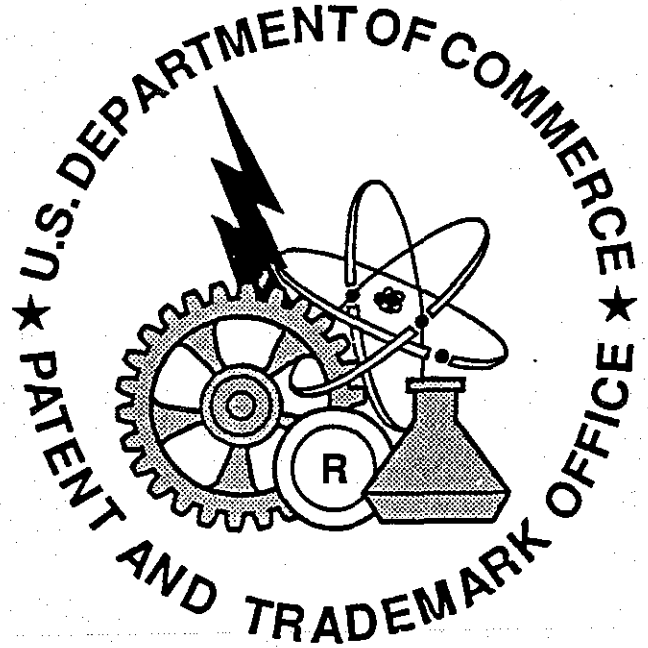
PTO

HELPFUL HINTS



OCTOBER 1992

U.S. DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

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PTO Helpful Hints

1. APPEALS

a. Appeal Briefs to the Board of Patent Appeals and Interferences

Briefs filed in appeals to the Board of Patent Appeals and Interferences must comply with 37 CFR 1.192(c) which requires that the brief contain at least the following headings, in the order indicated, and narratives as explained therein and elaborated upon in MPEP Section 1206:

- Status of Claims
- Status of Amendments
- Summary of Invention
- Issues
- Grouping of Claims
- Argument - Each issue presented for review should be treated under the following headings, as appropriate:
  - 35 U.S.C. Section 112, first paragraph
  - 35 U.S.C. Section 112, second paragraph
  - 35 U.S.C. Section 102
  - 35 U.S.C. Section 103
  - Other Rejections
- Appendix - A clean copy of the claims, preferably double spaced, involved in the appeal.

37 CFR 1.192(d) provides that if a brief is filed which does not comply with the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance and given a one-month time limit within which to file an amended brief.

If the applicant does not file an amended brief within the one-month period, or files an amended brief which does not overcome all the reasons for noncompliance stated in the notification, the appeal will be dismissed.

b. Appeal Fees In Patent Cases

Appeal fees deficiencies are frequent, causing necessity for extension fees to cover the additional time consumed in making up the appeal fee deficiency. Ensuring proper payment at time of filing appeal papers which require fees will save money and time.

c. Notices of Appeal to the United States Court of Appeals for the Federal Circuit

Notices of appeal to the United States Court of Appeals for the Federal Circuit should be sent to the Solicitor at the address below:

Solicitor
Box 8
U.S. Patent and Trademark Office
Washington, DC 20231

Improperly addressing such communications, e.g. to the examining groups, may delay delivery to the Solicitor.

2. APPLICATION FILES

a. Requests for Allowed Patent Application Files

Applicants or attorneys requesting files from the Publishing Division, Office of Publication and Dissemination, should make their request at least twenty-four hours in advance to ensure file availability. Attention is especially directed to out-of-town requesters who visit the Office, anticipating same day service. Although the Office is usually able to respond promptly, unexpected inconvenience can be avoided if arrangements are made in advance.

Inquiries and requests should be directed to the Correspondence Section at (703) 305-8497 or (703) 305-8322 between the hours of 8:30 AM through 5:00 PM on weekdays.

b. Returning Files to the File Information Unit (FIU)

Customers are reminded that file histories obtained through the FIU are official government records which must not be removed from the confines of the Patent Search Room at any time. Such files must be returned to the File Information Unit by 7:45 PM on the same day they are obtained.

FIU personnel will continue to periodically monitor compliance. Should individual patterns of abuse be discerned, administrative sanctions up to termination of access privileges may be applied.

3. APPLICATION PAPERS FOLLOWING FILING OF NEW APPLICATIONS

a. Drawings - Proper Identification of Formal or Substitute Drawings

When the Office receives formal or substitute drawings for patent applications, a cover letter identifying the drawings by application number should accompany them. The application number should be placed on each sheet of drawing in accordance with 37 CFR 1.84(l). It is impossible to associate the drawings with the files when this information is missing.

Identifying indicia should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call. This information should be placed on the back of each sheet of drawings with a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page.

b. Drawings - Timeliness of Submission of Corrected Drawings in Allowed Cases

When drawings need to be corrected in an allowed patent application, the applicant is required to submit acceptable corrected drawings within a three-month shortened statutory period. Within that three-month period, two weeks should be allowed for review of the correction by the Office. If a correction is determined to be unacceptable by the Office, the applicant must arrange to have an acceptable correction resubmitted within the original three-month period to avoid the necessity of obtaining an extension of time and of paying the extension fee. Therefore, the applicant should file corrected drawings as soon as possible following the setting of the three-month shortened statutory period.

Corrected drawings, as well as the issue fee should be addressed to Box Issue Fee. Note that any assignment document should be submitted in a separate envelope, addressed to Box Assignment.

Each piece of correspondence should carry its own certificate of mailing. For example, drawings should have a certificate of mailing and the issue fee should have a certificate of mailing.

c. Information Disclosure Statements

If an information disclosure statement is to be filed before an Office action, it would be greatly appreciated if it were filed with the application. Some Group Art Units have greatly reduced the pendency to first action. Hence, many examiners are taking up new applications before an information disclosure statement is matched with the application.

d. Papers Related to Patent Applications

When a document concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, either the application number (consisting of the series code and the serial number, e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. No papers related to a new patent application should be filed in the Office prior to

receipt of this information. [37 CFR 1.5(a)] Any correspondence not containing either the application number or the serial number and filing date will be returned to the sender when a return address is available. Those papers which do not contain the required information and which have been in the Office for six months will be destroyed.

The rule provides that if the correspondence is remailed to the PTO within two weeks of the mailing date of the PTO's cover letter returning the correspondence, the PTO will grant the benefit of the original date of receipt of the returned correspondence. If for some reason returned correspondence is resubmitted later than two weeks after the return mailing by the PTO, the resubmitted correspondence will be accepted, but given its date of receipt.

e. Papers Related to Trademark Applications

For all papers related to trademark applications, the word "Trademark" and the series code/serial number should be placed in the upper right-hand corner of the document. Also, please set forth the applicant's name, filing date, law office, examining attorney, and mark.

f. Papers With No Particular Time Requirement

Patent and trademark documents which have no particular time or sequence requirements should be filed with materials submitted in response to the statutory or regulatory requirements. Examples are certified copies of foreign documents to support priority in patent applications, changes of Power of Attorney, or changes in Mailing Address following first action.

g. Request to Delay Action in Patent Cases

A request that action in an application be delayed will be granted only under the provisions of 37 CFR 1.103, which provides for "Suspension of Action." A petition for suspension of action must be presented as a separate paper accompanied by the petition fee, must request a specific and reasonable period of suspension not greater than six months, and must present good and sufficient reasons why the suspension is necessary. If the requirements of 37 CFR 1.103 are not met, applicants should expect that their applications, whether new or amended, will be taken up for action by the examiner in the order provided in 37 CFR 1.101, Order of Examination.

A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 CFR 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner.

In new applications, the mere inclusion in the transmittal form or letter of a request that action be delayed cannot be relied upon to avoid immediate action in the application. Many Group Art Units and examiners have greatly reduced the pendency to first action, and many new applications are being taken up for action before preliminary amendments are filed in those applications. Where a preliminary amendment and petition to suspend action have been filed, it would be helpful to telephone the examiner in that regard to avoid crossing in the mails of the amendment and the first office action. If you have any questions, please call Al Smith, (703) 308-1020.

h. Response to Final Rejection In Patent Applications - Expediting Processing

See section under MAIL.

i. Separation of Various Application Papers

In patent applications, requests for extensions of time, changes of address, proposed drawing corrections, and petitions are sometimes incorporated, improperly, in the remarks section or at the beginning of papers entitled "Amendment" or "Response." In trademark applications, change of address and powers of attorney are sometimes incorporated, improperly, in the remarks section or at the beginning of papers entitled "Amendment" or "Response." Please present such items in separate papers, appropriately titled, since they are all handled by different personnel [37 CFR 1.4(c)].

j. Transmittal Letters for Deposit Account Charges

When statutory fees are to be charged to a deposit account, the processing of the application can be facilitated by submitting the applicant's transmittal letter or other correspondence specifying the account to be charged in triplicate. Submission of these documents in triplicate will eliminate the need for the Mail Room to photocopy the document and will thereby reduce the processing time of incoming mail.

4. ASSIGNMENTS

a. Assistance

Customers are encouraged to call the Assignment Branch Status Section (703-308-9723/9724) with questions regarding procedure, fees or status of the document submitted.

b. Cover Sheet Requirement

Effective September 4, 1992, all documents submitted to the Assignment Branch must include a cover sheet comprised of the following:

1. The name of the conveying party (assignor)

2. The name and address of the receiving party (assignee);

3. A description of the interest conveyed or the transaction recorded;

4. Each application number (including series code and serial number or serial number and filing date), patent number or registration number;

5. The name and address of the party to whom the correspondence concerning the request to record the document should be mailed;

6. The number of applications, patent, or registrations identified in the cover sheet and the total fee;

7. The date the document was executed;

8. An indication that the assignee of a trademark application or registration who is not domiciled in the United States has designated a domestic representative;

9. A statement by the party submitting the document that to the best of a person's knowledge and belief, the information contained on the cover sheet is true and correct and any copy submitted is a true copy of the original document; and

10. The signature of the party submitting the document.

° A cover sheet must accompany each transaction submitted.

° Documents that have more than one transaction within the document must submit a separate cover sheet for each transaction.

° Documents comprised of a patent and trademark in the same document must have a cover sheet for patents and one for trademarks.

° Patent documents must be accompanied by a patent cover sheet.

° Trademark documents must be accompanied by a trademark cover sheet.

° The standard cover sheet may be obtained by calling the Public Service Center Branch at 703-308-HELP.

c. Legibility of Documents and Paper Requirements

° All documents submitted must be used on one side. Two sided documents are not acceptable for recording.

- All documents must be legible.

- Only one cover sheet is required for each transaction. Do not send duplicates.

d. Corrections in Recorded Documents

When correcting errors in recorded documents the following procedures should be used:

- If documents were recorded before September 4, 1992, there are two ways to correct a recorded document:

  1. A newly executed document must be submitted with the correct information. The Transmittal letter should indicate the recorded reel and frame number; or

  2. The original document is submitted with handwritten or typed corrections initialed and dated. A line must be drawn through the error on the original document.

- If the document was recorded after September 4, 1992, a newly executed cover sheet must be submitted along with the original recorded document along with the required fee of $40 per property for a patent. A $40.00 fee for the first property and $25.00 for each additional property is required for trademarks.

e. Procedures for Correcting Non-recordable Documents

- Non-recordable documents that are resubmitted will receive the original mailroom date if the document is returned within one month from the date of the non-recordation notice. This rule does not apply to documents returned for lack of an application, patent or registration number.

f. Routing of Assignment Documents

- Assignments should be sent to the following special box address unless they are filed concurrently with a new application or filed with a petition under 37 CFR 3.81(b).

  Commissioner of Patents and Trademarks
  Box Assignments
  Washington, D.C. 20231

- All hand deliveries must be submitted to the PTO mailroom to avoid improper routing. Do not submit assignment documents to the Examiner.

g. Trademark Registrations - Ensuring Correct Printing

To ensure the correct printing of ownership information on a Trademark Registration at issue date, provide the trademark examining attorney with the reel and frame number of the ap-

propriate assignment document as soon as you are notified of it.

5. CERTIFICATES OF CORRECTION

a. Accurate Requests

Many requests for "Certificate of Correction" result from a perfunctory comparison of the issued patent with the attorney's application file, without investigating whether the recitation in the issued patent is correct. In many instances, change to the PTO file wrapper has been caused by the examiner prior to printing of the patent in order to make appropriate corrections to the file.

6. CERTIFICATION SERVICES

a. Expedited Service for Patent and Trademark Applications-As-Filed

Expedited certification service is available only for patent and trademark applications-as-filed. Expedited requests are filled within seven calendar days, excluding mailing time. A request for expedited service may be obtained by paying the appropriate fee and sending your request to Box 10, Commissioner of Patents and Trademarks, Washington, D.C. 20231. A request for expedited service may also be obtained by handcarrying your request to the Assignment & Certification Services Division, (North Tower, 10th Floor Lobby) or to the Public Service Window in either the Patent Search Room or the Trademark Search Library. When submitting requests for expedited certified copies of patent applications-as-filed, please include only one application number on one request. Orders with a number of individual application numbers often result in one or more applications requiring special research or handling which can slow the process.

Please refrain from using the words such as "rush" or "special" and only use the term "expedite" when you have requested and paid for seven calendar day expedited service.

b. Methods of Ordering

Mail Orders: The address for mail orders is:

Box 10
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-carried Orders: Hand-carried requests for certification service may be taken to the Public Service Window in either the Patent Search Room or the Trademark Search Library where they

can be placed in the Certification Order Receipt Box or given to the attendant, or they may be taken to the Assignment/ Certification Services Division, North Tower, 10th Floor Lobby. For security reasons, the public is not permitted access to the Certification Branch itself.

c. Processing Time

The current goal for furnishing certified copies of applications-as-filed is 17 days from receipt in the Mail Room of the Patent and Trademark Office to mailing of the completed order by the Certification Branch. The 17 days includes 4 work days for Mail Room and Finance processing, 9 work days in the Certification Branch and 4 weekend days that accrue over the 13 work days.

As a rule, copies are prepared from microfiche of applications-as-filed available in the Certification Branch. The microfiche for a small percentage of the total orders for certified copies of applications-as-filed must be retrieved from a remote location, or be replaced due to damage or correction. While every effort will be made to fill these orders within 17 days, delays may occur. Customers will be advised of unusual problems promptly.

d. PTO versus Public-Supplied Copies for Certification

Requests for certified copies of patent and trademark applications-as-filed will be filled with PTO supplied copies of original source documents. No public supplied copies will be accepted for these requests. Local customers may supply copies of file wrappers or selected papers from the file, along with the file itself, and request that their copies be compared and certified.

e. Questions Frequently Asked

Q: What does "certified" mean?
A: Authentication of copies by ribbon and seal of the PTO with the signature of an officer authorized by the Commissioner of Patents and Trademarks.

