

Form Paragraphs

Chapter 200 - Types, Cross-Noting, and Status of Application

¶ 2.01 Definition of Division

This application appears to be a division of Application No. [1], filed [2]. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or “division.” The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

Examiner Note:

1. In bracket 1, insert the Application No.(series code and serial no.) of the parent application.
2. In bracket 2, insert the filing date of the parent application.
3. An application claiming the benefits of a provisional application under [35 U.S.C. 119\(e\)](#) should not be called a “division” of the provisional application since the application will have its patent term calculated from its filing date, whereas an application filed under [35 U.S.C. 120, 121, or 365\(c\)](#) will have its term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s), [35 U.S.C. 154\(a\)\(2\)](#) and (a)(3).

¶ 2.03 Affidavits or Declarations in Prior Application

Applicant refers to an affidavit or declaration filed in the prior application. Affidavits or declarations, such as those submitted under [37 CFR 1.130, 1.131 and 1.132](#), filed during the prosecution of the prior application do not automatically become a part of this application. Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make the remarks of record in this application and include a copy of the original affidavit or declaration filed in the prior application.

Examiner Note:

This form paragraph is to be used in applications filed under [37 CFR 1.53\(b\)](#). Do not use this form paragraph in applications filed under [37 CFR 1.53\(d\)](#) since affidavits and/or declarations, such as those submitted under [37 CFR 1.130, 1.131 and 1.132](#) filed during the prosecution of the parent nonprovisional application automatically become a part of the [37 CFR 1.53\(d\)](#) application.

¶ 2.05 Possible Status as Continuation

This application discloses and claims only subject matter disclosed in prior application no [1], filed [2], and names

an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to [35 U.S.C. 120](#) and [37 CFR 1.78](#).

Examiner Note:

1. This form paragraph should only be used if it appears that the application may be a continuation, but priority has not been properly established.
2. An application claiming the benefits of a provisional application under [35 U.S.C. 119\(e\)](#) should not be called a “continuation” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

¶ 2.06 Possible Status as Continuation-in-Part

This application repeats a substantial portion of prior Application No. [1], filed [2], and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to [35 U.S.C. 120](#) and [37 CFR 1.78](#).

Examiner Note:

1. This form paragraph should only be used when it appears that the application may qualify as a continuation-in-part, but no priority claim has been perfected.
2. An application claiming the benefits of a provisional application under [35 U.S.C. 119\(e\)](#) should not be called a “continuation-in-part” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

¶ 2.07 Definition of a Substitute

Applicant refers to this application as a “substitute” of Application No. [1], filed [2]. The use of the term “substitute” to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case finds official recognition in the decision, *Ex parte Komenak*, 45 USPQ 186, 1940 C.D. 1, 512 O.G. 739 (Comm’r Pat. 1940). The notation on the file wrapper (See [MPEP § 202.02](#)) that

one case is a “substitute” for another is printed in the heading of the patent copies. A “substitute” does not obtain the benefit of the filing date of the prior application.

¶ 2.08 *Definition of a Refile*

It is noted that applicant refers to this application as a “refile.” No official definition has been given the term “refile,” though it is sometimes used as an alternative for the term “substitute.” Since this application appears to be in fact a duplicate of a former application which was abandoned prior to the filing of the second case, the substitution of the word “substitute” for “refile” is required since the term “substitute” has official recognition. Applicant is required to make appropriate corrections.

¶ 2.09 *Heading for Conditions for Benefit Claims Under 35 U.S.C. 119(e), 120, 121, or 365(c)*

Applicant’s claim for the benefit of a prior-filed application under [35 U.S.C. 119\(e\)](#) or under [35 U.S.C. 120, 121](#), or [365\(c\)](#) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

Examiner Note:

1. In bracket 1, insert either or both --119(e)-- or --120--.
2. One or more of form paragraphs 2.10 to 2.11.01 or 2.38 to 2.40 must follow depending upon the circumstances.

¶ 2.10 *Disclosure of Prior-Filed Application Does Not Provide Support for Claimed Subject Matter*

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of [35 U.S.C. 112](#). See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. [1], fails to provide adequate support or enablement in the manner provided by the first paragraph of [35 U.S.C. 112](#) for one or more claims of this application. [2]

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. This form paragraph may be used when there is lack of support or enablement in the prior-filed application for

the claims in the application that is claiming the benefit of the prior-filed application under [35 U.S.C. 120, 121](#), or [365\(c\)](#) or under [35 U.S.C. 119\(e\)](#). The prior-filed application can be a provisional application or a nonprovisional application.

3. In bracket 1, insert the application number of the prior-filed application.

4. In bracket 2, provide an explanation of lack of support or enablement. If only some of the claims are not entitled to the benefit of the filing date of the prior application, the examiner should include a list those claims after the explanation (e.g., “Accordingly, claims 1-10 are not entitled to the benefit of the prior application.”).

¶ 2.10.01 *Continuation or Divisional Application Contains New Matter Relative to the Prior-Filed Application*

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to change the relationship (continuation or divisional application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: [1].

Examiner Note:

1. This form paragraph should be used when an application claims the benefit of a prior-filed application under [35 U.S.C. 120,121](#), or [365\(c\)](#), contains new matter, and purports to be a “continuation,” “division,” or “divisional application” of the prior-filed application. Do not use this form paragraph if the applicant is claiming the benefit of a provisional application under [35 U.S.C. 119\(e\)](#).
2. In bracket 1, provide an example of the matter not disclosed in the prior-filed application.

¶ 2.11 *Application Must Be Copending With Parent*

This application is claiming the benefit of prior-filed nonprovisional application No. [1] under 35 U.S.C. [120, 121](#), or [365\(c\)](#). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. Do not use this form paragraph for benefit claims under [35 U.S.C. 119\(e\)](#) to provisional applications.
3. In bracket 1, insert the application number of the prior-filed nonprovisional application.

¶ 2.11.01 Application Must Be Filed Within 12 Months From the Provisional Application

This application is claiming the benefit of provisional application No. [1] under 35 U.S.C. [119\(e\)](#). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application.

Note: If the day that is 12 months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application claiming the benefit of the provisional application may be filed on the next succeeding business day.

Applicant is required to delete the reference to the prior-filed provisional application from the first sentence(s) of the specification or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish that this application, or an intermediate nonprovisional application, was filed within 12 months of the filing date of the provisional application.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. In bracket 1, insert the application number of the prior-filed provisional application.

¶ 2.13 Correction of Inventorship Under 37 CFR 1.48(a), Insufficient

The request to correct the inventorship of this nonprovisional application under [37 CFR 1.48\(a\)](#) is deficient because:

Examiner Note:

1. This form paragraph should only be used in response to requests to correct an error in the naming of the prior inventors in nonprovisional 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 form paragraph 2.13.01 instead of this form paragraph.

Potential rejections

A rejection under [35 U.S.C. 102\(f\)](#) or (g) must be considered if the request is denied.

The grant or denial of the request 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 request if the request 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 request for correction of inventorship and request for waiver of the rules should be forwarded to the Office of Petitions.
3. One or more of form paragraphs 2.13a - 2.13e should follow this form paragraph, as applicable.
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 the original inventorship ([37 CFR 1.78](#)), follow this form paragraph with form paragraph 2.13f.
5. Requests under [37 CFR 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 request under [37 CFR 1.48](#) is inappropriate. See [MPEP § 605.04\(b\)](#) and (c) for name changes.
7. An initial executed oath or declaration under [37 CFR 1.63](#) may change the inventorship as originally set forth when the application is filed without an executed oath or declaration without request for correction of inventorship ([37 CFR 1.48\(f\)](#)).

¶ 2.13.01 Correction of Inventorship Under 37 CFR 1.48(b), Insufficient

The request for the deletion of an inventor in this nonprovisional application under [37 CFR 1.48\(b\)](#) is deficient because:

Examiner Note:

1. This form 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 form paragraph 2.13 instead of this form paragraph.

2. Follow this form paragraph with one or both of form paragraphs 2.13c and 2.13g.
3. See note 1 of form paragraph 2.13, Potential rejections.

¶ *2.13.02 Correction of Inventorship Under 37 CFR 1.48(c), Insufficient*

The request to correct the inventorship in this nonprovisional application under [37 CFR 1.48\(c\)](#) requesting addition of an inventor(s) is deficient because:

Examiner Note:

1. This form paragraph should only be used when the inventorship was previously correct when the application was originally executed, but 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. Follow this form paragraph with any of form paragraphs 2.13b-2.13e or 2.13h.
4. See note 1 of form paragraph 2.13, Potential rejections.
5. See notes 4-7 of form paragraph 2.13.

¶ *2.13a Statement of Facts Problem (for Use Following FP 2.13, If Applicable)*

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.

¶ *2.13b No New Oath or Declaration (for Use Following FP 2.13 or 2.13.02, If Applicable)*

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

¶ *2.13c Required Fee Not Submitted (for Use Following FP 2.13, 2.13.01 or 2.13.02, If Applicable)*

It lacks the required fee under [37 CFR 1.17\(i\)](#).

¶ *2.13d Written Consent Missing (for Use Following FP 2.13 or 2.13.02, If Applicable)*

It lacks the written consent of any assignee of one of the originally named inventors.

¶ *2.13e 37 CFR 3.73(b) Submission (for Use Following FP 2.13 or 2.13.02, If Applicable)*

A [37 CFR 3.73\(b\)](#) submission has not been received to support action by the assignee.

¶ *2.13f Hostile Inventor(s)/Inventorship Overlap (for Use Following FP 2.13, If Applicable)*

As it appears that a party required by [37 CFR 1.48\(a\)\(2\)](#) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under [37 CFR 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](#), Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under [37 CFR 1.53\(b\)](#) with a new oath or declaration and any necessary petition under [37 CFR 1.47](#), or where only deletion is needed, either under [37 CFR 1.53\(b\)](#) utilizing a copy of a prior oath or declaration under [37 CFR 1.63\(d\)\(1\)\(iv\)](#), or under [37 CFR 1.53\(d\)](#) (design applications only), thereby eliminating the need for a [37 CFR 1.48](#) request.

¶ *2.13g Statement Under 37 CFR 1.48(b)(2) Problem (for Use Following FP 2.13.01, If Applicable)*

The request was not accompanied by the statement required under [37 CFR 1.48](#) (b)(2).

¶ *2.13h Statement of Facts, Added Inventor (for Use Following FP 2.13.02, If Applicable)*

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.

¶ *2.14 Correction of Inventorship Under 37 CFR 1.48(a) or (c), Sufficient*

In view of the papers filed [1], it has been found that this nonprovisional 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 the Office of Initial Patent Examination (OIPE) for issuance of a corrected

filing receipt, and correction of Office records 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.

¶ *2.14.01 Correction of Inventorship Under 37 CFR 1.48(b), Sufficient*

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

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Examiner Note:

1. This form paragraph is to be used only for [37 CFR 1.48\(b\)](#) corrections.
2. In bracket 2, insert the names of the deleted inventor(s).

¶ *2.15 Reference to Prior Application, 35 U.S.C. 119(e) or 120 Benefit*

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. [1], a specific reference to the prior-filed application in compliance with [37 CFR 1.78\(a\)](#) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under [35 U.S.C. 120, 121](#) or [365\(c\)](#), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under [35 U.S.C. 111\(a\)](#) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with [35 U.S.C. 371](#), the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under [35 U.S.C. 371\(b\) or \(f\)](#) or sixteen months from the filing date of the prior application. See [37 CFR 1.78\(a\)\(2\)\(ii\) and \(a\)\(5\)\(ii\)](#). This time period is not extendable and a failure to submit the reference required by [35 U.S.C.](#)

[119\(e\)](#) and/or [120](#), where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under [35 U.S.C. 119\(e\), 120, 121](#) and [365\(c\)](#). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under [35 U.S.C. 119\(e\), 120, 121](#) and [365\(c\)](#). The petition must be accompanied by (1) the reference required by [35 U.S.C. 120](#) or [119\(e\)](#) and [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) to the prior application (unless previously submitted), (2) a surcharge under [37 CFR 1.17\(t\)](#), and (3) a statement that the entire delay between the date the claim was due under [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in [37 CFR 1.78\(a\)](#), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by [37 CFR 1.78\(a\)](#) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under [37 CFR 1.78\(a\)](#) and the surcharge under [37 CFR 1.17\(t\)](#) are not required. Applicant is still required to submit the reference in compliance with [37 CFR 1.78\(a\)](#) by filling an amendment to the first sentence(s) of the specification or an ADS. See MPEP § [201.11](#).

Examiner Note:

1. In bracket 1, insert --119(e)-- or --120--.
2. In a continued prosecution application (CPA) filed under [37 CFR 1.53\(d\)](#), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of [35 U.S.C. 120](#) is met by the transmittal request for the CPA which is considered to be part of the CPA. [37 CFR 1.53\(d\)\(2\)\(iv\) and \(d\)\(7\)](#).

¶ *2.16 Reference to a Prior Application*

It is noted that this application appears to claim subject matter disclosed in prior Application No. [1], filed [2]. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet ([37 CFR 1.76](#)), if applicant intends to rely on the filing date of the prior application under [35 U.S.C. 119\(e\), 120, 121](#), or [365\(c\)](#). See [37 CFR 1.78\(a\)](#). For benefit claims under [35 U.S.C. 120, 121](#), or

[365\(c\)](#), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications.

If the application is a utility or plant application filed under [35 U.S.C. 111\(a\)](#) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with [35 U.S.C. 371](#), the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under [35 U.S.C. 371\(b\) or \(f\)](#) or sixteen months from the filing date of the prior application. See [37 CFR 1.78\(a\)\(2\)\(ii\) and \(a\)\(5\)\(ii\)](#). This time period is not extendable and a failure to submit the reference required by [35 U.S.C. 119\(e\)](#) and/or [120](#), where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), [120](#), [121](#) and [365\(c\)](#). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under [35 U.S.C. 119\(e\)](#), [120](#), [121](#) and [365\(c\)](#). The petition must be accompanied by (1) the reference required by [35 U.S.C. 120](#) or [119\(e\)](#) and [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) to the prior application (unless previously submitted), (2) a surcharge under [37 CFR 1.17\(t\)](#), and (3) a statement that the entire delay between the date the claim was due under [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in [37 CFR 1.78\(a\)](#), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by [37 CFR 1.78\(a\)](#) (e.g., if the reference was submitted in an oath or declaration or the application transmitted letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under [37 CFR 1.78\(a\)](#) and the surcharge under [37 CFR 1.17\(t\)](#) are not required. Applicant is still required to submit the reference in compliance with [37 CFR 1.78\(a\)](#) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § [201.11](#)

Examiner Note:

In a continued prosecution application (CPA) filed under [37 CFR 1.53\(d\)](#), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of [35 U.S.C. 120](#) is met by the transmittal request for the CPA which is considered to be part of the CPA. [37 CFR 1.53\(d\)\(2\)\(iv\)](#) and (d)(7).

¶ *2.18 Right of Priority Under 35 U.S.C. 119(a)-(d) and (f)*

Applicant is advised of possible benefits under [35 U.S.C. 119\(a\)-\(d\)](#) and (f), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

¶ *2.19 Overcome Rejection by Translation*

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with [37 CFR 1.55](#). See [MPEP § 201.15](#).

Examiner Note:

This paragraph should follow a rejection based on an intervening reference.

¶ *2.20 Priority Papers in Parent or Related (Reissue Situation) - Application*

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent or related Application No. [1] under [35 U.S.C. 119\(a\)-\(d\) or \(f\)](#), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of [37 CFR 1.55\(a\)\(2\)](#) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

¶ *2.21 Oath, Declaration, or Application Data Sheet Does Not Contain Reference to Foreign Filing*

Receipt is acknowledged of papers filed under [35 U.S.C. 119\(a\)-\(d\)](#) based on an application filed in [1] on [2]. Applicant has not complied with the requirements of [37 CFR 1.63\(c\)](#), since the oath, declaration, or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration, or application data sheet is required in the body of which the present application should be identified by application number and filing date.

¶ *2.21.01 35 U.S.C. 119(a)-(d) or (f) or 365(a) Foreign Priority Claim is Untimely*

The foreign priority claim filed on [1] was not entered because the foreign priority claim was not filed during the time period set forth in [37 CFR 1.55\(a\)\(1\)](#). For original applications filed under [35 U.S.C. 111\(a\)](#) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with [35 U.S.C. 371](#), the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See [37 CFR 1.55\(a\)\(1\)\(ii\)](#). If applicant desires priority under [35 U.S.C. 119\(a\)-\(d\)](#), [\(f\)](#) or [365\(a\)](#) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim ([37 CFR 1.55\(c\)](#)). The petition must be accompanied by (1) the claim (i.e., the claim required by [35 U.S.C. 119\(a\)-\(d\)](#) and [\(f\)](#) and [37 CFR 1.55](#)) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under [37 CFR 1.17\(t\)](#); and (3) a statement that the entire delay between the date the claim was due under [37 CFR 1.55\(a\)\(1\)](#) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for original applications filed under [35 U.S.C. 111\(a\)](#) on or after November 29, 2000. DO NOT use for design applications.
2. In bracket 1, insert the date the amendment or paper containing the foreign priority claim was filed.

¶ 2.22 Certified Copy Filed, But No Claim Made

Receipt is acknowledged of a certified copy of the [1] application referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under [35 U.S.C. 119\(a\)-\(d\)](#), applicant should also file a claim for such priority as required by [35 U.S.C. 119\(b\)](#). If the application being examined is an original application filed under [35 U.S.C. 111\(a\)](#) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See [37 CFR 1.55\(a\)\(1\)\(i\)](#). If the application being examined has entered the national stage from an international application filed on or after

November 29, 2000, after compliance with [35 U.S.C. 371](#), the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and Regulations of the PCT. See [37 CFR 1.55\(a\)\(1\)\(ii\)](#). Any claim for priority under [35 U.S.C. 119\(a\)-\(d\) or \(f\)](#) or [365\(a\) or \(b\)](#) not presented within the time period set forth in [37 CFR 1.55\(a\)\(1\)](#) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in [37 CFR 1.55\(a\)\(1\)](#), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See [37 CFR 1.55\(c\)](#).

Examiner Note:

In bracket 1, insert the application number of the foreign application.

¶ 2.23 Foreign Filing More Than 12 Months Earlier

Acknowledgment is made of applicant's claim for priority under [35 U.S.C. 119\(a\)-\(d\)](#) based upon an application filed in [1] on [2]. A claim for priority under [35 U.S.C. 119\(a\)-\(d\)](#) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Examiner Note:

1. In bracket 1, insert the country name.
2. In bracket 2, insert the filing date of the foreign application.

¶ 2.24 Claimed Foreign Priority Date Not the Earliest Date

Receipt is acknowledged of papers filed on [1] purporting to comply with the requirements of [35 U.S.C. 119\(a\)-\(d\)](#) and they have been placed of record in the file. Attention is directed to the fact that the date for which foreign priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration.

¶ 2.25 Claimed Foreign Priority, No Papers Filed

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in [1] on [2]. It is noted, however, that applicant has not filed a certified copy of the [3] application as required by [35 U.S.C. 119\(b\)](#).

Examiner Note:

1. In bracket 1, insert the country name.
2. In bracket 2, insert the filing date of the foreign application.

3. In bracket 3, insert the application number of the foreign application.

¶ 2.26 *Claimed Foreign Priority - Papers Filed*

Receipt is acknowledged of papers submitted under [35 U.S.C. 119\(a\)](#)-(d), which papers have been placed of record in the file.

¶ 2.27 *Acknowledge Foreign Priority Paper in Parent*

Acknowledgment is made of applicant's claim for foreign priority under [35 U.S.C. 119](#) (a)-(d). The certified copy has been filed in parent Application No. [1], filed on [2].

Examiner Note:

1. For problems with foreign priority, see form paragraphs 2.18 to 2.24.
2. In bracket 1, insert series code and serial no. of parent.

¶ 2.30 *CPA Status Acceptable (for Design Applications)*

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 form 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. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § [706.07\(h\)](#).

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.

¶ 2.31 *CPA Status Not Acceptable - Request Not on Separate Paper (for Design Applications)*

Receipt is acknowledged of the request for a Continued Prosecution Application (CPA) filed on [1] 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 form paragraph to inform applicant that a request for a CPA in a design application is not in

compliance with [37 CFR 1.53\(d\)\(2\)](#) and, therefore, no CPA has been established.

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 identified in the CPA request.

¶ 2.32 *Request To Delete a Named Inventor*

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 form 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 request 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.

¶ 2.33 *New Inventor Identified*

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

2. In bracket 1 insert the name or names of the inventor(s) requested to be added followed by either --was-- or --were--, as appropriate.

3. In bracket 2 insert the filing date of the CPA.

¶ 2.34 *Reference in CPA to Prior Application (by Amendment to the Specification)*

The amendment filed [1] requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a [2] application of Application No. [3] 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(s) of the specification to refer back to the prior application and any such amendment shall be denied entry.

Examiner Note:

1. Use this form paragraph to inform the applicant that an amendment to the first sentence(s) 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 either --continuation-- or --divisional--.
4. In bracket 3, insert the Application Number of the prior nonprovisional application.

¶ 2.35 CPA Status Acceptable - Conditional Request (for Design Applications)

Receipt is acknowledged of the “conditional” request for a Continued Prosecution Application (CPA) filed on [1] 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 form paragraph in the first Office action of a CPA to advise the applicant that a “conditional” request for a CPA is treated as an unconditional request and the 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. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § [706.07\(h\)](#).
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number identified in the CPA request.

¶ 2.38 Claiming Benefit to a Non-English Language Provisional Application

This application claims benefit to provisional application No. [1], filed on [2], in a language other than English. An English translation of the non-English language provisional application and a statement that the translation

is accurate must be filed in provisional application No. [3]. See [37 CFR 1.78\(a\)\(5\)](#). The [4] required by [37 CFR 1.78\(a\)\(5\)](#) is missing. Accordingly, applicant must supply 1) the missing [5] in provisional application No. [6] and 2) in the present application, a confirmation that the translation and statement were filed in the provisional application. If 1) and 2) are not filed (or the benefit claim withdrawn by the filing of an amendment or Supplemental Application Data Sheet) prior to the expiration of the time period set in this Office action, the present application will be abandoned. See [37 CFR 1.78\(a\)\(5\)\(iv\)](#).

Examiner Note:

1. Use this form paragraph to notify applicant that an English translation of the non-English language provisional application and/or a statement that the translation is accurate is required. Do not use this form paragraph if a translation of the provisional application and a statement that the translation was accurate were filed in the nonprovisional application (the present application) before November 25, 2005.
2. In brackets 1 and 3, insert the application number of the non-English language provisional application.
3. In bracket 2, insert the filing date of the prior provisional application.
4. In brackets 4 and 5, insert --English translation and a statement that the translation is accurate-- or --statement that the translation is accurate--, where appropriate.

¶ 2.39 35 U.S.C. 119(e), 120, 121 or 365(c) Benefit Claim is Untimely

The benefit claim filed on [1] was not entered because the required reference was not timely filed within the time period set forth in [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#). If the application is an application filed under [35 U.S.C. 111\(a\)](#) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with [35 U.S.C. 371](#), the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under [35 U.S.C. 371\(b\) or \(f\)](#) or sixteen months from the filing date of the prior application. See [37 CFR 1.78\(a\)\(2\)\(ii\) and \(a\)\(5\)\(ii\)](#). If applicant desires the benefit under 35 U.S.C. [2] based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under [37 CFR 1.78\(a\)\(3\) or \(a\)\(6\)](#). The petition must be accompanied by: (1) the reference required by [35 U.S.C.](#)

[120](#) or [119\(e\)](#) and [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) to the prior application (unless previously submitted); (2) a surcharge under [37 CFR 1.17\(t\)](#); and (3) a statement that the entire delay between the date the claim was due under [37 CFR 1.78\(a\)\(2\) or \(a\)\(5\)](#) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for utility or plant applications filed on or after November 29, 2000.
2. In bracket 1, insert the filing date of the amendment or paper containing the benefit claim.
3. In bracket 2, insert --119(e)--, --120--, --121--, or --365(c)--.
4. Do not use this form paragraph if the reference to the prior application was previously submitted within the time period set forth in [37 CFR 1.78\(a\)](#), but not in the first sentence(s) of the specification or in an application data sheet (ADS) as required by [37 CFR 1.78\(a\)](#) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt. In this situation, the petition under [37 CFR 1.78\(a\)](#) and the surcharge under [37 CFR 1.17\(t\)](#) are not required. Applicant is still required to submit the reference in compliance with [37 CFR 1.78\(a\)](#) by filling an amendment to the first sentence(s) of the specification or an ADS, if the reference has not been previously submitted. See MPEP § [201.11](#).

¶ 2.40 Prior-Filed Application Not Entitled to a Filing Date or Basic Filing Fee Was Not Paid

This application claims the benefit of prior-filed application No. [1] under [35 U.S.C. 120, 121](#), or [365\(c\) or under 35 U.S.C. 119\(e\)](#). If the prior-filed application is an international application designating the United States of America, it must be entitled to a filing date in accordance with [PCT Article 11](#). See [37 CFR 1.78\(a\)\(1\)\(i\)](#). If the prior-filed application is a nonprovisional application, the prior-filed application must be entitled to a filing date as set forth in [37 CFR 1.53\(b\)](#) or [1.53\(d\)](#) and include the basic filing fee set forth in [37 CFR 1.16](#). See [37 CFR 1.78\(a\)\(1\)\(ii\)](#). If the prior-filed application is a provisional application, the prior-filed application must be entitled to a filing date as set forth in [37 CFR 1.53\(c\)](#) and the basic filing fee must be paid within the time period set forth in [37 CFR 1.53\(g\)](#). See [37 CFR 1.78\(a\)\(4\)](#).

This application is not entitled to the benefit of the prior-filed application because the prior-filed application [2]. Applicant is required to delete the reference to the prior-filed application.

Examiner Note:

1. Use this form paragraph to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.
2. In bracket 1, insert the application number of the prior-filed application.
3. In bracket 2, insert “was not entitled to a filing date”; “did not include the basic filing fee”; or “was not entitled to a filing date and did not include the basic filing fee”.

Chapter 400 - Representative of Inventor or Owner

¶ 4.01 Dual Correspondence

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

Examiner Note:

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

¶ 4.02 Death of Patent Practitioner, Notice Received from Patent Practitioner's Office

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

Examiner Note:

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

¶ 4.03 Death of Patent Practitioner, Notice from Other Source

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

Examiner Note:

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

¶ 4.04 Death of Patent Practitioner, Application Is Ready for Allowance

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

mailed to the office of the deceased attorney or agent in the absence of a new power of attorney.

Examiner Note:

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

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

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

Applicant may, of course, file a new power of attorney in the application to have a registered attorney or agent represent you before the Office. In the absence of an attorney or agent of record, all amendments and other papers filed in the application must be signed: (1) by you; or (2) if there is an assignee of record of an undivided part interest, by you and such assignee; or (3) if there is an assignee of the entire interest, by such assignee; or (4) by a registered patent attorney or agent, not of record, who acts in a representative capacity under the provisions of [37 CFR 1.34](#).

Applicant may obtain a list of registered patent attorneys and agents located in your area by consulting the USPTO web site, <http://www.uspto.gov>, or by calling the Office of Enrollment and Discipline at (571) 272-4097.

Examiner Note:

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

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

The instant application contains a power of attorney to [1] who has been [2] from practice before the Patent and

Trademark Office (Office). The Office does not communicate with attorneys or agents who have been suspended or excluded from practice. Accordingly, the Office action is being mailed to the address of the inventor first named in the application.

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

Applicants may obtain a list of registered patent attorneys and agents located in their area by consulting the USPTO web site, <http://www.uspto.gov>, or by calling the Office of Enrollment and Discipline at (571) 272-4097.

Examiner Note:

1. In bracket 1, insert the name of the suspended or excluded practitioner.
2. In bracket 2, insert either --suspended-- or --excluded--.
3. This form paragraph should be used when the suspended or excluded practitioner is the only practitioner of record and there are joint inventors. Use form paragraph 4.06 if there is a single inventor.
4. The Office action is to be mailed only to the inventor first named in the declaration at his or her current address of record.

¶ 4.08 *Attorney/Agent Suspended (Plural Practitioners)*

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

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

As a correspondence address, other than to [7], is not of record, this Office action is being mailed to [8] at his/her last known address as listed on the register of patent

attorneys and agents. To ensure that a copy of this Office action is received in a timely manner to allow for a timely reply, a copy of the Office action is being mailed directly to the address of the inventor first named in the declaration or oath. Any reply by applicant(s) should be by way of the remaining practitioner(s) of record and should include a new correspondence address.

Examiner Note:

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

¶ 4.09 *Unregistered Attorney or Agent*

An examination of this application reveals that applicant has attempted to appoint an attorney or agent who is neither registered to practice before the U.S. Patent and Trademark Office in patent matters nor named as an inventor in the application, contrary to the Code of Federal Regulations, [37 CFR 1.31](#) and [1.32](#). Therefore, the appointment is void, *ab initio*. We will not recognize the appointment and all correspondence concerning this application must be signed by: 1) all named applicants (inventors), 2) all the owners of the rights to the invention, or 3) a registered attorney or agent duly appointed by the inventor(s) or the owner(s). Furthermore, all communications from the Office will be addressed to the first named inventor, unless specific instructions to the contrary are supplied by the applicant(s) for patent or owner(s).

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

largely dependent upon skillful preparation and prosecution.

The Office cannot aid you in selecting a registered attorney or agent, however, a list of attorneys and agents registered to practice before the U.S. Patent and Trademark Office is available from the USPTO web site, <http://www.uspto.gov>. For assistance locating this information, contact the Office of Enrollment and Discipline at (571) 272-4097 or call the Inventors Assistance Center toll-free number, 1(800)786-9199.

Examiner Note:

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

applicant’s Zip Code copied from the Registered Attorney/Agent Roster posted on the USPTO Internet web site <http://www.uspto.gov>.

¶ 4.10 Employ Services of Attorney or Agent

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

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under “Attorney and Agent Roster”. Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Examiner Note:

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

Chapter 500 - Receipt and Handling of Mail and Papers

¶ 5.01 Proper Heading for Incoming Papers

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

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

¶ 5.01.01 Separate Paper Required

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

Examiner Note:

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

¶ 5.02 Format of Certificate of Mailing or Transmission

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under [37 CFR 1.8\(a\)](#). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under [37 CFR 1.8\(a\)](#). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
on _____.

(Date)

Typed or printed name of person signing this certificate:

Signature:

Registration Number:

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (____)____ - _____ on _____ (Date)

Typed or printed name of person signing this certificate:

Signature:

Registration Number:

Certificate of EFS-Web Transmission

I hereby certify that this correspondence is being transmitted via the U.S. Patent and Trademark Office (USPTO) electronic filing system (EFS-Web) to the USPTO on _____. (Date)

Typed or printed name of person signing this certificate:

Signature:

Registration Number:

Please refer to 37 CFR [1.6\(a\)\(4\)](#), [1.6\(d\)](#) and [1.8\(a\)\(2\)](#) for filing limitations concerning transmissions via EFS-Web, facsimile transmissions and mailing, respectively.

¶ 5.03 Reassignment Affecting Application Location

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this

application, all further correspondence regarding this application should be directed to Art Unit [1].

Examiner Note:

This paragraph should be used in all Office actions when the location of an application is changed due to a reassignment of the art, transfer of the application to a different Art Unit, or transfer of an examiner and the examiner’s docket.

¶ 5.04 *Benefit of Certificate of Mailing Denied*

The [1] filed [2] is not entitled to the benefits of 37 CFR 1.[3] since it was not deposited with the U. S. Postal Service for delivery to the U.S. Patent and Trademark Office. Therefore, the date of receipt in the U.S. Patent and Trademark Office has been used to determine the timeliness of the paper.

Examiner Note:

1. This form paragraph is to be used in those situations where correspondence contains a Certificate of Mailing

under [37 CFR 1.8](#) or requests the benefit of “Express Mail” under [37 CFR 1.10](#), but the correspondence was not actually deposited with the U. S. Postal Service.

2. In bracket 3, insert --8-- or --10--, as appropriate.

¶ 5.05 *Small Entity Status*

This application may qualify for “Small Entity Status” and, therefore, applicant may be entitled to the payment of reduced fees. In order to establish small entity status for the purpose of paying small entity fees, applicant must make a determination of entitlement to small entity status under 37 CFR [1.27\(f\)](#) and make an assertion of entitlement to small entity status in the manner set forth in 37 CFR [1.27\(c\)\(1\)](#) or 37 CFR [1.27\(c\)\(3\)](#). Accordingly, if applicant meets the requirements of 37 CFR [1.27\(a\)](#), applicant must submit a written assertion of entitlement to small entity status under 37 CFR [1.27\(e\)](#) before fees can be paid in the small entity amount. See 37 CFR [1.27\(d\)](#). The assertion must be signed, clearly identifiable, and convey the concept of entitlement to small entity status. See 37 CFR [1.27\(c\)\(1\)](#). No particular form is required.

Chapter 600 - Parts, Form, and Content of Application

¶ 6.01 Arrangement of the Sections of the Specification in a Utility Application

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in [37 CFR 1.77\(b\)](#), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under [37 CFR 1.97](#) and [1.98](#).
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING. (See MPEP § [2424](#) and [37 CFR 1.821-1.825](#). A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in [37 CFR 1.821\(a\)](#) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc.)

Examiner Note:

For the arrangement of the sections of the specification in a design application, see 37 CFR [1.154\(b\)](#). Form paragraph 15.05 may be used for a design application. For the arrangement of the sections of the specification in a plant application, see 37 CFR [1.163\(c\)](#). For the requirements of the specification in a reissue application, see 37 CFR [1.173\(a\)\(1\)](#).

¶ 6.02 Content of Specification

Content of Specification

- (a) TITLE OF THE INVENTION: See [37 CFR 1.72\(a\)](#) and [MPEP § 606](#). The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words. It may not contain more than 500 characters.
- (b) CROSS-REFERENCES TO RELATED APPLICATIONS: See [37 CFR 1.78](#) and [MPEP § 201.11](#).
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT: See [MPEP § 310](#).
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT. See [37 CFR 1.71\(g\)](#).
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See [37 CFR 1.52\(e\)](#) and [MPEP § 608.05](#). Computer program listings ([37 CFR 1.96\(c\)](#)), "Sequence Listings" ([37 CFR 1.821\(c\)](#)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

(f) **BACKGROUND OF THE INVENTION:** See [MPEP § 608.01\(c\)](#). The specification should set forth the Background of the Invention in two parts:

(1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled “Technical Field.”

(2) **Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98:** A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant’s invention. This item may also be titled “Background Art.”

(g) **BRIEF SUMMARY OF THE INVENTION:** See [MPEP § 608.01\(d\)](#). A brief summary or general statement of the invention as set forth in [37 CFR 1.73](#). The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h) **BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S):** See [MPEP § 608.01\(f\)](#). A reference to and brief description of the drawing(s) as set forth in [37 CFR 1.74](#).

(i) **DETAILED DESCRIPTION OF THE INVENTION:** See [MPEP § 608.01\(g\)](#). A description of the preferred embodiment(s) of the invention as required in [37 CFR 1.71](#). The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or

readily available publication which adequately describes the subject matter.

(j) **CLAIM OR CLAIMS:** See [37 CFR 1.75](#) and [MPEP § 608.01\(m\)](#). The claim or claims must commence on a separate sheet or electronic page ([37 CFR 1.52\(b\)\(3\)](#)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See [37 CFR 1.75](#) and [MPEP 608.01\(i\)-\(p\)](#).

(k) **ABSTRACT OF THE DISCLOSURE:** See [37 CFR 1.72\(b\)](#) and [MPEP § 608.01\(b\)](#). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage ([37 CFR 1.491\(b\)](#)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under [PCT Article 21](#). The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See [MPEP § 1893.03\(e\)](#).

(l) **SEQUENCE LISTING:** See [37 CFR 1.821-1.825](#) and [MPEP §§ 2421-2431](#). The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See [MPEP § 2421.02](#).

Examiner Note:

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications.

¶ 6.02.01 Non-Initialed and/or Non-Dated Alterations in Application Papers

The application is objected to because of alterations which have not been initialed and/or dated as is required by [37 CFR 1.52\(c\)](#). A properly executed oath or declaration which complies with [37 CFR 1.67\(a\)](#) and identifies the application by application number and filing date is required.

¶ 6.03 Oath, Declaration Cannot Be Amended

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly

identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See [MPEP §§ 602.01](#) and [602.02](#).

Examiner Note:

1. This form paragraph is intended primarily for use in *pro se* applications.
2. Use form paragraph 6.05 and one or more of form paragraphs 6.05.01 to 6.05.20 for a defective oath or declaration in a case where there is a power of attorney.
3. Some corrections may be made by an application data sheet. If the error is correctable by an application data sheet, applicant should be informed of the requirements of an application data sheet. See [37 CFR 1.76](#) and [MPEP § 601.05](#).

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with [37 CFR 1.67\(a\)](#) identifying this application by application number and filing date is required. See [MPEP §§ 602.01](#) and [602.02](#).

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.01 Improper Execution

It was not executed in accordance with either [37 CFR 1.66](#) or 1.68.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.02 Residence Omitted

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or a supplemental oath or declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.03 Citizenship Omitted

It does not identify the citizenship of each inventor.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05

¶ 6.05.05 “Reviewed and Understands” Statement Omitted

It does not state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration. See [37 CFR 1.63\(b\)\(2\)](#).

Examiner Note:

1. This paragraph must be preceded by form paragraph 6.05.
2. Oaths or declarations stating that “the person making the oath or declaration has reviewed and understands the contents of the specification,” as was required by 37 CFR 1.63(b)(1) prior to November 7, 2000, are no longer acceptable. See *Changes To Implement the Patent Business Goals*, final rule, 65 *Fed. Reg.* 54604 (September 8, 2000), 1238 *Off. Gaz. Pat. Office* 77 (September 19, 2000).

¶ 6.05.06 Original and First Omitted

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.07 Duty To Disclose Not Properly Acknowledged

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be “material to patentability as defined in [37 CFR 1.56](#).”

Examiner Note:

1. This paragraph must be preceded by form paragraph 6.05.
2. Oaths or declarations acknowledging a duty to disclose information “material to the examination of the application in accordance with 37 CFR 1.56(a),” as was required by 37 CFR 1.63(b)(3) prior to March 16, 1992, are no longer acceptable. See 1327 OG 112 (February 12, 2008).

¶ 6.05.08 Identification of Foreign Applications Omitted

It does not identify the foreign application for patent or inventor’s certificate on which priority is claimed pursuant to [37 CFR 1.55](#), and any foreign application having a filing date before that of the application on which priority

is claimed, by specifying the application number, country, day, month and year of its filing.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.11 *Notary Signature*

It does not include the notary’s signature, or the notary’s signature is in the wrong place.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.12 *Notary Seal and Venue Omitted*

It does not include the notary’s seal and venue.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.13 *Authority of Foreign Officer Not Certified*

It does not include an apostille, a consular certificate, or the position of authority of the officer signing an apostille or consular certificate, see [37 CFR 1.66\(a\)](#).

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

¶ 6.05.14 *No Ribbon Properly Attached*

It does not have a ribbon properly attached.

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

¶ 6.05.15 *Not in Permanent Ink*

The [1] is not in permanent ink, or its equivalent in quality, as required under [37 CFR 1.52\(a\)\(1\)\(iv\)](#).

Examiner Note:

1. In bracket 1, insert either signature or oath/declaration.
2. This paragraph must be preceded by form paragraph 6.05.
3. If other portions of the disclosure are not in permanent ink, use form paragraph 6.32.

¶ 6.05.16 *Non-Initialed/Non-Dated Alterations*

Non-initialed and/or non - dated alterations have been made to the oath or declaration. See [37 CFR 1.52\(c\)](#).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.17 *Declaration Clause Omitted*

The clause regarding “willful false statements ...” required by [37 CFR 1.68](#) has been omitted.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.18 *Full Given Name Is Not Set Forth*

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

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

¶ 6.05.19 *Mailing Address Omitted*

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See [37 CFR 1.63\(c\)](#) and [37 CFR 1.76](#).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.20 *Specification Not Identified*

The specification to which the oath or declaration is directed has not been adequately identified. See [MPEP § 602](#).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.06 *New Oath for Subject Matter Not Originally Claimed*

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under [37 CFR 1.67](#). The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See [MPEP §§ 602.01](#) and [602.02](#).

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See [MPEP § 608.01\(d\)](#) and [1302](#), and [37 CFR 1.73](#).

¶ *6.07 Lack of Venue*

The oath lacks the statement of venue. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by application number and filing date, or a certificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See [MPEP §§ 602.01](#) and [602.02](#).

¶ *6.08 Consul-Omission of Certificate*

The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; [37 CFR 1.66\(a\)](#). This informality can be overcome by filing either a declaration under [37 CFR 1.68](#), or a new properly authenticated oath under [37 CFR 1.66](#). The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See [MPEP §§ 602.01](#) and [602.02](#).

¶ *6.09.01 Post Office Address Omitted, Residence Given*

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

Examiner Note:

1. This form paragraph should only be used where the Post Office address has been omitted in an oath or declaration filed prior to December 1, 1997. Use form paragraphs 6.05 and 6.05.19 if the oath or declaration was filed on or after December 1, 1997.
2. If both the post office address and residence are incomplete, not uniform or omitted, use form paragraphs 6.05 and 6.05.02.

¶ *6.11 Title of Invention Is Not Descriptive*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Examiner Note:

If a change in the title of the invention is being suggested by the examiner, follow with form paragraph 6.11.01.

¶ *6.11.01 Title of Invention, Suggested Change*

The following title is suggested: “[1]”

¶ *6.12 Abstract Missing (Background)*

This application does not contain an abstract of the disclosure as required by [37 CFR 1.72\(b\)](#). An abstract on a separate sheet is required.

Examiner Note:

1. For *pro se* applicant, consider form paragraphs 6.14 to 6.16.
2. This form paragraph should not be used during the national stage prosecution of international applications (“371 applications”) if an abstract was published with the international application under PCT Article [21](#).

¶ *6.13 Abstract Objected To: Minor Informalities*

The abstract of the disclosure is objected to because [1]. Correction is required. See [MPEP § 608.01\(b\)](#).

Examiner Note:

In bracket 1, indicate the informalities that should be corrected. Use this paragraph for minor informalities such as the inclusion of legal phraseology, undue length, etc.

¶ *6.14 Abstract of the Disclosure: Content*

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of an apparatus should not be included in the abstract.

Examiner Note:

See form paragraph 6.16.

¶ 6.15 *Abstract of the Disclosure: Chemical Cases*

Applicant is reminded of the proper content of an abstract of the disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., “The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics.” Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

¶ 6.16 *Abstract of the Disclosure: Language*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. The form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using

phrases which can be implied, such as, “The disclosure concerns,” “The disclosure defined by this invention,” “The disclosure describes,” etc.

Examiner Note:

See also form paragraph 6.14.

¶ 6.16.01 *Abstract of the Disclosure: Placement*

The abstract of the disclosure does not commence on a separate sheet in accordance with [37 CFR 1.52\(b\)\(4\)](#). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Examiner Note:

1. This paragraph should only be used for applications filed on or after September 23, 1996.
2. [37 CFR 1.72\(b\)](#) requires that the abstract be set forth on a separate sheet. This requirement applies to amendments to the abstract as well as to the initial filing of the application.
3. This form paragraph should not be used during the national stage prosecution of international applications (“371 applications”) if an abstract was published with the international application under PCT Article [21](#).

¶ 6.17 *Numbering of Claims, 37 CFR 1.126*

The numbering of claims is not accordance with [37 CFR 1.126](#), which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim [1] been renumbered [2].

Examiner Note:

1. In bracket 1, insert appropriate claim number(s) and --has-- or -- have --.
2. In bracket 2, insert correct claim number(s) and --, respectively -- if more than one claim is involved.

¶ 6.18 *Series of Singular Dependent Claims*

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent

claim. In general, applicant's sequence will not be changed. See [MPEP § 608.01\(n\)](#).

¶ 6.18.01 *Claims: Placement*

The claims in this application do not commence on a separate sheet or electronic page in accordance with [37 CFR 1.52\(b\)\(3\)](#). Appropriate correction is required in response to this action.

Examiner Note:

This paragraph should only be used for applications filed on or after September 23, 1996.

¶ 6.19 *Incorporation by Reference, Unpublished U.S. Application, Foreign Patent or Application, Publication*

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR [1.57\(f\)](#).

Examiner Note:

Since the material that applicant is attempting to incorporate in the specification is considered to be essential material, an appropriate objection to the specification and/or rejection of the claim(s) under 35 U.S.C. [112](#), should be made. One or more of form paragraphs 7.31.01 to 7.31.04, as for example, should be used following this form paragraph.

¶ 6.19.01 *Ineffective Incorporation by Reference, General*

The attempt to incorporate subject matter into this application by reference to [1] is ineffective because [2].

Examiner Note:

1. In bracket 1, identify the document such as an application or patent number or other identification.
2. In bracket 2, give reason(s) why it is ineffective (e.g., the root words "incorporate" and/or "reference" have been omitted, see 37 CFR 1.57(b)(1); the reference document is not clearly identified as required by 37 CFR 1.57(b)(2)).
3. This form paragraph should be followed by form paragraph 6.19.03.

¶ 6.19.02 *Amendment Not in Compliance with 37 CFR 1.57(a)*

The amendment to add inadvertently omitted material pursuant to 37 CFR [1.57\(a\)](#) filed [1] is not in compliance with 37 CFR [1.57\(a\)](#) because [2].

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.
2. In bracket 2, insert the reason why the amendment has not been entered. For example: (1) the present application was filed before September 21, 2004, the effective date of 37 CFR [1.57\(a\)](#); (2) the claim for priority/benefit of the prior-filed application was not present on the filing date of the present application; (3) the inadvertently omitted portion is not completely contained in the prior-filed application; (4) a copy of the prior-filed application (except where the prior-filed application is an application filed under 35 U.S.C. [111](#)) was not submitted; (5) an English language translation of the prior-filed non-English language application was not submitted; or (6) applicant did not identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.
3. This form paragraph must be followed by form paragraph 7.28, where the amendment is made to the specification and/or drawings and introduces new matter into the disclosure, and/or form paragraph 7.31.01, where the amendment adds new matter to the claims or affects the claims.
4. If the amendment is an after-final amendment, an advisory action should be issued indicating that the amendment raises new issues because it is not in compliance with 37 CFR [1.57\(a\)](#).
5. This form paragraph should not be used if there is an express incorporation by reference since applicant would not need to comply with the requirements of 37 CFR [1.57\(a\)](#).

