/09-12)* ☐ Statement filed in prior application, Status still proper and desired
14. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
15. ☐ Other: .....
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NOTE FOR ITEMS 1 & 13: IN ORDER TO BE ENTITLED TO PAY SMALL ENTITY FEES, A SMALL ENTITY STATEMENT IS REQUIRED (37 C.F.R. § 1.27), EXCEPT IF ONE FILED IN A PRIOR APPLICATION IS RELIED UPON (37 C.F.R. § 1.28).

16. **If a CONTINUING APPLICATION,** *check appropriate box, and supply the requisite information below and in a preliminary amendment:*
☐ Continuation ☐ Divisional of prior application No: _____/_____
Prior application information: *Examiner* _____ *Group / Art Unit:* _____

17. CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* or ☐ *Correspondence address below*

Name					
Address					
City		*State*		*Zip Code*	
COUNTRY		*Telephone*		*Fax*	

Name (Print/Type)		*Registration No. (Attorney/Agent)*	
Signature		*Date*	

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

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

PTO/SB/29 (2/98)
Approved for use through 09/30/2000. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 C.F.R. § 1.53(d))

CHECK BOX, if applicable:

☐ **DUPLICATE**

Address to:

Assistant Commissioner for Patents
Box CPA
Washington, DC 20231

Attorney Docket No.	
First Named Inventor	
Examiner Name	
Group / Art Unit	
Express Mail Label No.	

This is a request for a ☐ continuation or ☐ divisional application under 37 C.F.R. § 1.53(d), (continued prosecution application (CPA)) of prior application number _____/_____, filed on _____, entitled _____.

NOTES

FILING QUALIFICATIONS: *The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. § 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. § 154(a)(2). Therefore, the prior application of a CPA may heve been filed before, on or after June 8, 1995.*

C-I-P NOT PERMITTED: *A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. § 1.53(d), but must be filed under 37 C.F.R. § 1.53(b).*

EXPRESS ABANDONMENT OF PRIOR APPLICATION: *The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. § 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.*

ACCESS TO PRIOR APPLICATION: *The filing of this CPA 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 37 C.F.R. § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.*

35 U.S.C. 120 STATEMENT: *In a CPA, no reference to the prior application is needed in the first sentence of the specification end none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 C.F.R. § 1.78(a).*

1. ☐ Enter the unentered amendment previously filed on _____ under 37 C.F.R. § 1.116 in the prior nonprovisional application.
2. ☐ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. § 1.53 (d)(4).
   a. ☐ ***DELETE*** the following inventor(s) named in the prior nonprovisional application:
      .....
      .....
   b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
   a. ☐ PTO-1449
   b. ☐ Copies of IDS Citations

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

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

PTO/SB/29 (2/98)
Approved for use through 09/30/2000. OMB 0651-0032
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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS (37 C.F.R. § 1.16(c) or (j))	-20* =		x $_____ =	$
	INDEPENDENT CLAIMS (37 C.F.R.§1.16(b) or (i))	-3** =		x $_____ =	
	MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d))			+ $_____ =	
				BASIC FEE (37 C.F.R. §1.16)	
				Total of above Calculations =	
	Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27 & 1.28).				
	* *Reissue claims in excess of 20 and over original patent.* ** *Reissue independent claims over original patent.*			TOTAL =	

6. Small entity status:
   a. ☐ A small entity statement is enclosed, if (b) and (c) do not apply.
   b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
   c. ☐ Is no longer claimed.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. _____-_____:
   a. ☐ Fees required under 37 C.F.R. § 1.16.
   b. ☐ Fees required under 37 C.F.R. § 1.17.
   c. ☐ Fees required under 37 C.F.R. § 1.18.
8. ☐ A check in the amount of $_____ is enclosed.
9. ☐ Other: .....

.....

NOTE: ***The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.***

10. NEW CORRESPONDENCE ADDRESS

☐ *Customer Number or Bar Code Label* *(Insert Customer No. or Attach bar code label here)* *or* ☐ *New correspondence address below*

Name					
Address					
City		*State*		*Zip Code*	
Country		*Telephone*		*Fax*	

11. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	
Signature	
Registration No. (Attorney/Agent)	
Date	

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

PTO/SB/50 (2/98)
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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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REISSUE PATENT APPLICATION TRANSMITTAL

Address to:
Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

Attorney Docket No.	
First Named Inventor	
Original Patent Number	
Original Patent Issue Date (Month/Day/Year)	
Express Mail Label No.	

APPLICATION FOR REISSUE OF: (check applicable box) ☐ Utility Patent ☐ Design Patent ☐ Plant Patent

APPLICATION ELEMENTS

1. ☐ * Fee Transmittal Form *(PTO/SB/56)* *(Submit an original, and a duplicate for fee processing)*
2. ☐ Specification and Claims (*amended, if appropriate*)
3. ☐ Drawing(s) *(proposed amendments, if appropriate)*
4. ☐ Reissue Oath / Declaration (original or copy) *(37 C.F.R. § 1.175)(PTO/SB/51 or 52)*
5. Original U.S. Patent
   - ☐ Offer to Surrender Original Patent *(37 C.F.R. § 1.178)* *(PTO/SB/53 or PTO/SB/54)*
   - or
   - ☐ Ribboned Original Patent Grant
   - ☐ Affidavit / Declaration of Loss *(PTO/SB/55)*
6. Original U.S. Patent currently assigned?
   - ☐ Yes ☐ No

   (If Yes, check applicable box(es))
   - ☐ Written Consent of all Assignees *(PTO/SB/53 or 54)*
   - ☐ 37 C.F.R. § 3.73(b) Statement ☐ Power of Attorney

ACCOMPANYING APPLICATION PARTS

7. ☐ Transfer drawings from Patent File
8. ☐ Foreign Priority Claim *(35 U.S.C. 119)* *(if applicable)*
9. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
10. ☐ English Translation of Reissue Oath/Declaration *(if applicable)*
11. ☐ * Small Entity Statement(s) *(PTO/SB/09-12)* ☐ Statement filed in prior application, Status still proper and desired
12. ☐ Preliminary Amendment
13. ☐ Return Receipt Postcard *(MPEP 503)* *(Should be specifically itemized)*
14. ☐ Other: .....

[redacted]

15. CORRESPONDENCE ADDRESS

☐ Customer Number or Bar Code Label *(Insert Customer No. or Attach bar code label here)* or ☐ Correspondence address below

Name					
Address					
City		State		Zip Code	
Country		Telephone		Fax	

NAME (Print/Type)		Registration No. (Attorney/Agent)	
Signature		Date	

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