Q: What does a patent application-as-filed consist of?
A: (1) Written Description (2) Claims and (3) Drawings, when necessary.

Q: What does a file wrapper and contents (file history) consist of?
A: The original application papers plus all correspondence between the applicant/attorney of record/assignee and the PTO.

Q: Why are certified copies of applications-as-filed required?
A: Since the rights granted by a U.S. patent extend only throughout the territory of the U.S. and have no effect in a foreign country, an inventor who wishes patent protection in other countries must submit a certified copy of his or her U.S. application when applying for a patent in that country in order to receive the benefit of the U.S. filing date.

Q: What regulations govern the filing of an U.S. application in a foreign country?
A: There is a treaty relating to patents which involves 100 countries and is known as the Paris Convention for the Protection of Industrial Property. It provides that each country guarantees to the citizens of other countries the same patent rights that it gives to its own citizens.

Q: Can anyone request a copy of a pending application?
A: No. Pending applications are preserved in secrecy. No information or copies may be obtained without written authority of the applicant or the owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

Q: Can orders for copies be placed by phone?
A: No. All orders must be in writing.

Q: May office copies of my application be sent to the PTO for certification?
A: No. We do not certify copies prepared outside the PTO.

Q: Will the PTO mail certified copies ordered directly to a foreign country?
A: No. With respect to the exportation of technical data, the PTO discontinued the practice of forwarding direct to any foreign country certified copies of U.S. applications ordered by residents of the United States.

Q: Are cited references in a file automatically furnished when a file wrapper and contents is requested?
A: No. Cited references are not automatically included as papers comprising the file history. References cited are furnished only if located within the file wrapper.

Q: Can cited references, when requested, be certified with the file wrapper and contents under one certificate?
A: No. Each reference must be certified separately.

Q: Are there instances when references are included in a file wrapper and contents?
A: Yes. If the references are submitted as attachments to a response from the applicant and if such response is entered and made a part of the file.

Q: Exclusive of applications-as-filed and file wrappers and contents of patented files, what other types of copies may be obtained from the Certification Branch?

A: The following items may be obtained:

- Certified copies of issued U.S. patents.
- Certified copies of foreign patents.
- Certified copies of publications from the Scientific Library.
- Certified copies of Office letters.
- Certified duplicate filing receipts.
- Copies of disclosure documents.
- Copies of the following files:
  - ° Defensive publication files.
  - ° Reexamination files.
  - ° Interference files.
  - ° Trademark files.
  - ° Opposition files.
  - ° Concurrent use proceedings files.
  - ° Statutory Invention Registration.
  - ° Certified copies of assignment documents.
  - ° Abstract of title. Copies of issued certificates of registration; updated registration certificates, and amendments to registrations can be obtained from Trademark Services Division.

f. Requests for Certification Services

Use Complete Application Number - When ordering certified copies of patent and trademark applications, please identify the document by its complete application number. The application number includes the two digit series code (Examples: patent - 06, 07; trademarks - 73, 74) and six-digit serial number. The filing date and inventors/applicants' names may also be included.

Authorization to Order Certified Copies of Applications-as-Filed - When requesting a certified copy of a patent application-as-filed, if either the attorney of record has changed since filing or a power to inspect has been filed, please provide a copy of the new power of attorney or the power to inspect. The Certification Branch prepares the bulk of certified copies of applications as filed from microfiche that contains information pertaining to the attorney of record at the time of filing. When a change in attorney of record is made, or when a power to inspect has been filed, this information is not readily available to the Certification Branch unless it is provided with the request.

Ordering Different Products from Certification Branch - When ordering copies from the Certification Branch, whenever possible request only one type of service per order to speed processing. Example: a request for a copy of a patent application-as-filed should be separate from a request for a patent file wrapper and contents.

g. Status Requests or Problems

For status inquiries, call the Special Handling Section of the Certification Branch at (703) 308-9723. For problem situations, call the Manager of the Certification Branch, at (703) 308-9700.

7. EXTENSIONS OF TIME IN PATENT CASES

a. Appropriateness

After a final rejection, where applicants' approval is not needed for an examiner's amendment, no extension of time is required. However, if applicants' approval is required for an examiner's amendment to be made and applicants did not file their response within two months of the Final Rejection, the appropriate extension of time fee must be paid.

Extensions of time by fee payment under 37 CFR 1.136(a) are appropriate for filing of the Brief on Appeal in regular applications. No more than four months may be granted under 37 CFR 1.136(a). Beyond those four months, any further request must show sufficient cause under 37 CFR 1.136(b), and no additional extension fee is required.

An extension of time is not required in order to hold an interview with the examiner. However, after the period for response has ended, an extension is required for the purpose of filing a follow-up amendment by applicant and/or for the entry of an Examiner's Amendment requiring approval of the applicant.

Extensions of time are appropriate for the purpose of achieving continuity between parent and continuing applications. A separate paper requesting the extension of time must be filed in the parent application. It would be useful to file a copy of that request or petition with the papers constituting the filing of the continuing application.

b. Extensions of Time Under 37 CFR 1.136(a)

Under 35 U.S.C. 41(a)(8) and 37 CFR 1.136(a), a response filed within a statutory period but outside of the period set for response may be rendered timely if accompanied by (1) a petition for an extension of time and (2) the appropriate extension fee. Experience indicates that there have been differing opinions as to the language necessary to constitute an acceptable extension of time petition. This Helpful Hint is intended to clarify the policy of the Patent and Trademark Office concerning the language required for such a petition.

An extension of time under §1.136(a) requires a petition therefor and payment of the appropriate fee. The §1.136(a) petition should explicitly request in writing an extension of

time for the specific number of months needed as explained in §710.02(e) of the Manual of Patent Examining Procedure. This is the best way to avoid mistakes by the applicant or by the Patent and Trademark Office and assure orderly and efficient processing of the petition.

The following language is an example of a preferred §1.136(a) request:

> Applicant petitions the Commissioner of Patents and Trademarks to extend the time for response to the Office action dated for_____month(s) from _____ to _____.
>
> [If paying by check:]
>
> Submitted herewith is a check for _____ to cover the cost of the extension. (Optionally, add: Any deficiency or overpayment should be charged or credited to deposit account number _____. A triplicate copy of this sheet is enclosed.)
>
> [If paying by charge to deposit account number:]
>
> Please charge my deposit account number _____ in the amount of _____ to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to this deposit account.

Applicants are cautioned that, in order to be timely, a response must be accompanied by a specific reference to an extension of time. A general authorization under 37 CFR 1.25(b) to charge necessary fees to a deposit account will not be interpreted as a petition for an extension of time. For example, a response accompanied by the statement "Please charge any fees necessary under 37 CFR 1.17 to my deposit account" would not be acceptable, since the statement does not make specific reference to an extension of time.

As previously indicated, a proper §1.136(a) petition must be in writing. However, when an extension of time is necessary to make an Examiner's Amendment timely, the extension may be obtained by way of a verbal communication. The verbal communication must be transcribed as a written part of the official application file record. For example, during a telephone interview with an examiner, an attorney for the applicant, in order to render an Examiner's Amendment timely, may verbally request an extension of time under 37 CFR 1.136(a) and authorize a charge of the appropriate fee to his or her deposit account. If this verbal request and authorization are transcribed as a written part of the application file record (e.g., via the Examiner's Amendment or an Examiner Interview Summary Record, PTOL-413), the desired extension of time may be obtained. The filing date of the §1.136(a) petition and fee

will be considered the date of the verbal request and authorization if this date is reflected in the written file record.

c. Instances Not Permitted

An extension of time under 37 CFR 1.136(a) is not permitted in the following instances:

- Where an applicant is so notified in an Office action as, for example, in a Reissue application involving a litigated patent.
- Where the application is involved in an interference declared pursuant to 37 CFR 1.611. See 37 CFR 1.645 for provisions governing extensions of time in interference proceedings.
- Where the response is to a decision by the Board of Patent Appeals and Interferences pursuant to 37 CFR 1.196, 1.197 or 1.304.
- In reexamination proceedings. See 37 CFR 1.550(c) for extensions of time in reexamination proceedings.
- In PCT international applications. See PCT Rule 26.2 for extensions for correction of PCT Article 14 defects in international applications before the Receiving Office.

d. Insufficient Fees

Many requests for extension of time are being filed with insufficient fees. In those instances where there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned.

If applicants have a deposit account, it is recommended that applicants file, in an individual application, a general authorization to charge any of the fees set forth in 37 CFR §§ 1.16 to 1.18 to a deposit account for the entire pendency of the application.

e. Policy

Where an extension of time is required to file a response in a timely manner, the response is not considered complete until the response, fee, and request or petition for an extension of time are received. The fee and request or petition must be filed before the expiration of the extended period requested. The fee cannot be paid outside the statutory six-month limit for the period of response.

f. Requirement for Request or Petition for Extension

Submission of the appropriate extension fee under 37 CFR 1.136(a) is to no avail unless a request or petition for extension is filed. The request or petition must be made in response to a particular office action, i.e., a generic request filed with the application for any extensions of time later needed in the application will not be accepted. Frequently, the request is omitted, which then requires an additional extension fee to cover the period to the date of the request. Occasionally, the application is held abandoned because the six month maximum statutory period has expired before detection of the omission of the request for extension. It is critical that a paper specifically requesting the extension be filed with late responses. It is also wise to use the Certificate of Mailing practice under 37 CFR 1.8 when requesting extensions.

g. Response to Final Rejection - Avoiding Extension Fees

In patent applications wherein a three month shortened statutory period (SSP) is set for response to a Final Rejection, the response would best be filed within two months of the date of the Office Action. In the case of a first response after Final Rejection, filed within two months, any Advisory Action addressing that response, which is mailed after the three month SSP expires, will reset the SSP to expire on the date of the Advisory Action for extension fee purposes, but never more than six months from the date of the Final Rejection.

h. Supplemental Amendments

If a timely and complete response has been filed after a Non-Final Office Action, an extension of time is not required to permit filing and/or entry of an additional amendment after expiration of the shortened statutory period.

If a timely response has been filed after a Final Rejection, an extension of time is required to permit filing and/or entry of a Notice of Appeal or filing and/or entry of an additional amendment after expiration of the shortened statutory period unless the timely-filed response placed the application in condition for allowance. Of course, if a Notice of Appeal has been filed within the shortened statutory period, the period for response to the Final Rejection has ceased to run.

8. FEES

The latest fee schedule can be obtained by contacting the Public Service Center at (703) 308-4357.

9. FILES

a. Official Searches

When requesting an official search for a lost patent or trademark file, please ensure that all pertinent information is completely filled out on the PTO Form 1216. In the case of an individual working for a particular firm, the firm's name should be included in block number 5 of the form along with the name of the requester. If you have any questions in this matter please call the Supervisor, Official Search Unit, on (703) 308-7015.

b. Requests for Reconstruction

To request the reconstruction of a file, submit a written request along with a notice from the PTO Official Search unit stating that the file cannot be located.

c. Requests for Trademark Files

To eliminate unnecessary delays when ordering Trademark files, requesters should complete all required information blocks on form PTO-1538 (Order and Charge for Trademark Files). Failure to properly complete the form is the primary reason for requests not being quickly processed. Submitting a completed form will reduce the number of requests that have to be returned and thus reduce the overall time required to fill the request.

10. FILING RECEIPTS FOR PATENT APPLICATIONS

a. Docket Numbers

Docket numbers must be limited to a maximum of 12 characters to prevent truncation. The Patent Application Location and Monitoring (PALM) system data base allows a maximum of 12 characters for the attorney's docket numbers. Spaces, slashes and hyphens will no longer be included in the entered docket number on the official filing receipt. In an application where CASE or NAVY-CASE appears before the first character in the docket number, only the characters after CASE or NAVY-CASE will be entered on the official filing receipt.

b. License to Foreign File

Each newly filed patent application is routinely reviewed for security interests during pre-examination processing. A code is entered into the data base to indicate the presence or absence of security interests. When no security interests are found, the filing receipt will be generated with the notation "Foreign license granted xx/xx/xx." There is no additional cost for this security screening and license notation.

c. Residence of Applicant

The residence of applicant should be indicated as city and state for United States residents and city and country for residents of foreign countries. The Patent Application Location and Monitoring (PALM) System data base allows a maximum of 15 characters for the city of residence. If the city name is longer than 15 characters, it will be truncated in the data base and appear in the shortened form on the filing receipt. However, the entire city name will be taken from the file and printed on any patent that issues.

Please do not call or write the Office for a corrected filing receipt should the printed city name be cut short due to the 15-character limit.

Often applicants who are residents of foreign countries indicate street address, sections of cities, provinces or other political divisions as part of their cities of residence. This leads to confusion and possible erroneous entries in the data base. Only the foreign city and country should be indicated as the applicant's residence.

11. INTERNATIONAL APPLICATIONS FILED UNDER THE PATENT COOPERATION TREATY

a. Responses Filed in International Applications

The 18-month publication deadline for international applications filed under the Patent Cooperation Treaty (PCT) is critical. Therefore, it is in applicant's interest to respond timely to an invitation to correct a PCT Article 14 defect (Form PCT/RO/106). An untimely response can result in the withdrawal of the international application under Article 14 and PCT Rule 26. The PTO will comply with PCT Article 14 and Rule 26 in holding international applications withdrawn when responses are untimely or not filed.

b. Oath or Declaration

The U.S. Patent and Trademark Office is continuing to receive oaths or declarations for applications entering the national stage of the Patent Cooperation Treaty under 35 U.S.C. 371, which do not comply with the rules and regulations. The statute requires at 35 U.S.C. 371(c)(4): "an oath or declaration of the inventor... complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants." Applicants are reminded that oaths or declarations filed pursuant to 35 U.S.C. 371(c)(4) must strictly adhere to the requirements set forth in 37 CFR 1.497 and 1.63. The following are examples of the most common defects:

- The oath or declaration fails to adequately identify the specification to which it is directed (see MPEP § 601.01).
- The oath or declaration fails to identify each inventor and the residence and country of citizenship of each inventor.
- The oath or declaration fails to identify the foreign application for patent on which priority is claimed by specifying the application number, country, day, month and year of its filing.

Failure to file an oath or declaration in compliance with the above noted provisions results in abandonment as provided by 35 U.S.C. 371(d).

12. INTERVIEWS WITH PATENT EXAMINERS

a. Appropriateness

Prior to filing, no interview is permitted; only search assistance may be given to the attorney, searcher or inventor.

Prior to first action, an interview is ordinarily granted only in continuing or substitute applications; a request for an interview is untimely and will not be granted prior to first action in all other applications.

