

The following form paragraphs will be deleted as part of revision 2 of the form paragraphs and should not be used: 6.09, 6.28.03, 10.10 - 10.12, 12.05 - 12.07, 12.14, 12.15, 12.46, 12.48, 12.51.06, 12.58, 12.58.01, 12.58.02, 12.60, 12.60.01, 12.60.02, 12.62, 14.02 - 14.04.01, 14.20, 14.21, and 14.31.

The following new and amended form paragraphs, which will be included as part of revision 2 of the form paragraphs, have been reproduced below: 2.13, 2.13.01, 2.13.02, 2.14, 2.14.01, 2.30-2.35, 6.05.18 - 6.05.20, 6.08.01, 6.51, 7.204 - 7.206, 8.23.02, 12.12, 12.13, 12.80, 12.81, 14.01 - 14.01.04, 14.05.02, 14.16, 14.16.01 - 14.16.06, 14.21.01, 14.21.09, 14.29.02, 14.33, 22.11, 22.12, 22.13, and 22.14.

Many other form paragraphs have been revised in revision 2.

### **CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48(a), INSUFFICIENT**

**2.13**

The petition to correct the inventorship of this non-provisional application under 37 CFR 1.48(a) is deficient because [1].

#### **EXAMINER NOTE:**

- 1. This paragraph should only be used in response to requests to correct an error in the naming of the prior inventors in non-provisional applications. If the request is merely to delete an inventor because claims were canceled or amended such that the deleted inventor is no longer an actual inventor of any claim in the application, use paragraph 2.13.01 instead of this paragraph.*

#### Potential rejections

*A rejection under 35 U.S.C. 102(f) or (g) must be considered if the petition is denied.*

*The grant or denial of the petition may result in the loss of inventorship overlap between a parent application and a continuing application and an inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.*

- 2. A primary examiner may not decide the petition if:  
(a) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.48(a) (typically a refusal of one of the inventors to be added or deleted to execute the required statement of facts) - the petition for correction of inventorship and request for waiver of the rules should be forwarded to*

- the Office of Petitions; or*
- (b) it represents an attempt to effect a second conversion under 37 CFR 1.48(a) - the second attempt must be forwarded to the Group Director.*
3. *Insert one or more of the following reasons in the bracket:*
- the statement of facts by an inventor or inventors to be added or deleted does not explicitly state that the inventorship error occurred without deceptive intent on his or her part or cannot be construed to so state;*
  - an oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted--;*
  - it lacks the required fee under 37 CFR 1.17(h)--;*
  - it lacks the written consent of any assignee of one of the originally named inventors--;*
  - a 37 CFR 3.73(b) certification has not been submitted to support a written consent of assignee.*
4. *Where it appears that: 1) the inventor(s) to be added or deleted may be hostile and will not execute a required statement of facts, and 2) the actual inventorship would overlap with the original inventorship (§1.78), include the following paragraph:*
- As it appears that a party required by § 1.48(a)(1) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under § 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an assignee who has given its consent to the requested inventorship correction, MPEP 201.03, Verified Statement of Facts, or b) refiling the application (where addition is needed under § 1.53(b) with a new oath or declaration and any necessary petition under § 1.47, or where only deletion is needed, either under § 1.53(b) utilizing a copy of a prior oath or declaration § 1.63(d)(iii), or under § 1.53(d)), thereby eliminating the need for a § 1.48 petition.*
5. *Petitions under § 1.41 to change inventorship where an executed oath or declaration has not been filed are to be acted upon by OIPE.*
6. *Where there is a correction in a person's name, e.g., due to misspelling, or marriage, a petition under § 1.48 is inappropriate. See 605.04(b) and (c) for name changes.*
7. *An initial executed oath or declaration under § 1.63 may change the inventorship as originally set forth when the application is filed without an executed oath or declaration and without a petition for the correction of inventorship. 37 CFR 1.48(f).*

**CORRECTION OF INVENTORSHIP UNDER  
37 CFR 1.48(b), INSUFFICIENT****2.13.01**

The petition requesting the deletion of an inventor in this non-provisional application under 37 CFR 1.48(b) is deficient because [1].