¶ 6.19.03 *Correction of Ineffective Incorporation by Reference*

The incorporation by reference will not be effective until correction is made to comply with [37 CFR 1.57\(b\)](#), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in [37 CFR](#)

[1.114\(b\)](#), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. [37 CFR 1.57\(f\)](#).

¶ 6.20 Trademarks and Their Use

The use of the trademark [1] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note:

1. Capitalize each letter of the word in the bracket or include a proper trademark symbol, such as TM or ® following the word.
2. Examiners may conduct a trademark search by using the Trademark Electronic Search System (TESS) which is available on the USPTO website to determine whether a trademark identified in the patent application is a registered trademark or not.

¶ 6.21 New Drawings, Competent Draftsperson

New corrected drawings are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

¶ 6.22 Drawings Objected To

The drawings are objected to because [1]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made

to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, insert the reason for the objection, for example, --the drawings do not show every feature of the invention specified in the claims-- or --the unlabeled rectangular box(es) shown in the drawings should be provided with descriptive text labels--.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.01 Drawings Objected To, Details Not Shown

The drawings are objected to under [37 CFR 1.83\(a\)](#) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § [608.02\(d\)](#). Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified

and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, identify the structural details not shown in the drawings.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.02 Drawings Objected to, Different Numbers Referred to Same Part

The drawings are objected to as failing to comply with [37 CFR 1.84\(p\)\(4\)](#) because reference characters “[1]” and [2] have both been used to designate [3]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In brackets 1 and 2, identify the numbers which refer to the same part.
2. In bracket 3, identify the part which is referred to by different numbers.
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.03 Drawings Objected to, Different Parts Referred to by Same Number

The drawings are objected to as failing to comply with 37 CFR [1.84\(p\)\(4\)](#) because reference character “[1]” has been used to designate both [2] and [3]. Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, identify the number which refers to the different parts.
2. In brackets 2 and 3, identify the parts which are referred to by the same number.
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).
4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.04 Drawings Objected to, Incomplete

The drawings are objected to under 37 CFR [1.83\(b\)](#) because they are incomplete. 37 CFR [1.83\(b\)](#) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the

figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 [CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. Supply a full explanation, if it is not readily apparent how the drawings are incomplete.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.05 Drawings Objected to, Modifications in Same Figure

The drawings are objected to under 37 CFR [1.84\(h\)\(5\)](#) because Figure [1] show(s) modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

pursuant to 37 [CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, insert the appropriate Figure number(s).
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.06 Drawings Objected to, Reference Numbers Not in Drawings

The drawings are objected to as failing to comply with 37 CFR [1.84\(p\)\(5\)](#) because they do not include the following reference sign(s) mentioned in the description: [1]. Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 [CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the drawings, including the page and line number where they first occur in the specification.
2. This form paragraph may be modified to require or allow the applicant to delete the reference character(s) from the description instead of adding them to the drawing(s).
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).

4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.22.07 *Drawings Objected to, Reference Numbers Not in Specification*

The drawings are objected to as failing to comply with 37 CFR [1.84\(p\)\(5\)](#) because they include the following reference character(s) not mentioned in the description: [1]. Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR [1.121\(b\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR [1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the specification, including the figure in which they occur.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See 37 CFR [1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

¶ 6.23 *Subject Matter Admits of Illustration*

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under [37 CFR 1.81\(c\)](#). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR [1.121\(d\)](#).

Examiner Note:

When requiring drawings before examination use form paragraph 6.23.01 with a PTOL-90 or PTO-90C form as a cover sheet.

¶ 6.23.01 *Subject Matter Admits of Illustration (No Examination of Claims)*

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under [37 CFR 1.81](#). No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with [37 CFR 1.81](#). Extensions of time may be obtained under the provisions of [37 CFR 1.136\(a\)](#). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to lack of an illustration of the invention resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

¶ 6.24.01 *Color Photographs and Color Drawings, Petition Required*

Color photographs and color drawings are not accepted unless a petition filed under 37 CFR [1.84\(a\)\(2\)](#) is granted. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR [1.17\(h\)](#), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See 37CFR [1.84\(b\)\(2\)](#).

Examiner Note:

1. This form paragraph should be used only if the application contains color photographs or color drawings as the drawings required by 37 CFR [1.81](#).

2. Do not use this form paragraph for black and white photographs. Black and white photographs are permitted pursuant to 37 CFR 1.84(b).

¶ 6.26 *Informal Drawings Do Not Permit Examination*

The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to the poor quality of the drawings resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

¶ 6.27 *Requirement for Marked-up Copy of Drawing Corrections*

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the corrected drawing and marked-up copy will result in the abandonment of the application.

Examiner Note:

1. When this form paragraph is used by the examiner, the applicant must provide a marked-up copy of any amended drawing figure, including annotations indicating the changes made in the drawing replacement sheets. See 37 CFR 1.121(d)(2).
2. Applicants should be encouraged to submit corrected drawings before allowance in order to avoid having any term adjustment reduced pursuant to 37 CFR 1.704(c)(10).

¶ 6.28 *Idiomatic English*

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

¶ 6.28.01 *Substitute Specification Required by Examiner*

A substitute specification [1] the claims is required pursuant to 37 CFR 1.125(a) because [2].

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strikethrough except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

Examiner Note:

1. In bracket 1, insert either --excluding-- or --including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.
4. See also form paragraph 13.01 for partial rewritten specification.

¶ 6.28.02 *Substitute Specification Filed Under 37 CFR 1.125(b) and (c) Not Entered.*

The substitute specification filed [1] has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: [2]

Examiner Note:

1. In bracket 2, insert statement of why the substitute specification is improper, for example: -- the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--, -- a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--; -- a clean copy of the substitute specification has not been supplied (in addition to the

marked-up copy)--; or, -- the substitute specification has been filed:- in a reissue application or in a reexamination proceeding, [37 CFR 1.125\(d\)](#)-, or - after payment of the issue fee-, or - containing claims (to be amended)- --.

2. A substitute specification filed after final action or appeal is governed by 37 CFR [1.116](#). A substitute specification filed after the mailing of a notice of allowance is governed by 37 CFR [1.312](#).

¶ 6.29 *Specification, Spacing of Lines*

The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1 1/2 or double spaced on good quality paper are required.

¶ 6.30 *Numerous Errors in Specification*

[35 U.S.C. 112](#), first paragraph, requires the specification to be written in “full, clear, concise, and exact terms.” The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with [35 U.S.C. 112](#), first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: [1].

¶ 6.31 *Lengthy Specification, Jumbo Application*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant’s cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examiner Note:

This paragraph is applicable in so-called “Jumbo Applications” (more than 20 pages, exclusive of claims).

¶ 6.32 *Application on Easily Erasable Paper or Erasable Ink*

The application papers are objected to because they are not a permanent copy as required by [37 CFR 1.52\(a\)\(1\)\(iv\)](#). Reference is made to [1].

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the U.S. Patent and Trademark Office at applicant’s expense for incorporation in the file. See [MPEP § 608.01](#).

Examiner Note:

In the bracket, identify: 1) all of the specification; 2) certain pages of the specification; 3) particular claim(s); 4) the oath or declaration; 5) etc.

¶ 6.32.01 *Application Papers Must Be Legible*

The specification (including the abstract and claims), and any amendments for applications, except as provided for in 37 CFR [1.821](#) through [1.825](#), must have text written plainly and legibly either by a typewriter or machine printer in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6) in portrait orientation and presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition; and only a single column of text. See 37 CFR [1.52](#)(a) and (b).

The application papers are objected to because [1].

A legible substitute specification in compliance with 37 CFR [1.52](#)(a) and (b) and [1.125](#) is required.

Examiner Note:

1. In bracket 1, identify the part of the specification that is illegible: all of the specification; or certain pages of the specification.
2. Do not use this form paragraph for reissue applications or reexamination proceedings.

¶ 6.36 *Drawings Do Not Show Claimed Subject Matter*

The drawings are objected to under [37 CFR 1.83\(a\)](#). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

pursuant to 37 [CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Examiner Note:

In bracket 1, insert the features that must be shown.

¶ 6.36.01 *Illustration of “Prior Art”*

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See [MPEP § 608.02\(g\)](#). Corrected drawings in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR [1.84\(c\)](#)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

¶ 6.37 *Acknowledgment of Replacement Drawing Sheets*

The drawings were received on [1]. These drawings are [2].

Examiner Note:

1. In bracket 2, insert either --acceptable-- or --not acceptable--.
2. If not acceptable because of noncompliance with 37 CFR [1.121\(d\)](#), an explanation must be provided. Form PTOL-324 may be used instead of this form paragraph to provide the explanation.

¶ 6.39 *USPTO No Longer Makes Drawing Changes*

The United States Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant’s responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

Examiner Note:

This form paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

¶ 6.40 *Information on How To Effect Drawing Changes*

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR [1.84](#). An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR [1.121\(d\)](#). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor’s name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR [1.85\(a\)](#). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the “Notice of Allowability.” Extensions of time may NOT be obtained under the

provisions of 37 CFR [1.136](#) for filing the corrected drawings after the mailing of a Notice of Allowability.

¶ 6.41 Reminder That USPTO No Longer Makes Drawing Changes

Applicant is reminded that the U.S. Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in the paper mailed on [1].

Examiner Note:

This form paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes.

¶ 6.42 Reminder That Applicant Must Make Drawing Changes

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in the paper mailed on [1].

Examiner Note:

This form paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes.

¶ 6.43 Drawings Contain Informalities, Application Allowed

The drawings filed on [1] are acceptable subject to correction of the informalities indicated below. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Examiner Note:

1. Use this form paragraph when allowing the application, particularly at time of first action issue. Supply an explanation of drawings informalities (see [MPEP § 608.02\(b\)](#), [§ 608.02\(d\)](#) - [§ 608.02\(h\)](#) and [§ 608.02\(p\)](#)).

2. Form paragraph 6.40 or 6.41 must follow.

¶ 6.46 Application Allowed, Substitute Declaration Needed

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth [1]. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability" (PTO-37).

Extensions of time may NOT be obtained under the provisions of [37 CFR 1.136](#). Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the "Notice of Allowance" (PTOL-85) and the application number in the upper right hand corner.

Examiner Note:

In the bracket, insert appropriate information, e.g., --in this communication--, --in the Office action mailed _____--.

¶ 6.47 Examiner's Amendment Involving Drawing Changes

The following changes to the drawings have been approved by the examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make these agreed upon drawing changes.

Examiner Note:

1. In bracket 1, insert the agreed upon drawing changes.
2. Form paragraphs 6.39 and 6.40 should follow, as appropriate.

¶ 6.48 Model, Exhibit, or Specimen - Applicant Must Make Arrangements for Return

The [1] is no longer necessary for the conduct of business before the Office. Applicant must arrange for the return of the model, exhibit or specimen at the applicant's expense in accordance with 37 CFR [1.94\(a\)](#).

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to make arrangements for return of the above-identified model, exhibit, or specimen to avoid its disposal in accordance with 37 CFR [1.94\(c\)](#). Extensions of time are available under 37 CFR [1.136](#), except in the case of perishables.

Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application unless one of the exceptions set forth in 37 CFR [1.94\(b\)](#) applies.

Examiner Note:

1. In bracket 1, identify the model, exhibit, or specimen that is no longer needed by the Office.
2. The Office will dispose of **perishables** without notice to Applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or

specimen is no longer necessary for the conduct of business before the Office.

¶ 6.49 Information Disclosure Statement Not Considered

The information disclosure statement filed [1] fails to comply with the provisions of [37 CFR 1.97](#), 1.98 and [MPEP § 609](#) because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all requirements for statements under [37 CFR 1.97\(e\)](#). See MPEP § [609.05\(a\)](#).

Examiner Note:

See [MPEP § 609.05\(a\)](#) for situations where the use of this form paragraph would be appropriate.

¶ 6.49.01 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Statement

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(c\)](#) because it lacks a statement as specified in [37 CFR 1.97\(e\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.02 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Fee

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(c\)](#) because it lacks the fee set forth in [37 CFR 1.17\(p\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.03 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Statement

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(d\)](#) because it lacks a statement as specified in [37 CFR 1.97\(e\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.05 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Fee

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(d\)](#) because it lacks the fee set forth in [37 CFR 1.17\(p\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.06 Information Disclosure Statement Not Considered, References Listed in Specification

The listing of references in the specification is not a proper information disclosure statement. [37 CFR 1.98\(b\)](#) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and MPEP § [609.04\(a\)](#), subsection I, states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

¶ 6.49.07 Information Disclosure Statement Not Considered, No Copy of References

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(2\)](#), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Examiner Note:

Do not use this form paragraph when the missing reference(s) are U.S. patents, U.S. patent application publications, or U.S. pending applications (limited to the specification, including claims, and drawings) stored in IFW.

¶ 6.49.08 Information Disclosure Statement Not Considered, Non-Compliant List of References

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(1\)](#), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner’s initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the

application file, but the information referred to therein has not been considered.

Examiner Note:

If an IDS listing includes a copy of an initialed IDS listing from another application, the IDS listing would not comply with the requirements under 37 CFR [1.98\(a\)\(1\)](#). This form paragraph is applicable for such an IDS submission.

¶ 6.49.09 *Information Disclosure Statement Not Considered, No Explanation of Relevance of Non-English Language Information*

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(3\)\(i\)](#) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in [37 CFR 1.56\(c\)](#) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.10 *Information Disclosure Statement Not Considered, Non-acceptable Electronic Medium*

The information disclosure statement filed [1] was submitted on an electronic medium that was not acceptable. It has been placed in the application file, but the information referred to therein has not been considered. Note that U.S. patents, U.S. application publications, foreign patent documents and non-patent literature cited in an information disclosure statement may be electronically submitted in compliance with the Office Electronic Filing System (EFS) requirements.

Examiner Note:

This form paragraph may be used when the IDS that includes patents and non-patent literature documents is submitted on compact discs or any other electronic medium, except via EFS. Only tables, sequence listings, and program listings may be submitted on CDs. See 37 CFR [1.52\(a\)](#) and (e).

¶ 6.51 *Time for Completing Information Disclosure Statement*

The information disclosure statement filed on [1] does not fully comply with the requirements of [37 CFR 1.98\(b\)](#) 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:

Use this form paragraph if an IDS complies with the timing requirements of 37 CFR [1.97](#) but part of the content requirements of 37 CFR [1.98\(b\)](#) has been inadvertently omitted.

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.

¶ 6.52 *Information Disclosure Statement Filed After Prosecution Has Been Closed*

The information disclosure statement (IDS) submitted on [1] was filed after the mailing date of the [2] on [3]. The submission is in compliance with the provisions of [37 CFR 1.97](#). Accordingly, the information disclosure statement is being considered by the examiner.

Examiner Note:

1. In bracket 1, insert the date the IDS was filed.
2. In bracket 2, insert --final Office action--, --Notice of Allowance--, or an -- *Ex parte Quayle* action-- as appropriate.

¶ 6.53 *References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Prior to Allowance*

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with [37 CFR 1.98\(a\)\(1\)](#). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

Examiner Note:

1. In bracket [1], identify the office (e.g., PCT, EPO, etc.) that issued the search report and the date it issued.
2. This form paragraph may be used for PCT National Stage applications submitted under [35 U.S.C. 371](#) where the examiner has obtained copies of the cited references. If receipt of such copies is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply copies for consideration. See [MPEP § 1893.03\(g\)](#).

3. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.

4. This form paragraph should only be used prior to allowance when a statutory period for reply is being set in the Office action.

5. If the application is being allowed, form paragraph 6.54 should be used with the Notice of Allowability instead of this form paragraph.

¶ 6.54 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Ready for Allowance

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with [37 CFR 1.98\(a\)\(1\)](#). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within ONE MONTH of the mailing date of this communication. NO EXTENSION OF TIME WILL BE GRANTED UNDER EITHER [37 CFR 1.136\(a\)](#) OR (b) to comply with this requirement.

Examiner Note:

1. In bracket [1], identify the office (e.g., PCT, EPO, etc.) that issued the search report and the date it issued.
2. This form paragraph may be used for PCT National Stage applications submitted under [35 U.S.C. 371](#) where the examiner has obtained copies of the cited references. If receipt of such copies is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply copies for consideration. See [MPEP § 1893.03\(g\)](#).
3. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.

¶ 6.55 References Not Considered in 35 U.S.C. 371 Application Based Upon Searched Report

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with [37 CFR 1.98](#). [37 CFR 1.98\(a\)\(2\)](#) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any

claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see [37 CFR 1.98\(a\)\(1\)](#) and (b)), and MPEP § [609.04\(a\)](#), subsection I. states, “the list ... must be submitted on a separate paper.” Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all “statement” requirements of [37 CFR 1.97\(e\)](#). See MPEP § [609.05\(a\)](#).

Examiner Note:

1. This form paragraph may be used in National Stage applications submitted under [35 U.S.C. 371](#).
2. Do not use this form paragraph when the missing references are U.S. patents, U.S. patent application publications, or U.S. pending applications that are stored in IFW.

¶ 6.56 Notify Applicant of Office Treatment of a Third-Party Submission

A third-party submission has been filed under [37 CFR 1.99](#) on [1] in the published application.

To ensure that a third-party submission does not amount to a protest or pre-grant opposition, [37 CFR 1.99](#) does not permit the third party to have the right to insist that the examiner consider any of the patents or publications submitted. Furthermore, if the submission or part of the submission is not in compliance with [37 CFR 1.99](#), that noncompliant submission or part thereof will not be entered in the application file. Therefore, unless the examiner clearly cites a patent or publication on form PTO-892, Notice of References Cited and such reference is used in a rejection or its relevance is actually discussed during prosecution, consideration by the examiner of any patent or publication submitted in a third-party submission cannot be presumed.

If the applicant wants to ensure that the information in a third-party submission is considered by the examiner, the applicant should submit the information in an IDS in compliance with [37 CFR 1.97](#) and [37 CFR 1.98](#). An individual who has a duty to disclose under [37 CFR 1.56](#) should also submit any material information contained in a third-party submission to the Office in an IDS in compliance with [37 CFR 1.97](#) and [37 CFR 1.98](#) to ensure

such material information is properly disclosed to the examiner.

Examiner Note:

1. In bracket 1, insert the date that the Office received the submission.

¶ 6.60.01 CD-ROM/CD-R Requirements (No Statement that CDs are Identical)

This application is objected to under 37 CFR [1.52\(e\)\(4\)](#) because it does not contain a statement in the transmittal letter that the two compact discs are identical. Correction is required.

¶ 6.60.02 CD-ROM/CD-R Requirements (No Listing in Transmittal Letter)

This application is objected to because it contains a data file on CD-ROM/CD-R, however, the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR [1.52\(e\)\(3\)](#). A statement listing the required information is required.

¶ 6.61.01 Specification Lacking List of Compact Disc(s) and /or Associated Files

Portions of this application are contained on compact disc(s). When portions of an application are contained on a compact disc, the paper portion of the specification must identify the compact disc(s) and list the files including name, file size, and creation date on each of the compact discs. See 37 CFR [1.52\(e\)](#). Compact disc labeled[1] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the file name, file size, and file creation date.

Examiner Note:

In bracket 1, insert the name on the label of the compact disc.

¶ 6.61.02 Specification Lacking An Incorporation By Reference Statement for the Compact Disc

This application contains compact disc(s) as part of the originally filed subject matter, but does not contain an incorporation by reference statement for the compact discs. See 37 CFR [1.77\(b\)\(4\)](#). Applicant(s) are required to insert in the specification an incorporation-by-reference of the material on the compact disc(s).

¶ 6.62 Data File on CD-ROM/CD-R Not in ASCII File Format

This application contains a data file on CD-ROM/CD-R that is not in an ASCII file format. See 37 CFR [1.52\(e\)](#). File [1] is not in an ASCII format. Applicant is required to resubmit file(s) in ASCII format. No new matter may be introduced in presenting the file(s) in ASCII format.

Examiner Note:

1. This form paragraph must be used to indicate whenever a data file (table, computer program listing or Sequence Listing) is submitted in a non-ASCII file format. The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file may contain non-ASCII characters.

2. In bracket 1, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters.

¶ 6.63.01 CD-ROM/CD-R Requirements (Table Listing in Specification)

The description portion of this application contains a table consisting of less than fifty one (51) pages only on a CD-ROM or CD-R. In accordance with 37 CFR [1.52\(e\)](#), only a table of at least fifty one (51) pages may be submitted on a CD-ROM or CD-R. Accordingly, applicant is required to cancel the references to the CD-ROM/CD-R table appearing in the specification on pages[1], file a paper version of the table in compliance with 37 CFR [1.52](#) and change all appropriate references to the former CD-ROM/CD-R table to the newly added paper version of the table in the remainder of the specification.

Examiner Note:

1. This form paragraph must be used whenever a table on a CD-ROM or CD-R consisting of less than fifty one (51) pages as part of the descriptive portion of the specification is filed on or after September 8, 2000. See MPEP § [608.05\(b\)](#).

2. In bracket 1, insert the range of page numbers of the specification which reference the table.

¶ 6.63.02 Table on CD-ROM/CD-R Column/Row Relationship Not Maintained

This application contains a table on CD-ROM/CD-R. Tables presented on CD-ROM/CD-R in compliance with 37 CFR [1.58](#) must maintain the spatial orientation of the cell entries. The table submitted does not maintain the data within each table cell in its proper row/column alignment. The data is misaligned in the table as follows: [1]. Applicant is required to submit a replacement compact disc with the table data properly aligned.

Examiner Note:

1. This form paragraph must be used whenever the data in a table cannot be accurately read because the data in the table cells do not maintain their row and column alignments.
2. In bracket 1, insert the area of the table that does not maintain the row and column alignments.

¶ 6.64.01 *Computer Program Listing Appendix on Compact Disc Requirement*

The description portion of this application contains a computer program listing consisting of more than three hundred (300) lines. In accordance with 37 CFR [1.96\(c\)](#), a computer program listing of more than three hundred lines must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR [1.96\(c\)\(2\)](#) and must be appropriately referenced in the specification (see 37 CFR [1.77\(b\)\(5\)](#)). Accordingly, applicant is required to cancel the computer program listing appearing in the specification on pages [1], file a computer program listing appendix on compact disc in compliance with 37 CFR [1.96\(c\)](#), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

Examiner Note:

1. This form paragraph must be used whenever a computer program listing consisting of more than three hundred lines is included as part of the descriptive portion of the specification if the computer program listing was filed on or after September 8, 2000. See MPEP § [608.05\(a\)](#).
2. In bracket 1, insert the range of page numbers of the specification which include the computer program listing.

¶ 6.64.02 *Computer Program Listing as Printout Within the Specification (More Than 60 Lines And Not More Than Three Hundred Lines)*

This application contains a computer program listing of over sixty (60) lines and less than three hundred and one (301) lines within the written specification. In accordance with 37 CFR [1.96\(b\)](#), a computer program listing contained on over sixty (60) lines and less than three hundred-one (301) lines must, if submitted as part of the specification, be positioned at the end of the specification and before the claims. Accordingly, applicant is required to cancel the computer program listing and either incorporate such listing in a compact disc in compliance with 37 CFR [1.96](#), or insert the computer program listing after the detailed description of the invention but before the claims, in the form of direct printouts from a computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper.

Examiner Note:

This form paragraph must be used whenever a computer program listing consisting of a paper printout of more than 60 lines and no more than three hundred lines is included as part of the descriptive portion of the specification and the computer program listing was filed on or after September 8, 2000. See MPEP § [608.05\(a\)](#).

¶ 6.64.03 *Computer Program Listing of More Than Three Hundred Lines*

This application contains a computer program listing of more than three hundred (300) lines. In accordance with 37 CFR [1.96\(c\)](#), a computer program listing contained on more than three hundred (300) lines must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR [1.96\(c\)\(2\)](#) and must be appropriately referenced in the specification (see 37 CFR [1.77\(b\)\(5\)](#)). Accordingly, applicant is required to cancel the current computer program listing, file a computer program listing appendix on compact disc in compliance with 37 CFR [1.96\(c\)](#), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

Examiner Note:

This form paragraph must be used whenever a computer program listing consisting of a paper printout of more than three hundred lines is filed on or after September 8, 2000.

¶ 6.64.04 *“Microfiche Appendix” Unacceptable*

The computer program listing filed on [1] as a “microfiche appendix” is unacceptable. A computer program listing conforming to the requirements of 37 CFR [1.96](#) is required.

Examiner Note:

1. This form paragraph should be used if a “microfiche appendix” was filed after March 1, 2001 or if a “microfiche appendix” filed on or before March 1, 2001 was not in compliance with former rule 37 CFR [1.96\(c\)](#). See MPEP § [608.05\(a\)](#).
2. In bracket 1, insert the date the “microfiche appendix” was filed.

¶ 6.70.01 *CD-ROM/CD-R Requirements (Amendment Does Not Include Statement that CDs are Identical)*

The amendment filed [1] is objected to under 37 CFR [1.52\(e\)\(4\)](#) because it does not contain a statement in the transmittal letter that the two compact discs are identical. Correction is required.

¶ 6.70.02 *CD-ROM/CD-R Requirements (No Listing in Transmittal Letter Submitted With Amendment)*

The amendment filed [1] contains data on compact disc(s). Compact disc labeled [2] is not identified in the transmittal letter and/or the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR [1.52\(e\)\(3\)](#). A statement listing the required information is required.

Examiner Note:

1. Use this form paragraph when the transmittal letter does not include a listing of the files and required information.
2. In bracket 1, insert the date of the amendment.
3. In bracket 2, insert the name on the label of the compact disc.

¶ 6.71.01 *Specification Lacking List of Compact Disc(s) and/or Associated Files (Amendment Filed With Compact Disc(s))*

The amendment filed [1] contains data on compact disc(s). Compact disc labeled [2] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the file name, file size, and file creation date. See 37 CFR [1.52\(e\)](#).

Examiner Note:

1. In bracket 1, insert the date of the amendment.
2. In bracket 2, insert the name on the label of the compact disc.

¶ 6.71.02 *Specification Lacking An Incorporation By Reference Statement for the Compact Disc (Amendment Filed With Compact Disc)*

The amendment filed [1] amends or adds a compact disc(s). See 37 CFR [1.77\(b\)\(4\)](#) and [1.52\(e\)\(5\)](#). Applicant is required to update or insert an incorporation-by-reference of the material on the compact disc(s) in the specification.

Examiner Note:

1. Use this form paragraph when the CD-ROM/CD-R is filed with an amendment, but the required incorporation-by-reference statement is neither amended nor added to the specification.
2. In bracket 1, insert the date of the amendment.

¶ 6.72.01 *CD-ROM/CD-R Requirements (CDs Not Identical)*

The amendment filed [1] is objected to under 37 CFR [1.52\(e\)\(4\)](#) because the two compact discs are not identical. Correction is required.

Examiner Note:

1. Use this form paragraph when the two compact discs are not identical.
2. See also form paragraph 6.70.01 where the transmittal letter does not include a statement that the two compact discs are identical.

¶ 6.72.02 *Data File, Submitted With Amendment, on CD-ROM/CD-R Not in ASCII File Format*

The amendment filed [1] contains a data file on CD-ROM/CD-R that is not in an ASCII file format. File [2] is not in an ASCII format. Applicant is required to resubmit file(s) in ASCII format as required by 37 CFR [1.52\(e\)\(3\)](#). No new matter may be introduced in presenting the file(s) in ASCII format.

Examiner Note:

1. This form paragraph must be used whenever a data file (table, computer program listing or Sequence Listing) is submitted in a non-ASCII file format. The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file contains non-ASCII characters.
2. In bracket 1, insert the date of the amendment.
3. In bracket 2, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters.

¶ 6.72.03 *CD-ROM/CD-R Are Not Readable*

The amendment filed [1] contains a data file on CD-ROM/CD-R that is unreadable. Applicant is required to resubmit the file(s) in International Standards Organization (ISO) 9660 standard and American Standard Code for Information Interchange (ASCII) format as required by 37 CFR [1.52\(e\)\(3\)](#). No new matter may be introduced in presenting the file in ISO 9660 and ASCII format.

¶ 6.72.04 *CD-ROM/CD-R Contains Viruses*

The amendment filed [1] is objected to because the compact disc contains at least one virus. Correction is required.

¶ 6.72.05 *CD-ROM/CD-R Requirements (Missing Files On Amended Compact Disc)*

The amendment to the application filed [1] is objected to because the newly submitted compact disc(s) do not contain all of the unamended data file(s) together with

the amended data file(s) that were on the CD-ROM/CD-R. Since amendments to a compact disc can only be made by providing a replacement compact disc, the replacement disc must include all of the files, both amended and unamended, to be a complete replacement.

Examiner Note:

Use this form paragraph when a replacement compact disc is submitted that fails to include all of the files on the original compact disc(s) that have not been cancelled by amendment.

Chapter 700 - Examination of Applications

¶ 7.01 Use of Unconventional Terminology, Cannot Be Examined

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that a proper search of the prior art cannot be made. For example: [1]

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. Use this or form paragraph 7.02 when a proper search cannot be made. However, see [MPEP § 702.01](#) which requires a reasonable search.
2. In bracket 1, fill in an appropriate indication of the terminology, properties, units of data, etc. that are the problem as well as the pages of the specification involved.
3. For the procedure to be followed when only the drawing is informal, see [MPEP §§ 608.02\(a\)](#) and [608.02\(b\)](#).

¶ 7.02 Disclosure Is Incomprehensible

The disclosure is objected to under [37 CFR 1.71](#), as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: [1]

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful NOT to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. Use this form paragraph when a search cannot be made.
2. In bracket 1, indicate the page numbers and features which are not understood.
3. See form paragraphs 6.28 and 6.30 for improper idiomatic English.
4. Use form paragraphs 7.31.01 – 7.31.04, as appropriate, for a rejection of claims (when necessary) based on the deficiencies set forth in this form paragraph.

¶ 7.04 Statement of Statutory Basis, 35 U.S.C. 101

[35 U.S.C. 101](#) reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Examiner Note:

This paragraph must precede the first use of [35 U.S.C. 101](#) in all first actions on the merits and final rejections.

¶ 7.04.01 Human Organism

Section 33(a) of the America Invents Act reads as follows:

Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.

Claim [1] rejected under [35 U.S.C. 101](#) and section 33(a) of the America Invents Act as being directed to or encompassing a human organism. See also *Animals - Patentability*, 1077 *Off. Gaz. Pat. Office* 24 (April 21, 1987) (indicating that human organisms are excluded from the scope of patentable subject matter under [35 U.S.C. 101](#)). [2]

Examiner Note:

1. This paragraph must be preceded by form paragraph 7.04 which quotes [35 U.S.C. 101](#).
2. In bracket 1, pluralize “Claim” if necessary, insert claim number(s), and insert “is” or “are” as appropriate.
3. In bracket 2, explain why the claim is interpreted to read on a human organism.

¶ 7.05 Rejection, 35 U.S.C. 101, -Heading Only- (Utility, Non-Statutory, Inoperative)

Claim [1] rejected under [35 U.S.C. 101](#) because

Examiner Note:

1. This form paragraph must be followed by one or more of form paragraphs - 7.05.01, 7.05.011, 7.05.012, 7.05.013, 7.05.02, 7.05.03, or another appropriate reason.
2. Explain the rejection following the recitation of the statute and the use of form paragraph(s) or other reason.
3. See [MPEP §§ 706.03\(a\)](#) and [2105- 2107.03](#) for other situations.
4. This form paragraph must be preceded by form paragraph 7.04 in first actions and final rejections.

¶ 7.05.01 Rejection, 35 U.S.C. 101, Non-Statutory

the claimed invention is directed to non-statutory subject matter because [1]

Examiner Note:

1. In bracket 1, explain why the claimed invention is not patent eligible subject matter, e.g.,
 - (a) why the claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. [101](#) (process, machine, manufacture, or composition of matter), e.g., the claim is directed to a signal *per se*, a contract between two parties, or a human being; or
 - (b) why the claimed invention, although nominally falling within at least one of the four eligible categories, is directed to a judicial exception to 35 U.S.C. [101](#) (i.e., an abstract idea, natural phenomenon, or law of nature); or
 - (c) why the claimed invention would impermissibly cover every substantial practical application of, and thereby preempt all use of, an abstract idea, natural phenomenon, or law of nature.
2. For a claim that is directed to an abstract idea and is non-statutory, use form paragraph 7.05.011.

¶ 7.05.011 Rejection, 35 U.S.C. 101, Non-Statutory Method (Abstract Idea)

the claimed invention is not directed to patent eligible subject matter. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) [1] is/are determined to be directed to an abstract idea. The rationale for this determination is explained below: [2]

Examiner Note:

1. This form paragraph should only be used when rejecting method claim(s) directed to an abstract idea.
2. In bracket 2, identify the decisive factors weighing against patent eligibility under [35 U.S.C. 101](#), and explain the manner in which these factors support a conclusion of patent ineligibility under [35 U.S.C. 101](#). For instance, that additional limitations are no more than a field of use or merely involve insignificant extrasolution activity; e.g., data gathering. The explanation needs to be sufficient to establish a *prima facie* case of patent ineligibility under [35 U.S.C. 101](#).

¶ 7.05.012 Dependent Claim(s) - Rejection, 35 U.S.C. 101, Non-Statutory Method (Abstract Idea)

Dependent claim(s) [1] when analyzed as a whole are held to be patent ineligible under [35 U.S.C. 101](#) because the additional recited limitation(s) fail(s) to establish that the claim(s) is/are not directed to an abstract idea, as detailed below: [2]

Examiner Note:

1. This form paragraph should only be used when rejecting dependent method claim(s) directed to an abstract idea.
2. In bracket 2, provide an explanation as to why the claim(s) is/are directed to an abstract idea; for instance, that the additional limitations are no more than a field of use or merely involve insignificant extrasolution activity; e.g., data gathering. The explanation needs to be sufficient to establish a *prima facie* case of patent ineligibility under [35 U.S.C. 101](#).

¶ 7.05.013 Rejection, 35 U.S.C. 101, Non-Statutory Method (Law of Nature)

the claimed invention is not directed to patent eligible subject matter. Based upon an analysis with respect to the claim as a whole, claim(s) [1] is/are determined to be directed to a law of nature/natural principle. The rationale for this determination is explained below: [2]

Examiner Note:

1. This form paragraph should only be used when rejecting method claim(s) that have a law of nature/natural principle as a claim limitation.
2. In bracket 2, identify the natural principle that is the limiting feature in the claim, and explain why the additional elements or steps in the claim do not integrate the natural principle into the method and/or why the additional elements or steps in the claim are not sufficient to ensure that the claim amounts to significantly more than the natural principle itself. For instance, the additional elements or steps can be shown to be extrasolution activity or mere field of use that impose no meaningful limit on the performance of the method or

can be shown to be no more than well-understood, purely conventional, and routinely taken by others in order to apply the natural principle. The explanation needs to be sufficient to establish a *prima facie* case of patent ineligibility under [35 U.S.C. 101](#).

¶ 7.05.02 *Rejection, 35 U.S.C. 101, Utility Lacking*

the claimed invention lacks patentable utility. [1]

Examiner Note:

In bracket 1, provide explanation of lack of utility. See [MPEP §§ 706.03\(a\)](#) and [2105 - 2107.03](#).

¶ 7.05.03 *Rejection, 35 U.S.C. 101, Inoperative*

the disclosed invention is inoperative and therefore lacks utility. [1]

Examiner Note:

In bracket 1, explain why invention is inoperative.

¶ 7.05.04 *Utility Rejections Under 35 U.S.C. 101 and 35 U.S.C. 112, First Paragraph*

Claim [1] rejected under [35 U.S.C. 101](#) because the claimed invention is not supported by either a [2] asserted utility or a well established utility.

[3]

Claim [4] also rejected under [35 U.S.C. 112](#), first paragraph. Specifically, since the claimed invention is not supported by either a [5] asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Examiner Note:

1. Where the specification would not enable one skilled in the art to make the claimed invention, or where alternative reasons support the enablement rejection, a separate rejection under [35 U.S.C. 112](#), first paragraph, enablement should be made using the factors set forth in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) and an undue experimentation analysis. See [MPEP §§ 2164 - 2164.08\(c\)](#).

2 Use Format A, B, or C below as appropriate.

Format A:

- (a) Insert the same claim numbers in brackets 1 and 4.
- (b) Insert --specific and substantial-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

(d) Format A is to be used when there is no asserted utility and when there is an asserted utility but that utility is not specific and substantial.

Format B:

(a) Insert the same claim numbers in brackets 1 and 4.

(b) Insert --credible-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a credible asserted utility or a well established utility.

Format C:

For claims that have multiple utilities, some of which are not specific and substantial, some of which are not credible, but none of which are specific, substantial and credible:

(a) Insert the same claim numbers in brackets 1 and 4.

(b) Insert --specific and substantial asserted utility, a credible-- in inserts 2 and 5.

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific and substantial asserted utility, a credible asserted utility or a well established utility. Each utility should be addressed.

¶ 7.05.05 *Duplicate Claims, Warning*

Applicant is advised that should claim [1] be found allowable, claim [2] will be objected to under [37 CFR 1.75](#) as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See [MPEP § 706.03\(k\)](#).

Examiner Note:

1. Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.

2. If the claims are allowable, use form paragraph 7.05.06.

¶ 7.05.06 *Duplicate Claims, Objection*

Claim [1] objected under [37 CFR 1.75](#) as being a substantial duplicate of claim [2]. When two claims in an

application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See [MPEP § 706.03\(k\)](#).

Examiner Note:

If the duplicate claims are not allowable, use form paragraph 7.05.05.

¶ 7.06 Claim Limitation Relating to a Tax Strategy Deemed To Be Within the Prior Art under 35 U.S.C. 102 and/or 103

Claim limitation “[1]” has been interpreted as a strategy for reducing, avoiding, or deferring tax liability (“tax strategy”) pursuant to Section 14 of the Leahy-Smith America Invents Act. Accordingly, this claim limitation is being treated as being within the prior art and is insufficient to differentiate the invention of claim[2] from the prior art.

Examiner Note:

1. In bracket 1, recite the claim limitation that relates to a tax strategy. For more information see the memorandum *Tax Strategies Are Deemed To Be Within the Prior Art* issued on September 20, 2011.

2. In bracket 2, insert claim number(s), pluralize “claim” as appropriate.

¶ 7.07 Statement of Statutory Basis, 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of [35 U.S.C. 102](#) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use form paragraph 7.103.

2. Form paragraphs 7.07 to 7.14 are to be used ONLY ONCE in a given Office action.

¶ 7.08 102(a), Activity by Another Before Invention by Applicant

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07.

¶ 7.09 102(b), Activity More Than One Year Prior to Filing

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Examiner Note:

This form paragraph must be preceded by paragraph form 7.07, and may be preceded by form paragraph 7.08.

¶ 7.10 102(c), Invention Abandoned

(c) he has abandoned the invention.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 and 7.09.

¶ 7.100 Name And Number of Examiner To Be Contacted

Any inquiry concerning this communication should be directed to [1] at telephone number [2].

Examiner Note:

1. This form paragraph, form paragraph 7.101, or form paragraph 7.102 should be used at the conclusion of all actions.

2. In bracket 1, insert the name of the examiner designated to be contacted first regarding inquiries about the Office action. This could be either the non-signatory examiner preparing the action or the signatory examiner.

3. In bracket 2, insert the individual area code and phone number of the examiner to be contacted.

¶ 7.101 Telephone Inquiry Contacts- Non 5/4/9 Schedule

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is [2]. The examiner can normally be reached on [3] from [4] to [5].

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, [6], can be reached on [7]. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information

Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off every Friday.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 5:00 PM."
5. In bracket 6, insert your SPE's name.
6. In bracket 7, insert your SPE's area code and phone number.

¶ 7.102 Telephone Inquiry Contacts- 5/4/9 Schedule

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is [2]. The examiner can normally be reached on [3] from [4] to [5]. The examiner can also be reached on alternate [6].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [7], can be reached on [8]. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual area code and phone number.

3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off on alternate Fridays.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 4:00 PM."
5. In bracket 6, insert the day in each pay-period that is your compressed day off, e.g. "Fridays" for an examiner on a 5/4/9 work schedule with the first Friday off.
6. In bracket 7, insert your SPE's name.
7. In bracket 8, insert your SPE's area code and phone number.

¶ 7.103 Statute Cited in Prior Action

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

¶ 7.104 Requirement for Information, Public Use or Sale

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under [35 U.S.C. 102\(b\)](#), additional information regarding this issue is required as follows: [1]

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Examiner Note:

1. Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability. See [MPEP § 2133.03](#).
2. A one or two month time period should be set by the examiner for reply to the requirement unless it is part of an Office action having an SSP, in which case the period for reply will apply also to the requirement.
3. If sufficient evidence already exists to establish a *prima facie* case of public use or on sale, use form paragraph 7.16 to make a rejection under [35 U.S.C. 102\(b\)](#). See [MPEP § 2133.03](#).

¶ 7.105 Requirement for Information, Heading

Applicant and the assignee of this application are required under 37 CFR [1.105](#) to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Examiner Note:

1. This form paragraph should appear at the beginning of any requirement for information under 37 CFR [1.105](#), and should be followed by an explanation of why the

required information is necessary for examination. Form paragraphs 7.106 – 7.121 may be used as appropriate.

2. The requirement for information should conclude with form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.105.01 *Stipulations of Facts Known to Applicant*

In response to this requirement, please agree or disagree to the stipulation of each of the following assertions of facts:

[1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. In bracket 1, specify each factual assertion, in the form of a separate, numbered sentence, that the applicant is to either agree or disagree to so stipulate. It is suggested that at the end of each assertion, the parenthetical phrase, “(agree/disagree)” be appended to facilitate a reply by way of applicant marking up a copy of the requested stipulations.

¶ 7.105.02 *Interrogatories of Facts Known to Applicant*

In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

[1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. In bracket 1, specify each interrogatory question, in the form of a separate, numbered sentence, that the applicant is to answer. The scope of each query must be clearly set forth and the content of the expected reply is to be characterized as factual information.

¶ 7.106 *Domain of Search*

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class [1] and subclasses [2], which describe [3]. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of [4].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. In bracket 4, insert a description of the art claimed but not found in the classification system.

¶ 7.107 *Level of Skill and Knowledge in the Art*

The information is required to document the level of skill and knowledge in the art of [1].

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.108 *Background Description*

The information is required to complete the background description in the disclosure by documenting [1].

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.109 *Products and Services Embodying Invention*

The information is required to identify products and services embodying the disclosed subject matter of [1] and identify the properties of similar products and services found in the prior art.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.11 102(d), *Foreign Patenting*

(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.10.

¶ 7.110 *Art Suggested as Relevant*

The information is required to enter in the record the art suggested by the applicant as relevant to this examination in [1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, describe where in the application file applicant suggests that the art is relevant, e.g., the specification and the relevant page thereof, or a paper received in the Office on a specified date and the relevant page thereof.

¶ 7.111 *List of Keywords*

In response to this requirement, please provide a list of keywords that are particularly helpful in locating publications related to the disclosed art of [1].

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.112 *Citations for Electronically Searchable Databases or Other Indexed Collections*

In response to this requirement, please provide a list of citations to electronically searchable databases or other indexed collections containing publications that document the knowledge within the disclosed art of [1].

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.113 *Copy of Art Referred to in the Disclosure, But Not Submitted*

In response to this requirement, please provide a copy of each of the following items of art referred to in the [1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. In bracket 1, describe where in the application file applicant refers to art that has not been previously submitted, e.g., the specification and the relevant page thereof, or a paper received in the Office on a specified date and the relevant page thereof.

¶ 7.114 *Copies of Publications Authored by Inventor(s)*

In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of [1].

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.115 *Art Relied Upon for Description of Prior Art*

In response to this requirement, please provide the title, citation and copy of each publication that is a source used for the description of the prior art in the disclosure. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.

¶ 7.116 *Art Relied Upon for Development of Invention*

In response to this requirement, please provide the title, citation and copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing [1]. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.
3. In bracket 1, insert a description of the most important inventive elements.

¶ 7.117 *Art Relied Upon for Drafting Claimed Subject Matter*

In response to this requirement, please provide the title, citation and copy of each publication that was relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. This requirement is limited in that only those documents actually relied on, rather than documents believed to be relevant, are required.

¶ 7.118 *Results of Applicant's Prior Art Search*

In response to this requirement, please state whether any search of prior art was performed. If a search was performed, please state the citation for each prior art collection searched. If any art retrieved from the search was considered material to demonstrating the knowledge of a person having ordinary skill in the art to the disclosed [1], please provide the citation for each piece of art considered and a copy of the art.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. In bracket 1, describe the subject matter for which art is required.

¶ 7.119 *Names of Products or Services Incorporating Claimed Invention*

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.12 *Rejection under 35 U.S.C. 102(e), Patent Application Publication or Patent to Another with Earlier Filing Date, in view of the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002*

(e) the invention was described in (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under [Article 21\(2\)](#) of such treaty in the English language.

Examiner Note:

1. This form paragraph should only be used if the reference is one of the following:

(a) a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);

(b) a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has an **international filing date on or after November 29, 2000**.

2. In determining the [35 U.S.C. 102\(e\)](#) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), U.S. nonprovisional applications under [35 U.S.C. 120](#) or [121](#), and international applications under [35 U.S.C. 120](#), [121](#) or [365\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\)](#)-(d) and [365\(a\)](#).

3. In order to rely on an international filing date for prior art purposes under [35 U.S.C. 102\(e\)](#), the international application must have been filed on or after November 29, 2000, it must have designated the U.S., and the international publication under [PCT Article 21\(2\)](#) by WIPO must have been in English. If any one of the conditions is not met, the international filing date is not a U.S. filing date for prior art purposes under [35 U.S.C. 102\(e\)](#).