After final rejection, an interview will not be denied merely because final Office action has been rendered. Normally, one interview after a final rejection is permitted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. In requesting an interview after final rejection, the intended purpose and content of the interview must be presented briefly, either orally or in writing. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied.

After a case is sent to issue, it is technically no longer under the jurisdiction of the primary examiner (37 CFR 1.312). Requests for interviews on cases already passed to issue should be granted only with specific approval of the Group Director upon a showing in writing of extraordinary circumstances.

The ideal time for personal interviews, during which time an interview is clearly available, is the "Conference Period", which is the time between the filing of applicant's thorough first response to the examiner's first action on the merits and a concluding action by the examiner.

In reexamination proceedings, an interview with the owner is permitted after first action. Requests that reexamination requesters be permitted to participate in or attend interviews will be denied.

When an interference has been declared, all questions involved are to be determined inter partes and will not be discussed ex parte.

Following the grant of a United States Patent, an examiner must refuse to express any opinion or view as to the invalidity of the patent, except on the record in the course of examining a reissue application or a reexamination proceeding. Even in the case of search assistance on an invention, if an examiner is aware that the invention has been patented in the United States, the searcher will be referred to the prosecution file history, and the examiner will make no comment on the appropriateness of the search conducted or the references cited.

Should any examiner fail to comply with the above guidelines, the matter would best be brought to the attention of the examiner's Group Director.

Direct questions to: Al Lawrence Smith
Director, Group 350
(703) 308-1020

b. Prohibitions

No interview will be conducted with an attorney who is not registered or who has been suspended or excluded from practice regarding an application unless the attorney is the applicant in the application.

Protestors are not permitted to participate in interviews, and the examiner will not communicate in any manner with such protestors.

13. MAIL

a. Certificate of Mailing - Separate Certificate for F ch Document

Practitioners and other are reminded of the requirement of MPEP 512(D) which state: "In situations wherein the correspondence includes papers for more than one application (e.g., a single envelope containing separate papers responding to Office actions in different applications) or papers for various parts of the Office (e.g., a patent issue fee transmittal form PTO-85 and an assignment), each paper must have its own certification as a part thereof or attached thereto." Although form PTOL-85b, Issue Fee Transmittal, may contain a Certificate of Mailing thereon, a separate Certificate of Mailing is required for all papers included with this form, including formal drawings, since papers are separated and flow to different areas of the Office. Checks submitted with papers do not require a Certificate of Mailing.

b. Certificate of Mailing AND Return Postcard

Use of the Certificate of Mailing Procedure is strongly encouraged.

37 CFR 1.8(a) provides for the use of a Certificate of Mailing on most correspondence with the PTO, whereby the correspondence (and/or fee) will be considered as timely filed if deposited with the U.S. Postal Service within the set time period. Consistent use of this procedure is extremely beneficial to practitioners, whether or not the Postcard Receipt provision of MPEP 503 is used.

In those instances where the PTO never receives the correspondence, no postcard receipt will be available to evidence the filing and/or timeliness of the correspondence. However, in those instances where a Certificate of Mailing is properly used, 37 CFR 1.8(b) provides relief, even if the correspondence is not received in the PTO at all. Under 37 CFR 1.8(b) the party who forwarded the correspondence need only (1) inform the PTO of the previous mailing of the correspondence, (2) supply a copy of the previously mailed correspondence and Certificate, and (3) include a declaration which adequately attests to the previous timely mailing.

c. Change of Correspondence Address

The Patent and Trademark Office's responsibility is to assure office correspondence reaches the correspondent's address of record. Studies conducted of mail returned to the PTO from the United States Postal Service (USPS) as undeliverable indicate that the majority of this mail is not delivered due to the expiration of a forwarding order placed with the USPS.

Whenever the correspondence address for a patent, patent application, registered trademark or trademark application changes, the applicant or his/her representative needs to submit a change of address (See Section 601.03 of the Manual of Patent Examining Procedures and Section 603 of the Trademark Manual of Examining Procedures). The mere inclusion of a new correspondence address in a paper being filed for another purpose would not ordinarily be recognized or deemed as instructions to change the address on the file record.

Although a change of correspondence address notification need take no particular form, a separate notification must be filed for each application. At a minimum, the following information should be provided:

- Identify the document as a "Change of Address"

- Present the new correspondence address

- For a registered trademark: Provide the registrant's name and the number and date of the certificate.

- For a trademark application: Provide the name of the applicant, the serial number and filing date of the application, along with the Trademark law office in which the case is pending. See Trademark Rule 1.5.

- For a patent: State the patent number and serial number

- For a national patent application: Identify the application number (consisting of the series code and the serial number (e.g., 07/123,456); or the serial number and filing date assigned to that application by the PTO. In addition, provide the group art unit where the application is pending or other unit prosecuting the application (e.g., the Board of Patent Appeals and Interferences).

- For an international application: Identify the international application number (e.g., PCT/US92/11111)

For patents and patent applications, as required by 37 CFR 1.33(a), a change of correspondence address notification must be signed by an attorney or agent of record or the applicant unless the assignee of record has intervened as provided by 37 CFR 3.71. In those instances where a change of address of a registered attorney or agent is necessary, provisions exist for changing a large number of applications and are contained in Section 601.03 of the Manual of Patent Examining Procedure.

d. Correspondence with Certificate of Mailing Delivered by Commercial Carrier

The benefits of 37 CFR 1.8 or 1.10 apply only to documents delivered to the PTO by the U.S. Postal Service.

A number of instances have been uncovered where individuals are certifying that documents were deposited with the U.S. Postal Service when, in fact, the documents were hand-carried or delivered to the PTO via commercial couriers, e.g., "Federal Express," "DHL," "Purolator," "Air Borne," "UPS," etc. In those instances where documents include a certificate of mailing under 37 CFR 1.8 or 1.10, but were delivered to the PTO by other than the U.S. Postal Service, Mail Room personnel are placing a notice indicating that fact on the correspondence involved to alert PTO personnel that the benefits of 37 CFR 1.8 or 1.10 do not apply.

e. Courier Services

If you plan to send a document via a private courier, the following address should be used to ensure proper receipt and handling:

Patent and Trademark Office
Correspondence and Mail Division
Crystal Plaza Building 2, Room 1A03
Arlington, VA 22202

f. Express Mail

Due to a failure to follow proper procedures, many applicants are losing the advantage of receiving the date a paper or fee was deposited at the Post Office when Express Mail is used. According to 37 CFR § 1.10, any such paper or fee must include a certificate of mailing by Express Mail, signed by the person mailing the paper or fee.

To ensure papers and fees sent by Express Mail are accorded the proper certificate date, the following suggestions and reminders are offered:

- Each document must have a certificate of mailing typed on or affixed to the document. The certificate should be placed on the first page of the document or the covering letter to ensure easy accessibility. Often, the certificate is missing, illegible, inaccurate, incomplete, or difficult to locate. As a result, the paper or fee is considered to have been filed on the date of receipt in the PTO.
- The certificate must be legible.
- The Express Mail label number must be placed on the certificate.
- Dates on the certificate must correspond to dates on the Express Mail label.

The PTO continues to receive correspondence filed under the provisions of 37 CFR 1.10 in which the certificate of mailing by Express Mail certifies that the correspondence is being mailed on one date while the Express Mail label shows a "Date-In" on a different date. This usually occurs when the Express Mail package is deposited in a remote Express Mail receptacle or mailbox after the last pickup, and accordingly is not being picked-up and processed by the Postal Service until the next business day. The question as to the treatment of such a situation was covered in the final rule making published on January 20, 1983, at 48 FR 2696-2714 and on February 10, 1983, at 1027 OG 9. The following comments appear therein.

> "Comment: One person questions what treatment will be accorded a paper placed in an Express Mail box receptacle after the box has been cleared for the last time on a given day."
>
> "Reply: The paper will be considered to be deposited as of the date of receipt indicated on the Express Mail mailing label by the Postal Service clerk."

It is recommended that when the filing date of a paper or fee is critical (e.g., the filing of a patent application, and particularly when the deposit by Express Mail is being made late in the business day), the correspondence should be personally delivered to a Post Office. There the date of receipt of the Express Mail package can be immediately indicated by the Postal Service clerk.

Each certificate must have an original signature of the person actually mailing the paper or fee (i.e., the person who actually deposits the paper or fee with the U.S. Postal Service). The PTO has encountered instances in which the certificate of mailing by Express Mail was signed by an attorney and the deposit was made by the attorney's secretary or another member of the attorney's staff. This is improper under the provisions of 37 CFR 1.10. This section differs in that regard from 37 CFR 1.8.

The preferred wording and information to be included on the certificate is as follows:

> Express Mail Mailing Label Number: (insert "B number" from Express Mail label)
> Date of Deposit (insert date)
>
> I hereby certify that this paper or fee is being deposited with the United States Postal Service's Express Mail Post Office To Addressee service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.
>
> (Typed or printed name of person mailing paper or fee)
>
> (Signature of person mailing paper or fee)

By following these procedures, problems concerning filing dates should be minimized.

g. Response to Final Rejections in Patent Applications - Expediting Processing and Reply by PTO

In order to ensure the quickest reply to an amendment or response after Final Rejection in patent applications, the paper must be marked in the upper right portion:

> "RESPONSE UNDER 37 CFR 1.116 EXPEDITED PROCEDURE
> EXAMINING GROUP (Insert Group Number)"

The marking on the paper preferably should be written in, highlighted by, or encircled with, a bright color felt-point marker.

The envelope in which the response is submitted must include only submissions under 37 CFR 1.116. The envelope must be marked "Box AF" in the lower left corner and must be addressed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

If the paper is being hand-carried to the Examining Group (instead of mailing to Box AF), the envelope, if any, and the response should both be marked:

"RESPONSE UNDER 37 CFR 1.116 EXPEDITED PROCEDURE
EXAMINING GROUP (Insert Group Number)"

Use of this procedure should avoid the necessity for extensions of time and the filing of unnecessary notices of appeal in many cases.

h. Return Postcard

If a receipt for any paper filed in the Patent and Trademark Office is desired, it may be obtained by enclosing with the paper a self-addressed postcard identifying the paper. The Patent and Trademark Office will stamp the receipt date on the card and place it in the outgoing mail.

The identifying data on the card should be so complete as to clearly identify the paper for which receipt is requested. For example, the card should identify the applicant name(s), serial number, filing date, interference number, etc. Also, the paper(s) should be identified by specifying the type thereof, namely affidavit, amendment, appeal, itemized components of applications, brief, drawings, fees, motions, supplemental oath or declaration, petition, etc.

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO unless the postcard receipt has been annotated by the PTO to indicate that one or more items were not received. A postcard receipt will not serve as prima facie evidence of receipt in the PTO if the papers are not itemized in a detailed manner, e.g., number of pages of specification and number of sheets of drawings, or if the postcard receipt has been annotated to indicate that one or more items was not received.

When papers for more than one application are filed under a single cover, a return addressed postcard should be attached to the paper for each application for which a receipt is desired.

i. Secrecy-Related Papers (37 CFR 5)

All correspondence in connection with 37 CFR 5 should be addressed to:

Commissioner of Patents and Trademarks
Attention Licensing and Review
Washington, D.C. 20231

Improperly addressing such correspondence may delay delivery and could result in violations of 37 CFR 5. See 37 CFR 5.33 regarding correspondence.

j. Special Box - Box AF

Since the establishment of the special box "Box Non-Fee Amendment," some questions have been received as to which box should be used for amendments after final rejections. Continue to use Box AF for amendments after final rejections, even if it is a non-fee amendment. Although mail delivery by the Mail Room should be the same in either case, the Patent Examining Group will expedite those labeled Box AF.

k. Special Box - Box Assignment

To ensure proper routing of patent and trademark assignments other than those filed with new patent applications, please place in a separate envelope addressed "Box Assignment" and use the words "Box Assignment" on transmittal letters for assignment documents. Do not put any other type of documents in the envelope.

Box Assignment cannot be used for assignments filed with new patent applications because these assignments remain with the patent applications until bibliographic data is key entered and the filing receipts are mailed. The bibliographic data keyed for filing receipts is then available in the automated patent assignment system for use in processing patent assignment documents.

l. Special Box - Box Reexam

Requests for reexamination should be clearly marked "Box Reexam" on the outer envelope, and include only requests for reexamination. The goal for processing requests for reexamination is 30 days from receipt in the Mail Room to delivery to the appropriate examining group. Requests for reexamination which are marked on the outside envelope for Box Reexam are immediately placed in a special box for pick up by reexamination processing clerks twice daily. Properly marked requests for reexamination allow us to meet the 30-day goal and allow the examiner adequate time for considering the request.

If requests for reexamination are included in packages with other mail, the entire package will be placed with the thousands of pieces of mail received on that date to be opened in date order. Reexamination requests are, therefore, delayed for several days making the 30-day goal nearly impossible to meet, and often reducing the time available for the examiner's consideration of the request.

m. Special Designations for Mail

Special PTO mail department numbers should be used to allow forwarding of particular types of mail to the appropriate areas as quickly as possible. Only the specified type of document should be placed in an envelope addressed to one of these special departments. If any documents other than the specified type identified for each department are addressed to that department, they will be significantly delayed in reaching the appropriate area for which they were intended.

The following special departments should be used only for their specified purpose. Address mail as follows:

Commissioner of Patents and Trademarks
Box _____
Washington, DC 20231

Box 4 - Mail for the Assistant Commissioner for External Affairs and the Office of Legislation and International Affairs.

Box 5 - "No fee" mail related to trademarks.

Box 6 - Mail for the Office of Procurement.

Box 7 - Reissue applications for patents involved in litigation and subsequently filed related papers.

Box 8 - All papers for the Office of the Solicitor except communications relating to pending litigation; papers relating to pending litigation shall be mailed only to Office of the Solicitor, P.O. Box 15667, Arlington, Virginia, 22215.

Box 9 - Coupon orders for U.S. patent and trademark copies.

Box 10 - Orders for certified copies of patent and trademark applications.

Box 11	- Establish new account for and other correspondence concerning Electronic Ordering Service (EOS).
Box 12	- Contributions to the Examiner Education Program.
Box 14	- Mail directed to the APS Contracts Office.
Box 15	- Mail for the Advisory Commission on Patent Law Reform.
Box 16	- Mail for the Office of Finance for deposit account holders who wish to mail replenishment checks to the PTO.
Box 17	- Invoices directed to the Office of Finance.
Box AF	- Expedited procedure for processing amendments and other responses after final rejection.
Box ASSIGNMENT	- All assignment documents except those filed with new applications.
Box DAC	- Petitions to revive, petitions to accept late payment of fees, petitions to defer issue, and petitions to withdraw an application from issue.
Box DD	- Disclosure Documents or materials related to the Disclosure Document Program.
Box FWC	- Requests for File Wrapper Continuation Applications (under 37 CFR 1.62)
Box INTERFERENCE -	- Communications relating to interferences and applications and patents involved in interference.
Box ISSUE FEE	- All communications following the receipt of a PTOL-85, "Notice of Allowance and Issue Fee Due," and prior to the issuance of a patent should be addressed to Box Issue Fee, unless advised to the contrary. Assignments are the exception. Assignments should be submitted in a separate envelope and addressed to Box ASSIGNMENT and not be sent to Box Issue Fee.