**EXAMINER NOTE:**

1. *This paragraph should only be used when the inventorship was previously correct when originally executed but an inventor is being deleted because claims have been amended or canceled such that he or she is no longer an inventor of any remaining claim in the non-provisional application. If the inventorship is being corrected because of an error in naming the correct inventors, use paragraph 2.13 instead of this paragraph.*
2. *Insert one or more of the following reasons in the bracket:  
--the petition lacks the statement required under 37 CFR 1.48 (b)(1)--;  
--it lacks the required fee under 37 CFR 1.17(i)--.*
3. *See note 1 of form paragraph 2.13 for potential rejections.*

**CORRECTION OF INVENTORSHIP UNDER  
37 CFR 1.48(c), INSUFFICIENT****2.13.02**

The petition to correct the inventorship in this non-provisional application under 37 CFR 1.48(c) requesting addition of an inventor(s) is deficient because [1].

**EXAMINER NOTE:**

1. *This paragraph should only be used if the inventorship was previously correct when the application was originally executed and the inventorship now needs to be changed due to subsequent addition of subject matter from the specification to the claims, which subject matter was contributed by a party not originally named as an inventor.*
2. *See note 2 of form paragraph 2.13.*
3. *Insert one or more of the following reasons in the bracket:  
--the statement of facts by the inventor(s) to be added does not explicitly state that the amendment of the inventorship is necessitated by amendment of the claims and that the inventorship error occurred without*

*deceptive intent on the part of the inventor(s) to be added, or cannot be construed to so state;*

*--an oath or declaration by each actual inventor or inventors,*

*listing the entire inventive entity, has not been submitted--;*

*--it lacks the required fee under 37 CFR 1.17(i)--;*

*--it lacks the written consent of any assignee of one of the originally named inventors--;*

*-a 37 CFR 3.73(b) certification has not been submitted to support a written consent of assignee.*

4. See note 1 of form paragraph 2.13 for potential rejections.

5. See notes 4-7 of form paragraph 2.13.

#### **CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48(a) OR (c), SUFFICIENT**

**2.14**

In view of the papers filed [1], it has been found that this non-provisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48([2]). The inventorship of this application has been changed by [3].

The application will be forwarded to OIPE for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

#### **EXAMINER NOTE:**

1. In bracket 2, insert --a-- or --c--, as appropriate.

2. In bracket 3, insert explanation of correction made, including addition or deletion of appropriate names.

#### **CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48(b), SUFFICIENT**

**2.14.01**

In view of the papers filed [1], the inventorship of this non-provisional application has been changed by the deletion of [2].

The application will be forwarded to OIPE for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

#### **EXAMINER NOTE:**

1. This form paragraph is to be used only for 37 CFR 1.48(b) conversions.

2. In bracket 2, insert the name(s) of the deleted inventor(s).

**CPA STATUS ACCEPTABLE****2.30**

The request filed on [1] for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. [2] is acceptable and a CPA has been established. An action on the CPA follows.

**EXAMINER NOTE:**

1. Use this paragraph in the first Office action of a CPA to advise the applicant that a request for a CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA.
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number of the parent application.

**CPA STATUS NOT ACCEPTABLE - REQUEST NOT ON SEPARATE PAPER** **2.31**

Receipt is acknowledged on [1] of the request for a Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) based on Application No. [2]. However, because the request was not submitted on a separate paper as required by 37 CFR 1.53(d)(2), the request is not acceptable and no CPA has been established.

**EXAMINER NOTE:**

1. Use this paragraph when a request for a CPA is not a separate paper per 37 CFR 1.53(d)(2) and, therefore, no CPA has been established. For example, if a request is included in an amendment submitted under § 1.116, the CPA request will not be acted upon. However, an extension of time may be included with the paper requesting a CPA without violating § 1.53(d)(2).
2. In bracket 1 insert the filing date of the paper containing the request for a CPA.
3. In bracket 2 insert the Application Number of the prior application identified in the CPA request.

**REQUEST TO DELETE A NAMED INVENTOR****2.32**

Receipt is acknowledged of the statement requesting that [1] be deleted as a named

inventor which was filed with the Continued Prosecution Application (CPA) on [2]. The inventorship has been corrected as requested.

**EXAMINER NOTE:**

- 1. Use this paragraph where a Continued Prosecution Application (CPA) is filed accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. Any request to delete a named inventor in a CPA filed after the CPA is filed must be accompanied by a petition under 37 CFR 1.48.*
- 2. In bracket 1 insert the name or names of the inventor(s) requested to be deleted.*
- 3. In bracket 2 insert the filing date of the CPA.*

**NEW INVENTOR IDENTIFIED**

**2.33**

It is noted that [1] was/were identified as a named inventor in the Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) on [2], but no petition required by 37 CFR 1.48, was filed to correct the inventorship. Any request to add an inventor must be in the form of a petition under 37 CFR 1.48. Otherwise, the inventorship in the CPA shall be the same as in the prior application.