4. If an international application was published by WIPO in a language other than English, or did not designate the U.S., the International Application's publication by WIPO, the U.S. publication of the national stage application ([35 U.S.C. 371](#)) of the international application and a U.S. patent issued from the national stage of the international application may not be applied as a reference under [35 U.S.C. 102\(e\)](#). The reference may be applied under [35 U.S.C. 102\(a\)](#) or (b) as of its publication date. See form paragraphs 7.08 and 7.09.

5. If an international application was published by WIPO in a language other than English, or did not designate the U.S., the U.S. publication of, or a U.S. patent issued from, a continuing application claiming benefit under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) to such an international application, has a [35 U.S.C. 102\(e\)](#) date as of the earliest U.S. filing date after the international filing date.

6. If the reference is a U.S. patent issued directly, or indirectly, from an international application that has an international filing date prior to November 29, 2000, use form paragraph 7.12.01. In that situation, pre-AIPA [35 U.S.C. 102\(e\)](#) is applicable in the determination of the prior art date of the patent issued from such an international application.

7. If the reference is a publication of an international application (including the U.S. publication of a national stage ([35 U.S.C. 371](#))) that has an international filing date

prior to November 29, 2000, do not use this form paragraph. Such a reference may not be applied as a prior art reference under [35 U.S.C. 102\(e\)](#). The reference may be applied under [35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date. See form paragraphs 7.08 and 7.09.

8. This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.11.

¶ 7.120 Names of Products or Services Incorporating Disclosed Prior Art

In response to this requirement, please provide the names of any products or services that have incorporated the disclosed prior art [1].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

2. In bracket 1, specify the attributes of the prior art that most closely approximate the claimed subject matter to narrow the focus of the reply.

¶ 7.12.01 Rejection under 35 U.S.C. 102(e), Patent to Another with Earlier Filing Date, Reference is a U.S. Patent Issued Directly or Indirectly From a National Stage of, or a Continuing Application Claiming Benefit under 35 U.S.C. 365(c) to, an International Application Having an International Filing Date Prior to November 29, 2000

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of [section 371\(c\)](#) of this title before the invention thereof by the applicant for patent.

The changes made to [35 U.S.C. 102\(e\)](#) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under [35 U.S.C. 102\(e\)](#) prior to the amendment by the AIPA (pre-AIPA [35 U.S.C. 102\(e\)](#)).

Examiner Note:

1. This form paragraph should only be used if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a

continuing application claiming benefit under [35 U.S.C. 365\(c\)](#) to an international application having an international filing date prior to November 29, 2000.

2. If the reference is a U.S. patent issued directly from a national stage of such an international application, the reference's [35 U.S.C. 102\(e\)](#) date is the date that the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. The language of WIPO publication (PCT) is not relevant in this situation. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under [35 U.S.C. 102\(a\) or 102\(b\)](#).

3. If the reference is a U.S. patent issued directly from a continuing application claiming benefit under [35 U.S.C. 120, 121](#) or [365\(c\)](#) to such an international application (which had not entered the national stage prior to the continuing application's filing date, otherwise see note 4), the prior art reference's [35 U.S.C. 102\(e\)](#) date is the actual U.S. filing date of the continuing application. Caution: the international publication of the international application (PCT) by WIPO may have an earlier prior art date under [35 U.S.C. 102\(a\) or 102\(b\)](#).

4. In determining the [35 U.S.C. 102\(e\)](#) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), U.S. nonprovisional applications under [35 U.S.C. 120](#) or [121](#), and international applications under [35 U.S.C. 120, 121](#) or [365\(c\)](#) only if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application may only result in an effective U.S. filing date as of the date the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\)-\(d\)](#) and [365\(a\)](#).

5. This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.11.

¶ 7.121 Details of Improvement Over the Prior Art

In response to this requirement, please state the specific improvements of the subject matter in claims [1] over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.

¶ 7.122 Submission of Only Pertinent Pages Where Document is Large

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant’s disclosure.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraphs 7.122 – 7.126 as appropriate.
2. Use this form paragraph where the scope of the requirement for information specifically includes copies of publications.

¶ 7.123 Waiver of Fee and Statement Requirements for Certain Information Disclosures

The fee and certification requirements of [37 CFR 1.97](#) are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of the requirement under [37 CFR 1.105](#) that are included in the applicant’s first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under [37 CFR 1.105](#) are subject to the fee and certification requirements of [37 CFR 1.97](#) where appropriate.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraph 7.124 and either form paragraph 7.125 or 7.126 as appropriate.
2. Use this form paragraph where the scope of the requirement for information specifically includes citations to and/or copies of publications.

¶ 7.124 Contents of Good Faith Reply

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR [1.56](#). Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily

obtained may be accepted as a complete reply to the requirement for that item.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should be followed by form paragraph 7.125 or 7.126 as appropriate.
2. This form paragraph should appear in the conclusion of any requirement for information.

¶ 7.125 Conclusion of Requirement That Accompanies Office Action

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should appear at the conclusion of any requirement for information that accompanies an Office action. If the requirement for information is mailed without any other Office action, use form paragraph 7.126 instead.
2. Form paragraph 7.127 should appear at the end of any Office action that includes an attached requirement for information.

¶ 7.126 Conclusion Of Requirement Mailed Without Any Other Office Action

This requirement is subject to the provisions of 37 CFR [1.134](#), [1.135](#) and [1.136](#) and has a shortened statutory period of [1] months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR [1.136\(a\)](#).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should appear at the conclusion of any requirement for information mailed without any other Office action. If the requirement for information is mailed with an Office action, use form paragraph 7.125 instead.
2. The period for reply is ordinarily set for 2 months.

¶ 7.126.AE Conclusion of Requirement Mailed Without Any Other Office Action – Application Under Accelerated Examination

This requirement is subject to the provisions of 37 CFR [1.134](#), [1.135](#) and [1.136](#) and has a shortened statutory period of **ONE (1) MONTH or THIRTY (30) DAYS**, whichever is longer. Since this application has been

granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.105, and should appear at the conclusion of any requirement for information mailed without any other Office action. If the requirement for information is mailed with an Office action, use form paragraph 7.125 instead.
2. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)](#)(2) or (d).
3. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)](#)(1) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 7.127 *Conclusion of Office Action That Includes Requirement*

This Office action has an attached requirement for information under 37 CFR [1.105](#). A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Examiner Note:

This form paragraph should appear at the end of any Office action that includes an attached requirement for information.

¶ 7.13 *102(f), Applicant Not the Inventor*

(f) he did not himself invent the subject matter sought to be patented.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.12.

¶ 7.14 *102(g), Priority of Invention*

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.07, and may be preceded by one or more of form paragraphs 7.08 to 7.13.

¶ 7.147 *Supplemental Reply Not Approved for Entry*

The supplemental reply filed on [1] was not entered because supplemental replies are not entered as a matter of right except as provided in 37 CFR [1.111\(a\)](#)(2)(ii). [2].

Examiner Note:

1. Use this form paragraph to notify applicant that the supplemental reply filed on or after October 21, 2004 is not approved for entry.
2. Do not use this form paragraph if the supplemental reply has been entered. Use the Office Action Summary (PTOL-326) or the Notice of Allowability (PTOL-37), whichever is appropriate, to indicate that the Office action is responsive to the reply filed in compliance with 37 CFR [1.111\(b\)](#) and the supplemental reply.
3. Do not use this form paragraph if the supplemental reply was filed within the period during which action is suspended by the Office under 37 CFR [1.103\(a\)](#) or (c). Such supplemental reply must be entered. If the supplemental reply filed during the suspended period is not in compliance with 37 CFR [1.121](#), a notice of non-compliant amendment (PTOL-324) should be mailed to the applicant.
4. In bracket 1, provide the date that the Office received the supplemental reply (use the date of receipt under 37 CFR [1.6](#), not the certificate of mailing date under 37 CFR [1.8](#)).
5. In bracket 2, insert a reason for non-entry as noted in 37 CFR [1.111\(a\)](#)(2)(i). For example, "The supplemental reply is clearly not limited to placement of the application in condition for allowance."

¶ 7.15 Rejection, 35 U.S.C. 102(a), (b) Patent or Publication, and (g)

Claim [1] rejected under [35 U.S.C. 102](#) as being [3] by [4].

Examiner Note:

1. In bracket 2, insert the appropriate paragraph letter or letters of [35 U.S.C. 102](#) in parentheses. If paragraph (e) of [35 U.S.C. 102](#) is applicable, use form paragraph 7.15.02 or 7.15.03.
2. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 4, insert the prior art relied upon.
4. This rejection must be preceded either by form paragraph 7.07 and form paragraphs 7.08, 7.09, and 7.14 as appropriate, or by form paragraph 7.103.
5. If [35 U.S.C. 102\(e\)](#) is also being applied, this form paragraph must be followed by either form paragraph 7.15.02 or 7.15.03.

¶ 7.15.01 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor

Claim [1] provisionally rejected under [35 U.S.C. 102\(e\)](#) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under [35 U.S.C. 102\(e\)](#), if published under [35 U.S.C. 122\(b\)](#) or patented. This provisional rejection under [35 U.S.C. 102\(e\)](#) is based upon a presumption of future publication or patenting of the copending application. [4].

This provisional rejection under [35 U.S.C. 102\(e\)](#) might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under [37 CFR 1.131](#).

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention which has not been published under 35 U.S.C. 122. The copending application must have either a common assignee or at least one common inventor.

2. Use [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) to determine the copending application reference’s prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under [35 U.S.C. 120, 121](#), or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA [35 U.S.C. 102\(e\)](#) (form paragraph 7.12.01). See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date.

3. If the claims would have been obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
4. In bracket 3, insert either --assignee-- or --inventor--.

5. In bracket 4, an appropriate explanation may be provided in support of the examiner’s position on anticipation, if necessary.

6. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using form paragraphs 8.30 and 8.32.

7. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using form paragraphs 7.13 and/or 7.14 should also be made.

¶ 7.15.02 Rejection, 35 U.S.C. 102(e), Common Assignee or Inventor(s)

Claim [1] rejected under [35 U.S.C. 102\(e\)](#) as being anticipated by [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under [35 U.S.C. 102\(e\)](#). This rejection under [35 U.S.C. 102\(e\)](#) might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under [37 CFR 1.131](#).

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date that discloses but does not claim the same invention. The

patent or patent application publication must have either a common assignee or a common inventor.

2. [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) must be applied if the reference is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**. See the Examiner Notes for form paragraph 7.12 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

3. Pre-AIPA [35 U.S.C 102\(e\)](#) (form paragraph 7.12.01) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

4. In determining the [35 U.S.C. 102\(e\)](#) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), U.S. nonprovisional applications under [35 U.S.C. 120](#) or [121](#), and international applications under [35 U.S.C. 120](#), [121](#) or [365\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29, 2000. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\)-\(d\)](#) and [365\(a\)](#).

5. If the reference is a publication of an international application (including voluntary U.S. publication under [35 U.S.C. 122](#) of the national stage or a WIPO publication) that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under [35 U.S.C. 102\(e\)](#). The reference may be applied under [35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date. See form paragraphs 7.08 and 7.09.

6. In bracket 3, insert either --assignee-- or --inventor--.

7. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.

8. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.

¶ 7.15.03 Rejection, 35 U.S.C. 102(e), No Common Assignee or Inventor(s)

Claim [1] rejected under [35 U.S.C. 102\(e\)](#) as being [2] by [3].

Examiner Note:

1. This form paragraph is used to reject over a patent or patent application publication with an earlier filing date that discloses but does not claim the same invention. The patent or patent application publication is not required to have a common assignee nor a common inventor.

2. [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 (form paragraph 7.12) must be applied if the reference is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**. See the Examiner Notes for form paragraph 7.12 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

3. Pre-AIPA [35 U.S.C 102\(e\)](#) (form paragraph 7.12.01) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

4. In determining the [35 U.S.C. 102\(e\)](#) date, consider priority/benefit claims to earlier-filed U.S. provisional applications under [35 U.S.C. 119\(e\)](#), U.S. nonprovisional applications under [35 U.S.C. 120](#) or [121](#), and international applications under [35 U.S.C. 120](#), [121](#) or [365\(c\)](#) if the subject matter used to make the rejection is appropriately supported in the relied upon earlier-filed application's disclosure (and any intermediate application(s)). A benefit claim to a U.S. patent of an earlier-filed international application, which has an international filing date prior to November 29, 2000, may only result in an effective U.S. filing date as of the date the requirements of [35 U.S.C. 371\(c\)\(1\), \(2\) and \(4\)](#) were fulfilled. Do NOT consider any priority/benefit claims to U.S. applications which are filed before an international application that has an international filing date prior to November 29,

2000. Do NOT consider foreign priority claims under [35 U.S.C. 119\(a\)-\(d\)](#) and [365\(a\)](#).

5. If the reference is a publication of an international application (including voluntary U.S. publication under [35 U.S.C. 122](#) of the national stage or a WIPO publication) that has an international filing date prior to November 29, 2000, did not designate the United States or was not published in English by WIPO, do not use this form paragraph. Such a reference is not a prior art reference under [35 U.S.C. 102\(e\)](#). The reference may be applied under [35 U.S.C. 102\(a\) or \(b\)](#) as of its publication date. See form paragraphs 7.08 and 7.09.

6. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.

7. In bracket 3, insert the prior art relied upon.

8. This form paragraph must be preceded by either of form paragraphs 7.12 or 7.12.01.

9. Patent application publications may only be used if this form paragraph was preceded by form paragraph 7.12.

¶ 7.16 *Rejection, 35 U.S.C. 102(b), Public Use or on Sale*

Claim [1] rejected under [35 U.S.C. 102\(b\)](#) based upon a public use or sale of the invention. [2]

Examiner Note:

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.09 or by form paragraph 7.103.

2. A full explanation of the evidence establishing a public use or sale must be provided in bracket 2.

¶ 7.169 *Advisory Action, Proposed Rejection of Claims, Before Appeal Brief*

For purposes of appeal, the proposed amendment(s) will be entered and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal:

Claim(s) [1] would be rejected for the reasons set forth in [2] of the final Office action mailed [3].

Examiner Note:

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.

2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (e.g., the rejection under 35 U.S.C. § [103](#) based

upon A in view of B) in the final Office action under which the claims would be rejected on appeal.

3. Repeat this form paragraph for each group of claims subject to the same rejection(s).

4. Use this form paragraph if item 7 of the Advisory Action form, PTOL-303 (Rev. 9-04 or later) has been checked to indicate that the proposed amendment(s) will be entered upon appeal.

¶ 7.17 *Rejection, 35 U.S.C. 102(c), Abandonment of Invention*

Claim [1] rejected under [35 U.S.C. 102\(c\)](#) because the invention has been abandoned. [2]

Examiner Note:

1. This form paragraph must be preceded either by form paragraph 7.07 and 7.10 or by form paragraph 7.103.

2. In bracket 2, insert a full explanation of the evidence establishing abandonment of the invention. See [MPEP § 2134](#).

¶ 7.18 *Rejection, 35 U.S.C. 102(d), Foreign Patenting*

Claim [1] rejected under [35 U.S.C. 102\(d\)](#) as being barred by applicants [2].

[3]

Examiner Note:

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.11 or by form paragraph 7.103.

2. In bracket 3, insert an explanation of this rejection which must include appropriate dates and how they make the foreign patent available under [35 U.S.C. 102\(d\)](#).

3. Refer to [MPEP § 2135](#) for applicable [35 U.S.C. 102\(d\)](#) prior art.

¶ 7.19 *Rejection, 35 U.S.C. 102(f), Applicant Not the Inventor*

Claim [1] rejected under [35 U.S.C. 102\(f\)](#) because the applicant did not invent the claimed subject matter. [2]

Examiner Note:

1. This paragraph must be preceded either by paragraphs 7.07 and 7.13 or by paragraph 7.103.

2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See [MPEP § 2137](#).

¶ 7.20 *Statement of Statutory Basis, 35 U.S.C. 103(a)*

The following is a quotation of [35 U.S.C. 103\(a\)](#) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Examiner Note:

1. The statute is not to be cited in all Office actions. It is only required in first actions on the merits employing [35 U.S.C. 103\(a\)](#) and final rejections. Where the statute is being applied, but is not cited in an action on the merits, use paragraph 7.103.
2. This form paragraph should only be used ONCE in a given Office action.
3. This form paragraph must precede form paragraphs 7.20.01 - 7.22 when this form paragraph is used to cite the statute in first actions and final rejections.

¶ 7.20.01 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Not Disqualified Under 35 U.S.C. 103(c) Because Reference Is Prior Art Under Another Subsection of 35 U.S.C. 102

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as [1] at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference [2] additionally qualifies as prior art under another subsection of [35 U.S.C. 102](#), and therefore is not disqualified as prior art under [35 U.S.C. 103\(c\)](#).

Applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention “by another,” or by antedating the applied art under [37 CFR 1.131](#).

Examiner Note:

1. This form paragraph must be included following form paragraph 7.20 in all actions containing rejections under [35 U.S.C. 103\(a\)](#) using art that is disqualified under 103(c) using 102(e), (f), or (g), but which qualifies under another section of [35 U.S.C. 102](#).
2. In brackets 1 and 2, identify the reference which is sought to be disqualified.

¶ 7.20.02 Joint Inventors, Common Ownership Presumed

This application currently names joint inventors. In considering patentability of the claims under [35 U.S.C. 103\(a\)](#), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under [37 CFR 1.56](#) to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of [35 U.S.C. 103\(c\)](#) and potential [35 U.S.C. 102\(e\), \(f\)](#) or (g) prior art under [35 U.S.C. 103\(a\)](#).

Examiner Note:

This paragraph must be used in all applications with joint inventors (unless the claims are clearly restricted to only one claimed invention, e.g., only a single claim is presented in the application).

¶ 7.20.04 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Attempted To Be Disqualified Under 35 U.S.C. 103(c) Using the Common Ownership or Assignment Provision

Applicant has attempted to disqualify reference [1] under [35 U.S.C. 103\(c\)](#) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as [2] at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under [35 U.S.C. 103\(a\)](#). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(l).

In addition, applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore not the invention “by another,” or by antedating the applied art under [37 CFR 1.131](#).

Examiner Note:

1. This form paragraph must be included in all actions containing rejections under [35 U.S.C. 103\(a\)](#) where an attempt has been made to disqualify the reference under [35 U.S.C. 103\(c\)](#), but where the applicant has not provided a proper statement indicating common ownership or assignment **at the time the invention was made**.
2. In brackets 1 and 2, identify the commonly owned applied art (e.g., patent or co-pending application).

¶ 7.20.05 103(a) Rejection Using Prior Art Under 102(e), (f), or (g) That Is Attempted To Be Disqualified Under 35

U.S.C. 103(c) Using the Joint Research Agreement Provisions

Applicant has attempted to disqualify reference [1] under [35 U.S.C. 103\(c\)](#) by showing that the invention was subject to a joint research agreement at the time this invention was made. However, applicant has failed to [2]. Applicant must file the missing requirements in order to properly disqualify the reference under [35 U.S.C. 103\(c\)](#). See [37 CFR 1.71\(g\)](#) and [1.104\(c\)](#) and [MPEP § 706.02\(d\)](#).

In addition, applicant may overcome the applied art either by a showing under [37 CFR 1.132](#) that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention “by another,” or by antedating the applied art under [37 CFR 1.131](#).

Examiner Note:

1. This form paragraph must be included in all actions containing rejections under [35 U.S.C. 103\(a\)](#) where an attempt has been made to disqualify the reference under [35 U.S.C. 103\(c\)](#) using the joint research agreement provisions but the disqualification attempt is ineffective.

2. In bracket 1, identify the reference which is sought to be disqualified under [35 U.S.C. 103\(c\)](#).

3. In bracket 2, identify the reason(s) why the disqualification attempt is ineffective. The reason(s) could be noncompliance with the statutory requirements of [35 U.S.C. 103\(c\)](#) or rule requirements relating to the CREATE Act, such as failure to submit the required statement or failure to amend the specification to include the names of the parties to the joint research agreement. See [37 CFR 1.104\(c\)\(4\)](#).

¶ 7.204 Petition Under 37 CFR 1.59(b) To Expunge Information: Decision Held in Abeyance

In re Application of [1]: Appl. No.: [2]: RESPONSE TO PETITION Filed: [3]: UNDER [37 CFR 1.59](#) For: [4]:

This is a response to the petition under [37 CFR 1.59\(b\)](#), filed [5], to expunge information from the above identified application.

The decision on the petition will be held in abeyance until allowance of the application or mailing of an *Ex parte Quayle* action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record. Petitioner states either: (A) 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; or (B)

that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in [37 CFR 1.17\(g\)](#) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. 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 decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be “material.” If the information is not considered by the examiner to be material, the information will be removed from the official file.

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement. 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](#). Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, 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).

3. This decision is printed with the USPTO 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. Mail with PTO-90C cover sheet.

¶ 7.205 Petition Under 37 CFR 1.59(b) To Expunge Information Granted

In re Application of [1]: Appl. No.: [2]: DECISION ON PETITION Filed: [3]: UNDER [37 CFR 1.59](#) For: [4]:

This is a decision on the petition under [37 CFR 1.59\(b\)](#), filed [5], to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record. Petitioner states that either (A) 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; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in [37 CFR 1.17\(g\)](#) has been paid.

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 issues on the above-identified application.

The expunged material has been removed from the official file.

Enclosure: [8]

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement. Furthermore, a petition to expunge may not be granted unless the application has been allowed or is abandoned, or an *Ex Parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement. 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](#). Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, 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).

3. This decision is printed with the USPTO letterhead.

4. In brackets 6 and 8, clearly identify the expunged document. For example, refer to the author and title of the document.

5. Mail with PTO-90C cover sheet.

¶ 7.206 Petition Under 37 CFR 1.59(b) To Expunge Information Dismissed

In re Application of [1]: Appl. No.: [2]: DECISION ON PETITION Filed: [3]: UNDER [37 CFR 1.59](#) For: [4]:

This is a decision on the petition under [37 CFR 1.59\(b\)](#), filed [5], to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled [6], filed [7], be expunged from the record.

“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. A Technology Center Director decides this petition only if the information was submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement. However, the petition should not be granted until the application has been allowed or abandoned, or an *Ex parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted either pursuant to [MPEP § 724.02](#) or in an information disclosure statement. 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](#). Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, 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).

3. This decision is printed with the USPTO 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. This form paragraph must be followed with one or more of form paragraphs 7.207 through 7.213.

¶ *7.207 Petition To Expunge, Conclusion, Lacks Fee*

the petition was not accompanied by the required fee under 37 CFR 1.17(g).

¶ *7.208 Petition to Expunge, Conclusion, Material to Determination of Patentability*

the information that petitioner requests to expunge is considered to be material to the determination of patentability because [1].

Examiner Note:

In bracket 1, provide an explanation of basis for conclusion that information is material to the determination of patentability.

¶ *7.209 Petition To Expunge, Conclusion, Information Made Public*

the information has been made public. [1]

Examiner Note:

In bracket 1, provide explanation of basis for conclusion that information has been made public.

¶ *7.21 Rejection, 35 U.S.C. 103(a)*

Claim [1] rejected under [35 U.S.C. 103\(a\)](#) as being unpatentable over [2].

Examiner Note:

1. This paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.
3. If the rejection relies upon prior art under [35 U.S.C. 102\(e\)](#), use [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA [35 U.S.C. 102\(e\)](#) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international

application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under [35 U.S.C. 120, 121](#) or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's [35 U.S.C. 102\(e\)](#) date.

4. If the applicability of this rejection (e.g., the availability of the prior art as a reference under [35 U.S.C. 102\(a\)](#) or [35 U.S.C. 102\(b\)](#)) prevents the reference from being disqualified under [35 U.S.C. 103\(c\)](#), form paragraph 7.20.01 must follow this form paragraph.

5. If this rejection is a provisional [35 U.S.C. 103\(a\)](#) rejection based upon a copending application that would comprise prior art under [35 U.S.C. 102\(e\)](#) if patented or published, use form paragraph 7.21.01 instead of this paragraph.

¶ *7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] provisionally rejected under [35 U.S.C. 103\(a\)](#) as being obvious over copending Application No. [2] which has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under [35 U.S.C. 102\(e\)](#) if published or patented. This provisional rejection under [35 U.S.C. 103\(a\)](#) is based upon a presumption of future publication or patenting of the conflicting application. [4]

This provisional rejection might be overcome either by a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under [37 CFR 1.131](#). This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § [706.02\(1\)\(1\)](#) and § [706.02\(1\)\(2\)](#).

Examiner Note:

1. This paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications pending on or after December 10, 2004 when the copending application is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection. See MPEP § [706.02\(1\)\(3\)](#).

2. Use [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act (AIPA) to determine the copending application reference's prior art date, unless the copending application reference is based directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. If the copending application reference is either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000, or a continuing application claiming benefit under [35 U.S.C. 120](#), [121](#), or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000, use pre-AIPA [35 U.S.C. 102\(e\)](#) to determine the copending application reference's prior art date. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date.

3. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.
4. In bracket 3, insert either --assignee-- or --inventor--.
5. In bracket 4, insert explanation of obviousness.
6. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using paragraph 8.33 and 8.37.
7. If evidence indicates that the copending application is also prior art under [35 U.S.C. 102\(f\) or \(g\)](#) and the copending application has not been disqualified as prior art in a [35 U.S.C. 103\(a\)](#) rejection pursuant to [35 U.S.C. 103\(c\)](#), a rejection should additionally be made under [35 U.S.C. 103\(a\)](#) using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

¶ 7.21.02 *Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor*

Claim [1] rejected under [35 U.S.C. 103\(a\)](#) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under [35 U.S.C. 102\(e\)](#). This rejection under [35 U.S.C. 103\(a\)](#) might be overcome by: (1) a showing under [37 CFR 1.132](#) that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under [37 CFR 1.131](#); or (3) an oath or declaration under [37 CFR 1.130](#) stating that the application and reference are currently

owned by the same party and that the inventor named in the application is the prior inventor under [35 U.S.C. 104](#), together with a terminal disclaimer in accordance with [37 CFR 1.321\(e\)](#). This rejection might also be overcome by showing that the reference is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a rejection under [35 U.S.C. 103\(a\)](#). See MPEP § [706.02\(1\)\(1\)](#) and § [706.02\(1\)\(2\)](#). [4]

Examiner Note:

1. This paragraph is used to reject over a reference (patent or published application) with an earlier filing date that discloses the claimed invention, and that only qualifies as prior art under [35 U.S.C. 102\(e\)](#). If the reference qualifies as prior art under [35 U.S.C. 102\(a\)](#) or (b), then this form paragraph should not be used (form paragraph 7.21 should be used instead). The reference must have either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications when the reference is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a 35 U.S.C. 103(a) rejection. See [MPEP § 706.02\(1\)\(3\)](#).

2. [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act of 1999 (AIPA) must be applied if the reference is one of the following:

- a. a U.S. patent or a publication of a U.S. application for patent filed under [35 U.S.C. 111\(a\)](#);
- b. a U.S. patent issued directly or indirectly from, or a U.S. or WIPO publication of, an international application if the international application has **an international filing date on or after November 29, 2000**. See the Examiner Notes for form paragraph 7.12 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

3. Pre-AIPA 35 U.S.C 102(e) must be applied if the reference is a U.S. patent issued directly, or indirectly, from an international application filed prior to November 29, 2000. See the Examiner Notes for form paragraph 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date of the reference.

4. In bracket 3, insert either --assignee-- or --inventor--.
5. In bracket 4, insert explanation of obviousness.

¶ 7.211 *Petition to Expunge, Conclusion, No Clear Statement That Information is Trade Secret, Proprietary, and/or Subject to Protective Order, or that Submission Was Unintentional*

the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who

submitted the information or to the party in interest on whose behalf the information was submitted. [1]

Examiner Note:

In bracket 1, indicate whether any such statement was provided and, if so, explain why such statement is not clear.

¶ 7.212 *Petition to Expunge, Conclusion, No Clear Identification of Information to be Expunged*

the petition does not clearly identify the information requested to be expunged. [1]

Examiner Note:

In bracket 1, explain why the identification of the information requested to be expunged is not clear.

¶ 7.213 *Petition to Expunge, Conclusion, No Statement That Petition Is Submitted By, or on Behalf of, Party in Interest Who Originally Submitted the Information*

the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

¶ 7.214 *Papers Not Returned, Pro Se*

Papers in an application that has received a filing date pursuant to 37 CFR 1.53 ordinarily will not be returned. If applicant has not preserved copies of the papers, the Office will furnish copies at applicant's expense. See 37 CFR 1.19 for a list of the current fees. See MPEP § 724.05 for information pertaining to petitions to expunge information.

¶ 7.22 *Rejection, 35 U.S.C. 103(a), Further in View Of*

Claim [1] rejected under 35 U.S.C. 103(a) as being unpatentable over [2] as applied to claim [3] above, and further in view of [4].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.21.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.
3. If the rejection relies upon prior art under 35 U.S.C. 102(e), use 35 U.S.C. 102(e) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international

application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121 or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

¶ 7.23 *Graham v. Deere, Test for Obviousness*

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Examiner Note:

This form paragraph may be used, if appropriate, in response to an argument of the use of *Graham v. Deere*.

¶ 7.27 *Rejection, 35 U.S.C. 102 or 103(a)*

Claim [1] rejected under 35 U.S.C. 102([2]) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over [3].

Examiner Note:

1. This form paragraph is NOT intended to be commonly used as a substitute for a rejection under 35 U.S.C. 102. In other words, a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103(a) should be made whenever possible using appropriate form paragraphs 7.15 to 7.19, 7.21 and 7.22. Examples of circumstances where this paragraph may be used are as follows:
 - a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP §§ 2111- 2116.01 for guidelines on claim interpretation.
 - b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious

the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See [MPEP §§ 2112-2112.02](#).

c. When the reference teaches a small genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under [35 U.S.C. 102](#). See [MPEP §§ 2131.02](#) and [2144.08](#) for more information on anticipation and obviousness of species by a disclosure of a genus.

d. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also [MPEP § 2113](#).

e. When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent to the claimed element and therefore anticipatory, or whether the prior art element is an obvious variant of the claimed element. See [MPEP §§ 2183-2184](#).

f. When the ranges disclosed in the reference and claimed by applicant overlap in scope but the reference does not contain a specific example within the claimed range. See the concurring opinion in *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). See [MPEP § 2131.03](#).

2. If the interpretation of the claim(s) renders the claim(s) indefinite, a rejection under [35 U.S.C. 112](#), 2nd paragraph, may be appropriate.

3. In bracket 2, insert the appropriate paragraph letter(s) in parenthesis.

4. A full explanation should follow this form paragraph.

5. If the rejection relies upon prior art under [35 U.S.C. 102\(e\)](#), use [35 U.S.C. 102\(e\)](#) as amended by the American Inventors Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. In other words, use pre-AIPA [35 U.S.C. 102\(e\)](#) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under [35](#)

[U.S.C. 120](#), [121](#) or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's [35 U.S.C. 102\(e\)](#) date.

6. This form paragraph must be preceded by 7.07, one or more of form paragraphs 7.08 to 7.14 as appropriate, and form paragraph 7.20 or form paragraph 7.103.

¶ 7.28 *Objection to New Matter Added to Specification*

The amendment filed [1] is objected to under [35 U.S.C. 132\(a\)](#) because it introduces new matter into the disclosure. [35 U.S.C. 132\(a\)](#) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: [2].

Applicant is required to cancel the new matter in the reply to this Office action.

Examiner Note:

1. This form paragraph is not to be used in reissue applications; use form paragraph 14.22.01 instead.

2. In bracket 2, identify the new matter by page and the line numbers and/or drawing figures and provide an appropriate explanation of your position. This explanation should address any statement by applicant to support the position that the subject matter is described in the specification as filed. It should further include any unresolved questions which raise a doubt as to the possession of the claimed invention at the time of filing.

3. If new matter is added to the claims, or affects the claims, a rejection under [35 U.S.C. 112](#), first paragraph, using form paragraph 7.31.01 should also be made. If new matter is added only to a claim, an objection using this paragraph should not be made, but the claim should be rejected using form paragraph 7.31.01. As to any other appropriate prior art or [35 U.S.C. 112](#) rejection, the new matter must be considered as part of the claimed subject matter and cannot be ignored.

¶ 7.29 *Disclosure Objected to, Minor Informalities*

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is required.

Examiner Note:

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology, numbering of elements, etc., which should be corrected. See form paragraphs 6.28 to 6.32 for specific informalities.

¶ 7.29.01 *Claims Objected to, Minor Informalities*

Claim[1] objected to because of the following informalities: [2]. Appropriate correction is required.

Examiner Note:

1. Use this form paragraph to point out minor informalities such as spelling errors, inconsistent terminology, etc., which should be corrected.
2. If the informalities render the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under [35 U.S.C. 112](#), second paragraph.

¶ 7.29.02 *Claims Objected to, Reference Characters Not Enclosed Within Parentheses*

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See [MPEP § 608.01\(m\)](#).

Examiner Note:

1. Use of this paragraph is optional. You may instead choose to correct the error yourself at time of allowance by informal examiner's amendment.
2. If the lack of parentheses renders the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under [35 U.S.C. 112](#), second paragraph.

¶ 7.29.03 *Claims Objected to, Spacing of Lines*

The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See [37 CFR 1.52\(b\)](#).

¶ 7.29.04 *Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code*

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See [MPEP § 608.01](#).

Examiner Note:

1. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "<>" and "http://" followed by a URL address. Nucleotide and/or amino acid sequence data placed between the symbols "<>" are not considered to be hyperlinks and/or browser-executable code.

2. If the application attempts to incorporate essential or nonessential subject matter into the patent application by reference to the contents of the site to which a hyperlink and/or other form of browser-executable code is directed, use form paragraph 6.19 or 6.19.01 instead. See also [MPEP § 608.01\(p\)](#).

3. The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO/SB/08B where the electronic document is identified by reference to a URL.

4. Examiners should not object to hyperlinks where the hyperlinks and/or browser-executable codes themselves (rather than the contents of the site to which the hyperlinks are directed) are necessary to be included in the patent application in order to meet the requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have those hyperlinks be active links.

¶ 7.30.01 *Statement of Statutory Basis, 35 U.S.C. 112, First Paragraph*

The following is a quotation of the first paragraph of [35 U.S.C. 112](#):

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Form paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

¶ 7.30.02 *Statement of Statutory Basis, 35 U.S.C. 112, Second Paragraph*

The following is a quotation of the second paragraph of [35 U.S.C. 112](#):

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Examiner Note:

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

¶ 7.31.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Description Requirement, Including New Matter Situations

Claim [1] rejected under [35 U.S.C. 112](#), first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, identify (by suitable reference to page and line numbers and/or drawing figures) the subject matter not properly described in the application as filed, and provide an explanation of your position. The explanation should include any questions the examiner asked which were not satisfactorily resolved and consequently raise doubt as to possession of the claimed invention at the time of filing.

¶ 7.31.02 Rejection, 35 U.S.C. 112, 1st Paragraph, Enablement

Claim [1] rejected under [35 U.S.C. 112](#), first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. If the problem is one of scope, form paragraph 7.31.03 should be used.
3. In bracket 2, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § [2164.01\(a\)](#) and § [2164.04](#). The explanation should include any questions the examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.

4. Where an essential component or step of the invention is not recited in the claims, use form paragraph 7.33.01.
- ¶ 7.31.03 Rejection, 35 U.S.C. 112, 1st Paragraph: Scope of Enablement

Claim [1] rejected under [35 U.S.C. 112](#), first paragraph, because the specification, while being enabling for [2], does not reasonably provide enablement for [3]. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to [4] the invention commensurate in scope with these claims. [5]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. This form paragraph is to be used when the scope of the claims is not commensurate with the scope of the enabling disclosure.
3. In bracket 2, identify the claimed subject matter for which the specification is enabling. This may be by reference to specific portions of the specification.
4. In bracket 3, identify aspect(s) of the claim(s) for which the specification is not enabling.
5. In bracket 4, fill in only the appropriate portion of the statute, i.e., one of the following: --make--, --use--, or --make and use--.
6. In bracket 5, identify the claimed subject matter for which the specification is not enabling. Also explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § [2164.01\(a\)](#) and § [2164.04](#). The explanation should include any questions posed by the examiner which were not satisfactorily resolved and consequently raise doubt as to enablement.

¶ 7.31.04 Rejection, 35 U.S.C. 112, 1st Paragraph: Best Mode Requirement

Claim [1] rejected under [35 U.S.C. 112](#), first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon [2].

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, insert the basis for holding that the best mode has been concealed, e.g., the quality of applicant's disclosure is so poor as to effectively result in concealment.

3. Use of this form paragraph should be rare. See [MPEP §§ 2165- 2165.04](#).

¶ 7.33.01 *Rejection, 35 U.S.C. 112, 1st Paragraph, Essential Subject Matter Missing From Claims (Enablement)*

Claim [1] rejected under [35 U.S.C. 112](#), first paragraph, as based on a disclosure which is not enabling. [2] critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). [3]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, recite the subject matter omitted from the claims.
3. In bracket 3, give the rationale for considering the omitted subject matter critical or essential.
4. The examiner shall cite the statement, argument, date, drawing, or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims which are rejected.

¶ 7.34 *Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Claim Applicant’s Invention*

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim [2] fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed [3]. In that paper, applicant has stated [4], and this statement indicates that the invention is different from what is defined in the claim(s) because [5].

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. This paragraph is to be used only where applicant has stated, somewhere other than in the application, as filed, that the invention is something different from what is defined in the claim(s).
3. In bracket 3, identify the submission by applicant (which is not the application, as filed, but may be in the remarks by applicant, in the brief, in an affidavit, etc.) by the date the paper was filed in the USPTO.
4. In bracket 4, set forth what applicant has stated in the submission to indicate a different invention.
5. In bracket 5, explain how the statement indicates an invention other than what is being claimed.

¶ 7.34.01 *Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)*

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. This form paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.11, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See [MPEP §§ 2171 - 2174](#) for guidance. See also form paragraph 7.34.15 for *pro se* applicants.

¶ 7.34.02 *Terminology Used Inconsistent with Accepted Meaning*

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “[1]” in claim [2] is used by the claim to mean “[3]”, while the accepted meaning is “[4].” The term is indefinite because the specification does not clearly redefine the term.

Examiner Note:

1. In bracket 3, point out the meaning that is assigned to the term by applicant’s claims, taking into account the entire disclosure.
2. In bracket 4, point out the accepted meaning of the term. Support for the examiner’s stated accepted meaning should be provided through the citation of an appropriate reference source, e.g., textbook or dictionary. See [MPEP § 2173.05\(a\)](#).
3. This paragraph must be preceded by form paragraph 7.34.01.

4. This paragraph should only be used where the specification does not clearly redefine the claim term at issue.

¶ 7.34.03 *Relative Term - Term of Degree Rendering Claim Indefinite*

The term “[1]” in claim [2] is a relative term which renders the claim indefinite. The term “[1]” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. [3]

Examiner Note:

1. In bracket 3, explain which parameter, quantity, or other limitation in the claim has been rendered indefinite by the use of the term appearing in bracket 1.
2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.04 *Broader Range/Limitation And Narrow Range/Limitation in Same Claim*

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See [MPEP § 2173.05\(c\)](#). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim [1] recites the broad recitation [2], and the claim also recites [3] which is the narrower statement of the range/limitation.

Examiner Note:

1. In bracket 2, insert the broader range/limitation and where it appears in the claim; in bracket 3, insert the narrow range/limitation and where it appears. This form paragraph may be modified to fit other instances of indefiniteness in the claims.
2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.05 *Lack of Antecedent Basis in the Claims*

Claim [1] recites the limitation [2] in [3]. There is insufficient antecedent basis for this limitation in the claim.

Examiner Note:

1. In bracket 2, insert the limitation which lacks antecedent basis, for example --said lever-- or --the lever--.
2. In bracket 3, identify where in the claim(s) the limitation appears, for example, --line 3--, --the 3rd paragraph of the claim--, --the last 2 lines of the claim--, etc.
3. This form paragraph should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate. It must be preceded by form paragraph 7.34.01.

¶ 7.34.06 *Use Claims*

Claim [1] provides for the use of [2], but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim [3] is rejected under [35 U.S.C. 101](#) because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under [35 U.S.C. 101](#). See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Examiner Note:

1. In bracket 2, insert what is being used. For example, insert --the monoclonal antibodies of claim 4--, where the claim recites “a method for using monoclonal antibodies of claim 4 to purify interferon.”
2. See [MPEP § 2173.05\(q\)](#).
3. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.07 *Claims Are a Literal Translation*

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.08 *Indefinite Claim Language: “For Example”*

Regarding claim [1], the phrase “for example” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See [MPEP § 2173.05\(d\)](#).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.09 *Indefinite Claim Language: “Or The Like”*

Regarding claim [1], the phrase “or the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable. See [MPEP § 2173.05\(d\)](#).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.10 *Indefinite Claim Language: “Such As”*

Regarding claim [1], the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See [MPEP § 2173.05\(d\)](#).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.11 *Modifier of “Means” Lacks Function*

Regarding claim [1], the word “means” is preceded by the word(s) “[2]” in an attempt to use a “means” clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding “means,” it is impossible to determine the equivalents of the element, as required by [35 U.S.C. 112](#), sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Examiner Note:

1. It is necessary for the words which precede “means” to convey a function to be performed. For example, the phrase “latch means” is definite because the word “latch” conveys the function “latching.” In general, if the phrase can be restated as “means for _____,” and it still makes sense, it is definite. In the above example, “latch means” can be restated as “means for latching.” This is clearly definite. However, if “conduit means” is restated as “means for conduiting,” the phrase makes no sense because the word “conduit” has no functional connotation, and the phrase is indefinite.

2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.12 *Essential Steps Omitted*

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See [MPEP § 2172.01](#). The omitted steps are: [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the steps omitted from the claims.
3. Give the rationale for considering the omitted steps critical or essential.

¶ 7.34.13 *Essential Elements Omitted*

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See [MPEP § 2172.01](#). The omitted elements are: [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the elements omitted from the claims.
3. Give the rationale for considering the omitted elements critical or essential.

¶ 7.34.14 *Essential Cooperative Relationships Omitted*

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See [MPEP § 2172.01](#). The omitted structural cooperative relationships are: [2]

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the structural cooperative relationships of elements omitted from the claims.
3. Give the rationale for considering the omitted structural cooperative relationships of elements being critical or essential.

¶ 7.34.15 *Rejection Under 35 U.S.C. 112, Pro Se*

Claim [1] rejected as failing to define the invention in the manner required by 35 U.S.C. [112](#), second paragraph.

The claim(s) are narrative in form and replete with indefinite language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

¶ 7.34.16 *Rejections Under 35 U.S.C. 112, Second Paragraph, Unclear Whether the Recited Structure, Material, or Acts in the Claim Preclude Application of 35 U.S.C. 112, Sixth Paragraph*

The claim limitation “[1]” uses the phrase “means for” or “step for” or a non-structural term coupled with functional language, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function because [2].

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant may amend the claim so that the phrase “means for” or “step for” or the non-structural term is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function, or may present a sufficient showing that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant may amend the claim so that it will clearly not invoke 35 U.S.C. 112, sixth paragraph, or present a sufficient showing that the claim recites sufficient structure, material, or acts for performing the claimed function to preclude application of 35 U.S.C. 112, sixth paragraph.

Examiner Note:

1. In bracket 1, recite the claim limitation that causes the claim to be rejected under 35 U.S.C. 112, second paragraph.
2. In bracket 2, explain why it is unclear whether the claim limitation invokes 35 U.S.C. 112, sixth paragraph (e.g., why it is unclear whether the limitation recites sufficient structure, material, or acts to preclude the application of 35 U.S.C. 112, sixth paragraph.)
3. This form paragraph may be used when the phrase “means for” (or a non-structural term without any structural modifier) or “step for” coupled with functional language is used in the claim limitation and it is unclear to one of ordinary skill in the art whether the recited structure, material, or acts in the claim are sufficient for performing the claimed function.

4. This form paragraph must be preceded by form paragraphs 7.30.02 and 7.34.01.

¶ 7.34.17 *Rejections Under 35 U.S.C. 112, 2nd Paragraph, Unclear Whether Claim Limitation Is Invoking 35 U.S.C. 112, Sixth Paragraph, the Phrase “Means for” or “Step for” Is Not Used*

Applicant asserts that the claim element “[1]” is a limitation that invokes 35 U.S.C. 112, sixth paragraph. However, it is unclear whether the claim element invokes 35 U.S.C. 112, sixth paragraph, because [2]. If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant may:

- (a) Amend the claim to include the phrase “means for” or “step for”. The phrase “means for” or “step for” must be modified by functional language, and the phrase or term must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

- (b) Present a sufficient showing that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function to preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

Examiner Note:

1. This form paragraph may be used in response to an applicant’s reply in which applicant asserted that a claim limitation is invoking 35 U.S.C. 112, sixth paragraph, even though the phrase “means for” or “step for” is not used in the claim limitation. See MPEP § 706.07(a) for guidance on when the second action may be made final.
2. In bracket 1, recite the claim limitation that causes the claim to be rejected under 35 U.S.C. 112, second paragraph.
3. In bracket 2, explain why it is unclear whether the claim limitation invokes 35 U.S.C. 112, sixth paragraph. For example, it is unclear whether the claim limitation is modified by sufficient structure for performing the claimed function or it is unclear whether the corresponding structure is sufficiently disclosed in the written description of the specification.
4. This form paragraph must be preceded by form paragraphs 7.30.02 and 7.34.01.

¶ 7.34.18 *Rejections Under 35 U.S.C. 112, 2nd Paragraph, No Disclosure or Insufficient Disclosure of the Structure, Material, or Acts for Performing the Function Recited in a Claim Limitation Invoking 35 U.S.C. 112, Sixth Paragraph*

Claim element “[1]” is a limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. [2]

Applicant may:

- (a) Amend the claim so that the claim limitation will no longer be interpreted as a limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function, without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant should clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Examiner Note:

- 1. In bracket 1, recite the limitation that invokes 35 U.S.C. 112, sixth paragraph.
- 2. In bracket 2, explain why there is insufficient disclosure of the corresponding structure, material, or acts for performing the claimed function.
- 3. This form paragraph must be preceded by form paragraphs 7.30.02 and 7.34.01.