Box ITU	- All intent to use documents, excluding the initial application and amendments to allege use.
Box M.FEE	- Correspondence related to a patent that is subject to the payment of a maintenance fee.
Box NON-FEE AMENDMENT	- Non-fee amendments to patent applications. (Use Box AF for responses after final rejection).B
Box OED	- Mail for the Office of Enrollment and Discipline.
Box PATENT APPLICATION	- New patent application and associated papers and fees.
Box TRADEMARK APPLICATION	- New trademark application and associated papers and fees.
Box PATENT EXT	- Applications for patent term extension.
Box PCT	- All mail related to applications filed under the Patent Cooperation Treaty.
Box RECON-STRUCTION	- Correspondence pertaining to the reconstruction of lost patent files.
Box REEXAM	- Requests for Reexamination for <u>original</u> request papers <u>only</u>.
Box SEQUENCE	- Submission of diskette for biotechnology application.
Box SN	- For fee and petitions under 37 CFR 1.182 to obtain date received and/or serial number for patent applications <u>prior</u> to the Office's standard notification (return post card or the official "Filing Receipt," "Notice to File Missing Parts," or "Notice of Incomplete Application").

14. <u>MAINTENANCE FEES</u>

a. <u>Address/Location for Submission of Maintenance Fees and Other Related Documents</u>

Maintenance Fee payments or other maintenance fee related documents may be mailed to:

Commissioner of Patents and Trademarks
Box M Fee
Washington, D.C. 20231

Maintenance Fee payments or other maintenance fee related documents may be hand carried to:

Patent and Trademark Office
Patent Maintenance Division
2800 Crystal Drive, North Tower 10B10
Arlington, Virginia 22202

or

Patent and Trademark Office
Correspondence and Mail Division
Crystal Plaza Building 2, Room 1A01
Arlington, Virginia 22202

Maintenance Fee payments, with authorization to charge to a deposit account, or other maintenance fee related documents may be faxed to:

(703) 308-7110

b. Address to Which Correspondence is Sent Regarding Patent Maintenance Fees

Under 37 CFR 1.33(d), a "correspondence address" or change thereto may be filed with the Office during the enforceable life of a patent. This "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified solely for maintenance fee purposes as provided by CFR 1.363.

Practitioners who do not wish to receive correspondence relating to maintenance fees must change the correspondence address in the patented file or provide the PTO with a fee address to which the correspondence should be sent. It is not required that a practitioner file a request for permission to withdraw pursuant to 37 CFR 1.36 solely for the purpose of changing the correspondence address in a patent, even though a withdrawal of a practitioner would change the correspondence address.

c. Correspondence Address and/or Fee Address on Maintenance Fees

Effective November 1, 1984, 37 CFR 1.363 provides for a "fee address" to be entered in the Office patent file records for use in all correspondence relating to maintenance fees. The fee address is in addition to the "correspondence address" under 37 CFR 1.33. The "correspondence address" will continue to be used for all reexamination and interference

purposes. If no separate fee address is specified, the correspondence address will also be used for maintenance fee correspondence. A similar reminder appears on the Issue Fee Transmittal Form, PTOL-85(b).

Practitioners should maintain a current "correspondence address" and, if desired, a separate current "fee address" during the enforceable life of the patent in order to ensure receipt of correspondence regarding maintenance fee.

Practitioners are reminded that they are obliged to inform a client or former client (or timely notify the Office of an inability to notify a client or former client) of any maintenance fee correspondence received from the PTO. See 37 CFR 10.23(c)(8). This is similar to the practice with respect to interferences and reexamination proceedings.

Practitioners who do not wish to receive correspondence relating to maintenance fees must change the correspondence address in the patented file or provide the PTO with a "fee address" to which such correspondence should be sent.

It is not required that a practitioner file a request for permission to withdraw pursuant to 37 CFR 1.36 solely for the purpose of changing the correspondence address in a patent even though a withdrawal of a practitioner would change the correspondence address. However, a request for permission to withdraw pursuant to 37 CFR 1.36 must be filed in the patent if the attorney or agent of record does not desire to receive correspondence relating to reexamination.

d. Delayed Payment of Maintenance Fees

Payment of any maintenance fee due on a patent after expiration of the patent may be accepted if the conditions set forth in 37 CFR 1.378 are satisfied. In the past, petitions under 37 CFR 1.378 to accept delayed payment of the maintenance fee in an expired patent have been filed which allege, as a basis for unavoidable delay: (1) lack of knowledge that a maintenance fee was due and/or (2) failure to receive a Maintenance Fee Reminder notice from the PTO.

Practitioners are reminded that a patentee's lack of knowledge of a requirement to pay a maintenance fee does not constitute a showing of unavoidable delay; see 49 FR 34716 at page 34720, and 1046 OG 28 at page 32.

Maintenance Fee Reminder notices are mailed only as a courtesy after the "grace period" has begun; see 37 CFR 1.362(e). Patentees are expected to maintain their own docket systems to ensure timely payment of maintenance fees, preferably during the "window period"; see 37 CFR 1.362(d). Since patentees are expected to maintain their own docket

systems for timely payment of maintenance fees, proof that a Maintenance Fee Reminder notice was not received from the PTO does not constitute a showing of unavoidable delay; see 49 FR 34716-34726, and 1046 OG 28-37.

Practitioners are cautioned that any petition to accept delayed payment of a maintenance fee under CFR 1.378 must include an enumeration of the steps taken to ensure timely payment of the maintenance fee. In this regard, the petition should include a detailed explanation of the docket system employed to ensure such timely payment.

e. Maintenance Fee Transmittal Form Notice

Where maintenance fee payments are to be made by authorization to charge a deposit account, the Maintenance Fee Transmittal Form, should reflect both the Payor's Name and signature in the bottom left corner thereof.

f. Mandatory Identifiers when Submitting Maintenance Fees

Practitioners are reminded that a patent maintenance fee payment and any surcharge payment submitted must identify the patent to which it relates by at least two mandatory identifiers [see 37 CFR 1.366(c)]: the patent number and the serial number of the United States application for the patent on which the maintenance fee is being paid.

Reissue patent maintenance fee due dates are based on the issue date of the original, rather than the reissue patent. The payment must identify the reissue patent by reissue patent number and reissue application serial number as the two mandatory identifiers and should also include the original patent number, the original patent issue date and the original United States application filing date. See 37 CFR 1.366(d).

The two mandatory identifiers are required as a minimum to enable a cross-check to be made to avoid errors in crediting payment of maintenance fees.

It is suggested that the payment identify the fee being paid for each patent as to whether it is the 3 1/2, 7 1/2 or 11 1/2 year fee; whether small entity status is being changed or claimed; the amount of the maintenance fee and any surcharge being paid; any assigned payor number; the patent issue date; and the United States application filing date. See 37 CFR 1.366(d).

Failure to provide at least the two above-named mandatory identifiers will likely result in the non-acceptance of the maintenance fee payment. The date the two mandatory identifiers and the required fee are submitted is the date the maintenance fee payment is credited as being made.

g. Payor Number

In order to simplify changes in address by patent owners having several patents, and data input by the Patent and Trademark Office, a "payor number" will be assigned to each fee address when a fee address is presented to the Office in a patent or earlier upon request. A request for a payor number before a maintenance fee is paid or due will permit a patent owner to request that the fee address and payor number be recorded in the Office records of the patents owned on which maintenance fees are due so that all notices relating to maintenance fees will be sent to the fee address.

When a fee address has been specified as provided by 37 CFR 1.363, that address is assigned a "payor number". Processing time can be greatly reduced if practitioners cite that "payor number" when submitting a maintenance fee payment.

The Patent and Trademark Office has established a procedure for assigning a payor number upon request by a patent owner or a party responsible for paying maintenance fees. Such a party may be, for example, the finance office of a corporation or of a separate organization specializing in maintenance fee payments.

Under the procedure, a patent owner or other party may request a payor number for a particular fee address by writing to:

Commissioner of Patents and Trademarks
Box M. Fee
Washington, DC 20231

Each request for a payor number should include the:

- fee address to be used by the Office, and
- telephone number of the fee addressee to be used to resolve problems.

After receipt of a payor number, it may be used to indicate to the Patent and Trademark Office the fee address to be used in particular patents on which maintenance fees will become due and in applications in which issue fees have been or are being paid. Any request for entry of a payor number or fee address in the Office records of a patent, however, must be signed by the patent owner or his or her attorney or agent of record.

After a payor number has been assigned, it should be used in all future maintenance fee payments and related correspondence. However, where a payor number has not been previously entered in the Office records for a particular patent, the mere indication of a payor number at the time of payment of the maintenance fee, without the signature of the

patent owner or the owner's attorney or agent of record, will not serve to make the payor number of record in the Office for that patent.

The problems which most often arise in connection with attempts to establish a fee address in a particular patent or group of patents is that the request is being signed by an attorney who is not of record in each of the patents. This results in the request being entered only in part. Also, when the request is signed by an owner of the patent, the records of the Assignment Branch do not always reflect such ownership. Where the assignment was recorded prior to December 1980, it would help the Office if the PTO reel and frame number of the assignment recordation were presented in the paper requesting that a fee address be entered, and if the person signing the request would indicate his or her title.

h. Public Availability of Maintenance Fee Petitions/Decisions

Maintenance fee petitions and decisions thereon are public records. Copies thereof can be obtained by submitting a written request to the Certification Branch and including the appropriate fee. The request should state the patent number and serial number.

15. PATENT APPLICATIONS (NEW)

a. Attorney Docket Number on Incomplete/Missing Parts Notices

In response to several requests from patent attorneys, the PTO is now entering the attorney docket number on the Notice of Incomplete Application and Notice to File Missing Parts of Application.

The attorney docket number which will be entered on the Notice will be that which was submitted on the transmittal letter as filed with a new patent application. The number must be clearly identified as an "attorney docket number."

If the Office makes a mistake in recording the attorney docket number on the Notice of Incomplete Application or the Notice to File Missing Parts of Application, such mistake is not to be used by the attorney as cause for delay in response. Nor is the attorney to request that the Office correct the docket number prior to response to the Notice. The attorney can notify the Office in the response, but no change will be made by the Office until the Filing Receipt is issued.

If the attorney wishes to change the attorney docket number from that which was entered on a transmittal letter as filed, the request must be submitted through amendment, submitted to the Patent Examining Corps.

b. Computer Program Listings

Computer program listings may be submitted in patent applications in the following forms:

(1) If a computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification. If submitted as drawings, the listing must comply with the requirements for drawings as provided in 37 CFR 1.84. If submitted as part of the specification, regardless of the number of printout pages, it must be in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as "camera ready copy." Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper. The printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover.

(2) If the computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche. Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." This appendix will not be part of the printed patent. Microfiche submission requirements must be in accordance with the provisions contained in 37 CFR 1.96(b) (2).

c. Request to Delay Action In Patent Cases

See section under APPLICATION PAPERS FOLLOWING FILING OF NEW APPLICATION.

d. Continuation or Divisional - Retaining Original Claim

When filing under 37 CFR 1.60, retain at least one original claim from the parent application when filing a preliminary amendment. Only amendments reducing the number of claims or adding a reference to the prior application [37 CFR 1.78 (a)] will be entered, upon request, before calculating the filing fee and granting the filing date. Reminder: Applicant cannot file a CIP (continuation-in-part) under 37 CFR 1.60.

e. Continuation or Divisional - Problems

Applications are often filed incorrectly under 37 CFR 1.60. This causes problems not only for applicants but also for the Patent and Trademark Office. Filing dates are not

granted to applications which do not comply with the rules. As a result, petitions with fees are required to be filed in such applications before a filing date will be granted.

Most often, the problems that arise in this area can be characterized as the following:

° Applicants continue to fail to comply with the requirements of 37 CFR 1.60 with regard to what must be submitted upon filing under the rule. This is true even after the clarifying amendments (effective April 1, 1984) were made to the rule.

  A true copy of the prior application must be filed including the specification (with claims), drawings, oath or declaration showing the applicant's signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application.

° Applicants are using transmittal forms which request filings under 37 CFR 1.62 when it was really desired to file a divisional application under 37 CFR 1.60 and not to abandon the parent application.

f. Docket Numbers - Placement

If use of a docket number is desired, the docket number should be placed in the upper right corner of the transmittal letter accompanying newly filed patent applications. This will eliminate a time consuming search of the application papers for the docket number or the likelihood of it being overlooked during processing.

Docket numbers must be limited to a maximum of 12 characters to prevent truncation. The Patent Application Location and Monitoring (PALM) system data base allows a maximum of 12 characters for the attorney's docket numbers. Spaces, slashes and hyphens will no longer be included in the entered docket number on the official filing receipt. In an application where CASE or NAVY-CASE appears before the first character in the docket number, only the characters after CASE or NAVY-CASE will be entered on the official filing receipt.

g. Drawings in Applications

The general rule applicable to release of any paper in a patent application file is that no paper (including a drawing) will be returned for any purpose whatever. 37 CFR 1.59. Rules published in the Official Gazette [1097 OG 36 (December 13, 1988)] effective January 1, 1989, no longer require the submission of original (master) drawings in a patent application. Since corrections are the responsibil-

ity of the applicant, the original drawing(s) should be retained by the applicant for future correction, if necessary. The Patent and Trademark Office will no longer release to applicants, bonded drafting companies or others, drawings from patent applications.

Access to applications is still provided with the proper power to inspect. If copies of any papers or drawings within the application are required, arrangements may be made through the File Information Unit and copies may be made in the Public Search Room. If there is some extraordinary situation that requires release of an original drawing in possession of the Office, relief may be requested by filing a petition under 37 CFR 1.183.

h. Drawings - Proper Identification

During pre-examination processing, drawings are temporarily separated from the rest of the application papers. To facilitate the matching of drawings with the application, it would be helpful if the applicant's name, docket number, and the title of the invention were put on the back of the drawings. This may be done by writing lightly on the drawings or by using gum labels.

i. File Wrapper Continuation - Preliminary Amendment

Many continuation applications filed under 37 CFR 1.62 contain no preliminary amendment to the claims which were finally rejected in the parent application. The result is a first action final rejection of these claims. Applicants should file any desired amendments at the time the application is filed under 37 CFR 1.62, since the Office is treating these applications as "Special" and an action on the merits will be rendered quite promptly.