**EXAMINER NOTE:**

- 1. Use this paragraph where a request for a Continued Prosecution Application (CPA) identifies one or more inventors who were not named as inventors in the prior application on the filing date of the CPA and the request is not accompanied by a petition under 37 CFR 1.48.*
- 2. In bracket 1 insert the name or names of the inventor(s) requested to be added.*
- 3. In bracket 2 insert the filing date of the CPA.*

**REFERENCE IN CPA TO PRIOR APPLICATION**

**2.34**

The amendment filed [1] requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a continuing application of Application No. [2] has not been entered. As set forth in 37 CFR 1.53(d)(7), a request for a CPA is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. Thus, there is no need to amend the first sentence of the specification to

refer back to the prior application and any such amendment shall be denied entry.

**EXAMINER NOTE:**

1. *Use this paragraph to inform the applicant that an amendment to the first sentence of the specification referring to the CPA as a continuing application of the prior application has not been entered and will not be entered if submitted again.*
2. *In bracket 1 insert the filing date of the amendment.*
3. *In bracket 2 insert the Application Number of the prior nonprovisional application.*

**CPA STATUS ACCEPTABLE - CONDITIONAL REQUEST**

**2.35**

Receipt is acknowledged on [1] of the "conditional" request for a Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) based on prior Application No. [2]. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

**EXAMINER NOTE:**

1. *Use this paragraph in the first Office action of a CPA to advise the applicant that a "conditional" request for a CPA is acceptable and that a CPA has been established. This notice should be given since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA.*
2. *In bracket 1 insert the filing date of the request for a CPA.*
3. *In bracket 2 insert the Application Number of the parent application.*

**FULL GIVEN NAME IS NOT SET FORTH**

**6.05.18**

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

**EXAMINER NOTE:**

*This paragraph must be preceded by paragraph 6.05.*

**POST OFFICE ADDRESS OMITTED**

**06.05.19**

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

**EXAMINER NOTE:**

1. *This paragraph must be preceded by form paragraph 6.05.*
2. *For declarations filed before December 1, 1997, a post office address is not required as long as the post office address is stated elsewhere in the application.*

**SPECIFICATION NOT IDENTIFIED**

**6.05.20**

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

**EXAMINER NOTE:**

1. *This paragraph must be preceded by form paragraph 6.05.*

**POST OFFICE ADDRESS OMITTED, RESIDENCE GIVEN**

**6.09.01**

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of execution of the declaration. A statement over applicant's signature providing a complete post office address is required.

**EXAMINER NOTE:**

*If both the post office address and residence are incomplete, not uniform or omitted, use form paragraphs 6.05 and 6.05.02.*

**TIME LIMIT FOR COMPLETING INFORMATION  
DISCLOSURE STATEMENT**

**6.51**

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

being placed in the application file with the non-complying information **not** being considered. See 37 CFR 1.97(i).

**EXAMINER NOTE:**

1. *This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in 37 CFR 1.97, have not been complied with.*
2. *In bracket 1 insert the filing date of the information disclosure statement.*
3. *In bracket 2 insert the explanation as to why the information disclosure statement does not comply with the requirements of 37 CFR 1.98.*

**PETITION TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP § 724.02 DISMISSED AS PREMATURE 7.204**

In re Application of [1] :  
 Application No. [2] : DECISION ON PETITION  
 Filed: [3] : UNDER 37 C.F.R. § 1.59  
 For: [4] :

This is a decision on the petition under 37 CFR 1.59(b), filed [5], to expunge information submitted pursuant to MPEP § 724.02.

The petition is dismissed.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record. Petitioner states that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The petition is premature because the application has not been allowed or abandoned. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the petition to expunge must be dismissed at this time.

During prosecution on the merits, the examiner will determine whether or not the identified

document is considered to be "material." Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information. No further fee is required for such a second submission of a petition under 37 CFR 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be returned to applicant.