¶ 7.34.19 *Rejections Under 35 U.S.C. 112, 2nd Paragraph, Fails To Clearly Link or Associate the Disclosed Structure, Material, or Acts to the Function Recited in a Claim Limitation Invoking 35 U.S.C. 112, Sixth Paragraph*

Claim element “[1]” is a limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description

fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. [2]

Applicant may:

- (a) Amend the claim so that the claim limitation will no longer be interpreted as a limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

- (c) State on the record where the corresponding structure, material, or acts are set forth in the written description of the specification and linked or associated to the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Examiner Note:

- 1. In bracket 1, recite the limitation that invokes 35 U.S.C. 112, sixth paragraph.
- 2. In bracket 2, explain why the written description of the specification fails to clearly link or associate the structure, material, or acts to the claimed function.
- 3. This form paragraph must be preceded by form paragraphs 7.30.02 and 7.34.01.

¶ 7.34.20 *The Specification Is Objected To; the Written Description Only Implicitly or Inherently Discloses the Structure, Material, or Acts for Performing the Function Recited in a Claim Limitation Invoking 35 U.S.C. 112, Sixth Paragraph*

Claim element “[1]” is a limitation that invokes 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant should:

- (a) Amend the claim so that the claim limitation will no longer be interpreted as a limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts

to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

Examiner Note:

In bracket 1, recite the limitation that invokes 35 U.S.C. 112, sixth paragraph.

¶ 7.34.21 Claim Limitation Interpreted under 35 U.S.C. 112, Sixth Paragraph

Claim limitation “[1]” has been interpreted under 35 U.S.C. 112, sixth paragraph, because it uses a non-structural term “[2]” coupled with functional language “[3]” without reciting sufficient structure to achieve the function. Furthermore, the non-structural term is not preceded by a structural modifier. [4].

Since this claim limitation invokes 35 U.S.C. 112, sixth paragraph, claim [5] interpreted to cover the corresponding structure described in the specification that achieves the claimed function, and equivalents thereof.

A review of the specification shows that the following appears to be the corresponding structure described in the specification for the 35 U.S.C. 112, sixth paragraph limitation: [6].

If applicant wishes to provide further explanation or dispute the examiner’s interpretation of the corresponding structure, applicant must identify the corresponding structure with reference to the specification by page and line number, and to the drawing, if any, by reference characters in response to this Office action.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant may amend the claim so that it will clearly not invoke 35 U.S.C. 112, sixth paragraph, or present a sufficient showing that the claim recites sufficient structure, material, or acts for performing the claimed function to preclude application of 35 U.S.C. 112, sixth paragraph.

For more information, see *Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*, 76 FR 7162, 7167 (Feb. 9, 2011).

Examiner Note:

1. In bracket 1, recite the claim limitation that has been interpreted under 35 U.S.C. 112, sixth paragraph.

2. In bracket 2, recite the non-structural term that is merely a substitute for the term “means for.”
3. In bracket 3, recite the functional language.
4. In bracket 4, provide an explanation, if appropriate, why the non-structural term is not recognized as the name of a structure but is merely a substitute for the term “means for.”
5. In bracket 5, recite the claim number(s) of the claim(s) that contains/contain the claim limitation.
6. In bracket 6, recite the corresponding structure with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

¶ 7.35 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point Out And Distinctly Claim - Omnibus Claim

Claim [1] rejected under [35 U.S.C. 112](#), second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Examiner Note:

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. Use this paragraph to reject an “omnibus” type claim. No further explanation is necessary.
3. See [MPEP § 1302.04\(b\)](#) for cancellation of such a claim by examiner’s amendment upon allowance.
4. An example of an omnibus claim is: “A device substantially as shown and described.”

¶ 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claim [1] contains the trademark/trade name [2]. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of [35 U.S.C. 112](#), second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe [3] and, accordingly, the identification/description is indefinite.

Examiner Note:

1. In bracket 2, insert the trademark/trade name and where it is used in the claim.

2. In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.

¶ 7.36 *Statement of Statutory Basis, 35 U.S.C. 112, Fourth Paragraph*

The following is a quotation of the fourth paragraph of [35 U.S.C. 112](#):

Subject to the [fifth paragraph of 35 U.S.C. 112], a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Examiner Note:

1. The statute is no longer being recited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.

2. Form paragraph 7.36 is to be used ONLY ONCE in a given Office action.

¶ 7.36.01 *Rejection under 35 U.S.C. 112, 4th Paragraph, Improper Dependent Claim*

Claim [1] rejected under [35 U.S.C. 112, 4th paragraph](#), as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends. [2]. Applicant may cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, rewrite the claim(s) in independent form, or present a sufficient showing that the dependent claim(s) complies with the statutory requirements.

Examiner Note:

1. In bracket 2, insert an explanation of what is in the claim and why the claim does not contain a further limitation, or identify which limitation of the claim upon which it depends is missing.

2. The U.S. Court of Appeals for the Federal Circuit indicated that although the requirements of [35 U.S.C. 112, 4th paragraph](#), are related to matters of form, non-compliance with [35 U.S.C. 112, 4th paragraph](#), renders the claim unpatentable just as non-compliance with other paragraphs of 35 U.S.C. 112 would. See *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284, 1291-92, 79 USPQ2d 1583, 1589-90 (Fed. Cir. 2006) (holding a dependent claim in a patent invalid for failure to comply with [35 U.S.C. 112, 4th paragraph](#)).

Therefore, if a dependent claim does not comply with

the requirements of [35 U.S.C. 112, 4th paragraph](#), the dependent claim should be rejected under [35 U.S.C. 112, 4th paragraph](#), as unpatentable rather than objecting to the claim. See also [MPEP § 608.01\(n\), subsection III, "Infringement Test"](#) for dependent claims.

3. This form paragraph must be preceded by form paragraph 7.36.

¶ 7.37 *Arguments Are Not Persuasive*

Applicant's arguments filed [1] have been fully considered but they are not persuasive. [2]

Examiner Note:

1. The examiner must address all arguments which have not already been responded to in the statement of the rejection.

2. In bracket 2, provide explanation as to non-persuasiveness.

¶ 7.37.01 *Unpersuasive Argument: Age of Reference(s)*

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.02 *Unpersuasive Argument: Bodily Incorporation*

In response to applicant's argument that [1], the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of bodily incorporation.

2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.03 *Unpersuasive Argument: Hindsight Reasoning*

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.04 *Unpersuasive Argument: No Teaching, Suggestion, or Motivation To Combine*

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, [1].

Examiner Note:

1. In bracket 1, explain where the teaching, suggestion, or motivation for the rejection is found, either in the references, or in the knowledge generally available to one of ordinary skill in the art.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.05 *Unpersuasive Argument: Nonanalogous Art*

In response to applicant's argument that [1] is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, [2].

Examiner Note:

1. In bracket 1, enter the name of the reference which applicant alleges is nonanalogous.
2. In bracket 2, explain why the reference is analogous art.
3. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.06 *Unpersuasive Argument: Number of References*

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.07 *Unpersuasive Argument: Applicant Obtains Result Not Contemplated by Prior Art*

In response to applicant's argument that [1], the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of results not contemplated by the prior art.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.08 *Unpersuasive Argument: Arguing Limitations Which Are Not Claimed*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., [1]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner Note:

1. In bracket 1, recite the features upon which applicant relies, but which are not recited in the claim(s).
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.09 *Unpersuasive Argument: Intended Use*

In response to applicant's argument that [1], a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Examiner Note:

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of intended use.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.10 *Unpersuasive Argument: Limitation(s) in Preamble*

In response to applicant's arguments, the recitation [1] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Examiner Note:

1. In bracket 1, briefly restate the recitation about which applicant is arguing.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.11 *Unpersuasive Argument: General Allegation of Patentability*

Applicant's arguments fail to comply with [37 CFR 1.111\(b\)](#) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.12 *Unpersuasive Argument: Novelty Not Clearly Pointed Out*

Applicant's arguments do not comply with [37 CFR 1.111\(c\)](#) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.13 *Unpersuasive Argument: Arguing Against References Individually*

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.38 *Arguments Are Moot Because of New Ground(s) of Rejection*

Applicant's arguments with respect to claim [1] have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

Examiner Note:

The examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied.

¶ 7.38.01 *Arguments Persuasive, Previous Rejection/Objection Withdrawn*

Applicant's arguments, see [1], filed [2], with respect to [3] have been fully considered and are persuasive. The [4] of [5] has been withdrawn.

Examiner Note:

1. In bracket 1, identify the page(s) and line number(s) from applicant's remarks which form the basis for withdrawing the previous rejection/objection.
2. In bracket 3, insert claim number, figure number, the specification, the abstract, etc.
3. In bracket 4, insert rejection or objection.
4. In bracket 5, insert claim number, figure number, the specification, the abstract, etc.

¶ 7.38.02 *Arguments Persuasive, New Ground(s) of Rejection*

Applicant's arguments, see [1], filed [2], with respect to the rejection(s) of claim(s) [3] under [4] have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of [5].

Examiner Note:

1. In bracket 1, identify the page(s) and line number(s) from applicant's remarks which form the basis for withdrawing the previous rejection.
2. In bracket 3, insert the claim number(s).

3. In bracket 4, insert the statutory basis for the previous rejection.

4. In bracket 5, insert the new ground(s) of rejection, e.g., different interpretation of the previously applied reference, newly found prior art reference(s), and provide an explanation of the rejection.

¶ 7.39 *Action Is Final*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. [37 CFR 1.136\(a\)](#) should not be available in a reissue litigation case and is not available in reexamination proceedings.

¶ 7.39.01 *Final Rejection, Options for Applicant, Pro Se*

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR [1.113](#) to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$[1].

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a

showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR [1.113](#) to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR [1.136\(a\)](#) or (b), the application will become abandoned.

Examiner Note:

The form paragraph must be preceded by any one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.42.03, or 7.42.09.

¶ 7.40 *Action Is Final, Necessitated by Amendment*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See [MPEP § 706.07\(a\)](#). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. [37 CFR 1.136\(a\)](#) should not be available in a reissue litigation case and is not available in reexamination proceedings.

¶ 7.40.01 *Action Is Final, Necessitated by IDS With Fee*

Applicant's submission of an information disclosure statement under [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#) on [1] prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See [MPEP §](#)

609.04(b). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should **not** be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.
2. In bracket 1, insert the filing date of the information disclosure statement containing the identification of the item of information used in the new ground of rejection.

¶ 7.40.02 *Action Is Final, Necessitated by Invoking the Joint Research Agreement Prior Art Exclusion Under 35 U.S.C. 103(c)*

Applicant's submission of the requirements for the joint research agreement prior art exclusion under [35 U.S.C. 103\(c\)](#) on [1] prompted the new double patenting rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See [MPEP § 706.02\(1\)\(3\)](#). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims nor based on information submitted in an information disclosure

statement filed during the period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#).

2. In bracket 1, insert the filing date of the submission of the requirements for the joint research agreement prior art exclusion under [35 U.S.C. 103\(c\)](#).

¶ 7.41 *Action Is Final, First Action*

This is a [1] of applicant's earlier Application No. [2]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See [MPEP § 706.07\(b\)](#). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. In bracket 1, insert either --continuation-- or --substitute--, as appropriate.
2. If an amendment was refused entry in the parent case on the grounds that it raised new issues or new matter, this form paragraph cannot be used. See [MPEP § 706.07\(b\)](#).
3. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP-1 or 2 months).
4. [37 CFR 1.136\(a\)](#) should not be available in a reissue litigation case and is not available in reexamination proceedings.

¶ 7.41.01 *Transitional After Final Practice, First Submission (37 CFR 1.129(a))*

This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under [35 U.S.C. 120](#), 121 or 365(c), applicant, under [37 CFR 1.129\(a\)](#), is entitled to have a first submission entered and considered on the

merits if, prior to abandonment, the submission and the fee set forth in [37 CFR 1.17\(r\)](#) are filed prior to the filing of an appeal brief under [37 CFR 41.37](#). Upon the timely filing of a first submission and the appropriate fee of \$[1] for a [2] entity under [37 CFR 1.17\(r\)](#), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in [37 CFR 41.20\(b\)](#) were filed prior to or with the payment of the fee set forth in [37 CFR 1.17\(r\)](#), the payment of the fee set forth in [37 CFR 1.17\(r\)](#) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under [37 CFR 1.129\(a\)](#). In view of [35 U.S.C. 132](#), no amendment considered as a result of payment of the fee set forth in [37 CFR 1.17\(r\)](#) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under [37 CFR 1.17\(r\)](#).

Examiner Note:

1. This form paragraph may follow any of form paragraphs 7.39 - 7.41 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under [35 U.S.C. 120](#), 121 or 365(c) to a previously filed application and no previous fee has been paid under [37 CFR 1.17\(r\)](#).
2. This form paragraph should NOT be used in a design or reissue application, or in a reexamination proceeding.
3. In bracket 1, insert the current fee for a large or small entity, as appropriate.
4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.

¶ 7.41.02 *Transitional After Final Practice, Second Submission (37 CFR 1.129(a))*

Since the fee set forth in [37 CFR 1.17\(r\)](#) for a first submission subsequent to a final rejection has been previously paid, applicant, under [37 CFR 1.129\(a\)](#), is entitled to have a second submission entered and considered on the merits if, prior to abandonment, the second submission and the fee set forth in [37 CFR 1.17\(r\)](#) are filed prior to the filing of an appeal brief under [37 CFR 41.37](#). Upon the timely filing of a second submission and the appropriate fee of \$[1] for a [2] entity under [37 CFR 1.17\(r\)](#), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in [37 CFR 41.20\(b\)](#) were filed prior to or with the payment of the fee set forth in [37 CFR 1.17\(r\)](#), the payment of the fee set forth in [37 CFR 1.17\(r\)](#) by

applicant will be construed as a request to dismiss the appeal and to continue prosecution under [37 CFR 1.129\(a\)](#). In view of [35 U.S.C. 132](#), no amendment considered as a result of payment of the fee set forth in [37 CFR 1.17\(r\)](#) may introduce new matter into the disclosure of the application.

Examiner Note:

1. This form paragraph is to follow any of form paragraphs 7.39-7.41 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under [35 U.S.C. 120](#), 121 or 365(c) to a previously filed application and a first submission fee has been previously paid under [37 CFR 1.17\(r\)](#).
2. This form paragraph should NOT be used in a design or reissue application or in a reexamination proceeding.
3. In bracket 1, insert the current fee for a large or small entity, as appropriate.
4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.
5. If the fee set forth in [37 CFR 1.17\(r\)](#) has been twice paid, the provisions of [37 CFR 1.129\(a\)](#) are no longer available.

¶ 7.41.03 *Action Is Final, First Action Following Submission Under 37 CFR 1.53(d), Continued Prosecution Application (CPA)*

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under [37 CFR 1.53\(d\)](#) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under [37 CFR 1.53\(d\)](#). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph is for a first action final rejection in a Continued Prosecution Application filed under [37 CFR 1.53\(d\)](#).
2. This form paragraph must be preceded by one of form paragraphs 2.30 or 2.35, as appropriate.

¶ 7.42 *Withdrawal of Finality of Last Office Action*

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

¶ 7.42.01 *Withdrawal of Finality of Last Office Action - Transitional Application Under 37 CFR 1.129(a)*

Since this application is eligible for the transitional procedure of [37 CFR 1.129\(a\)](#), and the fee set forth in [37 CFR 1.17\(r\)](#) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to [37 CFR 1.129\(a\)](#). Applicant's [1] submission after final filed on [2] has been entered.

Examiner Note:

Insert --first-- or --second-- in bracket 1.

¶ 7.42.02 *Nonresponsive Submission Filed Under 37 CFR 1.129(a)*

The timely submission under [37 CFR 1.129\(a\)](#) filed on [1] is not fully responsive to the prior Office action because [2]. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to [37 CFR 1.136\(a\)](#). If a notice of appeal and the appeal fee set forth in [37 CFR 41.20\(b\)](#) were filed prior to or with the payment of the fee set forth in [37 CFR 1.17\(r\)](#), the payment of the fee set forth in [37 CFR 1.17\(r\)](#) by applicant is construed as a request to dismiss the appeal and to continue prosecution under [37 CFR 1.129\(a\)](#). The appeal stands dismissed.

Examiner Note:

The reasons why the examiner considers the submission not to be fully responsive must be set forth in bracket 2.

¶ 7.42.03 *Action Is Final, First Action Following Submission Under 37 CFR 1.129(a) Filed Prior to June 8, 2005*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under [37](#)

[CFR 1.129\(a\)](#) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under [37 CFR 1.129\(a\)](#). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under [37 CFR 1.129\(a\)](#). See [MPEP § 706.07\(b\)](#). Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

Also use form paragraph 7.41.02 if this is a final rejection following a first submission under [37 CFR 1.129\(a\)](#).

¶ 7.42.031 *Action Is Final, Action Following Submission Under 37 CFR 1.129(a) Filed On or After June 8, 2005*

Under the final action practice for Office actions following a submission under [37 CFR 1.129\(a\)](#) filed on or after June 8, 2005, the next Office action following timely filing of a submission under [37 CFR 1.129\(a\)](#) will be equivalent to the next Office action following a reply to a non-final Office action. Under existing Office second action final practice, such an Office action on the merits will be made final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#). See [MPEP § 706.07\(a\)](#).

In this Office action, there is no new ground of rejection that was not necessitated by applicant's amendment of the claims or based on information submitted in an information disclosure statement filed during the period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#). Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in [37 CFR 1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date

of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to [37 CFR 1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

Also use form paragraph 7.41.02 if this is a final rejection following a first submission under [37 CFR 1.129\(a\)](#).

¶ 7.42.04 *Continued Examination under 37 CFR 1.114 after Final Rejection*

A request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR [1.114](#), and the fee set forth in 37 CFR [1.17\(e\)](#) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR [1.114](#). Applicant's submission filed on [1] has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, was filed after a final rejection.
2. In bracket 1, insert the date(s) of receipt of the submission. The submission may be a previously filed amendment(s) after final rejection and/or an amendment accompanying the RCE. As set forth in 37 CFR [1.114](#), a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If a reply to the Office action is outstanding the submission must meet the reply requirements of 37 CFR [1.111](#). Use instead form paragraph 7.42.08 if the submission does not comply with 37 CFR [1.111](#). Arguments which were previously submitted in a reply after final rejection, which were entered but not found persuasive, may be considered a submission under 37 CFR [1.114](#) if the arguments are responsive within the meaning of 37 CFR [1.111](#) to the outstanding Office action. If the last sentence of this form paragraph does not apply (e.g., the submission consists of previously entered arguments), it may be deleted or modified as necessary.
3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35

U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.05 *Continued Examination Under 37 CFR 1.114 After Allowance or Quayle Action*

A request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR [1.114](#), and the fee set forth in 37 CFR [1.17\(e\)](#) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR [1.114](#). Applicant's submission filed on [1] has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, was filed after a notice of allowance (or notice of allowability) or Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).
2. In bracket 1 insert the date(s) of receipt of the submission. As set forth in 37 CFR [1.114](#), a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability.
3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.
4. If the RCE was filed after the issue fee was paid, a petition under 37 CFR [1.313](#) to withdraw the application from issue must have been filed and *granted*.

¶ 7.42.06 *Continued Examination Under 37 CFR 1.114 After Appeal But Before A Board Decision*

A request for continued examination under 37 CFR [1.114](#) was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR [1.114](#) and the fee set forth in 37 CFR [1.17\(e\)](#) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR [1.114](#) and prosecution in this application has been reopened pursuant to 37 CFR [1.114](#). Applicant's submission filed on [1] has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, was filed after a Notice of Appeal or an appeal brief, but there has not been a decision on the appeal. Note that it is not necessary for an appeal brief to have been filed.

2. As set forth in 37 CFR [1.114](#), a submission may include an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. The submission may consist of arguments in a previously filed appeal brief or reply brief, or an incorporation of such arguments in the transmittal letter or other paper accompanying the RCE.

3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.07 *Continued Examination under 37 CFR 1.114 after Board Decision but Before Further Appeal or Civil Action*

A request for continued examination under 37 CFR [1.114](#) was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR [1.114](#) and the fee set forth in 37 CFR [1.17\(e\)](#) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR [1.114](#) and prosecution in this application has been reopened pursuant to 37 CFR [1.114](#). Applicant's submission filed on [1] has been entered.

Examiner Note:

1. Use this form paragraph if a request for continued examination (RCE), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, was timely filed after a decision by the Board of Patent Appeals and Interferences but before further appeal or civil action. Generally, the time for filing a notice of appeal to the Federal Circuit or for commencing a civil action is within two months of the Board's decision. See MPEP § [1216](#) and 37 CFR [1.304](#).

2. A Board of Patent Appeals and Interferences decision in an application has *res judicata* effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. See MPEP § [706.03\(w\)](#) and [1214.01](#).

3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.08 *Request For Continued Examination With Submission Filed Under 37 CFR 1.114 Which is Not Fully Responsive*

Receipt is acknowledged of a request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, filed on [1]. The submission, however, is not fully responsive to the prior Office action because [2]. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period for reply supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR [1.136\(a\)](#).

Examiner Note:

1. Use this form paragraph to acknowledge an RCE filed with the fee and a submission where the submission is not fully responsive to the prior Office action. This form paragraph may be used for any RCE filed with a submission which is not fully responsive, i.e., an RCE filed after final rejection, after allowance, after an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or after appeal.

2. In bracket 2, identify the reasons why the examiner considers the submission not to be fully responsive.

3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.08.AE *Request for Continued Examination With Submission Filed Under 37 CFR 1.114 Which Is Not Fully Responsive - Application Under Accelerated Examination*

Receipt is acknowledged of a request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#) and a submission, filed on [1]. The submission, however, is not fully responsive to the prior Office action because [2]. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this letter,

whichever is longer, to submit a complete reply. This shortened statutory period for reply supersedes the time period set in the prior Office action. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. Use this form paragraph to acknowledge an RCE filed with the fee and a submission where the submission is not fully responsive to the prior Office action. This form paragraph may be used for any RCE filed with a submission which is not fully responsive, i.e., an RCE filed after final rejection, after allowance, after an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or after appeal.
2. In bracket 2, identify the reasons why the examiner considers the submission not to be fully responsive.
3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.
4. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).
5. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 7.42.09 *Action Is Final, First Action Following Request for Continued Examination under 37 CFR 1.114*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR [1.114](#) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR [1.114](#). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission

under 37 CFR [1.114](#). See MPEP § [706.07\(b\)](#). Applicant is reminded of the extension of time policy as set forth in 37 CFR [1.136\(a\)](#).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR [1.136\(a\)](#) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

This form paragraph is for a first action final rejection following a Request for Continued Examination filed under 37 CFR [1.114](#).

¶ 7.42.10 *Application On Appeal, Request For Continued Examination Under 37 CFR 1.114 Without Submission/Fee; No Claims Allowed*

A request for continued examination under 37 CFR [1.114](#) was filed in this application on [1] after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR [1.114](#). The request, however, lacks the fee required by 37 CFR [1.17\(e\)](#) and/or the submission required by 37 CFR [1.114](#). Since the proceedings as to the rejected claims are considered terminated, and no claim is allowed, the application is abandoned. See MPEP [1215.01](#).

Examiner Note:

1. If a request for continued examination was filed after a Notice of Appeal or after an appeal brief, but before a decision on the appeal, and the request lacks the fee set forth in 37 CFR [1.17\(e\)](#) or a submission or both, use this form paragraph to withdraw the appeal and hold the application abandoned if there are no allowed claims.
2. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.11 *Application On Appeal, Request For Continued Examination Under 37 CFR 1.114 Without Submission; Claim Allowed*

A request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#), was filed

in this application on [1] after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR [1.114](#). The request, however, lacks the submission required by 37 CFR [1.114](#). Since the proceedings as to the rejected claims are considered terminated, the application will be passed to issue on allowed claim[2]. Claim[3] been canceled. See MPEP [§ 1215.01](#).

Examiner Note:

1. If a request for continued examination, including the fee, was filed after a Notice of Appeal or after an appeal brief but before a decision on the appeal, and the request lacks the required submission, use this form paragraph to withdraw the appeal and pass the application to issue on the allowed claims.
2. In bracket 3, insert the claim number(s) of the claim(s) which has/have been canceled followed by either --has-- or --have--. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected and therefore are to be canceled along with the rejected claims. See MPEP [§ 1215.01](#).
3. This form paragraph should be used with the mailing of a Notice of Allowability.
4. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.12 *Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Submission; Claim Allowed with Formal Matters Outstanding*

A request for continued examination under 37 CFR [1.114](#), including the fee set forth in 37 CFR [1.17\(e\)](#), was filed in this application on [1] after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR [1.114](#). The request, however, lacks the submission required by 37 CFR [1.114](#). The proceedings as to the rejected claims are considered terminated, and the application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed. See MPEP [§ 1215.01](#). Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR [1.136](#).

Examiner Note:

1. If a request for continued examination, including the fee, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the required submission, use this form paragraph to withdraw the appeal if there are allowed claims but outstanding formal matters need to be corrected.
2. In bracket 3, explain the formal matters which must be corrected.
3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.13 *Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Fee; Claim Allowed*

A request for continued examination under 37 CFR [1.114](#), including a submission, was filed in this application on [1] after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR [1.114](#). The request, however, lacks the fee required by 37 CFR [1.17\(e\)](#). Therefore, the submission has not been entered. See 37 CFR [1.116\(c\)](#). Since the proceedings as to the rejected claims are considered terminated, the application will be passed to issue on allowed claim[2]. Claim[3] been canceled. See MPEP [§ 1215.01](#).

Examiner Note:

1. If a request for continued examination, including the submission, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the required fee, use this form paragraph to withdraw the appeal and pass the application to issue on the allowed claims.
2. In bracket 3, insert the claim number(s) of the claim(s) which has/have been canceled followed by either --has-- or --have--. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected and therefore are to be canceled along with the rejected claims. See MPEP [§ 1215.01](#).
3. This form paragraph should be used with the mailing of a Notice of Allowability.
4. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.14 *Application on Appeal, Request for Continued Examination under 37 CFR 1.114 Without Fee; Claim Allowed With Formal Matters Outstanding*

A request for continued examination under 37 CFR [1.114](#), including a submission, was filed in this application on [1] after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR [1.114](#). The request, however, lacks the fee required by 37 CFR [1.17\(e\)](#). Therefore, the submission has not been entered. See 37 CFR [1.116\(c\)](#). The proceedings as to the rejected claims are considered terminated, and the application will be passed to issue on allowed claim[2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed. See MPEP § [1215.01](#). Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR [1.136](#).

Examiner Note:

1. If a request for continued examination, including a submission, was filed after a Notice of Appeal or an appeal brief but before a decision on the appeal, and the request lacks the fee required by 37 CFR [1.17\(e\)](#), use this form paragraph to withdraw the appeal if there are allowed claims but outstanding formal matters need to be corrected.
2. In bracket 3, explain the formal matters that must be corrected.
3. To be eligible for continued examination under 37 CFR [1.114](#), the application must be a utility or plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. The RCE must be filed on or after May 29, 2000.

¶ 7.42.15 *Continued Prosecution Application Treated as Continued Examination under 37 CFR 1.114*

The request for a continued prosecution application (CPA) under 37 CFR [1.53\(d\)](#) filed on [1] is acknowledged. 37 CFR [1.53\(d\)\(1\)](#) was amended to provide that a CPA must be for a design patent and the prior application of the CPA must be a design application that is complete as defined by 37 CFR [1.51\(b\)](#). See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, final rule, 68 *Fed. Reg.* 32376 (May 30, 2003), 1271 *Off. Gaz. Pat. Office* 143 (June 24, 2003). Since a CPA of this application is not permitted under 37 CFR [1.53\(d\)\(1\)](#), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR [1.114](#).

Examiner Note:

1. Use this form paragraph to advise the applicant that a CPA is being treated as an RCE.
2. Also use form paragraph 7.42.04, 7.42.05, 7.42.06, or 7.42.07 as applicable, to acknowledge entry of applicant's submission if the fee set forth in 37 CFR [1.17\(e\)](#) has been timely paid.
3. If the fee set forth in 37 CFR [1.17\(e\)](#) and/or a submission as required by 37 CFR [1.114](#) is/are missing and the application is not under appeal, a Notice of Improper Request for Continued Examination should be mailed. If the application is under appeal and the fee set forth in 37 CFR [1.17\(e\)](#) and/or submission is/are missing, this form paragraph should be followed with one of form paragraphs 7.42.10 - 7.42.14, as applicable.

¶ 7.42.16 *After Board Decision But Before Further Appeal Or Civil Action, Request for Continued Examination Under 37 CFR 1.114 Without Submission and/or Fee*

A request for continued examination (RCE) under 37 CFR [1.114](#) was filed in this application on [1] after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. The request, however, lacks the fee required by 37 CFR [1.17\(e\)](#) and/or the submission required by 37 CFR [1.114](#). Accordingly, the RCE is improper and any time period running was not tolled by the filing of the improper request.

Examiner Note:

1. This form paragraph should be used with the mailing of a Notice of Allowability or a Notice of Abandonment, as appropriate, if the time for seeking court review has passed without such review being sought, or it should be used on a PTOL-90 if time still remains.
2. This form paragraph should not be used if the application is not a utility application or a plant application filed under 35 U.S.C. [111\(a\)](#) on or after June 8, 1995, or an international application filed under 35 U.S.C. [363](#) on or after June 8, 1995. In that situation, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, should be prepared and mailed by the technical support personnel to notify applicant that continued examination does not apply to the application.
3. In general, if a submission was filed with the improper RCE in this situation, it should not be entered. An exception exists for an amendment which obviously places the application in condition for allowance. See MPEP § [1214.07](#). The examiner should also include a statement as to whether or not any such submission has been entered (e.g., "The submission filed with the improper RCE has not been entered.").

¶ 7.43 *Objection to Claims, Allowable Subject Matter*

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

¶ 7.43.01 *Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Independent Claim/Dependent Claim*

Claim [1] would be allowable if rewritten or amended to overcome the rejection(s) under [35 U.S.C. 112](#), 2nd paragraph, set forth in this Office action.

Examiner Note:

This form paragraph is to be used when (1) the noted independent claim(s) or (2) the noted dependent claim(s), which depend from an allowable claim, have been rejected solely on the basis of [35 U.S.C. 112](#), second paragraph, and would be allowable if amended to overcome the rejection.

¶ 7.43.02 *Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Dependent Claim*

Claim [1] would be allowable if rewritten to overcome the rejection(s) under [35 U.S.C. 112](#), 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner Note:

This form paragraph is to be used only when the noted dependent claim(s), which depend from a claim that is rejected based on prior art, have been rejected solely on the basis of [35 U.S.C. 112](#), second paragraph, and would be allowable if amended as indicated.

¶ 7.43.03 *Allowable Subject Matter, Formal Requirements Outstanding*

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See [37 CFR 1.111\(b\)](#) and [MPEP § 707.07\(a\)](#).

Examiner Note:

This form paragraph would be appropriate when changes (for example, drawing corrections or corrections to the specification) must be made prior to allowance.

¶ 7.43.04 *Suggestion of Allowable Drafted Claim(s), Pro Se*

The following claim [1] drafted by the examiner and considered to distinguish patentably over the art of record in this application, [2] presented to applicant for consideration:

[3].

Examiner Note:

1. If the suggested claim is not considered to be embraced by the original oath or declaration, a supplemental oath or declaration should be required under 37 CFR [1.67](#).
2. In bracket 2, insert --is-- or --are--.
3. In bracket 3, insert complete text of suggested claim(s).

¶ 7.44 *Claimed Subject Matter Not in Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See [37 CFR 1.75\(d\)\(1\)](#) and [MPEP § 608.01\(o\)](#). Correction of the following is required: [1]

¶ 7.45 *Improper Multiple Dependent Claims*

Claim [1] objected to under [37 CFR 1.75\(c\)](#) as being in improper form because a multiple dependent claim [2]. See [MPEP § 608.01\(n\)](#). Accordingly, the claim [3] not been further treated on the merits.

Examiner Note:

1. In bracket 2, insert --should refer to other claims in the alternative only--, and/or, --cannot depend from any other multiple dependent claim--.
2. Use this paragraph rather than [35 U.S.C. 112](#), fifth paragraph.
3. In bracket 3, insert --has-- or --s have--.

¶ 7.46 *Preliminary Amendment Unduly Interferes with the Preparation of an Office Action*

The preliminary amendment filed on [1] was not entered because entry of the amendment would unduly interfere with the preparation of the Office action. See 37 CFR [1.115\(b\)\(2\)](#). The examiner spent a significant amount of time on the preparation of an Office action before the preliminary amendment was received. On the date of receipt of the amendment, the examiner had completed [2].

Furthermore, entry of the preliminary amendment would require significant additional time on the preparation of the Office action. Specifically, entry of the preliminary amendment would require the examiner to [3].

A responsive reply (under 37 CFR [1.111](#) or 37 CFR [1.113](#) as appropriate) to this Office action must be timely filed to avoid abandonment.

If this is not a final Office action, applicant may wish to resubmit the amendment along with a responsive reply under 37 CFR [1.111](#) to ensure proper entry of the amendment.

Examiner Note:

1. In bracket 1, provide the date that the Office received the preliminary amendment (use the date of receipt under 37 CFR [1.6](#), not the certificate of mailing date under 37 CFR [1.8](#)).
2. In bracket 2, provide an explanation on the state of preparation of the Office action as of the receipt date of the preliminary amendment. For example, where appropriate insert --the claim analysis and the search of prior art of all pending claims-- or --the drafting of the Office action and was waiting for the supervisory patent examiner's approval--.
3. In bracket 3, provide a brief explanation of how entry of the preliminary amendment would require the examiner to spend significant additional time in the preparation of the Office action. For example, where appropriate insert --conduct prior art search in another classification area that was not previously searched and required-- or --revise the Office action extensively to address the new issues raised and the new claims added in the preliminary amendment--.

¶ *7.48 Failure To Present Claims for Interference*

Claim [1] rejected under 35 U.S.C. [2] based upon claim [3] of Patent No. [4].

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Examiner Note:

1. This form paragraph should be used only after applicant has been notified that interference proceedings must be instituted before the claims can be allowed and applicant has refused to copy the claims.
2. In bracket 2, insert --102(g)-- or --102(g)/103(a)--.
3. In bracket 4, insert the patent number, and --in view of ____-- if another reference is also relied upon. When the rejection is under [35 U.S.C. 103\(a\)](#), the examiner's basis for a finding of obviousness should be included.

Note that interferences may include obvious variants, see [MPEP Chapter 2300](#).

¶ *7.49 Rejection, Disclaimer, Failure To Appeal*

An adverse judgment against claim [1] has been entered by the Board. Claim [2] stand(s) finally disposed of for failure to reply to or appeal from the examiner's rejection of such claim(s) presented for interference within the time for appeal or civil action specified in 37 CFR [1.304](#). Adverse judgment against a claim is a final action of the Office requiring no further action by the Office to dispose of the claim permanently. See [37 CFR 41.127\(a\)\(2\)](#).

¶ *7.50 Claims Previously Allowed, Now Rejected, New Art*

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

Examiner Note:

1. In bracket 2, insert the name(s) of the newly discovered reference.
2. Any action including this form paragraph requires the signature of a Primary Examiner. [MPEP § 1004](#).

¶ *7.51 Quayle Action*

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Examiner Note:

Explain the formal matters which must be corrected in bracket 1.

¶ *7.51.AE Quayle Action - Application Under Accelerated Examination*

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935).

Since this application has been granted special status under the accelerated examination program, a shortened

statutory period for reply to this action is set to expire **ONE (1) MONTH** or **THIRTY (30) DAYS**, whichever is longer, from the mailing date of this letter. **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. Explain the formal matters which must be corrected in bracket 1.
2. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).
3. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 7.52 *Suspension of Action, Awaiting New Reference*

A reference relevant to the examination of this application may soon become available. *Ex parte* prosecution is **SUSPENDED FOR A PERIOD OF [1] MONTHS** from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.
2. The TC Director must approve all second or subsequent suspensions, see [MPEP § 1003](#).
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.

¶ 7.53 *Suspension of Action, Possible Interference*

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is **SUSPENDED FOR A PERIOD OF [1] MONTHS** from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

1. Maximum period for suspension is six months.

2. The TC Director must approve all second or subsequent suspensions, see [MPEP § 1003](#).
3. The TC Director's signature must appear on the letter granting any second or subsequent suspension.

¶ 7.54 *Suspension of Action, Applicant's Request*

Pursuant to applicant's request filed on [1], action by the Office is suspended on this application under [37 CFR 1.103\(a\)](#) for a period of [2] months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See [MPEP § 709](#).

Examiner Note:

1. Maximum period for suspension is 6 months.
2. Only the Technology Center Director can grant second or subsequent suspensions. See [MPEP § 1003](#). Such approval must appear on the Office letter.

¶ 7.54.01 *Request for Deferral of Examination under 37 CFR 1.103(d), Granted*

Applicant's request filed on [1], for deferral of examination under 37 CFR [1.103\(d\)](#) in the application has been approved. The examination of the application will be deferred for a period of [2] months.

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.
2. In bracket 2, insert the number of months for the deferral.

¶ 7.54.02 *Request for Termination of a Suspension of Action, Granted*

Applicant's request filed on [1], for termination of a suspension of action under 37 CFR [1.103](#), has been approved. The suspension of action has been terminated on the date of mailing this notice.

Examiner Note:

In bracket 1, insert the filing date of the request for termination of the suspension of action.

¶ 7.56 *Request for Suspension, Denied, Outstanding Office Action*

Applicant's request filed [1], for suspension of action in this application under [37 CFR 1.103\(a\)](#), is denied as being improper. Action cannot be suspended in an application awaiting a reply by the applicant. See [MPEP § 709](#).

¶ 7.56.01 *Request for Suspension of Action under 37 CFR 1.103, Denied*

Applicant's request filed [1], for suspension of action in this application under 37 CFR [1.103\(b\)](#) or (c) is denied as being improper. The request was (1) not filed at the time of filing a CPA or RCE, and/or (2) not accompanied by the requisite fee as set forth in 37 CFR [1.17\(i\)](#). See MPEP § [709](#).

Examiner Note:

In bracket 1, insert the filing date of the request for suspension of action.

¶ 7.56.02 *Request for Deferral of Examination under 37 CFR 1.103(d), Denied*

Applicant's request filed on [1], for deferral of examination under 37 CFR [1.103\(d\)](#) in the application is denied as being improper. [2]

See MPEP § [709](#).

Examiner Note:

1. In bracket 1, insert the filing date of the request for deferral of examination.

2. In bracket 2, insert the reason(s) for denying the request. For example, if appropriate insert --The applicant has not filed a request under 37 CFR [1.213\(b\)](#) to rescind the previously filed nonpublication request--; --A first Office action has been issued in the application--; or --Applicant has not submitted a request for voluntary publication under 37 CFR [1.221](#)--.

¶ 7.57 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective- Heading*

The [1] filed on [2] under [37 CFR 1.131](#) has been considered but is ineffective to overcome the [3] reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.

2. This form paragraph must be followed by one or more of form paragraphs 7.58 to 7.63 or a paragraph setting forth proper basis for the insufficiency, such as failure to establish acts performed in this country, or that the scope of the declaration or affidavit is not commensurate with the scope of the claim(s).

¶ 7.58 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Claiming Same Invention*

The [1] reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR [1.131\(a\)](#) when the reference is claiming the same patentable

invention, see MPEP Chapter [2300](#). If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter [2300](#) for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under [37 CFR 1.130](#). See [MPEP § 718](#).

Examiner Note:

1. If used to respond to the submission of an affidavit under [37 CFR 1.131](#), this paragraph must be preceded by paragraph 7.57.

2. This form paragraph may be used without form paragraph 7.57 when an affidavit has not yet been filed, and the examiner desires to notify applicant that the submission of an affidavit under [37 CFR 1.131](#) would be inappropriate.

¶ 7.59 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction to Practice Before Reference Date*

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the [1] reference. [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.

2. An explanation of the lack of showing of the alleged reduction to practice must be provided in bracket 2.

¶ 7.60 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Reference Is a Statutory Bar*

The [1] reference is a statutory bar under [35 U.S.C. 102\(b\)](#) and thus cannot be overcome by an affidavit or declaration under [37 CFR 1.131](#).

Examiner Note:

This form paragraph must be preceded by form paragraph 7.57.

¶ 7.61 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Conception*

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the [1] reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their

interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. An explanation of the deficiency in the showing of conception must be presented in bracket 2.
3. If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this form paragraph should be followed by form paragraph 7.62 and/or 7.63. If either diligence or a reduction to practice is established, a statement to that effect should follow this paragraph.

¶ 7.62 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking*

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the [1] reference to either a constructive reduction to practice or an actual reduction to practice. [2]

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. If the affidavit additionally fails to establish conception, this paragraph must also be preceded by form paragraph 7.61. If the affidavit establishes conception, a statement to that effect should be added to this paragraph.
3. If the affidavit additionally fails to establish an alleged reduction to practice prior to the application filing date, this paragraph must be followed by form paragraph 7.63. If such an alleged reduction to practice is established, a statement to that effect should be added to this paragraph.
4. An explanation of the reasons for a holding of non-diligence must be provided in bracket 2.
5. See [MPEP § 715.07\(a\)](#), *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947), which indicates that diligence is not required after reduction to practice.

¶ 7.63 *Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Actual Reduction to Practice*

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the [1] reference. [2].

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.57.
2. If the alleged reduction to practice is prior to the effective date of the reference, do not use this paragraph. See form paragraph 7.59.
3. If the affidavit additionally fails to establish either conception or diligence, form paragraphs 7.61 and/or 7.62 should precede this paragraph. If either conception or diligence is established, a statement to that effect should be included after this paragraph.
4. An explanation of the lack of showing of the alleged reduction to practice must be given in bracket 2.

¶ 7.64 *Affidavit or Declaration Under 37 CFR 1.131: Effective To Overcome Reference*

The [1] filed on [2] under [37 CFR 1.131](#) is sufficient to overcome the [3] reference.

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the name of the reference.

¶ 7.65 *Affidavit or Declaration Under 37 CFR 1.132: Effective To Withdraw Rejection*

The [1] under [37 CFR 1.132](#) filed [2] is sufficient to overcome the rejection of claim [3] based upon [4].

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the affected claim or claims.
4. In bracket 4, indicate the rejection that has been overcome, including the statutory grounds, e.g.: insufficiency of disclosure under [35 U.S.C. 112](#), first paragraph; lack of utility under [35 U.S.C. 101](#); inoperativeness under [35 U.S.C. 101](#); a specific reference applied under [35 U.S.C. 103](#); etc. See [MPEP § 716](#).

¶ 7.66 *Affidavit or Declaration Under 37 CFR 1.132: Insufficient*

The [1] under [37 CFR 1.132](#) filed [2] is insufficient to overcome the rejection of claim [3] based upon [4] as set forth in the last Office action because:

Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the claim or claims affected.
4. In bracket 4, indicate the rejection that has not been overcome, including the statutory grounds, i.e.: insufficiency of disclosure under [35 U.S.C. 112](#), first paragraph; lack of utility and/or inoperativeness under [35 U.S.C. 101](#); a specific reference applied under [35 U.S.C. 103](#); etc. See [MPEP § 716](#).
5. Following this form paragraph, set forth the reasons for the insufficiency; e.g., categories include: --untimely--; --fails to set forth facts--; --facts presented are not germane to the rejection at issue--; --showing is not commensurate in scope with the claims--; etc. See [MPEP § 716](#). Also include a detailed explanation of the reasons why the affidavit or declaration is insufficient. Any of form paragraphs 7.66.01 - 7.66.05 may be used, as appropriate.

¶ 7.66.01 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Affiant Has Never Seen Invention Before

It includes statements which amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See [MPEP § 716](#).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.02 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Invention Works as Intended

It includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See [MPEP § 716](#).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.03 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Refers Only to Invention, Not to Claims

It refers only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See [MPEP § 716](#).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.04 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: No Evidence of Long-Felt Need

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See [MPEP § 716.04](#).

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.05 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Conclusion

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Examiner Note:

This form paragraph should be presented as a conclusion to your explanation of why the affidavit or declaration under [37 CFR 1.132](#) is insufficient, and it must be preceded by form paragraph 7.66.

¶ 7.70.AE Updated Accelerated Examination Support Document Required for Claim Amendments Not Encompassed by Previous Accelerated Examination Support Document(s) – Application Under Accelerated Examination

Applicant is reminded that for any amendments to the claims (including any new claim) that is not encompassed by the preexamination search and accelerated examination support documents previously filed, applicant is required to provide updated preexamination search and accelerated examination support documents that encompass the

amended or new claims at the time of filing the amendment. Failure to provide such updated preexamination search and accelerated examination support documents at the time of filing the amendment will cause the amendment to be treated as not fully responsive and not to be entered. See MPEP § 708.02(a) subsection VIII.D. for more information.

If the reply is not fully responsive, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. This form paragraph and form paragraph 7.71.AE must be included in every Office action, other than a notice of allowance, in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR 1.102(c)(2) or (d).

2. This form paragraph should not be used for an application that has been granted special status under 37 CFR 1.102(c)(1) on the basis of applicant’s health or age, or the Patent Prosecution Highway Program (pilot and permanent).

¶ 7.71.AE Use Of Proper Document and Fee Codes When Filing A Reply Electronically Via EFS-Web – Application Under Accelerated Examination

Any reply or other papers must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the papers are not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Any reply to this communication filed via EFS-Web must include a document that is filed using the document description of “Accelerated Exam - Transmittal amendment/reply.” Applicant is reminded to use proper indexing for documents to avoid any delay in processing of follow on papers. Currently document indexing is not automated in EFS-Web and applicant must select a particular document description for each attached file.

An incorrect document description for a particular file may potentially delay processing of the application. A complete listing of all document codes currently supported in EFS-Web is available at http://www.uspto.gov/ebc/portal/efs/efswb_document_descriptions.xls.

Any payment of fees via EFS-Web must be accompanied by selection of a proper fee code. An improper fee code may potentially delay processing of the application. Instructions on payment of fees via EFS-Web are

available at <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Examiner Note:

1. This form paragraph and form paragraph 7.70.AE must be included in every Office action, other than a notice of allowance, in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR 1.102(c)(2) or (d).