To expedite processing under 37 CFR 1.62, make certain that the parent serial number cited in the transmittal letter is the correct serial number.

j. File Wrapper Continuation - Problems

Applications continue to be filed incorrectly under both 37 CFR 1.60 and 37 CFR 1.62. Filing dates are not granted to applications which do not comply with the rules. As a result, petitions with fees are required to be filed in such applications before a filing date will be granted.

The problems that most frequently arise in this area can be characterized as the following:

- Applications have been filed with a transmittal form requesting filing under 37 CFR 1.60 when it was intended to file under 37 CFR 1.62. The confusion in the record

of such applications must be clarified by a decision on petition before the applications can be processed for examination.

- Some applicants fail to realize that the parent application is abandoned by the filing of a continuing application under 37 CFR 1.62. Paragraph (g) of 37 CFR 1.62 states:
  "The filing of a request for a continuing application under this section will be considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application."
  Correction after such a mistaken filing under 37 CFR 1.62 usually requires a revival of the parent application under 37 CFR 1.137(a) or (b) which expends resources of both the applicant and the PTO.
- Some applicants are attempting to file continuing applications under 37 CFR 1.62 after payment of the issue fee in the parent application. Such applications are improper and are not entitled to a filing date. Additionally, such filings will not affect the prior application; i.e., the parent application may issue as a patent. Paragraph (a) of 37 CFR 1.62 specifies that continuing applications may be filed under 37 CFR 1.62 "before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application."
- Some applicants are attempting to file continuation-in-part applications under 37 CFR 1.62 with a new specification rather than with the changes made by amendment to the prior application. As stated in 37 CFR 1.62(a), filings under 37 CFR 1.62 use the specification of the prior application. Note 37 CFR 1.62(e). Paragraph (c) of 37 CFR 1.62 also states:
  "In the case of a continuation-in-part application which <u>adds and claims additional disclosure by amendment</u>, an oath or declaration as required by §1.63 must also be filed..." (emphasis added)
- The request for a File Wrapper Continuation (FWC), under 37 CFR 1.62, <u>must</u> contain the original signature of the inventor, assignee, attorney or agent of record, or attorney or agent filing under representative capacity. [1.34(a)]

k. <u>Information Disclosure Citation - Form PTO 1449</u>

The Public is encouraged to use Form PTO 1449, "Information Disclosure Citation," when preparing a statement under 37 CFR 1.97-1.98 (see MPEP § 609). This form provides the Office with a uniform way of listing the citations and a vehicle from which the information thereon can be printed on the issued patent.

Some citations are being presented on various forms prepared by the public rather than on Form PTO 1449. As a result,

delays are cropping up in the printing process because the printer has difficulty in following the various formats and is having to query the examiner each time a non-PTO 1449 form is used.

Note that listing citations on Form PTO 1449 does not raise an irrebuttable presumption that the citation is prior art. A holding by an examiner that any citation on Form PTO 1449 is prior art to claimed subject matter can be rebutted by procedures commonly used to rebut the prior art status of an examiner's citations on Form PTO 892, "Notice of References Cited".

Among the information that should be provided for each citation on Form PTO 1449 is (1) the month and year of the date of publication for foreign patents, published applications and printed publications, and (2) the month and year of the patent date for United States patents. In addition, it is helpful if the class and subclass of each citation is provided. It is appreciated that classification information may not be known at the time the Form PTO 1449 is prepared. When classification information is not known, draw a line in the boxes under the class and subclass heading adjacent to the citation for which classification information is not known.

l. Petition for License

37 CFR 5.12 states that "filing of an application for patent for inventions made in the United States will be considered to include a petition for license under 35 USC 184 for the subject of the application. The filing receipt will indicate if a license is granted." There is no need to request a corrected filing receipt deleting the words "License Granted." Its intent is to provide the necessary acknowledgment for those filing abroad.

m. Processing and Retention Fees for Abandoned Applications

An application, which has become abandoned pursuant to 37 CFR 1.53(d) for failure to pay the filing fee, will be disposed of unless the processing and retention fee set forth in §1.21(1) is paid within the 1-year period referred to in §1.53(d). Moreover, the processing and retention fee must be timely paid in order to obtain certified copies of the application (e.g., for convention priority purposes) or to establish in a later filed application the filing date benefit of an earlier copending application under 35 USC 120 and 37 CFR 1.78(a)(3). Therefore, an application which has become abandoned for the reasons set forth above should be immediately reviewed in order to timely determine the advisability of submitting a processing and retention fee payment.

n. Residence of Applicant

The residence of applicant should be indicated as city and state for United States residents and city and country for residents of foreign countries.

o. Surcharge for Filing a Patent Application

Filing dates are accorded to applications filed without the basic filing fee and without the oath or declaration. In such cases, a notice is mailed by Application Division requiring at least the basic filing fee and the oath or declaration, accompanied by a surcharge [37 CFR 1.16(e)]. In numerous instances, applicants fail to submit the surcharge causing the application to become abandoned. See 37 CFR 1.53(d) and MPEP § 506.

16. PATENT AND TRADEMARK COPY SALES

a. Costs

Regulations require that the PTO receive payment for copies as they are ordered. The current charge for copies of U.S. patents and trademarks is $3.00 per copy. Plant patents are $12.00 per copy. Utility patents which have color drawings are $24.00 per copy. These are flat rate charges, return postage included. All foreign orders are returned by Air Mail at no additional charge.

The routine processing time for mail orders is 2-4 weeks.

b. Coupon Ordering Service

Copies of most U.S. patents and trademarks can be ordered utilizing prepaid coupons. Color utilities, plant patents, and foreign patents cannot be ordered via coupons.

Currently, several series of coupons are in circulation. All prepaid coupons are still redeemable for document copies as long as the correct valuation, or combination of coupons, is submitted for each order. If you need assistance in determining the valuation of coupons, please call (703) 305-4350/8492.

Prepaid coupon books are available to the public by writing:

U.S. Patent and Trademark Office
Office of Finance-Receipts Control
Washington, D.C. 20231
Telephone: (703) 308-4024

When ordering by coupon, please ensure that:

(1) All blocks on the form are accurately and neatly completed.

(2) The type of document desired is clearly indicated by checking the block for patent or trademark and indicating if the copy is a design patent.

If you need further assistance, please call (703) 305-4350/ 8492.

c. Electronic Ordering System (EOS)

EOS is a method of placing orders for copies of U.S. patents and trademarks using a computer and modem, for deposit account holders. The cost for copies of patents and trademarks ordered via EOS is the same as listed above. However, there is a communication service charge of approximately $0.25 per minute while you are actually using the system.

Additionally, expedited processing is available for $25.00 per copy. The expedited service ensures that your order will be processed within one working day and returned to you by an overnight delivery service.

If you need further assistance, please call (703) 305-4350/ 8492.

d. Expedited Processing of Orders

Special orders are currently accepted for two types of document orders: Public Service Window (PSW) Coupon-Specials (at the Arlington, Virginia, facility); and through the Electronic Ordering Service (EOS)-Specials. PSW Specials provide for 24-hour processing and delivery of the document to the PSW Window boxes at a cost of $6.00 per copy. EOS Specials provide for 48-hour processing and delivery via an express courier to the indicated address on the order at a cost of $25.00 per copy.

If you need further assistance, please call (703) 305-4350/ 8492.

e. Facsimile (FAX) Ordering Service

Deposit account holders may place orders for copies of U.S. patents and trademarks via fax at (703) 305-8759. All orders must contain 1) customer's complete name, mailing address, telephone or fax number, and PTO deposit account number; 2) patent or trademark number(s) ordered; and
3) number of copies of each document ordered.

Charges for fax orders will be billed to your deposit account. Credit cards may not be used to pay for fax orders. There are no additional fees beyond the cost of the copies for fax orders. Expedited service for fax orders is not yet available. All orders are returned via the U.S. Postal Service or U.P.S. Copies are not faxed to customers.

If you need further assistance, please call (703) 305-4350/ 8492.

f. Subscription Services

The process by which the PTO supplies copies of patents by subject matter as they issue is called a subscription. You may subscribe to any number of subject matter areas called subclasses. The fees for patent copies you receive through a subscription are the same as listed above and would be charged against your deposit account balance.

If you wish to subscribe, you must first determine the subclass(es) you want. Our subscription service is based on the U.S. patent classification system. If you need assistance or information about the U.S. patent classifi-cation system, please contact:

Patent Search Branch
Public Search Services Division
U.S. Patent and Trademark Office
Washington, D.C. 20231
Telephone: (703) 308-0595

If you decide to establish a subscription, your request should be sent to:

U.S. Patent and Trademark Office
Subscription Services
PK1-513B
Washington, D.C. 20231

It will take approximately six weeks following receipt of your request for your subscription to become effective. Then, you will be sent a copy of every patent which issues in the subclasses(es) you selected.

If you are interested in obtaining information about any patents issued in any subclass prior to establishment of your subscription, please contact:

Information Systems
Office of Electronic Information Products & Services
U.S. Patent and Trademark Office
Washington, D.C. 20231
Telephone: (703) 305-5652

If you need further assistance, please call (703) 305-4350/ 8492.

17. PETITIONS TO REVIVE

a. Request and Fee for Extension Not Required

Frequently, a petition to revive an abandoned application is accompanied by an unnecessary request and fee for extension

of time. Our policy is set forth in MPEP 711.03(c). Specifically, a response does not require a request and fee for extension of time as a condition of revival.

b. Terminal Disclaimer

A petition to revive an abandoned application is often accompanied by an unnecessary terminal disclaimer. A terminal disclaimer is required only when a grantable petition based on unavoidable delay is not filed within six months of the date of abandonment [37 CFR 1.137(a) and 1.137(c)]. It follows that a terminal disclaimer should not accompany a petition based on unintentional abandonment [(37 CFR 1.137(b)]. In these respects, analogous reasoning applies to petitions to accept late payment of the issue fee under 37 CFR 1.155 or 1.316.

When a terminal disclaimer is a necessary component of the petition, the period to be disclaimed must equal the number of months between the date of abandonment and the date a grantable petition is filed. The date of abandonment is the date the period for response has expired [see MPEP 711.04(a)]. This is normally the end of the three month shortened statutory period. Moreover, the terminal disclaimer should employ the format shown below.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of (NAME)
Serial Number:
Filed:
For:

TERMINAL DISCLAIMER

Petitioner, _____, is the owner of ___ percent interest in the above-identified application.

Petitioner hereby disclaims a terminal part of the term of the patent equivalent to the period of abandonment of the above-identified application. This terminal disclaimer applies to any patent granted on the above-identified application or on any application which is entitled to the benefit of the filing date of this application under 35 U.S.C. 120. This disclaimer is binding upon the grantee, its successors or assigns.

For submissions on behalf of an organization (e.g. corporation, partnership, university, government agency, etc.), the person signing (whose title is supplied below) is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

_____
Printed name (and title if applicable)

_____ _____
Date Signature

_____ terminal disclaimer fee under 37 CFR 1.20(d) included.

THE STATEMENT BELOW IS FOR OFFICE USE ONLY
In accordance with the decision granting the petition filed on _____, this terminal disclaimer is accepted. The period of abandonment specified above has been accepted as equivalent to _____ months.

_____
Petitions Examiner

18. POWER TO INSPECT

a. Power of Attorney

The Office receives letters granting power to inspect patent applications. Power to inspect may only be properly granted by the agent or attorney of record, the inventor, or the assignee of record. Sometimes the person signing the power is not authorized to do so. The most frequent error in this regard is an attempt, by a person who was properly granted a power to inspect, to assign or delegate or grant the power to a third person. This does not comply with 37 CFR 1.14(a) and merely causes a delay until proper authorization is received.

Copies of complete applications (37 CFR 1.51(a)) cannot be made during the pre-examination process. Although these can be inspected, they may not be pulled from the work flow in order to have copies made.

19. PRACTICE AFTER FINAL REJECTION IN PATENT CASES

a. Interviews

Although one interview after final is normally available, the purpose of the interview must be clear and specific, and must be communicated to the examiner in advance. No extension of time is necessary to conduct an interview after the period for response expires, however, an extension is required for the purpose of filing a follow-up amendment or for the entry of an Examiner's Amendment requiring approval by the applicant.

b. Amendment After Final Rejection

A response to a final rejection will receive expedited handling and processing, and thus may avoid the necessity for filing an extension of time and/or an unnecessary notice of appeal, if the BOX AF Expedited Processing procedures is used by applicant.

In order to avoid some extension fees, responses to final rejections should be filed within two months of the date of the final rejection. In the case of a first response after Final Rejection, if filed within two months, any Advisory Action addressing that response, which is mailed after the 3-month shortened statutory period (SSP) expires, will reset the SSP, for extension fee purposes, to expire on the date of the Advisory Action.

Although prosecution is restricted after a final action, applicant may anticipate entry of amendments which (1)

cancel claims, (2) comply with formal requirements, (3) adopt an examiner's suggestions, (4) place the application in better form for appeal, or (5) place the application in condition for allowance. The examiner will usually refuse entry of an amendment which does not place the application in better form for appeal or in condition for allowance. If applicant believes that the examiner improperly denied entry of an amendment, applicant should promptly file a request for reconsideration and/or a petition under 37 CFR 1.181 for supervisory review, neither of which require an extension fee or petition fee.

c. Continuing Application in Lieu of Response

The filing of a continuing application within the period for response is acceptable in lieu of a response, Notice of Appeal or Brief in a finally rejected application. Applicant is cautioned, however, that this may not be done as compliance with a notice of incomplete response pursuant to 37 CFR 1.135(c). If time remains in the six-month maximum statutory period running from the date of the final rejection, applicant may acquire the necessary extensions of time in the finally rejected application to render the continuing application timely to avoid a hiatus in continuity.

Applicant should file a preliminary amendment in a continuation application filed after a final rejection in the parent application. If this is not done, a first action final rejection will be properly rendered in the continuation application. It is well to remember, also, that when an examiner has indicated that an amendment or certain portions of an amendment have not been entered for purposes of appeal, the amendment has not been entered. Therefore, the amendment should be presented in a preliminary amendment in the continuing application. In the case of a File Wrapper Continuation (37 CFR 1.62), applicant may merely request entry of the non-entered amendment.

A first action final rejection is proper in a continuation application, even if a preliminary amendment is filed, if all claims of the new application (1) are drawn to the same invention claimed in the parent application, and (2) would have been properly finally rejected on the grounds or art of record in the next Office Action if they had been entered in the parent application. However, a first action final rejection is improper if the continuation application, or a preliminary amendment thereto, contains material which was presented after final rejection in the parent application, but was denied entry because it raised new issues requiring further consideration and/or search, or raised the issue of new matter. See MPEP 706.07(b). Accordingly, it is beneficial to first present an amendment under 37 CFR 1.116 in the parent application rather than first presenting it by way of preliminary amendment in a continuation application.