**EXAMINER NOTE:**

1. *An examiner may only decide this petition if the information was submitted pursuant to MPEP 724.02.*
2. *An examiner may not decide the petition if:*
  - (a) *the information is part of the original disclosure. Information which is part of the original disclosure (specification including any claims, drawings and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Although some papers entered into the application file, e.g. arguments made in an amendment, may be expunged under appropriate circumstances, a petition to expunge information other than that submitted as part of an Information Disclosure Statement should be sent to the Office of Petitions for decision; or*
  - (b) *the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g. requesting expungement of part of the original disclosure) which is decided by the Office of Petitions.*
3. *This decision is printed using a PTO letterhead.*
4. *In bracket 6, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.*

**PETITION TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP § 724.02 GRANTED**

**7.205**

In re Application of [1] :  
 Application No. [2] : DECISION ON PETITION  
 Filed: [3] : UNDER 37 C.F.R. § 1.59  
 For: [4] :

This is a decision on the petition filed [5] to expunge information submitted pursuant to MPEP § 724.02.

The petition is granted.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record. Petitioner states that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

Prosecution on the merits has been closed in the above-identified application since the application has been allowed or abandoned, or an *Ex parte Quayle* action has been mailed. The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which may issue on the above-identified application.

The expunged material is returned herewith.

Enclosure: [8]

**EXAMINER NOTE:**

1. An examiner may only decide this petition if the information was submitted pursuant to MPEP 724.02. Furthermore, a petition to expunge should not be granted unless the application has been allowed or is abandoned, or an *Ex parte Quayle* action has been mailed.
2. An examiner may not decide the petition if:
  - (a) the information is part of the original disclosure. Information which is part of the original disclosure (specification including any claims, drawings and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. However, some papers entered into the application file, e.g. arguments made in an amendment, may be expunged under appropriate circumstances, however the petition should be sent to the Office of Petitions for decision; or
  - (b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g. requesting expungement of part of the original disclosure) which is decided by the Office of Petitions.
3. This decision is printed using a PTO letterhead.

4. In bracket 6, clearly identify the expunged document. For example, refer to the author and title of the document.

**PETITION TO EXPUNGE INFORMATION SUBMITTED UNDER MPEP § 724.02 DISMISSED 7.206**

In re Application of [1] :  
 Application No. [2] : DECISION ON PETITION  
 Filed: [3] : UNDER 37 C.F.R. § 1.59  
 For: [4] :

This is a decision on the petition under 37 CFR 1.59(b), filed [5], to expunge information submitted pursuant to MPEP § 724.02.

The petition is dismissed.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record. Petitioner states that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims.

The petition is deficient because [8].

**EXAMINER NOTE:**

1. An examiner may only decide this petition if the information was submitted pursuant to MPEP 724.02. However, the examiner should not consider granting the petition until the application has been allowed or abandoned, or an Ex parte Quayle action has been mailed.
2. An examiner may not decide the petition if:
  - (a) the information is part of the original disclosure. Information which is part of the original disclosure (specification including any claims, drawings and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. However, some papers entered into the application file, e.g. arguments made in an

*amendment, may be expunged under appropriate circumstances, and such a petition should be sent to the Office of Petitions for decision; or (b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g. requesting expungement of part of the original disclosure) which is also decided by the Office of Petitions.*

3. *This decision is printed using a PTO letterhead.*
4. *In bracket 6, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.*
5. *In bracket 8, insert one or more of the following reasons in the bracket:*
  - the petition was not accompanied by the required fee under 37 CFR 1.17(i);*
  - the information that petitioner requests to expunge is considered to be material to the determination of patentability because (explanation required);*
  - the information has been made public (explanation required).*

## **JOINT INVENTORS, CORRECTION OF INVENTORSHIP**

**8.23.02**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **EXAMINER NOTE:**

*This paragraph must be included in all restriction requirements for applications having joint inventors.*

## **BRIEF DEFECTIVE - UNSIGNED**

**12.12**

The appeal brief filed on [1] is defective because it is unsigned. 37 CFR 1.33. A ratification properly signed is required.

To avoid dismissal of the appeal, appellant must ratify the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing of this communication, whichever is longer; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

**BRIEF DEFECTIVE - THREE COPIES LACKING****12.13**

The appeal brief filed on [1] is defective because the three copies of the Brief required under 37 CFR 1.192(a) have not been submitted.

To avoid dismissal of the appeal, appellant must submit the necessary additional copies of the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing of this communication, whichever is longer; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

**SUPPLEMENTAL EXAMINER'S ANSWER - ON REMAND****12.80**

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on [1], a supplemental examiner's answer is set forth below: [2].