2. This form paragraph should not be used for an application that has been granted special status under 37 CFR 1.102(c)(1) on the basis of applicant’s health or age, or the Patent Prosecution Highway Program (pilot and permanent).

¶ 7.81 Correction Letter Re Last Office Action

In response to applicant’s [1] regarding the last Office action, the following corrective action is taken.

The period for reply of [2] MONTHS set in said Office action is restarted to begin with the mailing date of this letter.

Examiner Note:

1. In bracket 1, insert --telephone inquiry of _____-- or --communication dated _____--.
2. In bracket 2, insert new period for reply.
3. This form paragraph must be followed by one or more of form paragraphs 7.82, 7.82.01 or 7.83.
4. Before restarting the period, the SPE should be consulted.

¶ 7.82 Correction of Reference Citation

The reference [1] was not correctly cited in the last Office action. The correct citation is shown on the attached PTO-892.

Examiner Note:

1. Every correction MUST be reflected on a corrected or new PTO-892.
2. This form paragraph must follow form paragraph 7.81.
3. If a copy of the PTO-892 is being provided without correction, use form paragraph 7.83 instead of this form paragraph.
4. Also use form paragraph 7.82.01 if reference copies are being supplied.

¶ 7.82.01 Copy of Reference(s) Furnished

Copies of the following references not previously supplied are enclosed:

Examiner Note:

1. The USPTO ceased mailing paper copies of U.S. patents and U.S. application publications cited in Office Actions in nonprovisional applications beginning in June 2004. See the phase-in schedule of the E-Patent Reference program provided in “USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies,” 1282 O.G. 109 (May 18, 2004). Therefore, this form paragraph should only be used for foreign patent documents, non-patent literature, pending applications that are not stored in the image file wrapper (IFW) system, and other information not previously supplied.
2. The reference copies being supplied must be listed following this form paragraph.
3. This form paragraph must be preceded by form paragraph 7.81 and may also be used with form paragraphs 7.82 or 7.83.

¶ 7.82.03 *How To Obtain Copies of U.S. Patents and U.S. Patent Application Publications*

In June 2004, the USPTO ceased mailing paper copies of cited U.S. patents and U.S. patent application publications with all Office actions. See “USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies,” 1282 O.G. 109 (May 18, 2004). Foreign patent documents and non-patent literature will continue to be provided to the applicant on paper.

All U.S. patents and U.S. patent application publications are available free of charge from the USPTO web site (www.uspto.gov/patft/index.html), for a fee from the Office of Public Records (<http://ebiz1.uspto.gov/oems25p/index.html>), and from commercial sources. Copies are also available at the Patent and Trademark Resource Centers (PTRCs). A list of the PTRCs may be found on the USPTO web site (www.uspto.gov/products/library/ptdl/locations/index.jsp). Additionally, a simple new feature in the Office’s Private Patent Application Information Retrieval system (PAIR), E-Patent Reference, is available for downloading and printing of U.S. patents and U.S. patent application publications cited in U.S. Office Actions.

STEPS TO USE THE E-PATENT REFERENCE FEATURE

Access to Private PAIR is required to utilize E-Patent Reference. If you do not already have access to Private PAIR, the Office urges practitioners and applicants not

represented by a practitioner to: (1) obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate; (2) obtain a USPTO customer number; (3) associate all of their pending and new application filings with their customer number; (4) install free software (supplied by the Office) required to access Private PAIR and the E-Patent Reference; and (5) make appropriate arrangements for Internet access.

Instructions for performing the 5 steps:

Step 1: Full instructions for obtaining a PKI digital certificate are available at the Office’s Electronic Business Center (EBC) web page (www.uspto.gov/ebc/downloads.html). Note that a notarized signature will be required to obtain a digital certificate.

Step 2: To get a Customer Number, download and complete the Customer Number Request form, PTO-SB/125, from the USPTO web site (www.uspto.gov/web/forms/sb0125.pdf). The completed form can be transmitted by facsimile to the Patent Electronic Business Center at (571) 273-0177, or mailed to the address on the form. If you are a registered attorney or agent, your registration number must be associated with your customer number. This association is accomplished by adding your registration number to the Customer Number Request form.

Step 3: A description of associating a customer number with the correspondence address of an application is described at the EBC Web page (www.uspto.gov/ebc/registration_pair.html).

Step 4: The software for electronic filing is available for downloading at www.uspto.gov/ebc. Users can also contact the EFS Help Desk at (571) 272-4100 and request a copy of the software on compact disc. Users will also need Adobe Acrobat Reader, which is available through a link from the USPTO web site.

Step 5: Internet access will be required which applicants may obtain through a supplier of their own choice. As images of large documents must be downloaded, high-speed Internet access is recommended.

The E-Patent Reference feature is accessed using a button on the Private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office’s new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated.

Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents in Portable Document Format (PDF). The downloaded documents can be viewed and printed using commercially available software, such as ADOBE® READER®. ADOBE® READER® is available free of charge from Adobe Systems Incorporated (www.adobe.com/products/acrobat/readermain.html).

Examiner Note:

This form paragraph is recommended for use in Office actions citing U.S. patents or U.S. patent application publications when the applicant is not represented by a registered patent attorney or a registered patent agent.

¶ 7.83 *Copy of Office Action Supplied*

[1] of the last Office action is enclosed.

Examiner Note:

1. In bracket 1, explain what is enclosed. For example:
 - a. “A corrected copy”
 - b. “A complete copy”
 - c. A specific page or pages, e.g., “Pages 3-5”
 - d. “A Notice of References Cited, Form PTO-892”
2. This form paragraph should follow form paragraph 7.81 and may follow form paragraphs 7.82 and 7.82.01.

¶ 7.84 *Amendment Is Non-Responsive to Interview*

The reply filed on [1] is not fully responsive to the prior Office action because it fails to include a complete or accurate record of the substance of the [2] interview. [3] Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER [37 CFR 1.136\(a\)](#).

Examiner Note:

1. In bracket 2, insert the date of the interview.
2. In bracket 3, explain the deficiencies.

¶ 7.84.01 *Paper Is Unsigned*

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer,

within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER [37 CFR 1.136\(a\)](#).

¶ 7.84.01.AE *Paper Is Unsigned – Application Under Accelerated Examination*

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of this time period under [37 CFR 1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. Examiner should first try to contact applicant by telephone and ask for a properly signed reply or ratification of the reply. If attempts to contact applicant are unsuccessful, examiner may use this form paragraph in a letter requiring a properly signed reply or ratification if the reply is to a non-final Office action.
2. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under [37 CFR 1.102\(c\)\(2\)](#) or (d).
3. This form paragraph should not be used for an application that has been granted special status under [37 CFR 1.102\(c\)\(1\)](#) on the basis of applicant’s health or age, or the Patent Prosecution Highway pilot program.

¶ 7.84.AE *Amendment Is Non-Responsive to Interview – Application Under Accelerated Examination*

The reply filed on [1] is not fully responsive to the prior Office action because it fails to include a complete or accurate record of the substance of the [2] interview. [3] Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the

omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of this time period under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. In bracket 2, insert the date of the interview.
2. In bracket 3, explain the deficiencies.
3. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).
4. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 7.85 *Amendment Under 37 CFR 1.312 Entered*

The amendment filed on [1] under [37 CFR 1.312](#) has been entered.

Examiner Note:

Use this form paragraph both for amendments under [37 CFR 1.312](#) that do not affect the scope of the claims (may be signed by primary examiner) and for amendments being entered under [37 CFR 1.312](#) which do affect the scope of the claims. (requires signature of supervisory patent examiner). See [MPEP § 714.16](#).

¶ 7.86 *Amendment Under 37 CFR 1.312 Entered in Part*

The amendment filed on [1] under [37 CFR 1.312](#) has been entered-in-part. [2]

Examiner Note:

When an amendment under [37 CFR 1.312](#) is proposed containing plural changes, some of which may be acceptable and some not, the acceptable changes should be entered. An indication of which changes have and have not been entered with appropriate explanation should follow in bracket 2.

¶ 7.87 *Amendment Under 37 CFR 1.312 Not Entered*

The proposed amendment filed on [1] under [37 CFR 1.312](#) has not been entered. [2]

Examiner Note:

The reasons for non-entry should be specified in bracket 2:

--The amendment changes the scope of the claims.--; or

--The amendment was filed in a reissue application and was not accompanied by a supplemental reissue oath or declaration, [37 CFR 1.175\(b\)](#)--

¶ 7.90 *Abandonment, Failure to Reply*

This application is abandoned in view of applicant's failure to submit a proper reply to the Office action mailed on [1] within the required period for reply.

Examiner Note:

1. A letter of abandonment should not be mailed until after the period for requesting an extension of time under [37 CFR 1.136\(a\)](#) has expired.
2. In *pro se* cases see form paragraph 7.98.02.

¶ 7.91 *Reply Is Not Fully Responsive, Extension of Time Suggested*

The reply filed on [1] is not fully responsive to the prior Office action because: [2]. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under [37 CFR 1.136\(a\)](#).

The date on which the petition under [37 CFR 1.136\(a\)](#) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

Examiner Note:

1. In bracket 2, set forth why the examiner considers there to be a failure to take "complete and proper action" within the statutory period.
2. If the reply appears to be a *bona fide* attempt to respond with an inadvertent omission, do not use this form paragraph; instead use form paragraph 7.95.

¶ 7.95 *Bona Fide, Non-Responsive Amendments*

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. See [37 CFR 1.111](#). Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER [37 CFR 1.136\(a\)](#).

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

¶ 7.95.01 *Lack of Arguments in Response*

Applicant should submit an argument under the heading “Remarks” pointing out disagreements with the examiner’s contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.95.
2. This form paragraph is intended primarily for use in *pro se* applications.

¶ 7.95.AE *Bona Fide, Non-Responsive Amendments – Application Under Accelerated Examination*

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. See 37 CFR [1.111](#). Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.
2. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).
3. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant’s health or age, or the Patent Prosecution Highway pilot program

¶ 7.96 *Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. [1]

Examiner Note:

When such prior art is cited, its relevance should be explained in bracket 1 in accordance with [MPEP § 707.05](#).

¶ 7.97 *Claims Allowed*

Claim [1] allowed.

¶ 7.98 *Reply Is Late, Extension of Time Suggested*

Applicant’s reply was received in the Office on [1], which is after the expiration of the period for reply set in the last Office action mailed on [2]. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office action under [37 CFR 1.136\(a\)](#).

Examiner Note:

Since the provisions of [37 CFR 1.136\(a\)](#) do not apply to reexamination proceedings or to litigation related reissue applications, do not use this form paragraph in these cases.

¶ 7.98.01 *Reply Is Late, Extension of Time Suggested, Pro Se*

Applicant’s reply to the Office Action of [1] was received in the Patent and Trademark Office on [2], which is after the expiration of the period for reply set in the above noted Office action. The application will become abandoned unless applicant obtains an extension of the period for reply set in the above noted Office action. An extension of the reply period may be obtained by filing a petition under 37 CFR [1.136\(a\)](#). The petition must be accompanied by the appropriate fee as set forth in 37 CFR [1.17\(a\)](#) (copy

of current fee schedule attached). The date on which the reply, the petition, and the fee have been filed is the date of the reply and also the date for purposes of determining the period of extension and the corresponding amount of the fee due. The expiration of the time period is determined by the amount of the fee paid. Applicant is advised that in no case can any extension carry the date for reply to an Office action beyond the maximum period of SIX MONTHS set by statute. Additionally, extensions may not be granted under 37 CFR 1.136(a) for more than FIVE MONTHS beyond the time period set in an Office action.

Examiner Note:

Enclose a photocopy of current fee schedule with action so that applicant can determine the required fee.

¶ 7.98.02 *Reply Is Late, Petition To Revive Suggested, Pro Se*

Applicant's reply to the Office Action of [1] was received in the Patent and Trademark Office on [2], which is after the expiration of the period for reply set in the last Office Action. Since no time remains for applicant to obtain an extension of the period for reply by filing a petition under 37 CFR 1.136(a), this application is *abandoned*. Applicant is advised that the abandonment of this application may only be overcome by filing a petition to revive under 37 CFR 1.137. A petition to revive may be appropriate if applicant's failure to reply was either unavoidable or unintentional, as set forth below.

A. Failure to reply was unavoidable.

A petition to revive an abandoned application on the grounds that the failure to reply was unavoidable (37 CFR 1.137(a)) must be accompanied by: (1) the required reply (which has been filed); (2) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(d); and (4) the \$[3] petition fee as set forth in 37 CFR 1.17(l). No consideration to the substance of a petition will be given until this fee is received.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable, as well as inadvertent. This must include: (1) a satisfactory showing that the cause of the delay resulting in failure to reply in timely fashion to the Office action was unavoidable; and (2) a satisfactory

showing that the cause of any delay during the time period between abandonment and filing of the petition to revive was also unavoidable.

A terminal disclaimer and the \$[4] terminal disclaimer fee is required under 37 CFR 1.137(d) if the application is: (1) a design application, (2) a utility application filed before June 8, 1995, or (3) a plant application filed before June 8, 1995. The terminal disclaimer must dedicate to the public a terminal part of the term of any patent granted the application equivalent to the period of abandonment of the application, and must also apply to any patent granted on any application containing a specific reference under 35 U.S.C. 120, 121 or 365(c) to the application for which revival is sought.

B. Failure to reply was unintentional.

A petition to revive an abandoned application on the grounds that the failure to reply was unintentional (37 CFR 1.137(b)) must be accompanied by: (1) the required reply (which has been filed); (2) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(d) (see above discussion); and (4) the \$[5] petition fee as set forth in 37 CFR 1.17(m). No consideration to the substance of a petition will be given until this fee is received. The Director may require additional information where there is a question whether the delay was unintentional.

The required items and fees must be submitted promptly under a cover letter entitled "Petition to Revive."

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX:

571-273-8300 Attn: Office of Petitions

Telephone inquiries with respect to this matter should be

directed to the Office of Petitions Staff at (571) 272-3282.

For more detailed information, see MPEP § [711.03\(c\)](#).

Chapter 800 - Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

¶ 8.01 Election of Species; Species Claim(s) Present

This application contains claims directed to the following patentably distinct species [1]. The species are independent or distinct because [2].

Applicant is required under [35 U.S.C. 121](#) to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, [3] generic.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply: [4].

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed ([37 CFR 1.143](#)) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under [37 CFR 1.144](#). If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under [35 U.S.C. 103\(a\)](#) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species

which depend from or otherwise require all the limitations of an allowable generic claim as provided by [37 CFR 1.141](#).

Examiner Note:

1. In bracket 1, identify the species and/or grouping(s) of patentably indistinct species from which an election is to be made. The species may be identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. Where the election requirement identifies a grouping of patentably indistinct species, applicant should not be required to elect a specific species within that grouping.

2. In bracket 2 insert the reason(s) why the species or grouping(s) of species are independent or distinct. See [MPEP § 806.04\(b\)](#), [§ 806.04\(f\)](#) and [§ 806.04\(h\)](#). For example, insert --the claims to the different species recite the mutually exclusive characteristics of such species--, and provide a description of the mutually exclusive characteristics of each species or grouping of species.

3. In bracket 3 insert the appropriate generic claim information.

4. In bracket 4 insert the applicable reason(s) why there is a search and/or examination burden:

--the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification

--the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter

--the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search strategies or search queries).

5. This form paragraph does not need to be followed by form paragraph 8.21.

¶ 8.02 Requiring an Election of Species; No Species Claim Present

Claim(s) [1] is/are generic to the following disclosed patentably distinct species: [2]. The species are independent or distinct because [3]. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under [35 U.S.C. 121](#) to elect a single disclosed species, or a single grouping of patentably

indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply: [4]

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species or grouping of patentably indistinct species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Examiner Note:

1. This form paragraph should be used for the election of species requirement described in MPEP § 803.02 (Markush group) and MPEP § 808.01(a) where only generic claims are presented.
2. In bracket 1, insert the claim number(s).

3. In bracket 2, clearly identify the species and/or grouping(s) of patentably indistinct species from which an election is to be made. The species may be identified as the species of figures 1, 2, and 3, for example, or the species of examples I, II, and III, respectively. Where the election requirement identifies a grouping of patentably indistinct species, applicant should not be required to elect a specific species within that grouping.

4. In bracket 3 insert the reason(s) why the species or groupings of species as disclosed are independent or distinct. See MPEP § 806.04(b), § 806.04(f) and MPEP § 806.04(h). For example, insert --as disclosed the different species have mutually exclusive characteristics for each identified species--, and provide a description of the mutually exclusive characteristics of each species or grouping of species.

5. In bracket 4 insert the applicable reason(s) why there is a search and/or examination burden:

--the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification

--the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter

--the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search strategies or search queries).

6. This form paragraph does not need to be followed by form paragraph 8.21.

¶ 8.03 In Condition for Allowance, Non-elected Claims Withdrawn with Traverse

This application is in condition for allowance except for the presence of claim [1] directed to an invention non-elected with traverse in the reply filed on [2]. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

¶ 8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See [37 CFR 1.142\(b\)](#) and [MPEP § 821.03](#).

¶ *8.05 Claims Stand Withdrawn With Traverse*

Claim [1] withdrawn from further consideration pursuant to [37 CFR 1.142\(b\)](#), as being drawn to a nonelected [2], there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on [3].

Examiner Note:

In bracket 2, insert --invention-- or --species--.

¶ *8.06 Claims Stand Withdrawn Without Traverse*

Claim [1] withdrawn from further consideration pursuant to [37 CFR 1.142\(b\)](#) as being drawn to a nonelected [2], there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on [3].

Examiner Note:

In bracket 2, insert --invention--, or --species--.

¶ *8.07 Ready for Allowance, Non-elected Claims Withdrawn Without Traverse*

This application is in condition for allowance except for the presence of claim [1] directed to [2] nonelected without traverse. Accordingly, claim [3] been canceled.

Examiner Note:

In bracket 2, insert --an invention--, --inventions--, --a species--, or --species--.

¶ *8.08 Restriction, Two Groupings*

Restriction to one of the following inventions is required under [35 U.S.C. 121](#):

I. Claim [1], drawn to [2], classified in class [3], subclass [4].

II. Claim [5], drawn to [6], classified in class [7], subclass [8].

¶ *8.09 Restriction, 3rd Grouping*

III. Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ *8.10 Restriction, 4th Grouping*

IV. Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ *8.11 Restriction, Additional Groupings*

[1]. Claim [2], drawn to [3], classified in class [4], subclass [5].

Examiner Note:

In bracket 1, insert the appropriate roman numeral, e.g., --V--, --VI--, etc.

¶ *8.12 Restriction, Linking Claims*

Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is **subject to** the nonallowance of the linking claim(s), claim [5]. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with [37 CFR 1.104](#). **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by [37 CFR 1.116](#); amendments submitted after allowance are governed by [37 CFR 1.312](#).

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph must be included in any restriction requirement with at least one linking claim present.
2. In bracket 4, insert either --between-- or --among--.
3. In bracket 5, insert the claim number(s) of the linking claims.
4. See related form paragraphs 8.45, 8.46 and 8.47.

¶ 8.13 *Distinctness (Heading)*

The inventions are independent or distinct, each from the other because:

Examiner Note:

This form paragraph should be followed by one of form paragraphs 8.14-8.20.02 to show independence or distinctness.

¶ 8.14 *Intermediate-Final Product*

Inventions [1] and [2] are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product and the species are patentably distinct ([MPEP § 806.05\(j\)](#)). In the instant case, the intermediate product is deemed to be useful as [3] and the inventions are deemed patentably distinct because there is nothing of record to show them to be obvious variants.

Examiner Note:

1. This form paragraph is to be used when claims are presented to both **an intermediate** and **final product** ([MPEP § 806.05\(j\)](#)).
2. Conclude restriction requirement with form paragraph 8.21.

¶ 8.14.01 *Distinct Products or Distinct Processes*

Inventions [1] and [2] are directed to related [3]. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See [MPEP § 806.05\(j\)](#). In the instant case, the inventions as claimed [4]. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Examiner Note:

1. This form paragraph may be used when claims are presented to two or more related product inventions, or two or more related process inventions, wherein the inventions as claimed are mutually exclusive, i.e., there is no product (or process) that would infringe both of the identified inventions. Use form paragraph 8.15 to restrict between combination(s) and subcombination(s).
2. If a generic claim or claim linking multiple product inventions or multiple process inventions is present, see [MPEP § 809 - § 809.03](#).
3. In bracket 3, insert --products -- or --processes--.

4. In bracket 4, explain why the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

5. Conclude restriction requirement with form paragraph 8.21.

¶ 8.15 *Combination-Subcombination*

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations ([MPEP § 806.05\(c\)](#)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with [37 CFR 1.104](#). See [MPEP § 821.04\(a\)](#). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Examiner Note:

1. This form paragraph is to be used when claims are presented to both **combination(s)** and **subcombination(s)** ([MPEP § 806.05\(c\)](#)).
2. In bracket 3, specify the limitations of the claimed subcombination that are not required by the claimed combination, or the evidence that supports the conclusion that the combination does not rely upon the specific details of the subcombination for patentability. See [MPEP § 806.05\(c\)](#), subsection II and [§ 806.05\(d\)](#).
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.

¶ 8.16 *Subcombinations, Usable Together*

Inventions [1] and [2] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in

scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case subcombination [3] has separate utility such as [4]. See [MPEP § 806.05\(d\)](#).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with [37 CFR 1.104](#). See [MPEP § 821.04\(a\)](#). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Examiner Note:

1. This form paragraph is to be used when claims are presented to subcombinations usable together ([MPEP § 806.05\(d\)](#)).
2. In bracket 3, insert the appropriate group number or identify the subcombination.
3. In bracket 4, suggest utility other than with the other subcombination.
4. Conclude restriction requirement with form paragraph 8.21.

¶ 8.17 Process and Apparatus

Inventions [1] and [2] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process. ([MPEP § 806.05\(e\)](#)). In this case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both a **process** and **apparatus for its practice** ([MPEP § 806.05\(e\)](#)).
2. In bracket 3, use one or more of the following reasons:
 - (a) --the process as claimed can be practiced by another materially different apparatus such as.....--,
 - (b) --the process as claimed can be practiced by hand--,
 - (c) --the apparatus as claimed can be used to practice another materially different process such as.....--.

3. A process can be practiced by hand if it can be performed without using any apparatus.
4. Conclude restriction requirement with one of form paragraphs 8.21.
5. All restriction requirements between a process and an apparatus (or product) for practicing the process should be followed by form paragraph 8.21.04 to notify the applicant that if an apparatus claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable apparatus may be rejoined.

¶ 8.18 Product and Process of Making

Inventions [1] and [2] are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another materially different process ([MPEP § 806.05\(f\)](#)). In the instant case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both a **product** and the **process of making** the product ([MPEP § 806.05\(f\)](#)).
2. In bracket 3, use one or more of the following reasons:
 - (a) --the process as claimed can be used to make a materially different product such as.....--,
 - (b) --the product as claimed can be made by a materially different process such as.....--.
3. Conclude the basis for the restriction requirement with form paragraph 8.21.

4. All restriction requirements between a product and a process of making the product should be followed by form paragraph 8.21.04 to notify the applicant that if a product claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable product may be rejoined.

¶ 8.19 Apparatus and Product Made

Inventions [1] and [2] are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another materially different apparatus ([MPEP § 806.05\(g\)](#)). In this case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both the **apparatus** and **product made** ([MPEP § 806.05\(g\)](#)).

2. In bracket 3, use one or more of the following reasons:

- (a) --the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as.....--,
- (b) --the product can be made by a materially different apparatus such as.....--.

3. Conclude restriction requirement with form paragraph 8.21.

¶ 8.20 Product and Process of Using

Inventions [1] and [2] are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See [MPEP § 806.05\(h\)](#). In the instant case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both the **product** and **process of using the product** ([MPEP § 806.05\(h\)](#)). If claims to a process specially adapted for (i.e., not patentably distinct from) making the product are also presented such process of making claims should be grouped with the product invention. See [MPEP § 806.05\(i\)](#).

2. In bracket 3, use one or more of the following reasons:

- (a) --the process as claimed can be practiced with another materially different product such as.....--,
- (b) --the product as claimed can be used in a materially different process such as.....--.

3. Conclude the basis for the restriction requirement with form paragraph 8.21.

4. All restriction requirements between a product and a process of using the product should be followed by form paragraph 8.21.04 to notify the applicant that if a product claim is found allowable, process claims that depend from or otherwise require all the limitations of the patentable product may be rejoined.

¶ 8.20.02 Unrelated Inventions

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, and they have different designs,

modes of operation, and effects. ([MPEP § 802.01](#) and [MPEP § 806.06](#)). In the instant case, the different inventions [3].

Examiner Note:

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing not disclosed as capable of use together.

2. In bracket 3, insert reasons for concluding that the inventions are unrelated.

3. This form paragraph must be followed by form paragraph 8.21.

¶ 8.20.03 Unrelated Product and Process Inventions

Inventions [1] and [2] are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See [MPEP § 802.01](#) and [§ 806.06](#). In the instant case, [3].

Examiner Note:

1. In bracket 3, insert reasons for concluding that the inventions are unrelated.

2. This form paragraph must be followed by form paragraph 8.21.

¶ 8.21.01 Conclusion to All Restriction Requirements: Different Classification

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.02 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.01,8.02, or 8.14 to 8.20.03.

¶ 8.21.02 Conclusion to All Restriction Requirements: Recognized Divergent Subject Matter

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.01, 8.02, or 8.14 to 8.20.03.

¶ 8.21.03 Conclusion to All Restriction Requirements: Different Search

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.02) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.01, 8.02, or 8.14 to 8.20.03.

¶ 8.21.04 Notice of Potential Rejoinder of Process Claims

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product/apparatus, and all product/apparatus claims are subsequently found allowable, withdrawn process claims that include all the limitations of the allowable product/apparatus claims should be considered for rejoinder. All claims directed to a nonelected process invention must include all the limitations of an allowable product/apparatus claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product/apparatus claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product/apparatus are found allowable, an otherwise proper restriction requirement between product/apparatus claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product/apparatus claim will not be rejoined. See MPEP § 821.04. Additionally, in order for rejoinder to occur, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product/apparatus claims. **Failure to do so may result in no rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction

requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Examiner Note:

This form paragraph should appear at the end of any requirement for restriction between a process and a product/apparatus for practicing the process (see form paragraph 8.17), a product/apparatus and a process of making the product/apparatus (see form paragraph 8.18) or between a product/apparatus and a process of using the product/apparatus (see form paragraph 8.20). See MPEP § 821.04 for rejoinder practice.

¶ 8.22 Requirement for Election and Means for Traversal

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Examiner Note:

This form paragraph must be used in Office actions containing a restriction requirement with or without an action on the merits.

¶ 8.23 Requirement, When Elected by Telephone

During a telephone conversation with [1] on [2] a provisional election was made [3] traverse to prosecute the invention of [4], claim [5]. Affirmation of this election must be made by applicant in replying to this Office action. Claim [6] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Examiner Note:

1. In bracket 3, insert --with-- or --without--, whichever is applicable.

2. In bracket 4, insert either the elected group or species.
3. An action on the merits of the claims to the elected invention should follow.

¶ 8.23.01 *Requirement, No Election by Telephone*

A telephone call was made to [1] on [2] to request an oral election to the above restriction requirement, but did not result in an election being made.

Examiner Note:

1. In bracket 1, insert the name of the applicant or attorney or agent contacted.
2. In bracket 2, insert the date(s) of the telephone contact(s).
3. This form paragraph should be used in all instances where a telephone election was attempted and the applicant's representative did not or would not make an election.
4. This form paragraph should **not** be used if no contact was made with applicant or applicant's representative.

¶ 8.23.02 *Joint Inventors, Correction of Inventorship*

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 request under [37 CFR 1.48\(b\)](#) and by the fee required under [37 CFR 1.17\(i\)](#).

Examiner Note:

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

¶ 8.24 *Reply to Final Must Include Cancellation of Claims Non-elected with Traverse*

This application contains claim [1] drawn to an invention nonelected with traverse in the reply filed on [2]. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action ([37 CFR 1.144](#)). See [MPEP § 821.01](#).

Examiner Note:

For use in FINAL rejections of applications containing claims drawn to an invention non-elected with traverse.

¶ 8.25 *Answer to Arguments With Traverse*

Applicant's election with traverse of [1] in the reply filed on [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [4].

The requirement is still deemed proper and is therefore made FINAL.

Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground(s) on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

¶ 8.25.01 *Election Without Traverse*

Applicant's election without traverse of [1] in the reply filed on [2] is acknowledged.

¶ 8.25.02 *Election Without Traverse Based on Incomplete Reply*

Applicant's election of [1] in the reply filed on [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse ([MPEP § 818.03\(a\)](#)).

¶ 8.26 *Canceled Elected Claims, Non-Responsive*

The amendment filed on [1] canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive ([MPEP § 821.03](#)). The remaining claims are not readable on the elected invention because [2].

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER [37 CFR 1.136\(a\)](#) ARE AVAILABLE.

¶ 8.26.AE *Canceled Elected Claims, Non-Responsive – Application Under Accelerated Examination*

The amendment filed on [1] canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive ([MPEP § 821.03](#)). The remaining claims are not readable on the elected invention because [2].

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination

program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. This form paragraph should only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).

2. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ *8.27 Different Inventors, Common Assignee, Same Invention*

Claim [1] directed to the same invention as that of claim [2] of commonly assigned [3]. The issue of priority under [35 U.S.C. 102\(g\)](#) and possibly [35 U.S.C. 102\(f\)](#) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see [MPEP Chapter 2300](#)), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under [35 U.S.C. 102\(f\)](#) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Examiner Note:

1. In bracket 3, insert the U.S. patent number or the copending application number.
2. The claims listed in brackets 1 and 2 must be for the same invention. If one invention would have been obvious in view of the other, do not use this form paragraph; see form paragraph 8.28.
3. A provisional or actual statutory double patenting rejection should also be made using form paragraphs 8.31 or 8.32.

4. If the commonly assigned application or patent has an earlier U.S. filing date, a rejection under [35 U.S.C. 102\(e\)](#) may also be made using form paragraph 7.15.01 or 7.15.02.

¶ *8.28 Different Inventors, Common Assignee, Obvious Inventions, No Evidence of Common Ownership at Time of Invention*

Claim [1] directed to an invention not patentably distinct from claim [2] of commonly assigned [3]. Specifically, [4].

Examiner Note:

1. This form paragraph should be used when the application being examined is commonly assigned with a conflicting application or patent, but there is no indication that they were commonly assigned at the time the invention was actually made.

2. A rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) using form paragraph 7.21, 7.21.01 or 7.21.02 also should be made, as appropriate. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. [102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

3. In bracket 3, insert the number of the conflicting patent or application.

4. An obviousness-type double patenting rejection should also be included in the action using one of form paragraphs 8.34 to 8.37

5. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.

6. Form paragraph 8.28.01 MUST follow this paragraph.

¶ *8.28.01 Advisory Information Relating to Form Paragraph 8.28*

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see [MPEP Chapter 2300](#)). Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under [35 U.S.C. 103\(a\)](#) if the commonly assigned case qualifies as prior art under [35 U.S.C. 102\(e\)](#), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue the assignee can, under [35 U.S.C. 103\(c\)](#) and [37 CFR 1.78\(c\)](#), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under [35 U.S.C. 103\(a\)](#) based upon the commonly assigned case as a reference under [35 U.S.C. 102\(f\)](#) or (g), or 35 U.S.C. [102\(e\)](#) for applications pending on or after December 10, 2004.

Examiner Note:

This form paragraph should follow form paragraph 8.28 and should only be used ONCE in an Office action.

¶ 8.29 *Conflicting Claims, Copending Applications*

Claim [1] of this application conflict with claim [2] of Application No. [3]. [37 CFR 1.78\(b\)](#) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See [MPEP § 822](#).

Examiner Note:

This form paragraph is appropriate only when the conflicting claims are not patentably distinct.

¶ 8.30 *35 U.S.C. 101, Statutory Basis for Double Patenting “Heading” Only*

A rejection based on double patenting of the “same invention” type finds its support in the language of [35 U.S.C. 101](#) which states that “whoever invents or discovers any new and useful process... may obtain a patent therefor...” (Emphasis added). Thus, the term “same invention,” in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type ([35 U.S.C. 101](#)) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon [35 U.S.C. 101](#).

Examiner Note:

The above form paragraph must be used as a heading for all subsequent double patenting rejections of the statutory (same invention) type using either of form paragraphs 8.31 or 8.32.

¶ 8.31 *Rejection, 35 U.S.C. 101, Double Patenting*

Claim [1] rejected under [35 U.S.C. 101](#) as claiming the same invention as that of claim [2] of prior U.S. Patent No. [3]. This is a double patenting rejection.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the “scope” of the inventions claimed is identical.
2. If the conflicting claims are in another copending application, do not use this form paragraph. A provisional double patenting rejection should be made using form paragraph 8.32.
3. Do not use this form paragraph for nonstatutory-type double patenting rejections. If nonstatutory type, use appropriate form paragraphs 8.33 to 8.39.
4. This form paragraph may be used where the conflicting patent and the pending application are:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and are commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but have at least one common inventor, or
 - (d) made as a result of activities undertaken within the scope of a joint research agreement.
5. In bracket 3, insert the number of the conflicting patent.
6. If the patent is to a different inventive entity and is commonly assigned with the application, form paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
7. If evidence is of record to indicate that the patent is prior art under either [35 U.S.C. 102\(f\)](#) or (g), a rejection should also be made using form paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.
8. If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under [35 U.S.C. 102\(e\)](#) should additionally be made using form paragraph 7.15.02.

¶ 8.32 *Provisional Rejection, 35 U.S.C. 101, Double Patenting*

Claim [1] provisionally rejected under [35 U.S.C. 101](#) as claiming the same invention as that of claim [2] of copending Application No. [3]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.
2. If the conflicting claims are from an issued patent, do not use this paragraph. See form paragraph 8.31.
3. Do not use this paragraph for nonstatutory-type double patenting rejections. See form paragraphs 8.33 to 8.39.
4. This form paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor, or
 - (d) made as a result of activities undertaken within the scope of a joint research agreement.
5. Form paragraph 8.28 may be used along with this form paragraph to resolve any remaining issues relating to priority under [35 U.S.C. 102\(f\)](#) or (g).
6. In bracket 3, insert the number of the conflicting application.
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If the copending application is by a different inventive entity and is commonly assigned, form paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
9. If evidence is also of record to show that either application is prior art unto the other under [35 U.S.C. 102\(f\)](#) or (g), a rejection should also be made in the other application using form paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.
10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using form paragraph 7.15.01.

¶ 8.33 Basis for Nonstatutory Double Patenting, "Heading" Only

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with [37 CFR 1.321\(c\)](#) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with [37 CFR 3.73\(b\)](#).

Examiner Note:

This form paragraph is to be used as a heading before a nonstatutory double patenting rejection using any of form paragraphs 8.34 - 8.39.

¶ 8.34 Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)

Claim [1] rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [4].

Examiner Note:

1. This form paragraph is used for obviousness-type double patenting rejections based upon a patent.
2. If the obviousness-type double patenting rejection is based upon another application, do not use this form paragraph. A provisional double patenting rejection should be made using form paragraph 8.33 and either form paragraph 8.35 or 8.37.
3. This form paragraph may be used where the conflicting invention is claimed in a patent which is:
 - (a) by the same inventive entity, or

- (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one inventor in common, or
 - (d) made as a result of activities undertaken within the scope of a joint research agreement.
4. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
 5. In bracket 3, insert the number of the patent.
 6. If evidence indicates that the conflicting patent is prior art under [35 U.S.C. 102\(f\)](#) or (g), a rejection should additionally be made under [102\(f\)/103\(a\)](#) or [102\(g\)/103\(a\)](#) using form paragraph 7.21, unless the patent is disqualified under 35 U.S.C. [103\(c\)](#) as prior art in a 35 U.S.C. [103\(a\)](#) rejection.

7. If the patent is to a different inventive entity and has an earlier effective U.S. filing date, a rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. [102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under 35 U.S.C. [103\(c\)](#) as prior art in a 35 U.S.C. [103\(a\)](#) **rejection**.

¶ 8.35 *Provisional Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)*

Claim [1] provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim [2] of copending Application No. [3]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [4].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. This form paragraph should be used when the conflicting claims are in another copending application.
2. If the conflicting claims are in a patent, do not use this form paragraph. Use form paragraphs 8.33 and 8.34.
3. This form paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) commonly assigned even though there is no common inventor, or

- (c) not commonly assigned but has at least one common inventor, or
- (d) made as a result of activities undertaken within the scope of a joint research agreement.

4. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.

5. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).

6. In bracket 3, insert the number of the conflicting application.

7. A provisional obviousness-type double patenting rejection should also be made in the conflicting application.

8. If evidence shows that either application is prior art unto the other under [35 U.S.C. 102\(f\)](#) or (g) and the copending application has not been disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a 103(a) rejection, a rejection should additionally be made in the other application under [35 U.S.C. 102\(f\)/103\(a\)](#) or [102\(g\)/103\(a\)](#) using form paragraph 7.21.

9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use form paragraph 7.21.01 to additionally make a rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) in the later filed application. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. [102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

10. In bracket 4, provide appropriate rationale for obviousness of claims being rejected over the claims of the cited application.

¶ 8.36 *Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)*

Claim [1] rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3] in view of [4]. [5]

Examiner Note:

1. This form paragraph is used for obviousness-type double patenting rejections where the primary reference is a conflicting patent.

2. If the obviousness double patenting rejection is based on another application, do not use this form paragraph. A provisional obviousness-type double patenting rejection should be made using form paragraphs 8.33 and either 8.35 or 8.37.
3. This form paragraph may be used where the prior invention is claimed in a patent which is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor, or
 - (d) made as a result of activities undertaken within the scope of a joint research agreement.
4. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
5. In bracket 3, insert the number of the conflicting patent.
6. In bracket 4, insert the secondary reference.
7. In bracket 5, insert an explanation of the obviousness-type rejection.
8. If evidence shows that the conflicting patent is prior art under [35 U.S.C. 102\(f\)](#) or (g), a rejection should additionally be made under [35 U.S.C. 102\(f\)/103\(a\)](#) or [102\(g\)/103\(a\)](#) using form paragraph 7.21, unless the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.
9. If the patent issued to a different inventive entity and has an earlier effective U.S. filing date, a rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under [35 U.S.C. 102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

¶ 8.37 *Provisional Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)*

Claim [1] provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim [2] of copending Application No. [3] in view of [4]. [5]

This is a provisional obviousness-type double patenting rejection.

Examiner Note:

1. This form paragraph is used for obviousness-type double patenting rejections where the primary reference is a conflicting application.
2. If the conflicting claims are in a patent, do not use this form paragraph, use form paragraph 8.36.
3. This form paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor, or
 - (d) made as a result of activities undertaken within the scope of a joint research agreement.
4. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
5. If the conflicting cases are currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in addition to this form paragraph to also resolve any issues relating to priority under [35 U.S.C. 102\(f\)](#) and/or (g).
6. In bracket 3, insert the number of the conflicting application.
7. In bracket 4, insert the secondary reference.
8. In bracket 5, insert an explanation of the obviousness-type rejection.
9. A provisional obviousness-type double patenting rejection should also be made in the conflicting application.
10. If evidence shows that either application is prior art unto the other under [35 U.S.C. 102\(f\)](#) or (g) and the copending application has not been disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection, a rejection should additionally be made under [35 U.S.C. 102\(f\)/103\(a\)](#) or [102\(g\)/103\(a\)](#) using form paragraph 7.21.
11. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use form paragraph 7.21.01 to additionally make a rejection under [35 U.S.C. 102\(e\)/103\(a\) in the application with the later effective U.S. filing date](#). For applications pending on or after December 10, 2004, rejections under [35 U.S.C. 102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\) rejection](#).

¶ 8.38 *Double Patenting - Nonstatutory (Based Solely on Improper Timewise Extension of Patent Rights) With a Patent*

Claim [1] rejected on the ground of nonstatutory double patenting over claim [2] of U.S. Patent No. [3] since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also [MPEP § 804](#).

Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the patent.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the patent.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
6. If evidence indicates that the conflicting patent is prior art under [35 U.S.C. 102\(f\)](#) or (g), a rejection should additionally be made under [35 U.S.C. 102\(f\)](#)/103(a) or 102(g)/103(a) using form paragraph 7.21, unless the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.
7. If the patent is to another inventive entity and has an earlier U.S. filing date, a rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) may be made using form paragraph 7.21.02. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. [102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

¶ 8.39 *Double Patenting - Nonstatutory (Based Solely on Improper Timewise Extension of Patent Rights) With Another Application*

Claim [1] provisionally rejected on the ground of nonstatutory double patenting over claim [2] of copending Application No. [3]. This is a provisional double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also [MPEP § 804](#).

Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, another copending application which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the conflicting application.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the copending application.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
6. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in addition to this form paragraph to also resolve any issues relating to priority under [35 U.S.C. 102\(f\)](#) and/or (g).
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If evidence shows that either application is prior art unto the other under [35 U.S.C. 102\(f\)](#) or (g) and the

copending application has not been disqualified (as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under [35 U.S.C. 102\(f\)/103\(a\)](#) or [102\(g\)/103\(a\)](#) using form paragraph 7.21, unless the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use form paragraph 7.21.01 to additionally make a rejection under [35 U.S.C. 102\(e\)/103\(a\)](#) in the application with the later effective U.S. filing date. For applications pending on or after December 10, 2004, rejections under 35 U.S.C. [102\(e\)/103\(a\)](#) should not be made or maintained if the patent is disqualified under [35 U.S.C. 103\(c\)](#) as prior art in a [35 U.S.C. 103\(a\)](#) rejection.

¶ *8.41 Transitional Restriction or Election of Species Requirement To Be Mailed After June 8, 1995*

This application is subject to the transitional restriction provisions of Public Law 103-465, which became effective on June 8, 1995, because:

1. the application was filed on or before June 8, 1995, and has an effective U.S. filing date of June 8, 1992, or earlier;
2. a requirement for restriction was not made in the present or a parent application prior to April 8, 1995; and
3. the examiner was not prevented from making a requirement for restriction in the present or a parent application prior to April 8, 1995, due to actions by the applicant.

The transitional restriction provisions permit applicant to have more than one independent and distinct invention examined in the same application by paying a fee for each invention in excess of one.

Final rules concerning the transition restriction provisions were published in the *Federal Register* at 60 FR 20195 (April 25, 1995) and in the *Official Gazette* at 1174 O.G. 15 (May 2, 1995). The final rules at [37 CFR 1.17\(s\)](#) include the fee amount required to be paid for each additional invention as set forth in the following requirement for restriction. See the current fee schedule for the proper amount of the fee.

Applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in [37 CFR 1.17\(s\)](#) for each independent and distinct invention in excess of one which applicant elects; or (2) file a petition under [37 CFR 1.129\(b\)](#) traversing the requirement.

Examiner Note:

1. This form paragraph should be used in all restriction or election of species requirements made in applications subject to the transition restriction provisions set forth in [37 CFR 1.129\(b\)](#) where the requirement is being mailed after June 8, 1995. The procedure is NOT applicable to any design or reissue application.

¶ *8.42 Allowable Product, Rejoinder of at Least One Process Claim, Less Than All Claims*

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in [MPEP § 821.04\(b\)](#), claim [2], directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, [3] hereby rejoined and fully examined for patentability under [37 CFR 1.104](#). Claim [4], directed to the invention(s) of [5] require all the limitations of an allowable product claim, and [6] NOT been rejoined.

Because a claimed invention previously withdrawn from consideration under [37 CFR 1.142](#) has been rejoined, **the restriction requirement [7] groups [8] as set forth in the Office action mailed on [9] is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. If ALL previously withdrawn process claims are being rejoined, then form paragraph 8.43 should be used instead of this form paragraph. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. See [MPEP § 821.04\(b\)](#).
2. In bracket 1, insert the claim number(s) of the allowable product claims followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of ALL the rejoined process claims.
4. In bracket 3, insert either --is-- or --are--.
5. In bracket 4, insert the number(s) of the claims NOT being rejoined followed by either -- is-- or -- are--.

6. In bracket 5, insert the group(s) or subject matter of the invention(s) to which the claims NOT being rejoined are directed, followed by either --, do not all-- or --, does not--.

7. In bracket 6, insert --has-- or --have--.

8. In bracket 7, insert either -- among -- or -- between--.

9. In bracket 8, insert group numbers of the elected product and rejoined process.

¶ 8.43 Allowable Product, Rejoinder of All Previously Withdrawn Process Claims

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in [MPEP § 821.04\(b\)](#), claim [2], directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, [3] hereby rejoined and fully examined for patentability under [37 CFR 1.104](#).

Because all claims previously withdrawn from consideration under [37 CFR 1.142](#) have been rejoined, **the restriction requirement as set forth in the Office action mailed on [4] is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. If LESS THAN ALL previously withdrawn claims are being rejoined, then form paragraph 8.42 should be used instead of this form paragraph. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined. See [MPEP § 821.04\(b\)](#).
2. In bracket 1, insert the claim number(s) of the allowable product claim(s) followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of the process claim(s) previously withdrawn from consideration.
4. In bracket 3, insert either --is-- or --are--.
5. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under [35 U.S.C. 112](#), first paragraph is

made, then the next Office action may be made final if proper under [MPEP § 706.07\(a\)](#).