It is beneficial because: (1) the examiner may determine that the amendment places the parent application in condition for allowance, which would avoid prolonging prosecution and would save the additional expense of filing a continuation application, and (2) it would obviate a first action final rejection in the event it is deemed necessary by applicant to file a continuation application.

20. REISSUES

a. Amendments

To avoid unnecessary delays in the issuance of reissue applications, applicants and their attorneys are reminded to exercise caution and give sufficient attention to 37 CFR 1.121(a) and (e) in presenting reissue amendments. The practices and procedures vary somewhat from regular utility application amendments.

MPEP Sec. 1455 provides guidance for proper entry of amendments and claim numbering. Publication of the reissue application(s) may be needlessly postponed while formal irregularities are corrected.

b. Oaths and/or Declarations

Since standard oath and declaration forms are not used in reissue applications, applicants are commonly neglecting to include averments required by 37 CFR 1.63 per 37 CFR 1.175(a). The most frequent omissions involve the "duty of disclosure" acknowledgment, and the "reviewed and understands" statement. Such omissions usually necessitate additional handling and correspondence, and cause undue time delays, which result in postponement of publication of the reissue patent.

A frequent problem in reissue practice is the failure of applicants to satisfactorily comply with 37 CFR 1.175 regarding the description of all errors of the original patent in the reissue oath or declaration. Applicants are required to specify errors in the original reissue oath or declaration at the time of filing the reissue application. They must also specify, in a supplemental oath or declaration, any errors brought to their attention during the prosecution, as well as the circumstances surrounding the occurrence or discovery of these errors. Every departure from the original patent represents an "error" and must be particularly and distinctly specified and supported in the original, or a supplemental, reissue oath or declaration under 37 CFR 1.175. See MPEP Sec. 1414 and 1444. Postponement of publication of the reissue patent may result if these requirements are not met at the time of allowance.

21. REEXAMINATION PROCEEDINGS

a. Extensions of Time

Extensions of time under 37 CFR 1.136(a) and (b) are not permitted in reexamination proceedings. Extensions in reexamination proceedings are provided for in 37 CFR 1.550(c) and require no fee. However, the request must be filed prior to the expiration of the period set for response. A first request will be granted for sufficient cause and for a reasonable time specified - usually one month. Second or subsequent requests, or requests for more than one month, will be granted only in extraordinary situations.

b. Time for Response After Final Action - Automatic Extension Policy

In a reexamination proceeding only, filing of a timely first response to a final rejection is construed as including a request to extend the shortened statutory period for an additional month; which one-month extension will be granted even if previous extensions have been granted under 37 CFR 1.550(c). However, in no case may the period for response exceed six months from the date of the final rejection.

c. Amendment Format

The format for amendments in reexamination proceedings is controlled solely by 37 CFR 1.121(f). In amending the description, the entire text of each paragraph to be amended must be presented. In amending the claims, the entire text of each claim to be amended must be presented. Each amendment must indicate ALL of the changes (insertions by underlining, and deletions by bracketing) in relation to the current text of the PATENT under reexamination, and NOT in relation to any prior amendment in the proceeding. New claims added during reexamination must be underlined in their entirety no matter how many times they are amended during the proceeding, and they should never contain brackets.

d. Amendment after Close of Prosecution - Petition Required

37 CFC 1.312, which provides for amendment of an application after allowance, does not apply in reexamination, because a reexamination proceeding is not an application. The reexamination rules do not provide for an amendment to be filed after prosecution has been closed. Consequently, any such proposed amendment must be accompanied by a separate petition under 37 CFR 1.182 in order to have the amendment considered.

22. SMALL ENTITY STATUS

a. Small Entity Statements

Verified statements claiming small entity status, where appropriate, would best be signed and submitted at the time the application oath or declaration is signed to permit filing of the statement with the application. This would reduce correspondence between attorney and client, reduce paper handling by the PTO support staff and the PTO Finance Branch, and greatly simplify the processing of subsequent papers involving fees. If small entity status is being claimed for the first time at the time of payment of the issue fee, a verified statement claiming small entity status should be submitted with the fee. See MPEP § 509.03.

b. Small Entity Statement in Continuing Application

A new verified statement claiming small entity status must be filed in each application or patent in which it is desired to pay reduced fees, including continuing applications filed under 37 CFR 1.53, with the following exception: In continuing applications filed under 37 CFR 1.60 and 1.62, a reference to a verified statement in the parent application is adequate if the conditions for small entity are still satisfied.

23. TRADEMARKS

a. Application Issues

The Trademark Law Revision Act became effective on November 16, 1989. Various changes in filing date requirements have taken effect because of this legislation. While there has been an increase in the number of filings after this date, most applicants are in compliance with the changes. However, some problem areas persist:
Bona Fide Intent to Use Mark in Commerce - No Statement of "Bona Fide Intention to Use the Mark in Commerce" in applications filed or the application included a statement of bona fide intent to use but no "in commerce" statement.
Drawing -No drawing; too large; no heading; no mark on drawing
Applications based on a claim of use in commerce under Section 1(a) - No date of first use in commerce; no specimens.
Applications claiming a dual basis under Sections 1(a) & 1(b)
No Basis
No Fee or Insufficient Fee
No Signature/Verification
Identification of Goods and Services - No identification in

application: indefinite; mark as identification.
Applications based on Sections 44(d) and (e) - 44(e): No certification; 44(d): Not within 6 months

b. Application Drawings

Applications are returned because of defective drawings. Many applications are held informal because the drawing heading is omitted.

Applicants are reminded that, although the heading on the drawing does not have to be complete in order to get a filing date, the drawing must be in substantial compliance with Trademark Rule 2.52. Applicants should be careful to identify their goods and/or services in the body of the application and in the appropriate part of the application form. The Office will not presume that goods identified in other parts of the application or on the drawing are the goods for which registration is sought.
A filing date will not be granted to an application using the class titles from International Classes 35 or 42 as an identification of services.

c. Intent to Use Issues

The following are reminders about changes which have taken place due to intent-to-use:

- To receive a filing date, all applications based on Section 1(b) (intent-to-use) or Section 44 must contain a statement that the applicant has a bona fide intention to use the mark in commerce.
- An application cannot be based on both Section 1(a) (use in commerce) and Section 1(b) (intent to use). The applicant may assert Section 1(a) **or** Section 1(b) with a Section 44(d) or (e) dual basis if that intention is clearly stated in the application.
- The Office recommends that applicants wait until they have received a filing fee receipt before filing any papers related to a trademark application. The filing fee receipt includes the application serial number. The applicant should refer to that serial number in filing any paper to ensure the paper will be associated with the correct application file.

d. Examination Issues

An application reciting concurrent use may not be filed based on a claim of bona fide intent to use the mark in commerce.

An application may be divided into two or more applications upon submission by the applicant of a request to do so. A

fee for dividing goods or services within a class (but not for separating classes) must be submitted. Any outstanding time period for action by the applicant in the original application at the time of the division will be applicable to each new separate application.

e. Other Intent to Use Issues

Carefully review the Notice of Allowance, which is issued after an intent-to-use application is published in the *Trademark Official Gazette* and the opposition period is passed. Ensure all the information is correct and, if it is not, notify the Office immediately.

When filing requests for extensions of time to file a statement of use the applicant must state the goods or services to which the mark pertains. Applicant may incorporate by reference the goods and services set out in the Notice of Allowance. If applicant no longer intends to use the mark on certain goods listed in the application, applicant should state this clearly in its filing. In addition, the request for extension of time to file a statement of use must be signed by the applicant. The "color of authority" provision does not apply to requests for an extension of time. If applicant's request for an extension of time is denied and no time remains in the existing six month extension period to file another extension of time request, applicant's only recourse is to file a petition to the Commissioner in accordance with §§2.66 or 2.146.

f. Post Registration

All Section 8(a) affidavits or declarations must "state that the registered mark is in use in commerce and specify the nature of such commerce." The affidavit or declaration must be filed between the fifth and sixth year following the date of registration and it must contain a statement that the mark is in use in commerce. There may be no extensions of time beyond the sixth year for submission of this statement. However, if the timely-filed affidavit or declaration does not set forth the type of commerce, the registrant will be given six months to submit that information. The rules do not provide for any extensions of time beyond the six months.

While the Post Registration Division will allow up to six months to respond to a letter from the Office, a supplemental affidavit or declaration required by Section 8(a) will not be considered unless it is received before the expiration of the six-year anniversary of the registration. It is suggested that applicants file Section 8(a) affidavits as early as possible between the fifth and sixth year following registration to allow time to submit an affidavit or declaration which is correct, if required.

All Section 8 affidavits filed on or after November 16, 1989, must identify the goods or services recited in the registration on or in connection with which the mark is in use in commerce. These goods or services may be incorporated by reference, if the incorporation by reference is specifically stated in the affidavit.

All Section 8 affidavits are now required to be accompanied by a specimen showing current use of the mark unless a showing of excusable non-use is made.

It will speed up processing of Section 8 affidavits and renewal applications if the affiant/declarant will furnish a copy of any relevant assignment, date stamped by the PTO with the reel and frame number. These can be accepted by the Post-Registration Branch as valid evidence of an assignment.

Trademark registrations issued on or after November 16, 1989, will remain in force for ten (10) years provided a Section 8 affidavit is filed and accepted by the PTO between the fifth and sixth year, and the registration is not otherwise cancelled or abandoned. Registrations which have expired on or after November 16, 1989, will be renewed for 10 years. Only registrations which would have expired before November 16, 1989, and were renewed before
November 16, 1989, were renewed for a 20-year term.

g. Trademark Trial and Appeal Board

The total number of interrogatories which a party may serve upon another in a proceeding shall not exceed seventy-five (75), counting sub-parts, except upon motion to the Board.

If you have any questions, please call (703) 308-0928. Status inquiries can be an wered by calling (703) 305-8747.

24. WITHDRAWAL OF ATTORNEY

To expedite requests for permission to withdraw as attorney under 37 CFR §1.36, submit the request in triplicate (original and two copies) and indicate thereon, (1) the present mailing address of the attorney who is withdrawing, and (2) the last known address of the applicant. The examining group number should also appear on all such requests. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

A request to withdraw is effective when approved rather than when received. This is particularly important when such requests are submitted toward the end of the period

appln. This cannot be re-expanded.

Computer program ID's. must specify function or purpose of program - not users, intended use, or industry for which program is intended. This is to minimize likelihood of confusion.

TM office - registrability of 1-800 - generic term. Cts. of Appeals split re registrability 1-800 + generic term office will no longer register or single color, even if strong evidence of 2° meaning. Office wants fed. Cir. reading on this.

Due diligence std. - 10-27-92 O.G. notice

§ 711 of TMEP inquiries of status should be made within 6 mos. of time at which office action is expected.

Electronic filing pub. in 11-30-92 Federal Register

for response. There should be at least 30 days between approval of withdrawal and the expiration date of a time response period so that the applicant will have time to obtain other representation or take other action. If less than 30 days remains in a running response period, a request to withdraw is normally disapproved.

If a period has been set for response and the period may be extended [without a showing of cause pursuant to 37 CFR 1.136(a)] by filing a petition for extension of time and fee, it is not necessary to seek such extension of time for withdrawal to be approved. In such a situation, however, withdrawal will not be approved unless at least 30 days would remain between the date of approval and the last date on which such a petition for extension of time and fee could properly be filed.

TM Update - Samuels

ITU - must state bona fide intent to use in commerce
§44 - use in commerce does not obviate requirement for statement of bona fide intent to use.

Amendments to allege use - Rule 2.76 - can only be filed between filing of appln. & notice of publication. Rule 2.88 statement of use cannot be filed prior to notice of Allowance

Safest time to file Amdt. to allege use - when appln. is under control of application - need to file response to OA.

Check c̄ TM status line, file by XPRS mail - office will consider amdt. timely filed. Blackout does not begin until day after mark is approved for publication.

If amt. to allege use is returned as untimely, refile c̄ cover sheet stating this is statement of use. Need not re-execute papers if filed within 6 mos. after signing, no requirement for certification. Examiners have discretion to extend this period.

Requests for extention of time to file statement of use - 6 mo. increments. After 1st, must show good cause - see rules for cause.

Rule 2.89 - Corrections of defects in extension request must be made by refiling or petition to Commissioner

Only applicant can sign extension request.

Must pay separate fee for each class extension.

Must specify goods or services for which applicant has bona fide intent to use. Better to incorporate by ref "goods c̄ ~~serv~~ services set forth in notice of allowance" or - "except for" those to be deleted.

Cannot use certificate of ~~express~~ mailing for statement of use or request to extension - CAN use express mail

Absent clear error, any issue that could have or should have been raised during prosecution cannot be raised during statement of use.

In re Land's End 24 PQ2d 1314 - Catalog specimens ok if picture of goods is in catalog & mark is close enuf to goods, & catalog gives enuf info. to permit customer to place order by phone or mail c̄ TM.

Rule 2.71b - ID of goods or services may be amended to clarify or limit, but not to broaden.

In re Swensen 21 PQ2d 1794 - atty. consented by error to limit

PUBLISHED DECISIONS

1. Intentional Abandonment

   - In re Maldague, 10 USPQ2d 1477

   - In re Application of G, 11 USPQ2d 1378

2. Unavoidable Abandonment

   - In re Wilson, 8 USPQ2d 1375

   - In re Application of S, 8 USPQ2d 1630

   - Kim v. Quigg, 12 USPQ2d 1604 & In re Kim, 12 USPQ2d 1595

   - Krahn v. Commissioner, 15 USPQ2d 1823

   - In re Lonardo, 17 USPQ2d 1455

   - In re Borenstein, 20 USPQ2d 1621

   - Douglas v. Manbeck, 21 USPQ2d 1697

3. Maintenance Fees

   - Rydeen v. Quigg, 16 USPQ2d 1876

   - In re Patent No. 4,461,759, 16 USPQ2d 1883

UNINTENTIONALLY DELAYED PAYMENT OF A MAINTENANCE FEE

Public Law 102-444, enacted October 23, 1992, provides for the acceptance of an unintentionally delayed payment of a maintenance fee. The Office has issued interim rules (published November 30, 1992 in the Federal Register at 57 FR 56448 and on December 8, 1992 in the Official Gazette at 1145 OG 339) to put the bill's provisions into effect.