**EXAMINER NOTE:**

- 1. Insert the date of the Remand.*
- 2. Provide reasons supporting the rejections set forth in the supplemental examiner's answer.*

**REOPENING OF PROSECUTION - NEW GROUND OF REJECTION AFTER APPEAL OR EXAMINER'S REBUTTAL OF REPLY BRIEF****12.81**

In view of the [1] filed on [2], PROSECUTION IS HEREBY REOPENED. [3] set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

file a reply under 37 CFR 1.111 if this Office action is non-final or a reply under 37 CFR 1.113 if this Office action is final; or

request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

**EXAMINER NOTE:**

**Use this form paragraph to reopen prosecution in order to make a new ground of**

**rejection of claims or to enter a rebuttal to the reply brief. The finality or non-finality of an Office action following a reopening of prosecution depends on whether the action could have been properly made final had it been entered prior to the appeal.**

1. Insert “*appeal brief*”, “*supplemental appeal brief*”, “*reply brief*” or “*supplemental reply brief*” in bracket [1].
2. Insert the date on which the brief was filed in bracket [2].
3. Insert “*A new ground of rejection is,*” “*New grounds of rejection are,*” or “*A rebuttal to the Reply Brief is*” in bracket [3].

**DEFECTIVE REISSUE OATH/DECLARATION,  
37 CFR 1.175(a)(1)-NO STATEMENT OF A SPECIFIC ERROR**

**14.01.01**

The reissue oath or declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and see MPEP 1414.

**EXAMINER NOTE:**

1. Use this paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.
2. This paragraph can be used where the reissue oath or declaration does not even mention error. It can also be used where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state “*this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure.*”
3. Paragraph 14.14 must follow.

**DEFECTIVE REISSUE OATH/DECLARATION,  
37 CFR 1.175(a)(1)-THE IDENTIFIED "ERROR"  
IS NOT APPROPRIATE ERROR**

**14.01.02**

The reissue oath or declaration filed with this application is defective because the error which is relied upon to support the reissue application is not in fact an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and see MPEP 1414.

**EXAMINER NOTE:**

1. Use this paragraph when the reissue oath or declaration identifies only

- one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.*
2. Paragraph 14.14 must follow.

**DEFECTIVE REISSUE OATH/DECLARATION, 37 CFR 1.175(a)(1)14.01.03  
- MULTIPLE IDENTIFIED "ERRORS" NOT APPROPRIATE ERRORS**

The reissue oath or declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and see MPEP 1414.

**EXAMINER NOTE:**

1. *Use this paragraph when the reissue oath or declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.*
2. *Note that if the reissue oath or declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this paragraph should not be used, despite the additional reliance by applicant on "errors" which do not support the reissue. Only one appropriate error is needed to support a reissue.*
3. Paragraph 14.14 must follow.

**DEFECTIVE REISSUE OATH/DECLARATION, 37 CFR 1.175- 14.01.04  
LACK OF STATEMENT OF "WITHOUT ANY DECEPTIVE INTENTION"**

The reissue oath or declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath or declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and see MPEP 1414.

**EXAMINER NOTE:**

1. *Use this paragraph when the reissue oath or declaration does not contain the statement required by 37 CFR 1.175 that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.*
2. *This paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of 37 CFR 1.175(a)(2), 37 CFR 1.175(b)(1), or 37 CFR 1.175(b)(2).*
3. Paragraph 14.14 must follow.

**SUPPLEMENTAL OATH OR DECLARATION REQUIRED PRIOR  
14.05.02  
TO ALLOWANCE**

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath or declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth in the immediately-above paragraph.

Receipt of an appropriate supplemental oath or declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath or declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

**EXAMINER NOTE:**

- 1. In bracket 1, list all claims in the reissue application.*
- 2. In bracket 2, insert either --oath-- or --declaration--.*
- 3. This form paragraph is used in an Office action to (a) remind applicant of the requirement for submission of the supplemental reissue oath or declaration under 37 CFR 1.175(b)(1) before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath or declaration is submitted.*
- 4. Do not use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath or declaration filed in the case; instead allow the case.*
- 5. This form paragraph can not be used in an Ex parte Quayle action to require the supplemental oath or declaration, because the rejection under 35 U.S.C. 251 is more than a matter of form.*
- 6. Do not use this form paragraph in an examiner's amendment. The supplemental oath or declaration must be filed prior to mailing of the Notice of Allowability.*

This application is objected to under 37 C.F.R. § 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 C.F.R. § 1.172(a)*. The assignee's ownership interest is established by:

- (a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or
- (b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee.