¶ 8.45 Elected Invention Allowable, Rejoinder of All Previously Withdrawn Claims

Claim [1] allowable. Claim [2], previously withdrawn from consideration as a result of a restriction requirement, [3] all the limitations of an allowable claim. Pursuant to the procedures set forth in [MPEP § 821.04\(a\)](#), **the restriction requirement [4] inventions [5], as set forth in the Office action mailed on [6], is hereby withdrawn** and claim [7] hereby rejoined and fully examined for patentability under [37 CFR 1.104](#). In view of the withdrawal of the restriction requirement, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. Where the elected invention is directed to a product and previously nonelected process claims are rejoined, form paragraph 8.43 should be used instead of this paragraph.
2. This form paragraph should be used whenever ALL previously withdrawn claims depend from or otherwise require all the limitations of an allowable claim (e.g., a generic claim, linking claim, or subcombination claim) and wherein the non-elected claims have NOT been canceled. Use form paragraph 8.46, 8.47, or 8.47.01 as appropriate where the nonelected claims HAVE BEEN canceled. Use form paragraph 8.49 or 8.50 as appropriate when the elected invention is allowable and the restriction requirement is withdrawn at least in part.
3. In bracket 2, insert the number(s) of the rejoined claim(s) followed by either -- is-- or -- are--.
4. In bracket 3 insert-- requires-- or -- require--.
5. In bracket 4, insert either --between-- or --among--.
6. In bracket 5, insert the group(s), species, or subject matter of the invention(s) being rejoined.
7. In bracket 7, insert the number(s) of the rejoined claim(s) followed by either --is-- or --are--.

¶ 8.46 Elected Invention Allowable, Non-elected Claims Canceled, Other Issues Remain Outstanding

Claim [1] allowable. The restriction requirement [2] inventions [3], as set forth in the Office action mailed on [4], has been reconsidered in view of the allowability of claims to the elected invention pursuant to [MPEP § 821.04\(a\)](#). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim [5], which required all the limitations of an allowable claim, previously withdrawn from consideration as a result of the restriction requirement, [6] canceled by applicant in the reply filed on [7]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in a timely filed amendment in reply to this action. Upon entry of the amendment, such amended claim(s) will be examined for patentability under [37 CFR 1.104](#).

In view of the withdrawal of the restriction requirement as set forth above, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. This form paragraph is applicable where a restriction requirement was made between related product inventions or between related process inventions. See [MPEP § 806.05\(j\)](#) and § 821.04(a).
2. This form paragraph (or form paragraph 8.47 or 8.47.01) **must** be used upon the allowance of a linking claim, generic claim, or subcombination claim following a restriction requirement with at least one of these claim types present and wherein the non-elected claims requiring all the limitations of an allowable claim HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled and all previously withdrawn claims are rejoined. Use form paragraph 8.49 or 8.50 as appropriate when the elected invention is allowable and the restriction requirement is withdrawn at least in part.
3. If no issues remain outstanding and application is otherwise ready for allowance, use form paragraph 8.47 or 8.47.01 instead of this form paragraph.
4. In bracket 2, insert either --between-- or --among--.
5. In bracket 3, insert the group(s), species, or subject matter of the invention(s) that were restricted.

6. In bracket 5, insert the number of each claim that required all the limitations of an allowable claim but was canceled as a result of the restriction requirement.

7. In bracket 6, insert either --was-- or --were--.

¶ 8.47 Elected Invention Allowable, Non-elected Claims Canceled, Before Final Rejection, No Outstanding Issues Remaining

Claim [1] allowable. The restriction requirement [2] inventions [3], as set forth in the Office action mailed on [4], has been reconsidered in view of the allowability of claims to the elected invention pursuant to [MPEP § 821.04\(a\)](#). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim [5], which required all the limitations of an allowable claim, previously withdrawn from consideration as a result of the restriction requirement, [6] canceled by applicant in the reply filed on [7]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in an amendment, limited to the addition of such claim(s), filed within a time period of ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Upon entry of the amendment, such amended claim(s) will be examined for patentability under [37 CFR 1.104](#). If NO such amendment is submitted within the set time period, the application will be passed to issue. PROSECUTION ON THE MERITS IS OTHERWISE CLOSED.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. This form paragraph is applicable where a restriction requirement was made between related product inventions or between related process inventions and the application has not been finally rejected. See [MPEP § 806.05\(j\)](#) and § [821.04\(a\)](#). After final rejection, use form paragraph 8.47.01 instead of this form paragraph.
2. This form paragraph (or form paragraph 8.46 or 8.47.01) **must** be used upon the allowance of a linking claim, generic claim, or subcombination claim following

a restriction requirement with at least one of these claim types present and wherein the non-elected claims requiring all the limitations of an allowable claim HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled and all previously withdrawn claims are rejoined. Use form paragraph 8.49 or 8.50 as appropriate when the elected invention is allowable and the restriction requirement is withdrawn at least in part.

3. This form paragraph should be used only when there are no outstanding issues remaining and is to be used with only a PTO-90C cover sheet.
4. In bracket 2, insert either --between-- or --among--.
5. In bracket 3, insert the group(s), species, or subject matter of the invention(s) that were restricted.
6. In bracket 5, insert the number of each claim that required all the limitations of an allowable claim but was canceled as a result of the restriction requirement.
7. In bracket 6, insert either --was-- or --were--.

¶ 8.47.01 *Elected Invention Allowable, Non-elected Claims Canceled, After Final Rejection, No Outstanding Issues Remaining*

Claim [1] allowable. The restriction requirement [2] inventions [3], as set forth in the Office action mailed on [4], has been reconsidered in view of the allowability of claims to the elected invention pursuant to [MPEP § 821.04\(a\)](#). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** In view of the withdrawal of the restriction requirement as set forth above, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. This form paragraph is applicable where a restriction requirement was made between related product inventions or between related process inventions and the application has been finally rejected. See [MPEP § 806.05\(j\)](#) and [§ 821.04\(a\)](#). Before final rejection, use form paragraph 8.47 instead of this form paragraph.
2. This form paragraph (or form paragraph 8.46) **must** be used upon the allowance of a linking claim, generic

claim, or subcombination claim following a restriction requirement with at least one of these claim types present and wherein the non-elected claims requiring all the limitations of an allowable claim HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled and all previously withdrawn claims are rejoined. Use form paragraph 8.49 or 8.50 as appropriate when the elected invention is allowable and the restriction requirement is withdrawn at least in part.

3. This form paragraph should be used only when there are no outstanding issues remaining and is to be used with only a PTO-90C cover sheet.
4. In bracket 2, insert either --between-- or --among--.
5. In bracket 3, insert the group(s), species, or subject matter of the invention(s) that were restricted.

¶ 8.49 *Elected Invention Allowable, Claims Stand Withdrawn as Not In Required Form*

Claim [1] allowable. The restriction requirement [2], as set forth in the Office action mailed on [3], has been reconsidered in view of the allowability of claims to the elected invention pursuant to [MPEP § 821.04\(a\)](#). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim [4], directed to [5] withdrawn from further consideration because [6] require all the limitations of an allowable generic linking claim as required by [37 CFR 1.141](#).

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. This form paragraph is applicable where a restriction requirement was made between related product inventions or between related process inventions. See [MPEP § 806.05\(j\)](#) and [§ 821.04\(a\)](#).
2. This form paragraph (or form paragraph 8.50) should be used upon the allowance of a linking claim, generic claim, or subcombination claim when none of the nonelected claims require all the limitations of an allowable claim.

3. In bracket 2, insert -- between-- or --among-- followed by identification of the inventions (i.e., groups or species) restricted.

4. In bracket 5, insert the subject matter of the claimed invention or species not being rejoined followed by -- remains-- or --remain--.

5. In bracket 6, insert --it does not-- or --they do not all--.

¶ 8.50 *Elected Invention Allowable, Some Claims No Longer Considered Withdrawn*

Claim [1] allowable. The restriction requirement [2], as set forth in the Office action mailed on [3], has been reconsidered in view of the allowability of claims to the elected invention pursuant to [MPEP § 821.04\(a\)](#). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claim [4], directed to [5] no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim. However, claim [6], directed to [7] withdrawn from consideration because [8] require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of [35 U.S.C. 121](#) are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also [MPEP § 804.01](#).

Examiner Note:

1. This form paragraph is applicable where a restriction requirement was made between related product inventions or between related process inventions. See [MPEP § 806.05\(j\)](#) and [§ 821.04\(a\)](#).

2. This form paragraph should be used upon the allowance of a linking claim, generic claim, or subcombination claim when, some, but not all, of the nonelected claims require all the limitations of an allowable claim.

3. In bracket 2, insert -- between-- or --among-- followed by identification of the inventions (i.e., groups or species) restricted.

4. In bracket 5, insert the subject matter of the claimed invention or species being rejoined followed by either -- is-- or -- are--.

5. In bracket 7, insert the subject matter of the claimed invention or species not being rejoined followed by -- remains-- or --remain--.

6. In bracket 8, insert --it does not-- or --they do not all--.

7. If all of the claims are in proper form, i.e., they include all the limitations of an allowable claim, one of form paragraphs 8.45, 8.46 or 8.47 must be used.

Chapter 1000 - Matters Decided by Various U.S. Patent and Trademark Office Officials

¶ 10.01 Withdrawal From Issue, Fee Not Paid

In re Application of [1]: Appl. No.: [2]:
WITHDRAWAL FROM ISSUE Filed: [3]: [37 CFR 1.313](#) For: [4]:

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to [37 CFR 1.313](#).

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

U.S. Patent and Trademark Office records reveal that the issue fee and the publication fee have not been paid. If the issue fee and the publication fee have been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Fee(s) Due, applicant may request that the previously submitted issue fee and publication fee be applied toward payment of the issue fee and publication fee in the amount identified on the new Notice of Allowance and Fee(s) Due. If the application is abandoned, applicant may request either a refund or a credit to a specified Deposit Account.

The application is being forwarded to the examiner for action.

[5]

Director,

Technology Center [6]

[7]

Examiner Note:

1. This letter is printed with the USPTO letterhead and must be signed by the TC Director.
2. DO NOT use this form letter if the issue fee and publication fee have been paid.
3. In bracket 7, insert the correspondence address of record.

¶ 10.13 Petition Under 37 CFR 1.324, Granted

In re Patent No. [1]: Issue Date: [2]: **DECISION** Appl. No.: [3]: **GRANTING** Filed: [4]: **PETITION** For: [5]: [37 CFR 1.324](#)

This is a decision on the petition filed [6] to correct inventorship under [37 CFR 1.324](#).

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

[7]

Supervisory Patent Examiner,

Art Unit [8],

Technology Center [9]

[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. In bracket 10, insert the correspondence address of record.
3. This form paragraph is printed with the USPTO letterhead.
4. Prepare Certificate using form paragraph 10.15.

¶ 10.14 Treatment of Request Under 37 CFR 1.48 Petition Under 37 CFR 1.324, Petition Granted

In re Patent No. [1]: Issue Date: [2]: **DECISION** Appl. No.: [3]: **GRANTING** Filed: [4]: **PETITION** For: [5]: [37 CFR 1.324](#)

This is a decision on the request under [37 CFR 1.48](#), filed [6]. In view of the fact that the patent has already issued, the request under 37 CFR [1.48](#) has been treated as a petition to correct inventorship under [37 CFR 1.324](#).

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

[7]

Supervisory Patent Examiner,

Art Unit [8],

Technology Center [9]

[10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. This form paragraph is printed with the USPTO letterhead.
3. Prepare Certificate using form paragraph 10.15.
4. In bracket 10, insert the correspondence address of record.

¶ 10.15 Memorandum - Certificate of Correction (Inventorship)

DATE: [1]TO: Certificates of Correction BranchFROM: [2], SPE, Art Unit [3]SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

[5], SPE

Art Unit [6]

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. [7]Patented: [8]

On petition requesting issuance of a certificate for correction of inventorship pursuant to [35 U.S.C. 256](#), it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

[9]

[10], Supervisory Patent Examiner

Art Unit [11]

Examiner Note:

1. In bracket 9, insert the full name and residence (City, State) of each actual inventor.
2. This is an internal memo, not to be mailed to applicant, which accompanies the patented file to Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.
3. In brackets 5 and 10, insert name of SPE; in brackets 6 and 11 the Art Unit and sign above each line.
4. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

¶ 10.16 Petition Under 37 CFR 1.324, Dismissed

In re Patent No. [1] : Issue Date: [2] : **DECISION** Appl. No.: [3] : **DISMISSING** Filed: [4] : **PETITION** For: [5] : [37 CFR 1.324](#)

This is a decision on the petition filed [6] to correct inventorship under [37 CFR 1.324](#).

The petition is dismissed.

A petition to correct inventorship as provided by [37 CFR 1.324](#) requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)" agreeing to the change of inventorship in the patent; such statement must comply with the requirements of [37 CFR 3.73\(b\)](#); and (4) the fee set forth in [37 CFR 1.20\(b\)](#). This petition lacks item(s) [7].

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. If each of the four specified items has been submitted but one or more is insufficient, the petition should be denied. See paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.

2. If the petition includes a request for suspension of the rules ([37 CFR 1.183](#)) of one or more provisions of [37 CFR 1.324](#) that are required by the statute ([35 U.S.C. 256](#)), form paragraph 10.18 should follow this form paragraph.

3. In bracket 7, pluralize as necessary and insert the item number(s) which are missing.

4. In bracket 11, insert correspondence address of record.

5. This form paragraph is printed with the USPTO letterhead.

¶ 10.17 Petition Under 37 CFR 1.324, Denied

In re Patent No. [1]: Issue Date: [2]:**DECISION DENYING PETITION** Appl. No.: [3]: [37 CFR 1.324](#) Filed: [4]: For: [5]:

This is a decision on the petition filed [6] to correct inventorship under [37 CFR 1.324](#).

The petition is denied.

[7]

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. In bracket 7, a full explanation of the deficiency must be provided.

2. If the petition lacks one or more of the required parts set forth in [37 CFR 1.324](#), it should be dismissed using form paragraph 10.14 or 10.20, rather than being denied.

3. In bracket 11, insert correspondence address of record.

4. This form paragraph is printed with the USPTO letterhead.

¶ 10.18 Waiver of Requirements of 37 CFR 1.324 Under 37 CFR 1.183, Dismissed

Suspension of the rules under [37 CFR 1.183](#) may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, [35 U.S.C. 256](#) requires [1]. Accordingly, the petition under [37 CFR 1.183](#) is dismissed as moot.

Examiner Note:

1. This form paragraph should follow form paragraph 10.16 whenever the petition requests waiver of one or more of the provisions of 37 CFR [1.324](#) that are also requirements of 35 U.S.C. [256](#).

2. If the petition requests waiver of requirements of 37 CFR [1.324](#) that are not specific requirements of the statute (i.e., the fee or the oath or declaration by all inventors), the application must be forwarded to a petitions attorney in the Office of the Deputy Commissioner for Patent Examination Policy for decision.

¶ 10.19 Memorandum - Certificate of Correction (Cross-Reference to Other Reissues in Family)

DATE: [1]

TO: Certificates of Correction Branch

FROM: [2], SPE, Art Unit [3]

SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

[5], SPE

Art Unit [6]

UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE

Patent No. [7]

Patented: [8]

The present reissue patent issued from an application that is one of a family of divisional reissue applications resulting from Patent No. [9]. The present reissue patent has issued without the cross reference to the other reissue application(s) of the family which is required pursuant to 37 CFR 1.177(a). Accordingly, insert in the first sentence of the specification as follows:

Notice: More than one reissue application has been filed for the reissue of patent [9]. The reissue applications are [10].

[11], Supervisory Patent Examiner

Art Unit [12]

Examiner Note:

- 1 In bracket 9, insert the patent number of the patent for which multiple reissue divisional applications have been filed.
- 2 This is an internal memo and must not be mailed to the applicant. This memo should accompany the patented file to the Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.
- 3 In brackets 5 and 11, insert the name of SPE and provide the signature of the SPE above each line.
- 4 In brackets 6 and 12, insert the Art Unit number.

5. Two separate pages of USPTO letterhead will be printed when using this form paragraph.
6. In bracket 10, identify each of the reissue applications (including the present application) and their relationship within the family of reissue applications, and to the original patent.

¶ 10.20 *Petition or Request Dismissed, Proper Fee Not Submitted*

Applicant's petition or request under 37 CFR [1] filed [2] is DISMISSED because the proper petition or processing fee of [3] required under [37 CFR 1.17](#) has not been submitted.

Examiner Note:

1. Requests under [37 CFR 1.48](#) for correcting inventorship require a fee as set forth in [37 CFR 1.17\(i\)](#).
2. Petitions to suspend action under [37 CFR 1.103\(a\)](#) require a fee as set forth in [37 CFR 1.17\(g\)](#).
3. Petitions to withdraw an application from issue under [37 CFR 1.313](#) require a fee as set forth in [37 CFR 1.17\(h\)](#).
4. Petitions for an extension of time under [37 CFR 1.136\(a\)](#) require varying fees. See [37 CFR 1.17\(a\)\(1\)-\(5\)](#).
5. Requests to suspend action under [37 CFR 1.103\(b\)](#) or (c) require a fee set forth in [37 CFR 1.17\(i\)](#).
6. Requests to defer examination under [37 CFR 1.103\(d\)](#) require a fee set forth in [37 CFR 1.17\(i\)](#) and publication fee set forth in [37 CFR 1.18\(d\)](#).

Chapter 1200 - Appeal

¶ 12.109.01 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR [41.37](#)(a)(1), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR [1.197](#)(b).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH OR THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under 37 CFR [1.136](#).

Examiner Note:

1. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP § [1215.04](#).
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See MPEP § [1215.04](#).

¶ 12.110 Extension To File Brief - Granted

The request for an extension of time under 37 CFR [1.136](#)(b) for filing the appeal brief under 37 CFR [41.37](#) filed on [1] has been **approved** for [2].

Examiner Note:

1. In bracket 2, insert the amount of time the extension of time has been approved for.
2. This form paragraph should only be used when 37 CFR [1.136](#)(a) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in 37 CFR [41.39](#)(b) and [41.50](#)(a)(2).

¶ 12.111 Extension To File Brief - Denied

The request for an extension of time under 37 CFR [1.136](#)(b) for filing the appeal brief under 37 CFR [41.37](#)

filed on [1] has been **disapproved** because no sufficient cause for the extension has been shown.

Examiner Note:

This form paragraph should only be used when 37 CFR [1.136](#)(a) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in 37 CFR [41.39](#)(b) and [41.50](#)(a)(2).

¶ 12.119 Amendment After Board Decision, Entry Refused

The amendment filed [1] after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR [41.50](#)(c). As provided in 37 CFR [1.198](#), prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of 37 CFR [1.114](#) (request for continued examination) or 37 CFR [41.50](#) without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.
2. This form paragraph is not to be used where a 37 CFR [41.50](#)(b) rejection has been made by the Board of Patent Appeals and Interferences.

¶ 12.119.01 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (No Allowed Claim)

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. There are no allowed claims in the application. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form to avoid ABANDONMENT of the application. NO EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) WILL BE GRANTED. Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).

2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).

¶ 12.119.02 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (At Least One Allowed Claim)

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form. NO EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) WILL BE GRANTED. Failure to comply will result in cancellation of the dependent claims and the application will be allowed with claim(s) [3]. Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).
3. In bracket 3, enter the claim number(s) of the allowed claims.

¶ 12.120 Period For Seeking Court Review Has Lapsed

The period under 37 CFR [1.304](#) for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see [37 CFR 1.197\(b\)](#).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#).

Examiner Note:

1. In bracket 1, enter the date of the decision.
2. In bracket 2, identify the allowed claims.
3. In bracket 3, identify the formal matters that need correction.

¶ 12.121 Withdrawal of Appeal as to Some of the Claims on Appeal

The withdrawal of the appeal as to claims [1] operates as an authorization to cancel these claims from the application or reexamination proceeding. See [MPEP § 1215.03](#). Accordingly, these claims are canceled.

Examiner Note:

1. In bracket 1, insert the claim numbers of the claims that were withdrawn from appeal.

¶ 12.149 Examiner's Answer Cover Sheet

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Application Number: [1]

Filing Date: [2]

Appellant(s): [3]

[4]

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed [5] appealing from the Office action mailed [6].

Examiner Note:

1. This form paragraph is printed with the USPTO letterhead.
2. In bracket 1, insert the application number of the appealed application.
3. In bracket 2, insert the filing date of the appealed application.
4. In bracket 3, insert the name(s) of the appellant.
5. In bracket 4, insert the name of the registered representative of the appellant.
6. In bracket 5, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.
7. In bracket 6, indicate the date on which the Office action being appealed was mailed.

8. Form paragraphs 12.149 to 12.179.01, as appropriate, should be used if the appeal brief was filed on or after September 13, 2004.

¶ 12.150.01 *Real Party in Interest*

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

¶ 12.150.04 *Related Appeals and Interferences*

(2) Related Appeals and Interferences

Examiner Note:

Follow this form paragraph with form paragraph 12.150.05 or 12.150.06.

¶ 12.150.05 *Identification of the Related Appeals and Interferences*

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Examiner Note:

1. Follow this form paragraph with an identification by application, patent, appeal or interference number of all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

2. Include a copy of all court and Board decisions identified in this section in a related proceeding(s) appendix using form paragraphs 12.162 and 12.162.02.

¶ 12.150.06 *No Related Appeals and Interferences Identified*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

¶ 12.151 *Status of Claims*

(3) Status of Claims

Examiner Note:

Follow this form paragraph with form paragraph 12.151.01.

¶ 12.151.01 *List of Rejected Claims That Are Pending*

The following is a list of claims that are rejected and pending in the application: [1].

Examiner Note:

In bracket 1, list all the claims that are rejected and pending in the application, including any claims that are rejected but were omitted from the appellant's listing (if any) of appealed claims in the Notice of Appeal. Do not list claims which are no longer rejected.

¶ 12.152 *Status of Amendments After Final*

(4) Status of Amendments After Final

Examiner Note:

Follow this form paragraph with form paragraph 12.152.01.

¶ 12.152.01 *No Comment on Appellant's Statement of Status of Amendments*

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

¶ 12.153 *Summary of Claimed Subject Matter*

(5) Summary of Claimed Subject Matter

Examiner Note:

Follow this form paragraph with form paragraph 12.153.01.

¶ 12.153.01 *No Comment on Appellant's Statement of the Summary of Claimed Subject Matter*

The examiner has no comment on the summary of claimed subject matter contained in the brief.

¶ 12.154 *Grounds of Rejection to be Reviewed on Appeal*

(6) Grounds of Rejection to be Reviewed on Appeal

Examiner Note:

Follow this form paragraph with form paragraph 12.154.01.

¶ 12.154.01 *Examiner's Statement of Grounds of Rejection*

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner

except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

Examiner Note:

1. Use form paragraph 12.154.04 to introduce any new grounds of rejection.
2. Use form paragraph 12.154.05 to withdraw a ground of rejection previously made in the final Office action or last Office action.

¶ 12.154.04 *New Grounds of Rejection - Heading*

NEW GROUNDS OF REJECTION

[1]

Examiner Note:

1. Any new ground(s) of rejection in the examiner’s answer must be prominently identified (e.g., using this form paragraph) in the following sections of the answer:

(6) *Grounds of Rejection to be Reviewed on Appeal* (form paragraph 12.154) – use this form paragraph in section (6) of the answer to provide a concise statement of each new ground of rejection presented for review in bracket 1; and

(9) *Grounds of Rejection* (form paragraph 12.159) – use this form paragraph in section (9) of the answer to set forth the new grounds of rejection.

2. Conclude an examiner’s answer raising new grounds of rejection with form paragraph 12.179.01: (1) to notify applicant of the response period and options following the new grounds of rejection; and (2) to include the required approval of the TC Director or his/her designee.

¶ 12.154.05 *Withdrawn Rejections*

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. [1].

Examiner Note:

In bracket 1, insert the grounds of rejection that have been withdrawn.

¶ 12.156 *Claims Appendix*

(7) Claims Appendix

Examiner Note:

Follow this form paragraph with form paragraph 12.156.01.

¶ 12.156.01 *No Comment on Appellant’s Claims Appendix*

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

¶ 12.157 *Evidence Relied Upon*

(8) Evidence Relied Upon

Examiner Note:

Follow this form paragraph with either form paragraph 12.157.01 or 12.157.02.

¶ 12.157.01 *No Evidence Relied Upon*

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

¶ 12.157.02 *Listing of Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Examiner Note:

1. Use the following format for providing information on each reference cited:

Number Name Date

2. The following are example formats for listing reference citations:

2,717,847 VERAINE 9-1955

1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963

(Figure 2 labeled as Prior Art in this document)

3. See MPEP § 707.05(e) for additional examples.

¶ 12.159 *Grounds of Rejection*

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner Note:

1. Explain each ground of rejection maintained by the examiner as provided below:

(i) For each rejection under 35 U.S.C. [112](#), first paragraph, the Examiner's Answer shall explain how the first paragraph of 35 U.S.C. [112](#) is not complied with, including, as appropriate, how the specification and drawings, if any, (a) do not describe the subject matter defined by each of the rejected claims, (b) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and (c) do not set forth the best mode contemplated by the appellant of carrying out his/her invention.

(ii) For each rejection under 35 U.S.C. [112](#), second paragraph, the Examiner's Answer shall explain how the claims do not particularly point out and distinctly claim the subject matter which appellant regards as the invention.

(iii) For each rejection under 35 U.S.C. [102](#), the Examiner's Answer shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. [102](#), pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. [103](#), the Examiner's Answer shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection, shall identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference) and shall explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter

(v) For each rejection under 35 U.S.C. [102](#) or [103](#) where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (ii), (iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the specific page, line number, drawing reference number and quotation from the prior art, as appropriate.

(vi) For each rejection, other than those referred to in paragraphs (i) to (v) for this section, the Examiner's Answer shall specifically explain the basis for the particular rejection.

2. If there are any new grounds of rejection, use form paragraph 12.154.04 to provide a prominent heading and use form paragraph 12.179.01 instead of form paragraph 12.179 to conclude the examiner's answer.

¶ *12.161 Response to Argument*

(10) Response to Argument

Examiner Note:

1. If an issue raised by appellant was fully responded to under the "Grounds of Rejection to be Reviewed on Appeal" portion, no additional response is required here.

2. If an issue has been raised by appellant that was not fully responded to under "Grounds of Rejection to be Reviewed on Appeal," a full response must be provided after this form paragraph.

¶ *12.162 Related Proceeding(s) Appendix*

(11) Related Proceeding(s) Appendix

Examiner Note:

Follow this form paragraph with either form paragraph 12.162.01 or 12.162.02.

¶ *12.162.01 No Related Proceeding Identified*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

¶ *12.162.02 Copies Related to Proceeding*

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

¶ *12.163 Request to Present Oral Arguments*

The examiner requests the opportunity to present arguments at the oral hearing.

Examiner Note:

1. Use this form paragraph only if an oral hearing has been requested by appellant and the primary examiner intends to present an oral argument.

2. This form paragraph must be included as a separate letter on a form PTOL-90.

¶ *12.179 Conclusion to Examiner's Answer, No New Grounds of Rejection*

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

[1]

Conferees:

[2]

[3]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert names of the conferees. The conferees must also place their initials next to their names.
3. In bracket 3, insert correspondence address of record.
4. If the examiner's answer includes a new ground of rejection, use form paragraph 12.179.01 instead of this form paragraph.

¶ 12.179.01 Conclusion to Examiner's Answer Raising New Grounds of Rejection

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

- (1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR [1.111](#) with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR [41.39](#)(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.
- (2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR [41.41](#). Such a reply brief must address each new ground of rejection as set forth in 37 CFR [41.37](#)(c)(1)(vii) and should be in compliance with the other requirements of

37 CFR [41.37](#)(c). If a reply brief filed pursuant to 37 CFR [41.39](#)(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR [41.39](#)(b)(1).

Extensions of time under 37 CFR [1.136](#)(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR [1.136](#)(b) for extensions of time to reply for patent applications and 37 CFR [1.550](#)(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

[1]

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

[2]

Conferees:

[3]

[4]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert TC Director's or designee's signature. All new grounds of rejection must be approved by a TC Director or designee.
3. In bracket 3, insert names of the conferees. The conferees must also place their initials next to their names.
4. In bracket 4, insert correspondence address of record.

¶ 12.179.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection. Under 37 CFR [41.39](#)(b), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR [1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR [41.41](#), addressing

each new ground of rejection, to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.39](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

¶ 12.181 Acknowledgment of Reply Brief

The reply brief filed [1] has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. In bracket 1, insert the date on which the reply brief was filed.
2. Use this form paragraph to notify the appellant under [37 CFR 41.43\(a\)\(1\)](#) that a reply brief has been received and entered.
3. This form paragraph is to be printed on a blank page for attachment to a PTOL-90 or PTO-90C.
4. Include form paragraph 12.184 after this paragraph to include a supplemental examiner's answer under [37 CFR 41.43\(a\)\(1\)](#) responding to any new issue raised in the reply brief.

¶ 12.182 Reply Brief Not Considered

The reply brief filed on [1] has not been considered because it is not in compliance with [37 CFR 41.41\(a\)](#). The reply brief [2].

Examiner Note:

1. In bracket 1, insert the date on which the reply brief was filed.

2. In bracket 2, insert the reasoning. For example, insert "was not filed within the non-extendable time period set in [37 CFR 41.41\(a\)\(1\)](#)" or insert "included a new or non-admitted amendment or new or non-admitted affidavit or other evidence".

3. Use this form paragraph to notify the appellant under [37 CFR 41.41\(b\)](#) that a reply brief is not being considered because it is not in compliance with [37 CFR 41.41\(a\)](#).

¶ 12.184 Supplemental Examiner's Answer - No option to Reopen Prosecution

Responsive to [1] on [2], a supplemental Examiner's Answer is set forth below: [3].

Appellant may file another reply brief in compliance with [37 CFR 41.41](#) within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to this two month time period. See [37 CFR 41.43\(b\)-\(c\)](#).

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[4]

Examiner Note:

1. In bracket 1, insert the reason the supplemental examiner's answer is being prepared, e.g., "the remand under [37 CFR 41.50\(a\)\(1\)](#) for reasons other than for further consideration of a rejection", or "the reply brief under [37 CFR 41.41](#) filed".
2. In bracket 2, insert the date of remand or the date the reply brief was filed.
3. In bracket 3, provide the supplemental examiner's answer (e.g., pursuant to [37 CFR 41.43\(a\)](#)), without raising any new grounds of rejection.
4. In bracket 4, insert the TC Director's or designee's signature. A TC Director or designee must approve every supplemental examiner's answer.

¶ 12.185 Supplemental Examiner's Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION

Pursuant to the remand under [37 CFR 41.50\(a\)\(1\)](#) by the Board of Patent Appeals and Interferences on [1] **for further consideration of a rejection**, a supplemental Examiner's Answer under [37 CFR 41.50\(a\)\(2\)](#) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR [1.111](#) with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR [41.50](#)(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR [41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR [41.50](#)(a)(2)(i). See 37 CFR [41.50](#)(a)(2)(ii).

Extensions of time under 37 CFR [1.136](#)(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR [1.136](#)(b) for extensions of time to reply for patent applications and 37 CFR [1.550](#)(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[3]

Examiner Note:

1. In bracket 1, insert the date of the remand.
2. In bracket 2, provide reasons supporting the rejections set forth in the supplemental Examiner's Answer.
3. In bracket 3, insert the TC Director's or designee's signature. A TC Director or designee must approve every supplemental examiner's answer.

¶ 12.186 Dismissal Following A Supplemental Examiner's Answer Written in Response to a Remand for Further Consideration of a Rejection

Appellant failed to timely respond to the supplemental examiner's answer mailed on [1] that was written in response to a remand by the Board for further consideration of a rejection. Under 37 CFR [41.50](#)(a)(2), appellant must, within two months from the date of the

supplemental examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under 37 CFR [1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under 37 CFR [41.41](#), to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by 37 CFR [41.50](#)(a)(2), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the supplemental examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the rejection for which the Board has remanded the proceeding.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the rejection.

¶ 12.187 Reopening of Prosecution After Appeal Brief or Reply Brief

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:

- (1) 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,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR [41.31](#) followed by an appeal brief under 37 CFR [41.37](#). **The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.**

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

[4]

Examiner Note:

1. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.
2. In bracket 2, insert the date on which the brief was filed.
3. In bracket 3, insert --A new ground of rejection is-- or --New grounds of rejection are--.
4. In bracket 4, insert the SPE's signature. Approval of the SPE is required to reopen prosecution after an appeal. See MPEP §§ [1002.02\(d\)](#) and [1207.04](#).
5. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims. The Office action following a reopening of prosecution may be made final if all new grounds of rejection were either (A) necessitated by amendment or (B) based on information presented in an information disclosure statement under 37 CFR [1.97\(c\)](#) where no statement under 37 CFR [1.97\(e\)](#) was filed. See MPEP § [706.07\(a\)](#).

¶ *12.209 Appeal Dismissed - Allowed Claims, Formal Matters Remaining*

In view of applicant's failure to file a brief within the time prescribed by [37 CFR 41.37\(a\)\(1\)](#), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See [37 CFR 1.197\(b\)](#).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#)

Examiner Note:

1. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See [MPEP § 1215.04](#).
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See [MPEP § 1215.04](#).

¶ *12.210 Extension To File Brief - Granted*

The request for an extension of time under [37 CFR 1.136\(b\)](#) for filing the appeal brief under [37 CFR 41.37](#) filed on [1] has been **approved** for [2].

Examiner Note:

1. In bracket 2, insert the amount of time the extension of time has been approved for.
2. This form paragraph should only be used when [37 CFR 1.136\(a\)](#) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in [37 CFR 41.39\(b\)](#) and [37 CFR 41.50\(a\)\(2\)](#).

¶ *12.211 Extension To File Brief - Denied*

The request for an extension of time under [37 CFR 1.136\(b\)](#) for filing the appeal brief under [37 CFR 41.37](#) filed on [1] has been **disapproved** because no sufficient cause for the extension has been shown.

Examiner Note:

This form paragraph should only be used when [37 CFR 1.136\(a\)](#) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in [37 CFR 41.39\(b\)](#) and [37 CFR 41.50\(a\)\(2\)](#).

¶ *12.239 Reopening of Prosecution After Appeal Brief*

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:

- (1) 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,
- (2) initiate a new appeal by filing a notice of appeal under [37 CFR 41.31](#) followed by an appeal brief under [37 CFR 41.37](#). The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in [37 CFR 41.20](#) have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

[4]

Examiner Note:

1. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.
2. In bracket 2, insert the date on which the brief was filed.
3. In bracket 3, insert --A new ground of rejection is-- or --New grounds of rejection are--.
4. In bracket 4, insert the SPE's signature. Approval of the SPE is required to reopen prosecution after an appeal. See MPEP §§ [1002.02\(d\)](#) and [1207.04](#).
5. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims. The Office action following a reopening of prosecution may be made final if all new grounds of rejection were either (A) necessitated by amendment or (B) based on information presented in an information disclosure statement under [37 CFR 1.97\(c\)](#) where no statement under [37 CFR 1.97\(e\)](#) was filed. See [MPEP § 706.07\(a\)](#).

¶ 12.249 Examiner's Answer Cover Sheet

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Application Number: [1]

Filing Date: [2]

Appellant(s): [3]

[4]

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed [5].

Examiner Note:

1. This form paragraph is printed with the USPTO letterhead.
2. In bracket 1, insert the application number of the appealed application.
3. In bracket 2, insert the filing date of the appealed application.
4. In bracket 3, insert the name(s) of the appellant.
5. In bracket 4, insert the name of the registered representative of the appellant.

6. In bracket 5, indicate the date on which the brief was filed.

¶ 12.254 Grounds of Rejection to be Reviewed on Appeal

(1) Grounds of Rejection to be Reviewed on Appeal

Examiner Note:

Follow this form paragraph with form paragraph 12.254.01 or 12.254.02.

¶ 12.254.01 Statement of Grounds of Rejection, not modified

Every ground of rejection set forth in the Office action dated [1] from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

Examiner Note:

1. In bracket 1, insert the mailing date of the Office action from which the appeal is being taken.
2. Use form paragraph 12.255 to restate the grounds of rejection and supporting rationale for each rejection involved in the appeal, when needed.
3. Use form paragraph 12.256 to introduce any new grounds of rejection.
4. Use form paragraph 12.257 to withdraw a ground of rejection previously made in the final Office action or last Office action.
5. Use this form paragraph when there was no modification made to the grounds of rejection in an advisory action or pre-appeal conference decision.

¶ 12.254.02 Statement of Grounds of Rejection, modified

The ground(s) of rejection set forth in the Office action dated [1] from which the appeal is taken have been modified by the [2] dated [3]. A list of rejections withdrawn by the examiner (if any) is included under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

Examiner Note:

1. In bracket 1, insert the mailing date of the Office action from which the appeal is being taken.
2. In bracket 2, insert --advisory action-- and/or --pre-appeal brief conference decision--.
3. In bracket 3, insert the mailing date of the advisory action and/or pre-appeal brief conference decision--.

4. Use form paragraph 12.255 to restate the grounds of rejection and supporting rationale for each rejection involved in the appeal, when needed.
5. Use form paragraph 12.256 to introduce any new grounds of rejection.
6. Use form paragraph 12.257 to withdraw a ground of rejection previously made in the final Office action or last Office action.
7. Use this form paragraph when the grounds of rejection were modified in an advisory action or pre-appeal brief conference decision.

¶ 12.255 *Restatement of Rejection*

The following ground(s) of rejection are applicable to the appealed claims.

[1]

Examiner Note:

1. Precede this form paragraph with either 12.254.01 or 12.254.02.
2. Use this form paragraph to optionally include a statement of rejection and/or supporting rationale for every ground of rejection involved in the appeal.
3. Only use this form paragraph when the restatement of the rejection does not include any new ground(s) of rejection.
4. In bracket 1, explain each ground of rejection maintained by the examiner.

¶ 12.256 *New Grounds of Rejection - Heading*

NEW GROUNDS OF REJECTION

[1]

Examiner Note:

1. Any new ground(s) of rejection in the examiner's answer must be prominently identified (e.g., using this form paragraph).
2. Provide a concise statement of each new ground of rejection presented for review in bracket 1; and
3. Conclude an examiner's answer raising new grounds of rejection with form paragraph 12.279.01: (1) to notify applicant of the reply period and options following the new grounds of rejection; and (2) to include the required approval of the TC Director or his/her designee.

¶ 12.257 *Withdrawn Rejections*

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. [1].

Examiner Note:

In bracket 1, insert the grounds of rejection that have been withdrawn.

¶ 12.261 *Response to Argument*

(2) Response to Argument

Examiner Note:

1. If an issue raised by appellant was fully responded to under the "Grounds of Rejection to be Reviewed on Appeal" portion, no additional response is required here.
2. If an issue has been raised by appellant that was not fully responded to under "Grounds of Rejection to be Reviewed on Appeal," a full response must be provided after this form paragraph.

¶ 12.279 *Conclusion to Examiner's Answer, No New Grounds of Rejection*

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

[1]

Conferees:

[2]

[3]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert names of the conferees. The conferees must also place their initials next to their names.
3. In bracket 3, insert correspondence address of record.
4. If the examiner's answer includes a new ground of rejection, use form paragraph 12.279.01 instead of this form paragraph.

¶ 12.279.01 *Conclusion to Examiner's Answer Raising New Grounds of Rejection*

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (I) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under [37 CFR 1.111](#) with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with [37 CFR 41.39\(b\)\(1\)](#) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in [37 CFR 41.41](#). Such a reply brief must address each new ground of rejection as set forth in [37 CFR 41.37\(c\)\(1\)](#) and should be in compliance with the other requirements of [37 CFR 41.37\(c\)](#). If a reply brief filed pursuant to [37 CFR 41.39\(b\)\(2\)](#) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under [37 CFR 41.39\(b\)\(1\)](#).

Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to the TWO MONTH time period set forth above. See [37 CFR 1.136\(b\)](#) for extensions of time to reply for patent applications and [37 CFR 1.550\(c\)](#) for extensions of time to reply for *ex parte* reexamination proceedings.

Respectfully submitted,

[1]

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (I) above by signing below:

[2]

Conferees:

[3]

[4]

Examiner Note:

1. In bracket 1, insert initials of the examiner and the date.
2. In bracket 2, insert TC Director's or designee's signature. All new grounds of rejection must be approved by a TC Director or designee.
3. In bracket 3, insert names of the conferees. The conferees must also place their initials next to their names.
4. In bracket 4, insert correspondence address of record.

¶ 12.279.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection. Under [37 CFR 41.39\(b\)](#), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), addressing each new ground of rejection, to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.39](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

¶ 12.279.03 Request to Present Oral Arguments

The examiner requests the opportunity to present arguments at the oral hearing.

Examiner Note:

1. Use this form paragraph only if an oral hearing has been requested by appellant and the primary examiner intends to present an oral argument.

2. This form paragraph must be included as a separate letter on a form PTOL-90.

¶ 12.285 *Supplemental Examiner's Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION*

Pursuant to the remand under [37 CFR 41.50\(a\)\(1\)](#) by the Board of Patent Appeals and Interferences on [1]for **further consideration of a rejection**, a supplemental Examiner's Answer under [37 CFR 41.50\(a\)\(2\)](#) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under [37 CFR 1.111](#) with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See [37 CFR 41.50\(a\)\(2\)\(i\)](#).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in [37 CFR 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#). See [37 CFR 41.50\(a\)\(2\)\(ii\)](#) .

Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to the **TWO MONTH** time period set forth above. See [37 CFR 1.136\(b\)](#) for extensions of time to reply for patent applications and [37 CFR 1.550\(c\)](#) for extensions of time to reply for *ex parte* reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

[3]

Examiner Note:

1. In bracket 1, insert the date of the remand.
2. In bracket 2, provide reasons supporting the rejections set forth in the supplemental Examiner's Answer.
3. In bracket 3, insert the TC Director's or designee's signature. A TC Director or designee must approve every supplemental examiner's answer.

¶ 12.286 *Dismissal Following A Supplemental Examiner's Answer Written in Response to a Remand for Further Consideration of a Rejection*

Appellant failed to timely respond to the supplemental examiner's answer mailed on [1] that was written in response to a remand by the Board for further consideration of a rejection. Under [37 CFR 41.50\(a\)\(2\)](#) , appellant must, within two months from the date of the supplemental examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.50\(a\)\(2\)](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

Examiner Note:

1. In bracket 1, insert the mailing date of the supplemental examiner's answer.
2. In bracket 2, insert the claim numbers of the claims subject to the rejection for which the Board has remanded the proceeding.
3. In bracket 3, insert the claim numbers of the claims that are not subject to the rejection.

¶ 12.291 *Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (No Allowed Claim)*

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. There are no allowed claims in the application. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form to avoid ABANDONMENT of the application. **NO EXTENSIONS OF TIME UNDER [37 CFR 1.136\(a\)](#) WILL BE GRANTED.** Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).

¶ 12.292 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (At Least One Allowed Claim)

The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a ONE MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form. NO EXTENSIONS OF TIME UNDER [37 CFR 1.136](#) WILL BE GRANTED. Failure to comply will result in cancellation of the dependent claims and the application will be allowed with claim(s) [3]. Prosecution is otherwise closed.

Examiner Note:

1. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
2. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).
3. In bracket 3, enter the claim number(s) of the allowed claims.

¶ 12.297 Period For Seeking Court Review Has Lapsed

The period under [37 CFR 1.304](#) for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see [37 CFR 1.197\(b\)](#).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#).

Examiner Note:

1. In bracket 1, enter the date of the decision.
2. In bracket 2, identify the allowed claims.
3. In bracket 3, identify the formal matters that need correction.

¶ 12.298 Amendment After Board Decision, Entry Refused

The amendment filed [1] after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed. As provided in [37 CFR 1.198](#), prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of [37 CFR 1.114](#) (request for continued examination) or [37 CFR 41.50](#) without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.
2. This form paragraph is not to be used where a [37 CFR 41.50\(b\)](#) rejection has been made by the Board of Patent Appeals and Interferences.

Chapter 1300 - Allowance and Issue

¶ 13.01 Requirement for Rewritten Specification

The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See [37 CFR 1.125](#) and [MPEP § 608.01\(q\)](#).

Examiner Note:

1. Specific discussion of the sections of the specification or claims required to be rewritten must be set forth.
2. See form paragraph 6.28.01 for a substitute specification.

¶ 13.02 Formal Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by [37 CFR 1.312](#). To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

This form paragraph is NOT to be used in a reexamination proceeding (use form paragraph 22.06 instead).

¶ 13.02.01 Examiner's Amendment Authorized

Authorization for this examiner's amendment was given in a telephone interview with [1] on [2].

¶ 13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone

An extension of time under [37 CFR 1.136\(a\)](#) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Director to charge Deposit Account No. [4] the required fee of \$ [5] for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by [37 CFR 1.312](#). To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See [MPEP § 706.07\(f\)](#) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

¶ 13.03 Reasons for Allowance

The following is an examiner's statement of reasons for allowance: [1]

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Examiner Note:

1. Do not use this form paragraph in reexamination proceedings, see form paragraph 22.16.
2. In bracket 1, provide a detailed statement of the reason(s) certain claim(s) have been indicated as being allowable or as containing allowable subject matter.

¶ 13.03.01 Reasons for Indication of Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: [1]

Examiner Note:

1. This form paragraph is for use in an Office action prior to allowance of the application. Use form paragraph 13.03 in the Notice of Allowability.
2. In bracket 1, provide a detailed statement of the reason(s) certain claim(s) have been indicated as being allowable or as containing allowable subject matter.

¶ 13.04 Reopen Prosecution - After Notice of Allowance

Prosecution on the merits of this application is reopened on claim [1] considered unpatentable for the reasons indicated below:

[2]

Examiner Note:

1. This paragraph should be used when a rejection is made on any previously allowed claim(s) which for one reason or another is considered unpatentable after the Notice of Allowance (PTOL-85) has been mailed.
2. Make appropriate rejection(s) as in any other action.

3. In bracket 1, identify claim(s) that are considered unpatentable.
4. In bracket 2, state all appropriate rejections for each claim considered unpatentable.

¶ 13.05 Reopen Prosecution - Vacate Notice of Allowance

Applicant is advised that the Notice of Allowance mailed [1] is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Examiner Note:

1. This form paragraph must be used when the prosecution is reopened after the mailing of the Notice of Allowance.
2. In bracket 1, insert date of the Notice of Allowance.

¶ 13.06 Extension of Time by Examiner's Amendment

An extension of time under [37 CFR 1.136\(a\)](#) is required to place this application in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Director to charge Deposit Account No. [4] the required fee of \$ [5] for this extension.

Examiner Note:

1. See [MPEP § 706.07\(f\)](#), item J which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.
2. When an examiner's amendment is also authorized, use form paragraph 13.02.02 instead.