(c) Any petition to accept an unintentionally delayed payment of a maintenance fee filed under paragraph (a) of this section must be FILED WITHIN TWENTY-FOUR MONTHS AFTER THE SIX-MONTH GRACE PERIOD provided in § 1.362(e) and must include:

(1) The required maintenance fee set forth in § 1.20 (e)-(g);
(2) The surcharge ($1500) set forth in § 1.20(i)(2); and
(3) A statement that the delay in payment of the maintenance fee was unintentional.

State DELAY unintentional

file petition ASAP after realizing delay

PROBLEMS:

(1) Entire period of delay must be unintentional;
(2) Statements of facts not necessary unless question of intentional delay is present;
(3) Statement of unintentional delay not made by appropriate person.

If final rule lowers $1500 fee, PTO must refund XS paid

No requirement for statement of facts unless there is evidence of intentional delay

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

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

(b) Any PETITION TO ACCEPT AN UNAVOIDABLY DELAYED PAYMENT OF A MAINTENANCE FEE filed under paragraph (a) of this section must include:

(1) The required maintenance fee set forth in § 1.20 (e)-(g);
(2) The surcharge (**$620**) set forth in § 1.20(i)(1); and
(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

PROBLEMS:

(1) Failure to change the address of record;
(2) Failure to properly inform clients upon issuance;
(3) Failure to provide statements and evidence.

- Rydeen v. Quigg, 16 USPQ2d 1876 - Reminder received by attorney close to expiration date - not unavoidable since PTO is not required to send notice and no steps were taken on behalf of patentee to ensure timely payment - Constitutional challenges (due process, equal protection, separation of powers) were not accepted

- In re Patent No. 4,461,759, 16 USPQ2d 1883 - Attorney stated that the client discharged attorney after issuance of patent. Client stated that attorney was never instructed to terminate their obligation to maintain records & forward notices regarding the maintenance fee - PTO not proper forum to resolve dispute between attorney & client - not unavoidable since record did not establish that any steps were taken to ensure timely payment of the maintenance fee

Someone - not necessarily atty must keep docket records & immediate to Atty

ABRAHAM HERSHKOVITZ (703) 305-9282

Virginia State Bar Association

February 16, 1993

This presentation will cover recent developments in patent practice and procedures.

Presentation Agenda

I. Changes in the acceptance of late maintenance fees

   1. Petitions to reinstate expired patents

      a. Unavoidable

      b. Unintentional

II. Filing of papers by an assignee

   1. Types of papers requiring compliance with 37 CFR 3.73(b)

   2. Certification

   3. Terminal disclaimer

III. International applications

   1. Requirements to obtain a filing date

   2. Notice to file missing parts

IV. Information disclosure statements

   1. Petitions to withdraw from issue

   2. Unpatentable claims

V. Filing of continuing applications

VI. Proposed rule changes

   1. Filing and signature requirements

   2. Revival of applications and reinstatement of patents

   3. Changes in patent drawing standards

   4. Miscellaneous changes in patent practice

3.73(b) Filing of papers by an assignee.

When an assignee seeks to take action in a matter before the Office with respect to a patent application, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee's ownership may be established either 1) by submitting to the Office copies of the documentary evidence of a chain of title from the original inventor to the assignee, or 2) by specifying, by reel and frame number for example, where such documentary evidence is recorded in the Office. In addition to the establishment of ownership, there is a further requirement that the assignee submit a statement specifying that the evidentiary documents have been reviewed and certifying that, to the best of the assignee's knowledge and belief, title is in the assignee seeking to take action.

If the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.), the statement must be signed by a person in the organization having the authority to sign on behalf of the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of a corporation. A statement signed by a person other than an officer will be accepted by the Office provided that the statement is a verified statement (accompanied by an oath or declaration under § 1.68) and includes an averment that the person signing is empowered to act on behalf of the assignee. Where a statement does not include such an averment, evidence of the person's authority to sign will be required.

Examples of situations considered to be taking an action before the Office in which ownership by the assignee must be established under 37 CFR 3.73(b) are: the appointment of a legal representative by the assignee; the filing of a terminal disclaimer by the assignee; an assignee's written consent in a reissue application; an assignee's oath or declaration in a reissue application which does not seek to enlarge the scope of the claims in the original patent; an assignee's written consent to the correction of inventorship; and a response to an Office action in which the response is signed by the assignee.

Examples of situations not considered to be taking an action before the Office so as to require compliance with 37 CFR 3.73(b) are: filing of a small entity declaration by the assignee or the filing of an affidavit or declaration of common ownership of two inventions by the assignee.

PTO will no longer do title searches to ascertain authority of "assignee".

Must give copy of assn. w Reel & frame #

Must certify that assignee believes that title resides in assignee

SEE ATTACHED SAMPLE FORM FOR REQUIREMENTS & CERTIFICATION

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant:_____

Application No.:_____ Filed:_____

For:_____

_____, a_____,

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

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

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

OR

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

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

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

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

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

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

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above .

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

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date :_____

Name :_____

Title :_____

Signature:_____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of
(NAME) _____

Patent No. _____

Issue Date: _____

For: _____

TERMINAL DISCLAIMER

Petitioner, _____, is the owner of _____ percent interest in the above-identified patent.

Petitioner hereby disclaims a terminal part of the term of the patent equivalent to the period that the patent has lapsed. This disclaimer is binding upon the grantee, its successors or assigns.

For submissions on behalf of an organization (e.g. corporation, partnership, university, government agency, etc.), the person signing (whose title is supplied below) is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

_____
Printed name (and title if applicable)

_____ _____
Date Signature

_____ terminal disclaimer fee under 37 CFR 1.20(d) included

THE STATEMENT BELOW IS FOR OFFICE USE ONLY

In accordance with the decision granting the petition filed on _____, this terminal disclaimer is accepted. The period of patent lapse specified above has been accepted as equivalent to _____ months.

_____
Petitions Examiner

(This is for disclaiming period of abandonment of application) NOTE "blank check" for period.

PCT Member Countries

▲ EPO Patent Only
❑ Not a member of Chapter II

Europe

Austria
▲ Belgium
Bulgaria
Czechoslovakia
Denmark
Federal Republic of Germany
Finland
▲ France
▲ ❑ Greece
Hungary
▲ Italy
▲ Ireland *(effective 01 Aug'92)*
❑ Liechtenstein
Luxembourg
Monaco
Netherlands
Norway
Poland
Portugal *(effective 24 Nov'92)*
Romania
Russian Federation
❑ Spain
Sweden
❑ Switzerland
Ukraine *(effective 21Sep92)*
United Kingdom

Africa

(OAPI)
Benin
Burkina Faso
Cameroon
Central African Republic
Chad
Congo
Cote d'Ivoire
Gabon
Guinea
Mali
Mauritania
Togo
Senegal

Madagascar
Malawi
Sudan

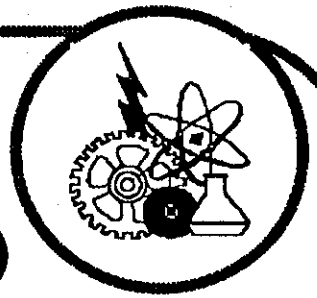
Western Hemisphere.

Barbados
Brazil
Canada
United States of America

Far East

Australia
Democratic Peoples Republic of Korea (North Korea)
Japan
Mongolia
New Zealand *(effective 01 Dec'92)*
❑ Republic of Korea (South Korea)
Sri Lanka

Changes effective 01 July 1992 (Summary)



I. The Applicant in an International Application

II. International Filing Fees

III. Designation of Member States

IV. Signing of International Application

V. Unity of Invention

VI. Miscellaneous Provisions

1. Computer generated forms acceptable
2. Publication of notice when Demand is filed
3. Consideration of Article 19 and 34 amendments

Changes effective 01 July 1992

I. The Applicant in an International Application

- Before 01 July 1992 at least one applicant for each designated state must have been a resident or national of a PCT member country (PCT Rule 18.4(a) and (b))

- On and after 01 July 1992 only one applicant in the international application is required to be a resident or national of a PCT member country (PCT Rule 18.4(a) and (b) have been canceled)

  This allows applicants from non- member states to be the sole applicant for a particular designation or designations so long as there is at least one applicant in the international application who is a resident or national of a PCT member country

Remember:

The international application must be filed with the national office of which the applicant is a resident or national.

Changes effective 01 July 1992

II. International Filing Fees

- payment of transmittal, basic and search fees due on filing, or one month from filing or one month from invitation to pay fees

- if not paid on filing or one month after filing, additional late payment fee must be paid equal to 50% of the amount of deficient fees up to a maximum amount of basic fee, or an amount equal to transmittal fee

- if designation fees are not paid within one year of priority date or one month from date of receipt of international application (whichever is later), same additional late payment fee must be paid within one month of invitation

- if at least one designation fee is not paid the international application will be withdrawn

Changes effective 01 July 1992

III. Designation of Member States

- previous rules were inflexible and unforgiving: original designation of states could not be changed

- initial designation of all member states with international application (use July '92 version of the Request (form RO/101) or follow PCT rule 4.9(b))

- confirmation of desired designated states by end of fifteen months from priority date (use Form PCT/RO/144)

- confirmation fee equal to 50% of the sum of the designation fees for the national and regional designations being confirmed

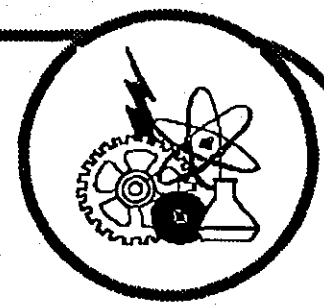
Changes effective 01 July 1992

IV. Signing of International Application

- where two or more applicants (inventors) file an international application designating the U.S., and one inventor refuses to sign or could not be found after diligent effort, the request need not be signed by that inventor if it is signed by at least one applicant, and a statement is furnished explaining, to the satisfaction of the receiving office, the lack of signature, PCT rule 4.15(b)

- for applications filed in the U.S. receiving office the statement must include compliance with 37 CFR 1.425
  - e.g. if at least one inventor refuses and at least one signs proof of the pertinent facts and the last known address of the omitted inventor(s) must be submitted, 37 CFR 1.425(a)
  - e.g. if the sole inventor refuses the assignee must submit proof of the pertinent facts and the last known address of the omitted inventor(s), 37 CFR 1.425(b)

Changes effective 01 July 1992



V. Unity of Invention

- test is whether there is a technical relationship among the claimed inventions having one or more of the same or corresponding special technical features

- special technical feature is a technical feature that defines a contribution which each claimed invention, considered as a whole, makes over the prior art

VI. Miscellaneous Provisions

- computer generated forms, 37 CFR

- publication when notice of demand is filed

- consideration of Article 19 and Article 34 amendments

Changes Effective 01 May 1993

Entry into the national stage in the United States

(new practice is closer to Rule 53 national application practice)

20/30 months
- **basic national fee (required to avoid abandonment)**
- **copy of international application (required to avoid abandonment)**
- **oath/declaration (notice of missing parts)**
- **translation (notice of missing parts)**

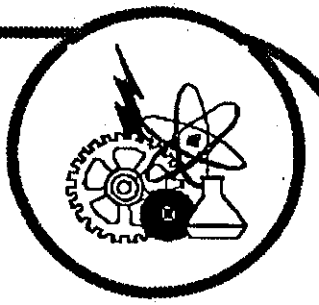
Applicant must have filed the basic national fee **by 20/30 months to avoid abandonment. Check to be sure the International Bureau has forwarded the copy of the international application.**

A missing parts notice (response time extendable under 37 CFR 1.136) will be sent to applicant if the oath or declaration and any required translation have not been received by 20/30 months. The 37 CFR 1.492(e) surcharge is required for oath/declaration submitted after 20/30 months & 37 CFR 1.492(f) processing fee is required for any required translationsubmitted after 20/30 months.

U.S. PATENT AND TRADEMARK OFFICE

U.S. PTO will send notice of missing parts, setting a deadline. Any applin. in which 20 or 30 mo. pd expires after 08 will be under OLD RULES!

Fee Changes



Effective 01 October 1992

Transmittal fee $200
Search fee...
-No prior U.S. $620; prior U.S. $410; supplemental $170; EPO $1,635
Examination fee
-ISA/US $450; additional invention $140
-ISA/EP $670; additional invention $230
National Stage
IPEA/US $320, $640
ISA/US but not IPEA/US $355, $710
US neither ISA nor IPEA $475, $950
EPO or JPO search report $415, $830
Independent claims in excess of 3 $74
Each claim in excess of 20 $22
Each application with a multiple dependent claim $230

Effective 01 December 1992

- **Basic fee (first 30 pages).....$ 593**
- **Basic Supplemental fee (for each page over 30).....$ 12**
- **Designation fee (per country or region up to 10) .....$ 144**
- **Handling fee .....$ 181**

Information disclosure statements § 1.97

(1) An information disclosure statement (IDS) will be considered if filed within 3 months of filing or before a first action on the merits, whichever is later.

(2) After (1), but before a final action or notice of allowance, need certification or § 1.17(p) fee.

(3) After final action or notice of allowance, but before payment of issue fee, need certification and petition and petition fee.

(4) After payment of the issue fee, an IDS will not be considered. However, the IDS could be considered if the application were first withdrawn from issue. See 37 CFR 1.313. The application will not be withdrawn from issue unless at least one claim is unpatentable (37 CFR 313(b)(3)) (in which case an amendment should also be filed to amend or cancel the non-allowable claim), or the application is to be abandoned in favor of a continuation application (37 CFR 313(b)(5)).

Note that the issue fee will not be refunded. Additionally, if insufficient time is left before issuance of the patent (usually at least one week), the petition to withdraw the application from issue will not be granted.

Filing of continuing applications

Applications filed under 37 CFR 1.60 will retain their original filing dates even if a copy of the oath or declaration is not provided at the time of filing. See 57 FR 56446 (November 30, 1992) and 1145 Off. Gaz. Pat. Office 377 (December 22, 1992). In a manner similar to applications filed under §§ 1.53 or 1.62, a notice of missing parts will be mailed out, giving applicant an opportunity to file the missing copy of the declaration.

Proposed rule changes

1. Filing and signature requirements (57 Fed. Reg. 36034 (August 12, 1992); 1142 OG 8 (September 1, 1992)).

Original signatures would no longer be required on most correspondence, i.e. photocopies and fax transmissions will be acceptable. Mail Drop Boxes provided in lobby of Crystal Plaza 3 and Main Commerce have been removed.

Most comments were favorable, with some asking for an even further liberalization from that proposed.

2. Revival of applications and reinstatement of patents

In an Interim rule published at 57 Fed. Reg. 56448 (November 30, 1992) and 1145 Off. Gaz. Pat. Office 339 (December 8, 1992), the unintentional standard was made available for late payment of maintenance fees if petition is filed within 24 months after the six month grace period provided in § 1.362(e). Require terminal disclaimer for certain petitions filed under the unintentional standard. Most comments were favorable.