See MPEP § 1410.01.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. As stated in MPEP 1410.01, "until the consent (assent) is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication the assignees have consented to the filing". As is pointed out immediately above, the assignee's ownership interest has not been submitted to provide support for the consent to the present reissue application. Thus, the consent is not proper and accordingly, the [2] is defective.

**EXAMINER NOTE:**

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. In bracket 2, insert either --oath-- or --declaration--.

**ESTABLISHMENT OF OWNERSHIP NOT SIGNED BY  
APPROPRIATE PARTY**

**14.16.01**

This application is objected to under 37 C.F.R. § 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 C.F.R. § 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b)

**EXAMINER NOTE:**

1. *This paragraph should be followed (a) by one of 14.16.02 through 14.16.04, (b) then by 14.16.05, (c) then optionally by 14.16.06.*
2. *See MPEP 1410.01.*

**FAILURE TO STATE CAPACITY TO SIGN****14.16.02**

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

**EXAMINER NOTE:**

1. *This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee.*
2. *Use 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.*

**LACK OF CAPACITY TO SIGN****14.16.03**

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

**EXAMINER NOTE:**

1. *This form paragraph is to be used when the person signing the submission establishing ownership interest is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.*
2. *Use 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.*

**ATTORNEY/AGENT OF RECORD SIGNS****14.16.04**

The submission establishing ownership interest was signed by applicant's [1]. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

**EXAMINER NOTE:**

1. *This form paragraph is to be used when the person signing the submission establishing ownership interest is an attorney of record who is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.*
2. *Use 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.*
3. *In bracket 1, insert either "attorney" or "agent".*

**REJECTION-ESTABLISHMENT OF OWNERSHIP  
NOT SIGNED BY APPROPRIATE PARTY****14.16.05**

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. As is pointed out above, the signature on the submission to establish assignee's ownership interest is not sufficient. Thus, the consent is not properly supported. MPEP 1410.01 states that, "until the consent (assent) is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication the assignees have consented to the filing". Since the consent is not properly supported, the [2] is defective.

**EXAMINER NOTE:**

1. *In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).*
2. *In bracket 2, insert either --oath-- or --declaration--.*

**CRITERIA TO ACCEPT WHEN SIGNED BY A  
NON-RECOGNIZED OFFICER****14.16.06**

It should be noted that it would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes the following statement:

(1) a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes item (1), above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a

proper empowerment statement would also be acceptable.

**EXAMINER NOTE:**

1. This paragraph **MUST** be preceded by 14.16.02 or 14.16.03 or 14.16.04.
2. When one of paragraphs 14.16.02 or 14.16.03 or 14.16.04 is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

**IMPROPER AMENDMENT TO REISSUE-37 CFR 1.121(b)**

**14.21.01**

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire one month from the date of this letter.

**EXAMINER NOTE:**

*This paragraph may be used for any 37 CFR 1.121(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered in an advisory Office action.*

**REJECTION, 35 U.S.C. 251, NO ERROR WITHOUT  
DECEPTIVE INTENTION-EXTERNAL KNOWLEDGE**

**14.21.09**

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was "without deceptive intention" cannot be supported. [4]

**EXAMINER NOTE:**

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the judicial determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert "fraud", "inequitable conduct" and/or "violation of duty of

*disclosure".*

4. *In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the judicial determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.*

**CRITERIA TO ACCEPT TERMINAL DISCLAIMER WHEN  
SIGNED BY A NON-RECOGNIZED OFFICER**

**14.29.02**

It should be noted that it would be acceptable for a person, other than a recognized officer, to execute a terminal disclaimer, provided the record for the application includes the following statement:

- (1) a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the organization.

Accordingly, a new terminal disclaimer which includes item (1), above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed terminal disclaimer and containing a proper empowerment statement would also be acceptable.