¶ 13.07 Disclosure To Be Limited to Claimed Invention

Applicant is required to modify the brief summary of the invention and to restrict the descriptive matter so that they are confined to and in harmony with the invention to which the allowed claims are directed. See [MPEP § 1302.01](#). For example, [1].

Examiner Note:

An example should be given as to the specific sheets or drawing figures and portions of the specification which should be cancelled. If drawing figures are to be cancelled,

applicant should be reminded that subsequent figures must be renumbered.

¶ 13.08 Disclosed Subject Matter Outside the Bounds of the Claims

The application contains disclosure entirely outside the bounds of the allowed claims. Applicant is required to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims ([MPEP § 1302.01](#)).

¶ 13.09 Information Disclosure Statement, Issue Fee Paid

Applicant's information disclosure statement of [1] was filed after the issue fee was paid. Information disclosure statements filed after payment of the issue fee will not be considered, but will be placed in the file. However, the application may be withdrawn from issue in order to file a request for continued examination (RCE) under 37 CFR [1.114](#) upon the grant of a petition under 37 CFR [1.313\(c\)\(2\)](#), or a continuing application under 37 CFR [1.53\(b\)](#) (or a continued prosecution application (CPA) under 37 CFR [1.53\(d\)](#) if the CPA is for a design patent and the prior application of the CPA is a design application) upon the grant of a petition filed under the provisions of [37 CFR 1.313\(c\)\(3\)](#). Alternatively, the other provisions of [37 CFR 1.313](#) may apply, e.g., a petition to withdraw the application from issue under the provisions of [37 CFR 1.313\(c\)\(1\)](#) may be filed together with an unequivocal statement by the applicant that one or more claims are unpatentable over the information contained in the statement. The information disclosure statement would then be considered upon withdrawal of the application from issue under [37 CFR 1.313\(c\)\(1\)](#).

Examiner Note:

1. For information disclosure statements submitted after the issue fee has been paid, use this form paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the filing date of the IDS.

¶ 13.10 Amendment Filed After the Payment of Issue Fee, Not Entered

Applicant's amendment filed on [1] will not be entered because the amendment was filed after the issue fee was paid. 37 CFR [1.312](#) no longer permits filing an amendment after the date the issue fee has been paid.

Examiner Note:

1. Use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the date of the amendment.

Chapter 1400 - Correction of Patents

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement(s) required under [37 CFR 1.175\(a\)\(1\)](#) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See [37 CFR 1.175\(a\)\(1\)](#) and see [MPEP § 1414.1](#)

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.
2. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of a Specific Error

The reissue oath/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 [MPEP § 1414](#).

Examiner Note:

1. Use this form 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 form 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. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1)-The Identified "Error" Is Not Appropriate Error

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See [37 CFR 1.175\(a\)\(1\)](#) and [MPEP § 1414](#).

Examiner Note:

1. Use this form paragraph when the reissue oath/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. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - Multiple Identified "Errors" Not Appropriate Errors

The reissue oath/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 [MPEP § 1414](#).

Examiner Note:

1. Use this form paragraph when the reissue oath/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/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 form 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. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.04 Defective Reissue Oath/Declaration, 37 CFR 1.175- Lack of Statement of "Without Any Deceptive Intention"

The reissue oath/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/declaration arose without any deceptive intention on the part of the applicant. See [37 CFR 1.175](#) and [MPEP § 1414](#).

Examiner Note:

1. Use this form paragraph when the reissue oath/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 form 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. Form paragraph 14.14 must follow.

¶ *14.01.05 Defective Reissue Oath/Declaration, 37 CFR 1.175 - General*

The reissue oath/declaration filed with this application is defective (see [37 CFR 1.175](#) and [MPEP § 1414](#)) because of the following:

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not comply with [37 CFR 1.175](#), and none of form paragraphs 14.01 - 14.01.04 or 14.05.02 apply.

2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.

3. Form paragraph 14.14 must follow the explanation of the defect.

¶ *14.05.02 Supplemental Oath or Declaration Required Prior to Allowance*

In accordance with [37 CFR 1.175\(b\)\(1\)](#), a supplemental reissue oath/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 above.

Receipt of an appropriate supplemental oath/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/declaration is as follows:

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

See [MPEP § 1414.01](#).

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/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/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/declaration filed in the case; instead allow the case.

5. This form paragraph cannot be used in an *Ex parte Quayle* action to require the supplemental oath/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/declaration must be filed prior to mailing of the Notice of Allowability.

¶ *14.06 Litigation-Related Reissue*

The patent sought to be reissued by this application [1] involved in litigation. Any documents and/or materials which would be material to patentability of this reissue application are required to be made of record in response to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF [37 CFR 1.136\(a\)](#) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Examiner Note:

In bracket 1, insert either —is— or —has been—.

¶ *14.07 Action in Reissue Not Stayed or Suspended — Related Litigation Stayed*

While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF [37 CFR 1.136\(a\)](#) WILL NOT BE PERMITTED.

¶ *14.08 Action in Reissue Not Stayed — Related Litigation Terminated*

Since the litigation related to this reissue application is terminated and final, action in this reissue application will NOT be stayed. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF [37 CFR 1.136\(a\)](#) WILL NOT BE PERMITTED.

¶ *14.09 Action in Reissue Not Stayed — Related Litigation Not Overlapping*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because there are no significant overlapping issues between the application and that litigation. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF [37 CFR 1.136\(a\)](#) WILL NOT BE PERMITTED.

¶ *14.10 Action in Reissue Not Stayed — Applicant’s Request*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant’s request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF [37 CFR 1.136\(a\)](#) WILL NOT BE PERMITTED.

¶ *14.11 Action in Reissue Stayed - Related Litigation*

In view of concurrent litigation, and in order to avoid duplication of effort between the two proceedings, action in this reissue application is STAYED until such time as it is evident to the examiner that (1) a stay of the litigation is in effect, (2) the litigation has been terminated, (3) there are no significant overlapping issues between the application and the litigation, or (4) applicant requests that the application be examined.

¶ *14.11.01 Reminder of Duties Imposed by 37 CFR 1.178(b) and 37 CFR 1.56*

Applicant is reminded of the continuing obligation under [37 CFR 1.178\(b\)](#), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. [1] is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under [37 CFR 1.56](#), to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ [1404](#), [1442.01](#) and [1442.04](#).

Examiner Note:

1. This form paragraph is to be used in the first action in a reissue application.
2. In bracket 1, insert the patent number of the original patent for which reissue is requested.

¶ *14.12 Rejection, 35 U.S.C. 251, Broadened Claims After Two Years*

Claim [1] rejected under [35 U.S.C. 251](#) as being broadened in a reissue application filed outside the two year statutory period. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product 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.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See [MPEP §§ 706.03\(x\)](#) and [1412.03](#).

¶ *14.13 Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee*

Claim [1] rejected under [35 U.S.C. 251](#) as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product 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.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See [MPEP §§ 706.03\(x\)](#) and [1412.03](#).

¶ *14.14 Rejection, Defective Reissue Oath or Declaration*

Claim [1] rejected as being based upon a defective reissue [2] under [35 U.S.C. 251](#) as set forth above. See [37 CFR 1.175](#).

The nature of the defect(s) in the [3] is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See [MPEP § 706.03\(x\)](#).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

¶ *14.15 Consent of Assignee to Reissue Lacking*

This application is objected to under [37 CFR 1.172\(a\)](#) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with [37 CFR 1.172](#). See [MPEP § 1410.01](#).

A proper assent of the assignee in compliance with [37 CFR 1.172](#) and [3.73](#) is required in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If a consent document/statement has been submitted but is insufficient (e.g., not by all the assignees) or is otherwise ineffective (e.g., a conditional consent, or a copy of the consent from the parent reissue application was filed in this continuation reissue application and the parent reissue application is not being abandoned), an explanation of such is to be included following this form paragraph.
3. If the case is otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

¶ *14.16 Failure of Assignee To Establish Ownership*

This application is objected to under [37 CFR 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 CFR 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](#).

An appropriate paper satisfying the requirements of [37 CFR 3.73](#) must be submitted in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

¶ *14.16.01 Establishment of Ownership Not Signed by Appropriate Party*

This application is objected to under [37 CFR 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 CFR 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\(b\)](#)

A proper submission establishing ownership interest in the patent, pursuant to [37 CFR 1.172\(a\)](#), is required in response to this action.

Examiner Note:

1. This form paragraph should be followed: by one of form paragraphs 14.16.02 through 14.16.04, and then optionally by form paragraph 14.16.06.
2. See [MPEP § 1410.01](#).

¶ *14.16.02 Failure To State Capacity To Sign*

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 form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.

¶ *14.16.03 Lack of Capacity To Sign*

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](#).

¶ *14.16.04 Attorney/Agent of Record Signs*

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 or agent 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 form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly sign a submission establishing ownership interest.
3. In bracket 1, insert either --attorney-- or --agent--.

¶ *14.16.06 Criteria To Accept When Signed by a Non-Recognized Officer*

It would be acceptable for a person, other than a recognized officer, to sign a submission establishing ownership interest, provided the record for the application includes a duly signed statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the assignee.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be signed 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 form paragraph **MUST** be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.
2. When one of form paragraphs 14.16.02, 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 form 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.

¶ *14.17 Rejection, 35 U.S.C. 251, Recapture*

Claim[1] rejected under [35 U.S.C. 251](#) as being an impermissible recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See*

North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005);

Pannu v. Storz Instruments Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161

(Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of [35 U.S.C. 251](#), and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See [MPEP § 1412.02](#).

¶ *14.20.01 Amendments To Reissue-37 CFR 1.173(b)*

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR [1.173\(b\)](#). In addition, when any substantive amendment is filed in the reissue application, which amendment otherwise places the reissue application in condition for allowance, a supplemental oath/declaration will be required. See [MPEP § 1414.01](#).

Examiner Note:

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments, and to notify applicant of the need to file a supplemental oath/declaration before the application can be allowed.

¶ *14.21.01 Improper Amendment To Reissue - 37 CFR 1.173(b)*

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR [1.173\(b\)](#), 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 or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

Examiner Note:

1. This form paragraph may be used for any 37 CFR [1.173\(b\)](#) 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 by way of an Advisory Office action.

2. In bracket 2, specify the proposed amendments that are not in compliance.

¶ *14.21.09 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge*

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 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 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.

¶ *14.22 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application*

Claims [1] rejected under [35 U.S.C. 251](#) since error “without any deceptive intention” has not been established. In view of the reply filed on [2], a conclusion that any error was “without deceptive intention” cannot be supported.

[3]

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the filing date of the reply which provides an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide

circumstances why applicant’s statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

¶ *14.22.01 Rejection, 35 U.S.C. 251, New Matter*

Claim [1] rejected under [35 U.S.C. 251](#) as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: [2]

Examiner Note:

1. In bracket 2, fill in the applicable page and line numbers and provide an explanation of your position, as appropriate.
2. A rejection under [35 U.S.C. 112](#), first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon [35 U.S.C. 132](#) using form paragraph 7.28.

¶ *14.23 Terminal Disclaimer Proper*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. If an assignment is submitted to support the terminal disclaimer, also use form paragraph 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See [MPEP § 1490](#) for discussion of requirements for a proper terminal disclaimer.
5. Use form paragraph 14.23.01 for reexamination proceedings.
6. For improper terminal disclaimers, see form paragraphs 14.24 *et seq.*

¶ *14.23.01 Terminal Disclaimer Proper (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is accepted. The terminal disclaimer has been recorded.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. If an assignment is submitted to support the terminal disclaimer, also use 14.34 to suggest that the assignment be separately submitted for recording in the Office.
4. See [MPEP § 1490](#) for discussion of requirements for a proper terminal disclaimer.
5. For improper terminal disclaimers, see the form paragraphs which follow.

¶ *14.24 Terminal Disclaimer Not Proper - Introductory Paragraph*

The terminal disclaimer filed on [1] disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of [37 CFR 3.73](#) and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.
6. Do not use in reexamination proceedings, use form paragraph 14.25 instead.

¶ *14.25 Terminal Disclaimer Not Proper - Introductory Paragraph (Reexamination Only)*

The terminal disclaimer filed on [1] disclaiming the terminal portion of the patent being reexamined which would extend beyond the expiration date of [2] has been reviewed and is NOT accepted.

Examiner Note:

1. In bracket 1, insert the date the terminal disclaimer was filed.
2. In bracket 2, list the Patent Number and/or the Application Number (including series code and serial no.). Where an Application Number is listed, it must be preceded by the phrase --any patent granted on Application Number--.
3. One or more of the appropriate form paragraphs 14.26 to 14.32 MUST follow this form paragraph to indicate why the terminal disclaimer is not accepted.
4. Form paragraph 14.33 includes the full text of [37 CFR 3.73](#) and may be included in the Office action when deemed appropriate.
5. Form paragraph 14.35 may be used to inform applicant that an additional disclaimer fee will not be required for the submission of a replacement or supplemental terminal disclaimer.

¶ *14.26 Does Not Comply With 37 CFR 1.321(b) and/or (c) "Sub-Heading" Only*

The terminal disclaimer does not comply with [37 CFR 1.321\(b\)](#) and/or (c) because:

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 and followed by one or more of the appropriate form paragraphs 14.26.01 to 14.27.03.

¶ *14.26.01 Extent of Interest Not Stated*

The person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent. See [37 CFR 1.321\(b\)\(3\)](#).

Examiner Note:

This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

¶ *14.26.02 Directed to Particular Claim(s)*

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See [MPEP § 1490](#).

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ 14.26.03 *Not Signed*

The terminal disclaimer was not signed.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ 14.26.04 *Application/Patent Not Identified*

The application/patent being disclaimed has not been identified.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ 14.26.05 *Application/Patent Improperly Identified*

The application/patent being disclaimed has been improperly identified since the number used to identify the [1] being disclaimed is incorrect. The correct number is [2].

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.
2. In bracket 1, insert --application-- or --patent--.
3. In bracket 2, insert the correct Application Number (including series code and serial no.) or the correct Patent Number being disclaimed.
4. A terminal disclaimer is acceptable if it includes the correct Patent Number or the correct Application Number or the serial number together with the proper filing date or the proper series code.

¶ 14.26.06 *Not Signed by All Owners*

It was not signed by all owners and, therefore, supplemental terminal disclaimers are required from the remaining owners.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ 14.26.07 *No Disclaimer Fee Submitted*

The disclaimer fee of \$ [1] in accordance with [37 CFR 1.20\(d\)](#) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

Examiner Note:

1. In bracket 1, insert the fee for a disclaimer.

2. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26. If the disclaimer fee was paid for a terminal disclaimer which was not accepted, applicant does not have to pay another disclaimer fee when submitting a replacement or supplemental terminal disclaimer, and this form paragraph should not be used.

¶ 14.27.01 *Lacks Clause of Enforceable Only During Period of Common Ownership*

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See [37 CFR 1.321\(c\)\(3\)](#).

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26.

¶ 14.27.011 *Lacks 37 CFR 1.321(d) statement for joint research agreement under 35 U.S.C. 103(c)(2)&(3)*

It does not include the waiver and enforceability provisions of 37 CFR [1.321\(d\)](#). The terminal disclaimer must include a provision:

- (1) waiving the right to separately enforce (a) any patent granted on that application or the patent being reexamined and (b) the reference patent, or any patent granted on the reference application which formed the basis of the double patenting; and
- (2) agreeing that any patent granted on that application or patent being reexamined shall be enforceable only for and during such period that said patent and the reference patent, or any patent granted on the reference application, which formed the basis for the double patenting are not separately enforced.

See 37 CFR [1.321\(d\)\(3\)](#).

Examiner Note:

This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.26, and this paragraph should be followed by either form paragraph 14.27.07 or form paragraph 14.27.08.

¶ 14.27.02 *Fails To Disclaim Terminal Portion of Any Patent Granted On Subject Application*

It fails to disclaim the terminal portion of any patent granted on the subject application.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.
2. Use this form paragraph when the period disclaimed is not the correct period or when no period is specified at all.
3. When using this form paragraph, give an example of proper terminal disclaimer language using form paragraph 14.27.04 following this or the series of statements concerning the defective terminal disclaimer.

¶ 14.27.03 Fails To Disclaim Terminal Portion of Subject Patent

It fails to disclaim the terminal portion of the subject patent.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.
2. Use this form paragraph in a reissue application or reexamination proceeding when the period disclaimed is not the correct period or when no period is specified at all.

¶ 14.27.04 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

The owner,
 _____, of
 _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the

instant application and is binding upon the grantee, its successors or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

The owner,
 _____, of
 _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____ as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Alternatively, Form PTO/SB/25 may be used for situation I, and Form PTO/SB/26 may be used for situation II; a copy of each form may be found at the end of [MPEP § 1490](#).

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.06.
2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ 14.27.06 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation)

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application

was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and any patent granted on the above-listed pending application are commonly owned. This agreement is binding upon the patent owner, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of prior patent No. _____ as the term of said prior patent is presently shortened by any terminal disclaimer. The patent owner hereby agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the prior patent are commonly owned. This agreement is binding upon the patent owner, its successors, or assigns.

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined), other than for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.04.
2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.07 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.08 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ 14.27.07 Examples of Acceptable Terminal Disclaimer Language in Patent To Be Granted (activities undertaken within the scope of a joint research agreement)

Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

The owner, _____, of _____ percent interest in the instant application hereby disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number _____, filed on _____, as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application.

The owner of the instant application waives the right to separately enforce any patent granted on the instant application and any patent granted on the **reference** application. The owner of the instant application hereby agrees that any patent granted on the instant application and any patent granted on the **reference** application shall be enforceable only for and during such period that the instant application and the **reference** application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and any patent granted on the **reference** application, and are binding upon the owner of the instant application, its successors, or assigns.

Owner, or attorney/agent of record, of the instant application:

Signature: _____

Printed/Typed name: _____

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

The owner, _____, of _____ percent interest in the instant application hereby

disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No.

_____, as the term of said **prior patent** is presently shortened by any terminal disclaimer.

The owner of the instant application waives the right to separately enforce the **prior patent** and any patent granted on the instant application. The owner of the instant application hereby agrees that the **prior patent** and any patent granted on the instant application shall be enforceable only for and during such period that the **prior patent** and any patent granted on the instant application are not separately enforced. The waiver, and this agreement, run with any patent granted on the instant application and are binding upon the owner of the instant application, its successors, or assigns.

Owner, or attorney/agent of record, of the instant application:

Signature: _____

Printed/Typed name: _____

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent (e.g., for a reexamination situation) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.08.

2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ 14.27.08 Examples of Acceptable Terminal Disclaimer Language in Patent (Reexamination Situation; activities undertaken within the scope of a joint research agreement)

Examples of acceptable language for making the disclaimer of the terminal portion of the patent being reexamined (or otherwise for an existing patent) follow:

I. If a provisional obviousness-type double patenting rejection over a Pending Application was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of any patent granted on pending Application Number _____, filed on _____, as the term of any patent granted on said application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending application.

The patent owner waives the right to separately enforce the instant patent and the above-listed pending application. The patent owner agrees that the instant patent and any patent granted on the above-listed pending application shall be enforceable only for and during such period that the instant patent and the patent granted on the above-listed pending application are not separately enforced. The waiver, and this agreement, run with any patent granted on the above-listed pending application, and are binding upon the patent owner, its successors, or assigns.

Patent Owner, or attorney/agent of record:

Signature: _____

Printed/Typed name: _____

II. If an obviousness-type double patenting rejection over a Prior Patent was made, or is otherwise believed to be applicable to the patent, use:

The patent owner hereby disclaims the terminal part of the instant patent, which would extend beyond the expiration date of the full statutory term of **prior patent** No. _____, as the term of said **prior patent** is presently shortened by any terminal disclaimer.

The patent owner waives the right to separately enforce the instant patent and the **prior patent**. The patent owner agrees that the instant patent and the **prior patent** shall be enforceable only for and during such period that the instant patent and the **prior patent** are not separately enforced. The

waiver, and this agreement, are binding upon the patent owner, its successors, or assigns.

Patent Owner, or attorney/agent of record:

Signature: _____

Printed/Typed name: _____

Examiner Note:

1. To provide examples of acceptable terminal disclaimer language in a patent to be granted on an application (generally, an application being examined) for a terminal disclaimer based on activities undertaken within the scope of a joint research agreement, use form paragraph 14.27.07.
2. To provide examples of acceptable terminal disclaimer language for a terminal disclaimer in a situation other than one based on activities undertaken within the scope of a joint research agreement, (a) use form paragraph 14.27.04 for making the disclaimer of the terminal portion of a patent to be granted on an application (generally, an application being examined), and (b) use form paragraph 14.27.06 for making the disclaimer of the terminal portion of an existing patent (e.g., for a reexamination situation).

¶ 14.28 Failure To State Capacity To Sign

The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation, or other business entity or organization, and he/she has not been established as being authorized to act on behalf of the assignee.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25 AND 14.26.

¶ 14.29 Not Recognized as Officer of Assignee - "Sub-Heading" Only

The person who signed the terminal disclaimer 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 terminal disclaimer is not an authorized officer as defined in [MPEP § 324](#).
2. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 and followed by form paragraphs 14.29.01 and/or 14.29.02 when appropriate. An attorney or agent of record is always authorized to

sign the terminal disclaimer, even though there is no indication that he or she is an officer of the assignee.

3. Use form paragraph 14.29.02 to explain how an official, other than a recognized officer, may properly sign a terminal disclaimer.

¶ 14.29.01 Attorney/Agent Not of Record

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by [37 CFR 1.34](#) (a). See [37 CFR 1.321\(b\)](#) and/or (c).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. An attorney or agent, however, may sign a terminal disclaimer provided he/she is an attorney or agent of record or is established as an appropriate official of the assignee. To suggest to the attorney or agent, not of record, how he/she may establish status as an appropriate official of the assignee to sign a terminal disclaimer, use form paragraph 14.29.02.

¶ 14.29.02 Criteria To Accept Terminal Disclaimer When Signed by a Non-Recognized Officer

It would be acceptable for a person, other than a recognized officer, to sign a terminal disclaimer, provided the record for the application includes a statement that the person is empowered to sign terminal disclaimers and/or act on behalf of the assignee.

Accordingly, a new terminal disclaimer which includes the above empowerment statement will be considered to be signed 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 form paragraph MUST be preceded by form paragraphs 14.24 or 14.25 AND 14.29.
2. When form 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 form 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.

¶ 14.30 *No Evidence of Chain of Title to Assignee - Application*

The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to [37 CFR 3.11](#), or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office ([37 CFR 3.73\(b\)](#)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under [37 CFR 3.73\(b\)](#). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper.

¶ 14.30.01 *No Evidence of Chain of Title to Assignee - Patent*

The assignee has not established its ownership interest in the patent, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to [37 CFR 3.11](#), or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office ([37 CFR 3.73\(b\)](#)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide a statement under [37 CFR 3.73\(b\)](#). Thus, this form paragraph should not be used.
3. It should be noted that the documentary evidence or the specifying of reel and frame number may be found in the terminal disclaimer itself or in a separate paper in the application.

¶ 14.30.02 *Evidence of Chain of Title to Assignee - Submission Not Signed by Appropriate Party - Terminal Disclaimer Is Thus Not Entered*

The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission establishing the ownership interest is authorized to sign the submission ([37 CFR 3.73\(b\)](#)).

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Where an attorney or agent of record signs a terminal disclaimer, there is no need to provide any statement under [37 CFR 3.73\(b\)](#). Thus, this form paragraph should not be used.
3. This form paragraph should be followed by one of form paragraphs 14.16.02 or 14.16.03. In rare situations where BOTH form paragraphs 14.16.02 and 14.16.03 do not apply and thus cannot be used, the examiner should instead follow this form paragraph with a detailed statement of why there is no authorization to sign.
4. Use form paragraph 14.16.06 to point out one way to correct the problem.

¶ 14.32 *Application/Patent Which Forms Basis for Rejection Not Identified*

The application/patent which forms the basis for the double patenting rejection is not identified in the terminal disclaimer.

Examiner Note:

1. This form paragraph MUST be preceded by form paragraph 14.24 or 14.25.
2. Use this form paragraph when no information is presented. If incorrect information is contained in the terminal disclaimer, use form paragraphs 14.26 and 14.26.05.

¶ 14.33 *37 CFR 3.73 - Establishing Right of Assignee To Take Action*

The following is a statement of [37 CFR 3.73](#):

[37 CFR 3.73](#) Establishing right of assignee to take action.

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

trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § [3.11](#) in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office. For patent matters only, the submission of the documentary evidence must be accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to § [3.11](#); or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

¶ 14.34 Requirement for Statement To Record Assignment Submitted With Terminal Disclaimer

The assignment document filed on [1] is **not** acceptable as the documentary evidence required by [37 CFR 3.73](#). The submission of the documentary evidence was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR [3.11](#). See [37 CFR 3.11](#) and [MPEP § 302](#).

Examiner Note:

1. In bracket 1, insert the date the assignment document was filed.
2. This form paragraph should be used when an assignment document (an original, facsimile, or copy) is submitted to satisfy [37 CFR 3.73\(b\)](#) was not accompanied by a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation, and the documentary evidence has not been recorded among the assignment records of the Office.

¶ 14.35 Disclaimer Fee Not Required Twice - Applicant

It should be noted that applicant is not required to pay another disclaimer fee as set forth in [37 CFR 1.20\(d\)](#) when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

1. This form paragraph can be used to notify an applicant that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.
2. Use form paragraph 14.35.01 for providing notification to patent owner, rather than an applicant.

¶ 14.35.01 Disclaimer Fee Not Required Twice - Patent Owner

It should be noted that patent owner is not required to pay another disclaimer fee as set forth in [37 CFR 1.20\(d\)](#)

when submitting a replacement or supplemental terminal disclaimer.

Examiner Note:

This form paragraph can be used to notify a patent owner that another disclaimer fee will not be required when a replacement or supplemental terminal disclaimer is submitted.

¶ 14.36 Suggestion That “Applicant” Request a Refund

Since the required fee for the terminal disclaimer was previously paid, applicant’s payment of an additional terminal disclaimer fee is not required. Applicant may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify applicant that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.
2. Note - If applicant has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this paragraph should NOT be used.
3. Use form paragraph 14.36.01 for providing notification to patent owner, rather than an applicant.

¶ 14.36.01 Suggestion That “Patent Owner” Request a Refund

Since the required fee for the terminal disclaimer was previously paid, patent owner’s payment of an additional terminal disclaimer fee is not required. Patent owner may request a refund of this additional terminal disclaimer fee by submitting a written request for a refund and a copy of this Office action to: Mail Stop 16, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph should be used to notify patent owner that a refund can be obtained if another terminal disclaimer fee was paid when a replacement or supplemental terminal disclaimer was submitted.
2. Note - If patent owner has authorized or requested a fee refund to be credited to a specific Deposit Account or credit card, then an appropriate credit should be made to that Deposit Account or credit card and this form paragraph should NOT be used.

¶ 14.37 Samples of a Terminal Disclaimer Over a Pending Application and Assignee Statement Enclosed

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application ([37 CFR 1.321\(b\)](#) and (c)).

Also enclosed is a sample Statement Under [37 CFR 3.73\(b\)](#) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The “Copies of assignments...” box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the “Copies of assignments...” box is checked, either the part A box or the part B box, as appropriate, must be checked, and the “Reel____, Frame____” entries should be left blank. If the part B box is checked, and copies of assignments are not included, the “From:____ To:____” blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under [37 CFR 3.73\(b\)](#), e.g., when signing a terminal disclaimer or a power of attorney.

Examiner Note:

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome a provisional obviousness-type double patenting rejection over a pending application and a Statement to be signed by an assignee to ensure compliance with [37 CFR 3.73\(b\)](#).
2. Note that the requirements for compliance with [37 CFR 3.73](#) (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with [37 CFR 3.73\(b\)](#), the assignee’s ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR [3.11](#), or (b) specifying in the record of the application or patent 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 your Technology Center Paralegal or Special Program Examiner for copies of the sample terminal disclaimer and Statement Under 37 CFR [3.73\(b\)](#) to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found after [MPEP § 1490](#)

and the Sample Statement Under 37 CFR [3.73\(b\)](#) found after [MPEP § 324](#).)

¶ 14.38 Samples of a Terminal Disclaimer Over a Prior Patent and Assignee Statement Enclosed

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent ([37 CFR 1.321\(b\)](#) and (c)).

Also enclosed is a sample Statement Under [37 CFR 3.73\(b\)](#) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The “Copies of assignments...” box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the “Copies of assignments...” box is checked, either the part A box or the part B box, as appropriate, must be checked, and the “Reel____, Frame____” entries should be left blank. If the part B box is checked, and copies of assignments are not included, the “From:____ To:____” blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under [37 CFR 3.73\(b\)](#), e.g., when signing a terminal disclaimer or a power of attorney.

Examiner Note:

1. This form paragraph can be used to provide applicant samples of a terminal disclaimer which contains the necessary clauses to overcome an obviousness-type double patenting rejection over a prior patent and a Statement to be signed by an assignee to ensure compliance with [37 CFR 3.73\(b\)](#).
2. Note that the requirements for compliance with [37 CFR 3.73](#) (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with [37 CFR 3.73\(b\)](#), the assignee’s ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR [3.11](#), or (b) specifying in the record of the application or patent 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 your Technology Center Paralegal or Special Program

Examiner for copies of the sample terminal disclaimer and Statement Under 37 CFR [3.73\(b\)](#) to enclose with the Office action. Alternatively, it is permissible to copy the sample terminal disclaimer found after [MPEP § 1490](#) and the Sample Statement Under 37 CFR [3.73\(b\)](#) found after [MPEP § 324](#).)

¶ 14.39 Sample Assignee Statement Under 37 CFR 3.73(b) Enclosed

Enclosed with this Office action is a sample Statement under [37 CFR 3.73\(b\)](#) which an assignee may use in order to ensure compliance with the Rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The “Copies of assignments...” box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the “Copies of assignments...” box is checked, either the part A box or the part B box, as appropriate, must be checked, and the “Reel____, Frame____” entries should be left blank. If the part B box is checked, and copies of assignments are not included, the “From:____ To:____” blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under [37 CFR 3.73\(b\)](#).

Examiner Note:

1. This form paragraph can be used to provide applicant a sample of a Statement to be signed by an assignee to ensure compliance with [37 CFR 3.73\(b\)](#).
2. Note that the requirements for compliance with [37 CFR 3.73](#) (b) have been made more liberal, such that certain specifics of the sample statement are no longer required. At present, in order to comply with [37 CFR 3.73\(b\)](#), the assignee’s ownership interest must be established by (a) filing in the application or patent evidence of a chain of title from the original owner to the assignee and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR [3.11](#), or (b) specifying in the record of the application or patent 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 your Technology Center Paralegal or Special Program Examiner for a copy of the sample Statement Under 37 CFR [3.73\(b\)](#) to enclose with the Office action. Alternatively, it is permissible to copy the sample Statement Under 37 CFR [3.73\(b\)](#) found after [MPEP § 324](#).)

Chapter 1500 - Design Patents

¶ 15.01 Conditions Under 35 U.S.C. 119(a)-(d)

Applicant is advised of conditions as specified in [35 U.S.C. 119\(a\)](#)-(d). An application for a design patent for an invention filed in this country by any person who has, or whose legal representatives have previously filed an application for a design patent, or equivalent protection for the same design in a foreign country which offers similar privileges in the case of applications filed in the United States or in a WTO member country, or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within six (6) months from the earliest date on which such foreign application was filed.

¶ 15.01.01 Conditions Under 35 U.S.C. 172 Not Met

The claim for priority under 35 U.S.C. [119\(a\)](#)-(d) to the [1] application is acknowledged, however, the claim for priority cannot be based on such application since it was filed more than six (6) months before the filing of the application in the United States. 35 U.S.C. [172](#).

Examiner Note:

1. In bracket, insert the name of the foreign country.

¶ 15.02 Right of Priority Under 35 U.S.C. 119(b)

No application for design patent shall be entitled to the right of priority under [35 U.S.C. 119\(b\)](#) unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the United States Patent and Trademark Office before the issue fee is paid, or at such time during the pendency of the application as required by the Director not earlier than six (6) months after the filing of the application in this country. Such certification shall be made by the Patent Office, or other proper authority of the foreign country in which filed, and show the date of the application and of the filing of the specification and other papers. The Director may require a translation of the papers filed if not in the English language, and such other information as deemed necessary.

¶ 15.03 Untimely Priority Papers

Receipt is acknowledged of the filing on [1] of a certified copy of the [2] application referred to in the oath or declaration. A claim for priority cannot be based on said application, since the United States application was filed more than six (6) months thereafter ([35 U.S.C. 172](#)).

¶ 15.03.01 Foreign Filing More Than 6 Months Before U.S. Filing

Acknowledgment is made of the [1] application identified in the declaration which was filed more than six months prior to the filing date of the present application. Applicant is reminded that if the [2] application matured into a form of patent protection before the filing date of the present application it would constitute a statutory bar to the issuance of a design patent in the United States under [35 U.S.C. 102\(d\)](#) in view of [35 U.S.C. 172](#).

Examiner Note:

In brackets 1 and 2, insert the name of country where application was filed.

¶ 15.04 Priority Under Bilateral or Multilateral Treaties

The United States will recognize claims for the right of priority under [35 U.S.C. 119\(a\)](#)-(d) based on applications filed under such bilateral or multilateral treaties as the Hague Agreement Concerning the International Deposit of Industrial Designs, the Benelux Designs Convention and European Community Design. In filing a claim for priority of a foreign application previously filed under such a treaty, certain information must be supplied to the United States Patent and Trademark Office. In addition to the application number and the date of filing of the application, the following information is requested: (1) the name of the treaty under which the application was filed; (2) the name of at least one country other than the United States in which the application has the effect of, or is equivalent to, a regular national filing; and (3) the name and location of the national or international governmental authority which received such application.

¶ 15.05 Design Patent Specification Arrangement

The following order or arrangement should be observed in framing a design patent specification:

- (1) Preamble, stating name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied.
- (2) Cross-reference to related applications unless included in the application data sheet.
- (3) Statement regarding federally sponsored research or development.
- (4) Description of the figure or figures of the drawing.
- (5) Descriptive statement, if any.
- (6) A single claim.

¶ 15.05.01 Title of Design Invention

The title of a design being claimed must correspond to the name of the article in which the design is embodied or applied to. See [MPEP § 1503.01](#).

¶ *15.05.03 Drawing/Photograph Disclosure Objected To*

The drawing/photograph disclosure is objected to [1].

Examiner Note:

In bracket 1, insert statutory or regulatory basis for objection and an explanation.

¶ *15.05.04 Replacement Drawing Sheets Required*

Corrected drawing sheets in compliance with 37 CFR [1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as amended. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. If all the figures on a drawing sheet are canceled, a replacement sheet is not required. A marked-up copy of the drawing sheet (labeled as “Annotated Sheet”) including an annotation showing that all the figures on that drawing sheet have been canceled must be presented in the amendment or remarks section that explains the change to the drawings. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR [1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

¶ *15.05.041 Informal Color Drawing(s)/Photograph(s) Submitted*

Informal color photographs or drawings have been submitted for the purposes of obtaining a filing date. When formal drawings are submitted, any showing of color in a black and white drawing is limited to the symbols used to line a surface to show color (MPEP § [608.02](#)). Lining entire surfaces of a design to show color(s) may interfere with a clear showing of the design as required by [35 U.S.C. 112](#) because surface shading cannot be used simultaneously to define the contours of those surfaces. However, a surface may be partially lined

for color with a description that the color extends across the entire surface; this technique would allow for the use of shading on the rest of the surface showing the contours of the design (37 CFR [1.152](#)). In the alternative, a separate view, properly shaded to show the contours of the design but omitting the color(s), may be submitted if identified as shown only for clarity of illustration.

In any drawing lined for color, the following descriptive statement must be inserted in the specification (the specific colors may be identified for clarity):

--The drawing is lined for color.--

However, some designs disclosed in informal color photographs/drawings cannot be depicted in black and white drawings lined for color. For example, a design may include multiple shades of a single color which cannot be accurately represented by the single symbol for a specific color. Or, the color may be a shade other than a true primary or secondary color as represented by the drafting symbols and lining the drawing with one of the drafting symbols would not be an exact representation of the design as originally disclosed. In these situations, applicant may file a petition to accept formal color drawings or color photographs under 37 CFR [1.84\(a\)\(2\)](#).

¶ *15.05.05 Drawing Correction Required Prior to Appeal*

Any appeal of the design claim must include the correction of the drawings approved by the examiner in accordance with *Ex parte Bevan*, 142 USPQ 284 (Bd. App. 1964).

Examiner Note:

This form paragraph can be used in a FINAL rejection where an outstanding requirement for a drawing correction has not been satisfied.

¶ *15.07 Avoidance of New Matter*

When preparing new drawings in compliance with the requirement therefor, care must be exercised to avoid introduction of anything which could be construed to be new matter prohibited by [35 U.S.C. 132](#) and [37 CFR 1.121](#).

¶ *15.07.01 Statutory Basis, 35 U.S.C. 171*

The following is a quotation of [35 U.S.C. 171](#):

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

¶ 15.08 Lack of Ornamentality (Article Visible in End Use)

The claim is rejected under [35 U.S.C. 171](#) as being directed to nonstatutory subject matter in that it lacks ornamentality. To be patentable, a design must be “created for the purpose of ornamenting” the article in which it is embodied. See *In re Carletti*, 328 F.2d 1020, 140 USPQ 653 (CCPA 1964).

The following evidence establishes a *prima facie* case of a lack of ornamentality: [1]

Evidence that demonstrates the design is ornamental may be submitted from the applicant in the form of an affidavit or declaration under 37 CFR 1.132:

- (a) stating the ornamental considerations which entered into the design of the article; and
- (b) identifying what aspects of the design meet those considerations.

An affidavit or declaration under 37 CFR [1.132](#) may also be submitted from a representative of the company, which commissioned the design, to establish the ornamentality of the design by stating the motivating factors behind the creation of the design.

Attorney arguments are not a substitute for evidence to establish the ornamentality of the claim. *Ex parte Webb*, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Inter. 1993).

Examiner Note:

In bracket 1, insert source of evidence of lack of ornamentality, for example, a utility patent, a brochure, a response to a letter of inquiry, etc.

¶ 15.08.01 Lack of Ornamentality (Article Not Visible in its Normal and Intended Use)

The claim is rejected under [35 U.S.C. 171](#) as being directed to nonstatutory subject matter in that the design lacks ornamentality since it appears there is no period in the commercial life of applicant’s [1] when its ornamentality may be a matter of concern. *In re Webb*, 916 F.2d 1553, 1558, 16 USPQ2d 1433, 1436 (Fed. Cir. 1990); *In re Stevens*, 173 F.2d 1015, 81 USPQ 362 (CCPA 1949).

The following evidence establishes a *prima facie* case of lack of ornamentality: [2]

In order to overcome this rejection, two types of evidence are needed:

(1) Evidence to demonstrate there is some period in the commercial life of the article embodying the claimed design when its ornamentality is a matter of concern. Such evidence may include a showing of a period in the life of the design when the ornamentality of the article may be a matter of concern to a purchaser during the process of sale. An example of this type of evidence is a sample of sales literature such as an advertisement or a catalog sheet which presents the appearance of the article as ornamental and not merely as a means of identification or instruction; and

(2) Evidence to demonstrate the design is ornamental. This type of evidence should demonstrate “thought of ornament” in the design and should be presented in the form of an affidavit or declaration under 37 CFR 1.132 from the applicant:

- (a) stating the ornamental considerations which entered into the design of the article; and
- (b) identifying what aspects of the design meet those considerations.

An affidavit or declaration under 37 CFR [1.132](#) may also be submitted from a representative of the company, which commissioned the design, to establish the ornamentality of the design by stating the motivating factors behind the creation of the design.

Attorney arguments are not a substitute for evidence to establish the ornamentality of the claim. *Ex parte Webb*, 30 USPQ2d 1064, 1067-68 (Bd. Pat. App. & Inter. 1993).

Examiner Note:

1. In bracket 1, insert the name of the article in which the design is embodied.
2. In bracket 2, insert source of evidence of the article’s design being of no concern, for example, an analysis of a corresponding utility patent, a brochure, a response to a letter of inquiry, etc.

¶ 15.08.02 Simulation (Entire Article)

The claim is rejected under [35 U.S.C. 171](#) as being directed to nonstatutory subject matter in that the design lacks originality. The design is merely simulating [1] which applicant himself did not invent. See *In re Smith*,

25 USPQ 359, 1935 C.D. 565 (CCPA 1935); *In re Smith*, 25 USPQ 360, 1935 C.D. 573 (CCPA 1935); and *Bennage v. Phillippi*, 1876 C.D. 135, 9 O.G. 1159.

Examiner Note:

1. In bracket 1, insert the name of the article or person being simulated, e.g., the White House, Marilyn Monroe, an animal which is not stylized or caricatured in any way, a rock or shell to be used as paperweight, etc.
2. This form paragraph should be followed by form paragraph 15.08.03 when evidence has been cited to show the article or person being simulated.

¶ 15.08.03 *Explanation of evidence cited in support of simulation rejection*

Applicant's design has in no way departed from the natural appearance of [1]. This reference is not relied on in this rejection but is supplied merely as representative of the usual or typical appearance of [2] in order that the claim may be compared to that which it is simulating.

Examiner Note:

1. In bracket 1, insert name of article or person being simulated and source (patent, publication, etc.).
2. In bracket 2, insert name of article or person being simulated.

¶ 15.09 35 U.S.C. 171 Rejection

The claim is rejected under [35 U.S.C. 171](#) as directed to nonstatutory subject matter because the design is not shown embodied in or applied to an article.

Examiner Note:

This rejection should be used when the claim is directed to surface treatment which is not shown with an article in either full or broken lines.

¶ 15.10 *Offensive Subject Matter*

The disclosure, and therefore the claim in this application, is rejected as being offensive and therefore improper subject matter for design patent protection under [35 U.S.C. 171](#). Such subject matter does not meet the statutory requirements of [35 U.S.C. 171](#). Moreover, since [37 CFR 1.3](#) proscribes the presentation of papers which are lacking in decorum and courtesy, and this includes depictions of caricatures in the disclosure, drawings, and/or a claim which might reasonably be considered offensive, such subject matter as presented herein is deemed to be clearly contrary to [37CFR 1.3](#). See [MPEP § 608](#).

¶ 15.11 35 U.S.C. 102(a) Rejection

The claim is rejected under [35 U.S.C. 102\(a\)](#) as being clearly anticipated by [1] because the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country before the invention thereof by the applicant for patent.

¶ 15.12 35 U.S.C. 102(b) Rejection

The claim is rejected under [35 U.S.C. 102\(b\)](#) as being clearly anticipated by [1] because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

¶ 15.13 35 U.S.C. 102(c) Rejection

The claim is rejected under [35 U.S.C. 102\(c\)](#) because the invention has been abandoned.

¶ 15.14 35 U.S.C. 102(d)/172 Rejection

The claim is rejected under [35 U.S.C. 102\(d\)](#), as modified by [35 U.S.C. 172](#), as being clearly anticipated by [1] because the invention was first patented or caused to be patented, or was the subject of an inventor's certificate by the applicant, or his/her legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than six (6) months before the filing of the application in the United States.

¶ 15.15 35 U.S.C. 102(e) Rejection

The claim is rejected under [35 U.S.C. 102\(e\)](#) as being clearly anticipated by [1] because the invention was described in a patented or published application for patent by another filed in the United States before the invention thereof by the applicant for patent.

¶ 15.15.01 *Explanation of rejection under 35 U.S.C. 102(a), (b), (d), or (e)*

The shape and appearance of [1] is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

Examiner Note:

1. This paragraph should be included after paragraph 15.11, 15.12, 15.14 or 15.15 to explain the basis of the rejection.
2. In bracket [1], identify the reference applied against the claimed design.

¶ 15.15.02 *Provisional 35 U.S.C. 102(e) rejection - design disclosed but not claimed in another application with common inventor and/or assignee*

The claim is provisionally rejected under 35 U.S.C. [102\(e\)](#) as being anticipated by copending Application No. [1] which has a common [2] with the instant application.

Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. [102\(e\)](#), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. [102\(e\)](#) is based upon a presumption of future publication or patenting of the copending application.

Since the design claimed in the present application is not the same invention claimed in the [3] application, the examiner suggests overcoming this provisional rejection in one of the following ways: (A) a showing under 37 CFR [1.132](#) that the design in the reference was derived from the designer of this application and is thus not the invention “by another;” (B) a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR [1.131](#); (C) Perfecting a claim to priority under 35 U.S.C. [119](#) that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. [112](#), first paragraph; or (D) Perfecting priority under 35 U.S.C. [120](#) by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR [1.76](#) which contains a specific reference to a prior application in accordance with 37 CFR [1.78\(a\)](#) and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. [112](#), first paragraph.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application (utility or design) with an earlier filing date that discloses (but does not claim) the claimed invention which has not been patented or published under [35 U.S.C. 122](#). The copending application must have either a common assignee or at least one common inventor.
2. Use [35 U.S.C. 102\(e\)](#) as amended by the American Inventor’s Protection Act (form paragraph 7.12) to determine the reference’s prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an

international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) (form paragraph 7.12.01) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under [35 U.S.C. 371](#)) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under [35 U.S.C. 120, 121](#), or [365 \(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the [35 U.S.C. 102\(e\)](#) date.

3. In bracket 2, insert inventor or assignee.

¶ 15.15.03 *Provisional 35 U.S.C. 102(e) rejection - design claimed in an earlier filed design patent application with common inventor and/or assignee*

The claim is provisionally rejected under 35 U.S.C. [102\(e\)](#) as being anticipated by the claim in copending Design Patent Application No. [1] which has a common [2] with the instant application.

Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. [102\(e\)](#), if patented. This provisional rejection under 35 U.S.C. [102\(e\)](#) is based upon a presumption of future patenting of the copending application. The rejection may be overcome by abandoning the earlier filed copending application.

Examiner Note:

1. In bracket 2, insert inventor or assignee.
2. This form paragraph must be preceded by form paragraph 15.24.05 to notify the applicant that the question of patentability under 35 U.S.C. [102\(f\)/\(g\)](#) also exists.