3. **Changes in Patent Drawing Standards** (57 Fed. Reg. 42721 (September 16, 1992); 1143 Off. Gaz. Pat. Office 13 (October 6, 1992))

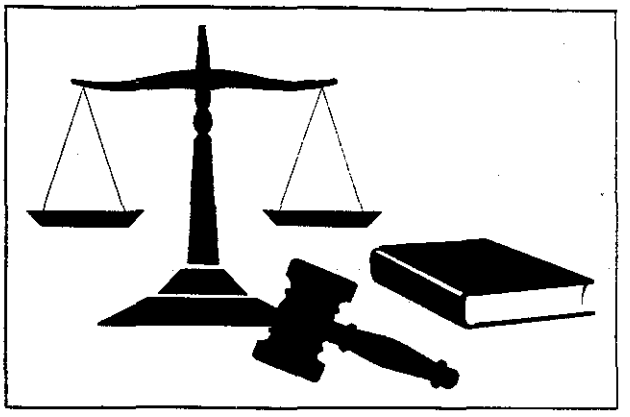
Adopt international standards for patent drawings. Permit design application drawings to include black and white photographs. Eliminate acceptability of mounted photographs in plant patent applications. Final rules being prepared, taking comments into consideration.

4. **Miscellaneous Changes in Patent Practice** (57 Fed. Reg. 43412 (September 21, 1992); 1143 Off. Gaz. Pat. Office 33 (October 13, 1992)).

Expand authority to sign terminal disclaimers. Prohibit paid extensions of time to: correct drawings after allowance; file reply briefs; request oral hearings on appeal. Require design applications to describe nature and intended use of article claimed. Final package being prepared to respond to a number of adverse comments.

CALL
DAVE C.

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.



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CHANGES IN U.S. PATENT LAW DUE TO GATT/TRIPs

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I. INTRODUCTION

On December 8, 1994, President Clinton signed into law the Uruguay Round Agreements Act, changing U.S. patent law in four significant ways. First, starting on January 1, 1996, individuals in World Trade Organization (WTO) member countries will be able to prove a date of invention based upon activities outside the United States, in the WTO country. Second, infringement will include not only "making, using, and selling" a patented product or a product made by a patented process but will also include "offers to sell" and "importation" of a patented product or a product made by a patented process. Third, starting on June 8, 1995, the term of a U.S. patent will expire 20 years from the first U.S. filing date. Finally, the United States has established a "domestic priority system," permitting applicants to file "provisional" applications. Each of these changes will significantly affect future U.S. patent prosecution and full benefit may not be obtained without immediate action.

II. DATE OF INVENTION UNDER 35 U.S.C. § 104

Under the Uruguay Round Agreements Act, 35 U.S.C. § 104 was amended to permit patentees and patent applicants to establish a date of invention by knowledge, use, or activity

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in a WTO member country. Effective January 1, 1996, an inventor may rely on inventive activity outside the United States to prove a date of invention earlier than a foreign priority or PCT filing date.

The amendment to 35 U.S.C. § 104 is not retroactive. It will only apply to applications filed after January 1, 1996. Thus, inventive activity occurring in a WTO country, even if before January 1, 1996, will not establish an invention "date" prior to January 1, 1996.

This change first affects *inter parties* interference proceedings in the United States Patent and Trademark Office (USPTO) that determine which of two or more parties claiming the same patentable invention are entitled to patent the claimed subject matter. Second, this change affects declarations under 37 C.F.R. § 1.131, which are used during patent prosecution to antedate applied prior art.

In the area of interferences, amended § 104(a)(3) appears to impose a mandatory requirement on the USPTO or a U.S. court to "draw appropriate inferences" when evidence relevant to the date of invention cannot be obtained from a party to the interference because of the laws of the WTO member country. Potentially, this requirement may apply to third parties in WTO member countries who possess relevant information. See proposed Rule 37 C.F.R. § 1.616.

Therefore, if nationals of WTO member countries wish to benefit from these changes in U.S. patent law and prove a date of invention in a WTO member country, they should modify the manner in which records are kept for research to comply with the rules of

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evidence in the United States, for example, by having all research data corroborated by a disinterested witness..

III. PATENT TERM

Subject to the payment of maintenance fees, a United States patent presently protects a claimed invention for 17 years from the issue date of the U.S. patent. However, for patents issuing from applications filed on or after June 8, 1995, the term of a U.S. patent will be measured 20 years from the "first" U.S. filing date. The "first" U.S. filing date is the earliest filing date to which the issuing patent application claims benefit under 35 U.S.C. §§ 120 (continuation and continuation-in-part applications), 121 (divisional applications), or 365(c) (PCT applications).

For patents issued from applications that are pending, or patents in force, on June 8, 1995, the patentee will benefit from a term of 17 years from the issue date or 20 years from the first U.S. filing date, whichever term is longer (17/20 year provision). Determination of the actual patent term, however, is subject to several factors, as explained below.

A. Issued Patents

Patents that are in force on June 8, 1995, will benefit from a term of either 17 years from the issue date or 20 years from the first U.S. filing date, whichever term is longer. 35 U.S.C. § 154(c)(1). A patent is considered to be in force if it has not expired and if all

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applicable maintenance fees have been paid. By operation of law, the term of any patent in force, based on an application with a total pendency (including claimed benefit) of less than three years, will enjoy the longer of 17 or 20 years and will expire at the end of the longer term.

Terminal disclaimers continue to apply to patents in force. A terminal disclaimer may link the expiration date of the disclaimed patent with that of a referenced patent. Therefore, if the term of the referenced patent is made longer by the 17/20 year provision, the expiration date of the disclaimed patent may be similarly affected. Since patent rights may be affected by this change, the language of existing terminal disclaimers should be reviewed to determine if they set a date certain for expiration. If not, the extension may apply.

Finally, agreements involving issued patents, for example, licenses and settlements, should be reevaluated to determine what, if any, effect the change in patent term may have.

B. Pending Applications

Patents that issue directly from applications filed before June 8, 1995, will enjoy the same benefits as patents in force on June 8th. Such patents will be subject to a term of 17 years from the issue date or 20 years from the first U.S. filing date, whichever term is longer.

For pending applications, the USPTO has proposed "transitional provisions" to help applicants place qualifying applications in condition for allowance or appeal without the need to file any continuing applications after June 8, 1995. See proposed Rule 37 C.F.R. § 1.129.

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The transitional provisions are expected to encompass only a small fraction of all pending applications. They apply to two areas, restriction and after-final practice.

The first transitional provision concerns restriction practice. If a pending application was first filed in the U.S. before June 8, 1992, and if a restriction requirement issues after April 8, 1995, the applicant may pay a fee for each additional invention examined in a single application. By this procedure, the applicant need not file divisional applications after June 8, 1995, and, thus, the applicant preserves the opportunity to obtain the longer patent term (i.e., 17 or 20 years). The only limitation on this provision is that it will not apply if the applicant took action to delay issuance of an Office Action (e.g., requesting suspension of examination). See proposed Rule 37 C.F.R. § 1.129.

Procedurally, the applicant must make a request and pay a fee of $730.00 for each independent invention in excess of the one elected invention. All independent inventions for which the fee is paid will be examined together in a single application, resulting in a single patent, for which a single issue fee and a single set of maintenance fees are due.

The second transitional provision concerns practice after a Final Office Action. If a patent application was first filed in the U.S. before June 8, 1993, and the applicant has received a Final Office Action, the applicant may have two further submissions considered as a matter of right by the USPTO. Therefore, the applicant may avail himself of traditional after-final practice under 37 C.F.R. § 1.116 and also may pay a fee ($730.00 each) in return for the Examiner's consideration of up to two submissions after final not qualifying for entry

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under § 1.116. See proposed rule 37 C.F.R. § 1.129. By this procedure, the applicant need not file continuing applications after June 8, 1995, to place the application in condition for allowance or better form for appeal. This potentially preserves the opportunity to obtain a patent with a term of 17 years from the issue date.

C. Future Applications

The changes to U.S. patent law provide a new term for patents issuing from applications filed on or after June 8, 1995. All patents issuing from applications filed on or after June 8, 1995, will have a term of 20 years from the first U.S. filing date and will not be entitled to a patent term of 17 years from the issue date.

Due to this change, foreign applicants who wish to preserve the opportunity to obtain a patent with a term of 17 years from the issue date should accelerate the filing of a U.S. counterpart to obtain a U.S. filing date no later than June 7, 1995.

The changes to U.S. patent law, effective on June 8, 1995, also provide for the extension of the term of a patent where the issuance of the patent was delayed because of certain administrative delays during pendency. These extensions are granted on patents that are issued from applications filed on or after June 8, 1995. Administrative delays include: (1) successful appeals, (2) secrecy orders, and (3) interferences. If a patent application encounters one or more of these three delays, the term of the patent that issues from such an application may be extended for a period up to, but not exceeding, five years. 35 U.S.C. §

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154(b).

If a patent application is subject to a secrecy order or interference during pendency, the term of the patent that issues from such an application will be extended for the time period equal to the administrative delay. For example, if the USPTO maintains a secrecy order for 100 days during pendency of the application, the term of the resulting patent will be extended for 100 days. If the USPTO declares an interference that is resolved after one year, the term of the resulting patent will be extended for one year. If, however, the USPTO maintains a secrecy order or fails to resolve an interference for more than five years, the term of the patent that issues will be extended for only five years. Moreover, the five year limitation is cumulative. If an application is subject to a secrecy order for two years followed by an interference that lasts for four years, the term of the resulting patent will be extended for only five years.

For successful appeals, the calculation of an extension of patent term is more complex. The USPTO will determine the period for extension of a patent that issues after a successful appeal to the Board of Patent Appeals and Interferences or to a Federal Court. To qualify for this extension, at least one claim must successfully survive the appeal. A patent subject to a terminal disclaimer is not eligible for patent term extension because of successful appellate review.

Procedurally, the USPTO will calculate the appeal period by: 1) determining the time period from the date of the Notice of Appeal to the date of the final determination; 2)

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subtracting from that time period the length of time the Notice of Appeal was in the USPTO before the end of three years from the filing date; and 3) subtracting any period that the applicant did not act with "due diligence." The USPTO has not determined what will constitute a period without "due diligence" but has suggested that whenever the applicant fails to timely prosecute the application, such a time period may be viewed as a period without "due diligence." One example given is when the applicant files an application which is not complete. The period before completing the filing requirements may be considered a time without "due diligence."

The USPTO will determine the term of the patent extension before a patent issues. If dissatisfied with the USPTO's determination, the applicant can petition the Commissioner for review.

IV. U.S. DOMESTIC PRIORITY SYSTEM

A U.S. domestic priority system has been established to allow filing a "provisional" application in the United States to which § 119 priority may be claimed. The effective date of the domestic priority system is June 8, 1995.

A "provisional" application must be filed with a specification, a drawing if needed to understand the invention, a cover sheet, and a filing fee of $150.00 (or $75.00 for a small entity). The cover sheet must contain a list of inventors, identify the paper as a provisional application, provide the title of the invention, and set forth a correspondence address. This

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application is abandoned at the end of 12 months. To preserve the benefit of the filing date of the provisional application, a regular application must be filed within the twelve months from the filing date of the provisional application, claiming priority to the earlier filed "provisional" application. Because priority is claimed under § 119(e)(1), not § 120, the pendency time of the provisional application is not included within the calculation of the 20 year term.

Provisional applications cannot claim priority to any other applications, either domestic or foreign. The provisional application need not be filed in English. However, to rely upon the provisional application, the USPTO may require the applicant to file a verified English translation. Provisional applications must also satisfy the disclosure requirements of 35 U.S.C. § 112, first paragraph.

A regular application may be converted into a provisional application within 12 months from the filing date, provided the issue fee has not been paid. Like regular applications, provisional applications can be assigned.

Provisional applications create a "shield" against prior art upon their filing. They may also, unlike foreign priority documents, provide a "sword" against the patentability of later-filed applications under 35 U.S.C. § 102(e).

Unlike foreign priority applications, provisional applications establish a U.S. filing date upon which an applicant may rely to avoid prior art under 35 U.S.C. § 102(b). The fee for filing a provisional application is modest in comparison to the fee associated with a regularly-

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filed U.S. patent application. Therefore, for a modest fee, an applicant can establish a U.S. filing date at the same time that he obtains a filing date in his home country. By filing a provisional application simultaneously with foreign counterparts, the applicant may effectively "push back" the § 102(b) prior art date by up to one year, successfully avoiding prior art that traditionally could not be avoided without filing a regular U.S. patent application. As a result, foreign applicants are encouraged to take advantage of these provisions.

V. INFRINGEMENT PROVISIONS

The amendments under the Uruguay Round Agreements Act also redefine patent infringement in two significant respects. First, to accommodate the change in patent term, the law addresses intervening rights for parties who become infringers because of the longer of the 17 or 20 year patent term. Second, the law adds "offers for sale" and "importation" to the acts that traditionally constitute patent infringement.

The change in patent term is expected to affect certain parties whose business plans may have been driven by the anticipated expiration of certain patents. As a result, the law allows parties, who have made a "substantial investment" before June 8th, to conduct acts of infringement, in the period between the expiration date of the 17 year patent term and the expiration date of the 20 year patent term, in return for payment to the patent owner of "equitable remuneration." 35 U.S.C. §§ 154(c)(2) and 154(c)(3). Neither "substantial investment" nor "equitable remuneration" is defined by the statute. Some view this provision

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as a compulsory license ("equitable remuneration") to those who have made "substantial investment" before June 8th.

On January 1, 1996, an "offer to sell" a patented product will become an act of patent infringement if that offer specifies a date of sale, and the date of sale precedes the expiration date of the patent. 35 U.S.C. § 271(i). Offers for sale that specify a date of sale after the expiration date of the patent do not qualify as acts of infringement. Similarly, solicitation of orders or advertising an infringing article, without more, cannot constitute infringement because the date of sale is not specified. Finally, "importation" of an infringing article or "importation" of an article made by an infringing process constitutes patent infringement even if the imported article is not made, used, sold, or offered for sale in the U.S. 35 U.S.C. §§ 154 and 271(g).

VI. CONCLUSION

At a minimum, the changes in U.S. patent law impact pending applications, issued patents, licenses, settlement agreements, and acts of infringement. Applicants should revisit pending applications to determine if any action should be taken to preserve the option of a 17 year term for the patents that issue from those applications. Patentees and patent owners should reevaluate the expiration date of issued patents because the new patent term may confer added value to existing patents. Licensors and licensees should reexamine their agreements, including settlement agreements, to determine if their rights are affected by the

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changes to patent term. Finally, manufacturers should reevaluate their marketing strategies because their actions, though permitted in the past, may now infringe a competitors patent rights.

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