**EXAMINER NOTE:**

1. *This paragraph MUST be preceded by 14.24 or 14.25 AND 14.29.*
2. *When paragraph 14.29 is used to indicate that a terminal disclaimer is denied because it was not signed by a recognized officer nor by an attorney or agent of record, this paragraph should be used to point out one way to correct the problem.*
3. *While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.*
4. *A sample terminal disclaimer should be sent with the Office action.*

**37 CFR 3.73- ESTABLISHING RIGHT OF ASSIGNEE TO PROSECUTE 14.33**

The following is a statement of 37 CFR 3.73, which became effective on September 4, 1992, and was revised to its present form in 1997:

37 CFR 3.73 Establishing right of assignee to prosecute.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application unless there is an assignment.

(b) When an assignee seeks to take action in a matter before the Office with respect to a patent application, trademark application, patent registration, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. Ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee; e.g., copy of an executed assignment submitted for recording,etc.; or by specifying (e.g., reel and frame number,etc.) where such evidence is recorded in the Office. The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

## **REJECTION, 35 U.S.C. 305, CLAIM ENLARGES SCOPE OF PATENT**

**22.11**

Claim [1] rejected under 35 U.S.C. 305(a) as enlarging the scope of the claim(s) of the patent being reexamined. In 35 U.S.C. 305(a), it is stated that “no proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding....” A claim presented in a reexamination “enlarges the scope” of the patent claim(s) where the claim is broader than any claim of the patent. A claim is broader in scope than the original claims if it contains within its scope any conceivable apparatus or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect, even though it may be narrower in other respects.

### **[2] EXAMINER NOTE:**

*The claim limitations which are considered to broaden the scope should be identified and explained in bracket 2. See MPEP § 2258.*

## **AMENDMENTS PROPOSED IN A REEXAMINATION- 37 CFR 1.530(d)**

**22.12**

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d).

### **EXAMINER NOTE:**

*This paragraph may be used in the order granting reexamination and/or in the first Office action to advise patent owner of the proper manner of making amendments in a reexamination proceeding.*

**IMPROPER AMENDMENT IN A REEXAMINATION-****22.13****37 CFR 1.530(d)**

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.530(d), which sets forth the manner of making amendments in reexamination proceedings. A supplemental paper correctly proposing amendments in the reexamination proceeding is required.

A shortened statutory period for response to this letter is set to expire one month from the date of this letter. If patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, the present reexamination proceeding will be terminated, and a reexamination certificate will issue. 37 CFR 1.550(d).

**EXAMINER NOTE:**

*This paragraph may be used for any 37 CFR 1.530(d) informality as to a proposed amendment submitted in a reexamination proceeding prior to final rejection. After final rejection, the amendment should not be entered and patent owner informed of such in an advisory Office action using Form PTOL 467.*

**SUBMISSION NOT FULLY RESPONSIVE TO NON-FINAL OFFICE ACTION 22.14**

The communication filed on [1] is not fully responsive to the prior Office action. [2]. The response appears to be *bona fide*, but through an apparent oversight or inadvertence consideration of some matter or compliance with some requirement has been omitted. Patent owner is required to deal with the omission to thereby provide a full response to the prior Office action.

A shortened statutory period for response to this letter is set to expire two months from the date of this letter. If patent owner fails to timely deal with the omission and thereby provide a full response to the prior Office action, the present reexamination proceeding will be terminated. 37 CFR 1.550(d).

**EXAMINER NOTE:**

*1. In bracket 2, the examiner should explain the nature of the omitted point necessary to complete the response, i.e., what part of the Office action was not responded to. The examiner should also make it clear what is needed to deal with the omitted point.*

2. *This paragraph may be used for a patent owner communication that is not completely responsive to the outstanding (i.e., prior) Office action-see MPEP 2266.01.*
3. *This practice does not apply where there has been a deliberate omission of some necessary part of a complete response.*
4. *This paragraph is only used for a response made prior to final rejection. After final rejection, an advisory Office action and Form PTOL 467 should be used, and the patent owner informed of any non-entry of the amendment.*

**LACK OF SERVICE-37 CFR 1.550(e)****22.15**

The submission filed on [1] is defective because it appears that the submission was not served on [2]. After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550(e).

It is required that service of the submission be made, and a certificate of service be provided to the Office. A shortened statutory period for response to this letter is set to expire two months from the date of this letter. If patent owner fails to timely deal with the omission as to service, the submission may be denied consideration.

**EXAMINER NOTE:**

1. *This paragraph may be used where a submission to the Office was not served as required in a third party requester reexamination proceeding.*
2. *In bracket 2, insert "patent owner" or "third party requester", whichever is appropriate.*