¶ 15.15.04 *35 U.S.C. 102(e) rejection - design disclosed but not claimed in a patent*

The claim is rejected under 35 U.S.C. [102\(e\)](#) as being anticipated by patent [1].

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. [102\(e\)](#).

Since the design claimed in the present application is not the same invention claimed in patent [2], the examiner suggests overcoming this rejection in one of the following ways: (A) a showing under 37 CFR [1.132](#) that the design in the reference was derived from the designer of this application and is thus not the invention “by another;” (B) a showing of a date of invention for the instant

application prior to the effective U.S. filing date of the reference under 37 CFR [1.131](#); (C) Perfecting a claim to priority under 35 U.S.C. [119](#) that antedates the reference by filing a certified priority document in the application that satisfies the enablement and description requirements of 35 U.S.C. [112](#), first paragraph; or (D) Perfecting priority under 35 U.S.C. [120](#) by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR [1.76](#) which contains a specific reference to a prior application in accordance with 37 CFR [1.78](#)(a) and establishing that the prior application satisfies the enablement and description requirements of 35 U.S.C. [112](#), first paragraph

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is disclosed in the drawings of an earlier filed design or utility patent but is not claimed therein. When the design claimed in the application being examined is disclosed in the drawings of an earlier filed design patent, it would most often be in the form of subcombination subject matter, (part or portion of an article), that is patentably distinct from the claim for the design embodied by the combination or whole article. It may also be unclaimed subject matter depicted in broken lines in the earlier filed application.
2. In brackets 1 and 2, insert number of patent.

¶ *15.16 35 U.S.C. 102(f) Rejection*

The claim is rejected under [35 U.S.C. 102\(f\)](#) because applicant did not himself invent the subject matter sought to be patented.

¶ *15.17 35 U.S.C. 102(g) Rejection*

The claim is rejected under [35 U.S.C. 102\(g\)](#) because, before the applicant's invention thereof, the invention was made in this country by another who had not abandoned, suppressed or concealed it.

¶ *15.18 35 U.S.C. 103(a) Rejection (Single Reference)*

The claim is rejected under [35 U.S.C. 103\(a\)](#) as being unpatentable over [1]. Although the invention is not identically disclosed or described as set forth in [35 U.S.C. 102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary

skill in the art to which said subject matter pertains, the invention is not patentable.

¶ *15.19 35 U.S.C. 103(a) Rejection (Multiple References)*

The claim is rejected under [35 U.S.C. 103\(a\)](#) as being unpatentable over [1] in view of [2].

Although the invention is not identically disclosed or described as set forth in [35 U.S.C. 102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer of ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

¶ *15.19.01 Summary Statement of Rejections*

The claim stands rejected under [1].

Examiner Note:

1. Use as summary statement of rejection(s) in Office action.
2. In bracket 1, insert appropriate basis for rejection, i.e., statutory provisions, etc.

¶ *15.19.02 Preface 35 U.S.C. 102(e)/103(a) rejection - Different inventors, common assignee, obvious designs, no evidence of common ownership at time later design was made*

The claim is directed to a design not patentably distinct from the design of commonly assigned [1]. Specifically, the claimed design is different from the one in [2] in that [3]. These differences are considered obvious and do not patentably distinguish the overall appearance of the claimed design over the design in [4].

The commonly assigned [5], discussed above, has a different inventive entity from the present application. Therefore, it qualifies as prior art under 35 U.S.C. [102](#)(e), (f) or (g) and forms the basis for a rejection of the claim in the present application under 35 U.S.C. [103](#)(a) if the conflicting design claims were not commonly owned at the time the design in this application was made. In order to resolve this issue, the applicant, assignee or attorney of record can state that the conflicting designs were commonly owned at the time the design in this application was made, or the assignee can name the prior inventor of the conflicting subject matter.

A showing that the designs were commonly owned at the time the design in this application was made will overcome a rejection under 35 U.S.C. [103](#)(a) based upon the commonly assigned case as a reference under 35

U.S.C. [102\(f\)](#) or (g), or 35 U.S.C. [102\(e\)](#) for applications filed on or after November 29, 1999.

Examiner Note:

1. This form paragraph should be used when the application being examined is commonly assigned with a conflicting application or patent, but there is no indication that they were commonly assigned at the time the invention was actually made.
2. If the conflicting claim is in a patent with an earlier U.S. filing date, a rejection under 35 U.S.C. [102\(e\)](#)/[103\(a\)](#) should be made.
3. If the conflicting claim is in a commonly assigned, copending application with an earlier filing date, a provisional rejection under 35 U.S.C. [102\(e\)](#)/[103\(a\)](#) should be made.
4. An obviousness double patenting rejection may also be included in the action.
5. In brackets 1, 2, 4 and 5, insert patent and number, or copending application and serial number.
6. In bracket 3, identify differences between design claimed in present application and that claimed in earlier filed patent or copending application.
7. This form paragraph should only be used ONCE in an Office action.
8. If the rejection relies upon prior art under 35 U.S.C. [102\(e\)](#), use 35 U.S.C. [102\(e\)](#) as amended by the American Inventor's Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. [102\(e\)](#) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. [371](#)) which has international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. [120](#), [121](#), or [365\(c\)](#) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. [102\(e\)](#) date.

¶ *15.19.03 Provisional 35 U.S.C. 102(e)/103(a) rejection - design disclosed but not claimed in another application with common inventor and/or assignee*

The claim is provisionally rejected under 35 U.S.C. [103\(a\)](#) as being obvious over copending Application No. [1] which has a common [2] with the instant application. Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. [102\(e\)](#) if

published under 35 U.S.C. [122\(b\)](#) or patented. This provisional rejection under 35 U.S.C. [103\(a\)](#) is based upon a presumption of future publication or patenting of the conflicting application.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. [102](#), if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[3]

Since the design claimed in the present application is not the same invention claimed in the [4] application, this provisional rejection may be overcome by a showing under 37 CFR [1.132](#) that the design in the reference was derived from the designer of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR [1.131](#). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § [706.02\(1\)\(1\)](#) and § [706.02\(1\)\(2\)](#).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier filed design or utility application but is not claimed therein. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier filed design application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.
2. In brackets 1 and 4 insert serial number of copending application.
3. In bracket 2, insert inventor or assignee.
4. In bracket 3, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70 and 15.67 or 15.68.
5. Use 35 U.S.C. [102\(e\)](#) as amended by the American Inventor's Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application

which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

¶ 15.19.04 *Provisional 35 U.S.C. 102(e)/103(a) rejection - design claimed in an earlier filed design patent application with common inventor and/or assignee*

The claim is provisionally rejected under 35 U.S.C. 103(a) as being obvious over the claim in copending Design Patent Application No. [1] which has a common [2] with the instant application. Based upon the different inventive entity and the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application.

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[3]

Since the design claimed in the present application is not patentably distinct from the design claimed in the [4] application, this provisional rejection may be overcome by merging the two applications into a single continuation-in-part and abandoning the separate parent applications. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in an earlier filed copending application.

2. A provisional obviousness-type double patenting rejection must also be included in the action.
3. In brackets 1 and 4, insert serial number of copending application.
4. In bracket 2, insert inventor or assignee.
5. In bracket 3, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70 and 15.67 or 15.68.
6. This form paragraph must be preceded by form paragraph 15.19.02.

¶ 15.19.05 *35 U.S.C. 102(e)/103(a) rejection - design disclosed but not claimed*

The claim is rejected under 35 U.S.C. 103(a) as being obvious over [1].

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[2]

Since the design claimed in the present application is not the same invention claimed in the [3] patent, this rejection may be overcome by a showing under 37 CFR 1.132 that the design in the reference was derived from the designer of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the reference under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over subject matter disclosed in the drawings of an earlier filed design or utility patent, or application publication, but is not claimed therein. The design claimed in the application being examined can be an obvious version of subject matter disclosed in the drawings of an earlier filed design

application. This subject matter may be depicted in broken lines, or may be in the form of a subcombination (part or portion of an article) that is patentably distinct from the claim for the design embodied by the combination or whole article.

2. In brackets 1 and 3, insert number of the U.S. patent, U.S. patent application publication, or the WIPO publication of an international application that qualifies as prior art under 35 U.S.C. 102(e). See note 5 below.

3. In bracket 2, provide explanation of obviousness including differences and follow the explanation with form paragraphs 15.70 and 15.67 or 15.68.

4. Use 35 U.S.C. 102(e) as amended by the American Inventor's Protection Act to determine the reference's prior art date, unless the reference is a U.S. patent issued directly, or indirectly, from an international application which has an international filing date prior to November 29, 2000. Use pre-AIPA 35 U.S.C. 102(e) only if the reference is a U.S. patent issued directly or indirectly from either a national stage of an international application (application under 35 U.S.C. 371) which has an international filing date prior to November 29, 2000 or a continuing application claiming benefit under 35 U.S.C. 120, 121, or 365(c) to an international application having an international filing date prior to November 29, 2000. See the Examiner Notes for form paragraphs 7.12 and 7.12.01 to assist in the determination of the reference's 35 U.S.C. 102(e) date.

¶ 15.19.06 35 U.S.C. 102(e)/103(a) rejection - design claimed in a design patent with an earlier effective filing date and common assignee

The claim is rejected under 35 U.S.C. 103(a) as being obvious over the claim in design patent [1].

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[2]

Since the design claimed in the present application is not patentably distinct from the design claimed in the [3] patent, this rejection may be overcome by submitting an oath or declaration under 37 CFR 1.130 stating that this

application and the reference are currently owned by the same party and that the inventor named in this application is the prior inventor of the subject matter in the reference under 35 U.S.C. 104. In addition, a terminal disclaimer in accordance with 37 CFR 1.321(c) is also required. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2)

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in a design patent having an earlier effective date and a common assignee.

2. An obviousness-type double patenting rejection must also be included in the action.

3. In brackets 1 and 3, insert number of patent.

4. In bracket 2, provide explanation of obviousness including differences and follow the explanation by form paragraphs 15.70 and 15.67 or 15.68.

5. This form paragraph must be preceded by form paragraph 15.19.02.

¶ 15.19.07 35 U.S.C. 102(e)/103(a) rejection - design claimed in a design patent having an earlier effective filing date and no common assignee

The claim is rejected under 35 U.S.C. 103(a) as being obvious over the claim in design patent [1].

Based upon the different inventive entity and the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

Although the invention is not identically disclosed or described as set forth in 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

[2]

Examiner Note:

1. This form paragraph should be used when the claimed design in the application being examined is obvious over the design claimed in a design patent having an earlier effective filing date.

2. In bracket 2, provide explanation of obviousness including differences and follow explanation with form paragraphs 15.70 and 15.67 or 15.68.

¶ *15.20.02 Suggestion To Overcome Rejection Under 35 U.S.C. 112, First and Second Paragraphs*

It is suggested that applicant may submit large, clear informal drawings or photographs which show [1] in order that the examiner may be in a position to determine if the claim may be clarified without the addition of new matter ([35 U.S.C. 132](#), [37 CFR 1.121](#)). In the alternative, applicant may disclaim the areas or portions of the design which are considered indefinite and nonenabling by converting them to broken lines and amend the specification to include a statement that the portions of the [2] shown in broken lines form no part of the claimed design.

Examiner Note:

1. In bracket 1, identify the areas or portions of the design which are unclear.
2. In bracket 2, insert title of the article.

¶ *15.21 Rejection, 35 U.S.C. 112, First And Second Paragraphs*

The claim is rejected under [35 U.S.C. 112](#), first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is indefinite and nonenabling [1].

Examiner Note:

1. This form paragraph should not be used when it is appropriate to make one or more separate rejections under the first and/or the second paragraph of [35 U.S.C. 112](#).
2. In bracket 1, a complete explanation of the basis for the rejection should be provided.

¶ *15.21.01 Rejection, 35 U.S.C. 112 (Second Paragraph) (Information Requested)*

The claim is rejected for failing to particularly point out and distinctly claim the invention as required in [35 U.S.C. 112](#), second paragraph. The title of the article in which the design is embodied or applied is too ambiguous and therefore indefinite for the examiner to make a proper examination of the claim under [37 CFR 1.104](#).

Applicant is therefore required to provide a sufficient explanation of the nature and intended use of the article in which the claimed design is embodied or applied, so

that a proper classification and reliable search can be made. See [37 CFR 1.154\(b\)\(1\)](#); MPEP 1503.01. Additional information, if available, regarding analogous fields of search, pertinent prior art, advertising brochures and the filing of copending utility applications would also prove helpful. If a utility application has been filed, please furnish its application number.

This information should be submitted in the form of a separate paper, and should not be inserted in the specification ([37 CFR 1.56](#)). See also [37 CFR 1.97](#), [1.98](#) and [1.99](#).

¶ *15.22 Rejection, 35 U.S.C. 112, 2nd Paragraph*

The claim is rejected under 35 U.S.C. [112](#), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is indefinite [1].

Examiner Note:

1. Use this form paragraph when the scope of the claimed design cannot be determined.
2. In bracket 1, provide a full explanation of the basis for the rejection.

¶ *15.22.02 Rejection, 35 U.S.C. 112, 2nd Paragraph (“Or the Like” In Claim)*

The claim is rejected under [35 U.S.C. 112](#), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is indefinite because of the use of the phrase “[1]” following the title. Cancellation of said phrase in the claim and each occurrence of the title throughout the papers, except the oath or declaration, will overcome the rejection. See *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. App. & Inter. 1992) and [37 CFR 1.153](#).

Examiner Note:

1. This rejection should be used where there is another rejection in the Office action. For issue with an examiner’s amendment, see form paragraph 15.69.01.
2. In bracket 1, insert --or the like-- or --or similar article--.
3. This form paragraph should not be used when “or the like” or “or similar article” in the title is directed to the environment of the article embodying the design.

¶ *15.22.03 Rejection, 35 U.S.C. 112, Second Paragraph (Title Fails to Specify a Known Article of Manufacture)*

The claim is rejected under [35 U.S.C. 112](#), second paragraph, as indefinite in that the title, as set forth in the claim, fails to identify an article of manufacture and the drawing disclosure does not inherently identify the article in which the design is embodied. *Ex parte Strijland*, 26 USPQ2d 1259, 1263 (Bd. Pat. App. & Int. 1992). Therefore, any attempt to clarify the title by specifying the article in which the design is embodied may introduce new matter. See [35 U.S.C. 132](#) and 37 CFR [1.121](#).

¶ *15.23 35 U.S.C. 171 Double Patenting Rejection (Design-Design)*

The claim is rejected under [35 U.S.C. 171](#) on the ground of double patenting since it is claiming the same design as that claimed in United States Design Patent No. [1].

Examiner Note:

Form paragraph 15.23.02 should follow all “same invention” type double patenting rejections.

¶ *15.23.01 35 U.S.C. 171 Provisional Double Patenting Rejection (Design-Design)*

The claim is provisionally rejected under [35 U.S.C. 171](#) on the ground of double patenting since it is claiming the same design as that claimed in copending Application No. [1]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner Note:

Form paragraph 15.23.02 should follow all “same invention” type double patenting rejections.

¶ *15.23.02 Summary for “Same Invention” – Type Double Patenting Rejections*

Applicant is advised that a terminal disclaimer may not be used to overcome a “same invention” type double patenting rejection. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); MPEP § [804.02](#).

Examiner Note:

This form paragraph should follow all “same invention” type double patenting rejections.

¶ *15.24 Obviousness-type Double Patenting Rejection (Single Reference)*

The claim is rejected under the judicially created doctrine of the obviousness-type double patenting of the claim in United States Patent No. [1]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [2].

Examiner Note:

1. In bracket 1, insert prior U.S. Patent Number.
2. In bracket 2, the differences between the conflicting claims must be identified and indicated as being minor and not distinguishing the overall appearance of one over the other.
3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ *15.24.03 Provisional Obviousness-Type Double Patenting Rejection (Single Reference)*

The claim is provisionally rejected under the judicially created doctrine of the obviousness-type double patenting of the claim of copending Application No. [1]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [2]. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.
2. In bracket 2, the differences between the conflicting claims must be identified and indicated as being minor and not distinguishing the overall appearance of one over the other.
3. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.67.

¶ *15.24.04 Provisional Obviousness-Type Double Patenting Rejection (Multiple References)*

The claim is provisionally rejected under the judicially created doctrine of the obviousness-type double patenting of the claim of copending Application No. [1] in view of [2]. At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to [3] as demonstrated by [4]. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. In bracket 1, insert conflicting application number.
2. In bracket 2, insert secondary reference(s).
3. In bracket 3, insert an explanation of how the conflicting claim in the copending application is modified.
4. In bracket 4, identify the secondary reference(s) teaching the modification(s).
5. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.68.

¶ 15.24.05 *Identical Claim: Common Assignee*

The claim is directed to the same invention as that of the claim of commonly assigned copending Application No. [1]. The issue of priority under [35 U.S.C. 102\(g\)](#) and possibly [35 U.S.C. 102\(f\)](#) of this single invention must be resolved. Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see [MPEP § 2302](#)), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under [35 U.S.C.102\(f\) or \(g\)](#) and not an extension of monopoly. Failure to comply with this requirement will result in a holding of abandonment of this application.

¶ 15.24.06 *Basis for Nonstatutory Double Patenting, "Heading Only"*

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with [37 CFR 1.321\(c\)](#) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See [37 CFR 1.130\(b\)](#).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with [37 CFR 3.73\(b\)](#).

Examiner Note:

This form paragraph must precede all nonstatutory double patenting rejections as a heading, except "same invention" type.

¶ 15.24.07 *Double Patenting Rejection (Design-Utility)*

The claim is rejected under the judicially created doctrine of double patenting as being directed to the same invention as that set forth in claim [1] of United States

Patent No. [2]. See *In re Thorington*, 418 F.2d 528,163 USPQ 644 (CCPA 1969).

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

¶ 15.24.08 *Provisional Double Patenting Rejection (Design-Utility)*

The claim is provisionally rejected under the judicially created doctrine of double patenting as being directed to the same invention as that set forth in claim [1] of copending Application No. [2]. See *In re Thorington*, 418 F.2d 528,163 USPQ 644 (CCPA 1969).

This is a provisional double patenting rejection because the claims have not in fact been patented.

Examiner Note:

Form paragraph 15.23.02 should follow all "same invention" type double patenting rejections.

¶ 15.25 *Obviousness-Type Double Patenting Rejection (Multiple References)*

The claim is rejected under the judicially created doctrine of the obviousness-type double patenting of the claim(s) in United States Patent No. [1] in view of [2]. At the time applicant made the design, it would have been obvious to a designer of ordinary skill in the art to [3] as demonstrated by [4].

Examiner Note:

1. In bracket 1, insert conflicting patent number.
2. In bracket 2, insert secondary reference(s).
3. In bracket 3, insert an explanation of how the conflicting claim in the patent is modified.
4. In bracket 4, identify the secondary reference(s) teaching the modification(s).
5. This form paragraph must be preceded by form paragraph 15.24.06 and followed by form paragraph 15.68.

¶ 15.26 *Identification of Prior Application(s) in Nonprovisional Applications - Benefit Claimed*

Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under [37 CFR 1.53\(d\)](#)), the first sentence(s) of the specification or the application data sheet ([37 CFR](#)

[1.76](#)) should include a reference to the prior application(s) from which benefit is sought. See [37 CFR 1.78](#). The following format is suggested: “This is a continuation (or division) of Application No. _____, filed _____, now (abandoned, pending or U.S. Patent No. _____).”

¶ *15.27 Restriction Under 35 U.S.C. 121*

This application discloses the following embodiments:

Embodiment 1 - Figs. [1]

Embodiment 2 - Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967). The [4] create(s) patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [5]

Group II: Embodiment [6]

[7]

Restriction is required under [35 U.S.C. 121](#) to one of the above identified patentably distinct groups of designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, [37 CFR 1.143](#). Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 4, insert an explanation of the difference(s) between the embodiments.
3. In bracket 7, add groups as necessary.

¶ *15.27.01 Restriction Under 35 U.S.C. 121 (Obvious Variations Within Group)*

This application discloses the following embodiments:

Embodiment 1 - Figs. [1]

Embodiment 2 - Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view analogous prior art cited. Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the [7] patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Restriction is required under [35 U.S.C. 121](#) to one of the patentably distinct groups of the designs.

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed, [37 CFR 1.143](#). Any reply that does not include election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 6, add groups as necessary.
3. In bracket 7, insert an explanation of the difference(s) between the groups.

¶ 15.27.02 *Restriction Not Required - Change In Appearance (First Action - Non Issue)*

This application discloses the following embodiments:

Embodiment 1 - Figs. [1]

Embodiment 2 - Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the above identified embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.03 *Restriction Not Required - Change In Appearance (First Action Issue)*

This application discloses the following embodiments:

Embodiment 1 - Figs. [1]

Embodiment 2 - Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between the appearances of the embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.04 *Restriction Not Required – Change In Scope (First Action – Non Issue)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design.

Ex parte Sanford, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this Office action will be

considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.05 *Restriction Not Required – Change In Scope (First Action Issue)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design patent protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the difference in scope between embodiments is considered minor and patentably indistinct. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application.

Examiner Note:

In bracket 3, add embodiments as necessary.

¶ 15.27.06 *Restriction Not Required (Change in Appearance and Scope – First Action Non Issue)*

This application discloses the following embodiments:

Embodiment 1 - Figs. [1] drawn to a [2].

Embodiment 2 - Figs. [3] drawn to a [4].

[5]

Embodiments [6] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in

the same design application. *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

Embodiment(s) [7] directed to the combination(s) in relation to Embodiment(s) [8] directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they are deemed to be obvious variations and are being retained and examined in the same application. Any rejection of one embodiment over prior art will apply equally to all other embodiments. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the embodiments will be considered once the embodiments have been determined to comprise a single inventive concept. Failure of applicant to traverse this determination in reply to this action will be considered an admission of lack of patentable distinction between the embodiments.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.
3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

¶ 15.27.07 *Restriction Not Required (Change in Appearance and Scope – First Action Issue)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Embodiment(s) [6] involve a difference in appearance. Multiple embodiments of a single inventive concept may

be included in the same design application only if they are patentably indistinct. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm’r Pat. 1967).

Embodiment(s) [7] directed to the combination(s) in relation to Embodiment(s) [8] directed to the subcombination(s)/element(s). Designs which involve a change in scope may be included in the same design application only if they are patentably indistinct. However, design protection does not extend to patentably distinct segregable parts of a design. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm’r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965).

The above identified embodiments are considered by the examiner to present overall appearances that are basically the same. Furthermore, the differences between embodiments are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Accordingly, they were deemed to be obvious variations and are being retained and examined in the same application. Accordingly, they were deemed to comprise a single inventive concept and have been examined together.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.
3. It is possible and proper that embodiments may be listed in both explanatory paragraphs.

¶ 15.27.08 *Restriction with Differences in Appearance and Scope*

This application discloses the following embodiments:

Embodiment 1: Figs. [1] drawn to a [2].

Embodiment 2: Figs. [3] drawn to a [4].

[5]

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [6]

Group II: Embodiment [7]

[8]

Group(s) [9] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [10] creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Group(s) [11] directed to the combination(s) in relation to Group(s) [12] directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965). It is further noted that combination/subcombination subject matter, if patentably distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

Restriction is required under [35 U.S.C. 121](#) to one of the patentably distinct groups of designs.

A reply to this requirement must include an election of a single group for prosecution on the merits even if this requirement is traversed. [37 CFR 1.143](#). Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also requested to direct

cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over prior art will apply equally to all other groups. *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add embodiments as necessary.
3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.
4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.
5. In bracket 10, insert an explanation of the differences between the designs.

¶ 15.28 Telephone Restriction Under 35 U.S.C. 121

This application discloses the following embodiments:

Embodiment 1 - Figs. [1]

Embodiment 2 - Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [4] create(s) patentably

distinct designs. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or, if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

The above disclosed embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [5]

Group II: Embodiment [6]

[7]

Restriction is required under [35 U.S.C. 121](#) to one of the patentably distinct groups of designs.

During a telephone discussion with [8] on [9], a provisional election was made [10] traverse to prosecute the design(s) of group [11]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [12] is withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 4, insert an explanation of the difference(s) between the embodiments.
3. In bracket 7, add groups as necessary.
4. In bracket 10, insert --with-- or --without--.

¶ 15.28.01 Telephone Restriction Under 35 U.S.C.121 (Obvious Variations Within Group)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1]

Embodiment 2 – Figs. [2]

[3]

Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. See *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967).

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [4]

Group II: Embodiment [5]

[6]

The embodiments disclosed within each group have overall appearances that are basically the same. Furthermore, the differences between them are considered minor and patentably indistinct, or are shown to be obvious in view of analogous prior art cited. Therefore, they are considered by the examiner to be obvious variations of one another within the group. These embodiments thus comprise a single inventive concept and are grouped together. However, the [7] patentably distinguishes each group from the other(s).

Because of the differences identified, the embodiments of each Group are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Restriction is required under [35 U.S.C. 121](#) to one of the patentably distinct groups of designs.

During a telephone discussion with [8] on [9], a provisional election was made [10] traverse to prosecute the design(s) of group [11]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [12] is withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#), as being for a nonelected design(s).

Examiner Note:

1. In bracket 3, add embodiments as necessary.
2. In bracket 6, add groups as necessary.

3. In bracket 7, insert an explanation of the differences between the groups.

4. In bracket 10, insert --with--or --without--.

¶ 15.28.02 Telephone Restriction with Differences in Appearance and Scope

This application discloses the following embodiments:

Embodiment 1: Figs. [1] drawn to a [2].

Embodiment 2: Figs. [3] drawn to a [4].

[5]

The above embodiments divide into the following patentably distinct groups of designs:

Group I: Embodiment [6]

Group II: Embodiment [7]

[8]

Group(s) [9] involve a difference in appearance. Multiple embodiments of a single inventive concept may be included in the same design application only if they are patentably indistinct. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959). Embodiments that are patentably distinct from one another do not constitute a single inventive concept and thus may not be included in the same design application. *In re Platner*, 155 USPQ 222 (Comm'r Pat. 1967). The [10] creates patentably distinct designs.

Because of the differences identified, the embodiments are considered to either have overall appearances that are **not** basically the same, or if they are basically the same, the differences are **not** minor and patentably indistinct or are **not** shown to be obvious in view of analogous prior art.

Group(s) [11] directed to the combination(s) in relation to Group(s) [12] directed to the subcombination(s)/element(s). The designs as grouped are distinct from each other since under the law a design patent covers only the design disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. *Ex parte Sanford*, 1914 C.D. 69, 204 O.G. 1346 (Comm'r Pat. 1914); *Blumcraft of Pittsburg v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C.1965). It is further noted that combination/subcombination subject matter, if patentably

distinct, must be supported by separate claims, whereas only a single claim is permissible in a design patent application. *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

In any groups that include multiple embodiments, the embodiments are considered by the examiner to be obvious variations of one another within the group and, therefore, patentably indistinct. These embodiments thus comprise a single inventive concept and are grouped together.

Restriction is required under [35 U.S.C. 121](#) to one of the patentably distinct groups of designs.

During a telephone discussion with [13] on [14], a provisional election was made [15] traverse to prosecute the invention of Group [16]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [17] is withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#), as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. Insert an explanation of the differences between the designs in the explanations of the embodiments; for example, Figs. 1 – 5 directed to a cup and saucer; Figs. 6 – 9 directed to a saucer.
4. It is possible and proper that embodiments may be listed in both explanatory paragraphs.
5. In bracket 10, insert an explanation of the differences between the designs.
6. In bracket 15, insert --with-- or --without--.

¶ 15.29 Restriction Under 35 U.S.C. 121 (Segregable Parts or Combination/Subcombination)

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Restriction to one of the following inventions is required under [35 U.S.C. 121](#):

Group I – Embodiment [6]

Group II – Embodiment [7]

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm’r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

Because the designs are distinct for the reason(s) given above, and have acquired separate status in the art, restriction for examination purposes as indicated is proper ([35 U.S.C. 121](#)).

A reply to this requirement must include an election of a single group for prosecution on the merits, even if this requirement is traversed. [37 CFR 1.143](#). Any reply that does not include an election of a single group will be held nonresponsive. Applicant is also requested to direct cancellation of all drawing figures and the corresponding descriptions which are directed to the nonelected groups.

Should applicant traverse this requirement on the grounds that the groups are not patentably distinct, applicant should present evidence or identify such evidence now of record showing the groups to be obvious variations of one another. If the groups are determined not to be patentably distinct and they remain in this application, any rejection of one group over the prior art will apply equally to all other groups. See *Ex parte Appeal No. 315-40*, 152 USPQ 71 (Bd. App. 1965). No argument asserting patentability based on the differences between the groups will be considered once the groups have been determined to comprise a single inventive concept.

In view of the above requirement, action on the merits is deferred pending compliance with the requirement in accordance with *Ex parte Heckman*, 135 USPQ 229 (P.O. Super. Exam. 1960).

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.
3. In bracket 9, add comments, if necessary.

¶ *15.30 Telephone Restriction Under 35 U.S.C. 121 (Segregable Parts or Combination/Subcombination)*

This application discloses the following embodiments:

Embodiment 1 – Figs. [1] drawn to a [2].

Embodiment 2 – Figs. [3] drawn to a [4].

[5]

Restriction to one of the following inventions is required under [35 U.S.C. 121](#):

Group I – Embodiment [6]

Group II – Embodiment [7]

[8]

The designs as grouped are distinct from each other since under the law a design patent covers only the invention disclosed as an entirety, and does not extend to patentably distinct segregable parts; the only way to protect such segregable parts is to apply for separate patents. See *Ex parte Sanford*, 1914 CD 69, 204 OG 1346 (Comm’r Pat. 1914); and *Blumcraft of Pittsburgh v. Ladd*, 238 F. Supp. 648, 144 USPQ 562 (D.D.C. 1965). It is further noted that patentably distinct combination/subcombination subject matter must be supported by separate claims, whereas only a single claim is permissible in a design patent application. See *In re Rubinfeld*, 270 F.2d 391, 123 USPQ 210 (CCPA 1959).

[9]

During a telephone discussion with [10] on [11], a provisional election was made [12] traverse to prosecute the invention of Group [13]. Affirmation of this election should be made by applicant in replying to this Office action.

Group [14] withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#) as being for a nonelected invention.

Examiner Note:

1. In bracket 5, add embodiments as necessary.
2. In bracket 8, add groups as necessary.

3. In bracket 9, insert additional comments, if necessary.

¶ 15.31 *Provisional Election Required (37 CFR 1.143)*

Applicant is advised that the **reply** to be complete must include a provisional election of one of the enumerated designs, even though the requirement may be traversed ([37 CFR 1.143](#)).

¶ 15.33 *Qualifying Statement To Be Used In Restriction When A Common Embodiment Is Included In More Than One Group*

The common embodiment is included in more than a single group as it is patentably indistinct from the other embodiment(s) in those groups and to give applicant the broadest possible choices in his or her election. If the common embodiment is elected in this application, then applicant is advised that the common embodiment should not be included in any continuing application to avoid a rejection on the ground of double patenting under [35 U.S.C. 171](#) in the new application.

¶ 15.34 *Groups Withdrawn From Consideration After Traverse*

Group [1] withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#), as being for a nonelected design, the requirement having been traversed in the reply filed on [2].

¶ 15.35 *Cancel Nonelected Design (Traverse)*

The restriction requirement maintained in this application is or has been made final. Applicant must cancel Group [1] directed to the design(s) nonelected with traverse in the reply filed on [2], or take other timely appropriate action ([37 CFR 1.144](#)).

¶ 15.36 *Groups Withdrawn From Consideration Without Traverse*

Group [1] withdrawn from further consideration by the examiner, [37 CFR 1.142\(b\)](#), as being for the nonelected design. Election was made without traverse in the reply filed on [2].

¶ 15.37 *Cancellation of Nonelected Groups, No Traverse*

In view of the fact that this application is in condition for allowance except for the presence of Group [1] directed to a design or designs nonelected without traverse in the reply filed on [2], and without the right to petition, such Group(s) have been canceled.

¶ 15.38 *Rejection Maintained*

The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under [1] should be withdrawn.

Examiner Note:

In bracket 1, insert basis of rejection.

¶ 15.39 *Obviousness Under 35 U.S.C. 103(a) Repeated*

It remains the examiner's position that the [1] design claimed is obvious under [35 U.S.C. 103\(a\)](#) over [2].

Examiner Note:

In bracket 1, insert name of design.

¶ 15.39.01 *35 U.S.C. 103(a) Rejection Repeated (Multiple References)*

It remains the examiner's position that the claim is obvious under [35 U.S.C. 103\(a\)](#) over [1] in view of [2].

¶ 15.39.02 *Final Rejection Under 35 U.S.C. 103(a) (Single Reference)*

The claim is again and FINALLY REJECTED under [35 U.S.C. 103\(a\)](#) over [1].

Examiner Note:

See form paragraphs in [MPEP Chapter 700](#), for "Action is Final" and "Advisory after Final" paragraphs.

¶ 15.40 *Final Rejection Under 35 U.S.C. 103(a) (Multiple References)*

The claim is again and FINALLY REJECTED under [35 U.S.C. 103\(a\)](#) as being unpatentable over [1] in view of [2].

Examiner Note:

See form paragraphs in MPEP Chapter [700](#) for "Action is Final" and "Advisory after Final" paragraphs.

¶ 15.40.01 *Final Rejection Under Other Statutory Provisions*

The claim is again and FINALLY REJECTED under [1] as [2].

Examiner Note:

1. In bracket 1, insert statutory basis.
2. In bracket 2, insert reasons for rejection.
3. See paragraphs in MPEP Chapter [700](#), for "Action is Final" and "Advisory after Final" paragraphs.

¶ 15.41 *Functional, Structural Features Not Considered*

Attention is directed to the fact that design patent applications are concerned solely with the ornamental appearance of an article of manufacture. The functional and/or structural features stressed by applicant in the papers are of no concern in design cases, and are neither permitted nor required. Function and structure fall under the realm of utility patent applications.

¶ 15.42 *Visual Characteristics*

The design for an article consists of the visual characteristics or aspect displayed by the article. It is the appearance presented by the article which creates an impression through the eye upon the mind of the observer.

¶ 15.43 *Subject Matter of Design Patent*

Since a design is manifested in appearance, the subject matter of a Design Patent may relate to the configuration or shape of an article, to the surface ornamentation on an article, or to both.

¶ 15.44 *Design Inseparable From Article to Which Applied*

Design is inseparable from the article to which it is applied, and cannot exist alone merely as a scheme of ornamentation. It must be a definite preconceived thing, capable of reproduction, and not merely the chance result of a method or of a combination of functional elements ([35 U.S.C. 171](#); [35 U.S.C. 112](#), first and second paragraphs). See *Blisscraft of Hollywood v. United Plastics Co.*, 189 F. Supp. 333, 127 USPQ 452 (S.D.N.Y. 1960), 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961).

¶ 15.45 *Color Photographs/Drawings As Informal Drawings*

For filing date purposes, in those design patent applications containing color photographs/drawings contrary to the requirement for ink drawings or black and white photographs, the Office of Initial Patent Examination has been authorized to construe the color photographs/drawings as informal drawings rather than to hold the applications incomplete as filed. By so doing, the Patent and Trademark Office can accept the applications without requiring applicants to file petitions to obtain the original deposit date as the filing date. However, color photographs or color drawings are not permitted in design applications in the absence of a grantable petition pursuant to [37 CFR 1.84\(a\)\(2\)](#). Before the color photographs or color drawings in this application can be treated as formal drawings, applicant must submit [1].

Examiner Note:

In bracket 1, insert --a petition--, --the fee--, --statement in the specification--, --explanation of why color disclosure is necessary--, and -- three full sets of color photographs or color drawings--.

¶ 15.46.01 *Impermissible Descriptive Statement*

The descriptive statement included in the specification is impermissible because [1]. See MPEP § [1503.01](#), subsection II. Therefore, the description should be canceled as any description of the design in the specification, other than a brief description of the drawing, is generally not necessary, since as a general rule, the illustration in the drawing views is its own best description.

Examiner Note:

In bracket 1, insert the reason why the descriptive statement is improper.

¶ 15.47 *Characteristic Feature Statement*

A “characteristic features” statement describing a particular feature of novelty or nonobviousness in the claimed design may be permissible in the specification. Such a statement should be in terms such as “The characteristic feature of the design resides in [1],” or if combined with one of the Figure descriptions, in terms such as “the characteristic feature of which resides in [2].” While consideration of the claim goes to the total or overall appearance, the use of a “characteristic feature” statement may serve later to limit the claim (*McGrady v. Aspenglas Corp.*, 487 F. Supp. 859, 208 USPQ 242 (S.D.N.Y. 1980)).

Examiner Note:

In brackets 1 and 2, insert brief but accurate description of the feature of novelty or nonobviousness of the claimed design.

¶ 15.47.01 *Feature Statement Caution*

The inclusion of a feature statement in the specification is noted. However, the patentability of the claimed design is not based on the specified feature but rather on a comparison of the *overall appearance* of the design with the prior art. *In re Leslie*, 547 F.2d 116, 192 USPQ 427 (CCPA 1977).

¶ 15.48 *Necessity for Good Drawings*

The necessity for good drawings in a design patent application cannot be overemphasized. As the drawing constitutes the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness, that nothing

regarding the design sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity ([35 U.S.C. 112](#), first paragraph). Moreover, an insufficient drawing may have a negative effect with respect to the effective filing date of a continuing application.

¶ 15.49 Surface Shading Necessary

The drawing figures should be appropriately and adequately shaded to show clearly the character and/or contour of all surfaces represented. See [37 CFR 1.152](#). This is of particular importance in the showing of three (3) dimensional articles where it is necessary to delineate plane, concave, convex, raised, and/or depressed surfaces of the subject matter, and to distinguish between open and closed areas. Solid black surface shading is not permitted except when used to represent the color black as well as color contrast.

¶ 15.50 Design Claimed Shown in Full Lines

The ornamental design which is being claimed must be shown in solid lines in the drawing. Dotted lines for the purpose of indicating unimportant or immaterial features of the design are not permitted. There are no portions of a claimed design which are immaterial or unimportant. See *In re Blum*, 374 F.2d 904, 153 USPQ 177 (CCPA 1967) and *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980).

¶ 15.50.01 Use of Broken Lines in Drawing

Environmental structure may be illustrated by broken lines in the drawing if clearly designated as environment in the specification. See [37 CFR 1.152](#) and [MPEP § 1503.02](#), subsection III.

¶ 15.50.02 Description of Broken Lines

The following statement must be used to describe the broken lines on the drawing ([MPEP § 1503.02](#), subsection III):

-- The broken line showing of [1] is for the purpose of illustrating [2] and forms no part of the claimed design.

--

The above statement [3] inserted in the specification preceding the claim.

Examiner Note:

1. In bracket 1, insert name of structure.
2. In bracket 2, insert --portions of the "article"-- or --environmental structure--.
3. In bracket 3, insert --must be-- or --has been--.

¶ 15.50.03 Objectionable Use of Broken Lines In Drawings

Dotted lines or broken lines used for environmental structure should not cross or intrude upon the representation of the claimed design for which design protection is sought. Such dotted lines may obscure the claimed design and render the disclosure indefinite ([35 U.S.C. 112](#)).

¶ 15.50.04 Proper Drawing Disclosure With Use of Broken Lines

Where broken lines showing environmental structure obscure the full line disclosure of the claimed design, a separate figure showing the broken lines must be included in the drawing in addition to the figures showing only claimed subject matter, [35 U.S.C. 112](#), first paragraph.

¶ 15.50.05 Description of Broken Lines as Boundary of Design

The following statement must be used to describe the broken line boundary of a design ([MPEP § 1503.02](#), subsection III):

-- The broken line(s) which define the bounds of the claimed design form no part thereof.--

¶ 15.51 35 U.S.C. 112, First Paragraph Rejection (New Matter)

The claim is rejected under 35 U.S.C. [112](#), first paragraph as failing to comply with the description requirement thereof since the [1] introduces new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure [2].

To overcome this rejection, applicant may attempt to demonstrate that the original disclosure establishes that he or she was in possession of the amended claim or [3].

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.
2. In bracket 2, specifically identify what is new matter so that the basis for the rejection is clear.

3. In bracket 3, insert specific suggestion how rejection may be overcome depending on the basis; such as, “the bracket in figures 3 and 4 of the new drawing may be corrected to correspond to the original drawing” or “the specification may be amended by deleting the descriptive statement.”

¶ *15.51.01 Amendment to Disclosure Not Affecting Claim - 35 U.S.C. 132 Objection (New Matter)*

The [1] is objected to under 35 U.S.C. [132](#) and 37 CFR [1.121](#) as introducing new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the amended subject matter at the time the application was filed. See *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure [2].

To overcome this objection, applicant may attempt to demonstrate that the original disclosure establishes that he or she was in possession of the amended subject matter or [3].

Examiner Note:

1. In bracket 1, specify whether new drawing or amendment to the drawing, title or specification.
2. In bracket 2, specifically identify what is new matter so that the basis for the objection is clear.
3. In bracket 3, insert specific suggestion how the objection may be overcome depending on the basis; such as, “the broken line showing of environmental structure in Fig. 1 of the new drawing may be omitted to correspond to the original drawing” or “the title may be amended by deleting the reference to environmental structure”.

¶ *15.55 Design Patent-Copyright Overlap*

There is an area of overlap between Copyright and Design Patent Statutes where an author/inventor can secure both a Copyright and a Design Patent. Thus, an ornamental design may be copyrighted as a work of art and may also be the subject matter of a Design Patent. The author/inventor may not be required to elect between securing a copyright or a design patent. See *In re Yardley*, 493 F.2d 1389, 181 USPQ 331 (CCPA 1974). In *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (U.S. 1954), the Supreme Court noted the election of protection doctrine but did not express any view on it since a Design Patent had been secured in the case and the issue was not before the Court..

It is the policy of the Patent and Trademark Office to permit the inclusion of a copyright notice in a Design

Patent application, and thereby any patent issuing therefrom, under the following conditions:

(1) A copyright notice must be placed adjacent to the copyright material and, therefore, may appear at any appropriate portion of the patent application disclosure including the drawing. However, if appearing on the drawing, the notice must be limited in print size from 1/8 inch to 1/4 inch and must be placed within the “sight” of the drawing immediately below the figure representing the copyright material. If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under [37 CFR 1.84](#).

(2) The content of the copyright notice must be limited to only those elements required by law. For example, “© 1983 John Doe” would be legally sufficient under 17 U.S.C. 401 and properly limited.

(3) Inclusion of a copyright notice will be permitted only if the following waiver is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

A portion of the disclosure of this patent document contains material to which a claim for copyright is made. The copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but reserves all other copyrights whatsoever.

(4) Inclusion of a copyright notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR [1.312](#) have been satisfied.

Any departure from these conditions may result in a refusal to permit the desired inclusion. If the waiver required under condition (3) above does not include the specific language “(t)he copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records....,” the copyright notice will be objected to as improper.

¶ *15.55.01 Design Patent - Trademark Overlap*

A design patent and a trademark may be obtained on the same subject matter. The Court of Customs and Patent Appeals, in *In re Mogen David Wine Corp.*, 328 F.2d 925, 140 USPQ 575 (CCPA 1964), later reaffirmed by the same court at 372 F.2d 539, 152 USPQ 593 (CCPA 1967), has held that the underlying purpose and essence of patent rights are separate and distinct from those pertaining to trademarks, and that no right accruing from the one is dependent upon or conditioned by any right concomitant to the other.

¶ 15.58 *Claimed Design Is Patentable (Ex parte Quayle Actions)*

The claimed design is patentable over the references cited.

¶ 15.58.01 *Claimed Design Is Patentable (35 U.S.C. 112 Rejections)*

The claimed design is patentable over the references cited. However, a final determination of patentability will be made upon resolution of the above rejection.

¶ 15.59 *Amend Title*

For [1], the title [2] amended throughout the application, original oath or declaration excepted, to read: [3]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert --should be-- or --has been--.

¶ 15.60 *Amend All Figure Descriptions*

For [1], the figure descriptions [2] amended to read: [3]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert --should be-- or --have been--.
3. In bracket 3, insert amended text.

¶ 15.61 *Amend Selected Figure Descriptions*

For [1], the description(s) of Fig(s). [2][3] amended to read: [4]

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert selected Figure descriptions.
3. In bracket 3, insert --should be-- or --have been--.
4. In bracket 4, insert amended text.

¶ 15.62 *Amend Claim “As Shown”*

For proper form (37 CFR 1.153), the claim [1] amended to read: “[2] claim: The ornamental design for [3] as shown.”

Examiner Note:

1. In bracket 1, insert --must be-- or --has been--.
2. In bracket 2, insert --I-- or --We--.
3. In bracket 3, insert title of the article in which the design is embodied or applied.

¶ 15.63 *Amend Claim “As Shown and Described”*

For proper form (37 CFR 1.153), the claim [1] amended to read: “[2] claim: The ornamental design for [3] as shown and described.”

Examiner Note:

1. In bracket 1, insert --must be-- or --has been--.
2. In bracket 2, insert --I-- or --We--.
3. In bracket 3, insert title of the article in which the design is embodied or applied.

¶ 15.64 *Addition of “And Described” to Claim*

Because of [1] -- and described -- [2] added to the claim after “shown.”

Examiner Note:

1. In bracket 1, insert reason.
2. In bracket 2, insert --must be-- or --has been--.

¶ 15.65 *Amendment May Not Be Possible*

The claim might be fatally defective; that is, it might not be possible to [1] without introducing new matter (35 U.S.C. 132, 37 CFR 1.121).

Examiner Note:

In bracket 1, identify portion of the claimed design which is insufficiently disclosed.

¶ 15.66 *Employ Services of Patent Attorney or Agent (Design Application Only)*

As the value of a design patent is largely dependent upon the skillful preparation of the drawings and specification, applicant might consider it desirable to employ the services of a registered patent attorney or agent. The U.S. Patent and Trademark Office cannot aid in the selection of an attorney or agent.

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

¶ 15.66.01 *Employ Services of Professional Patent Draftsperson (Design Application Only)*

As the value of a design patent is largely dependent upon the skillful preparation of the drawings, applicant might consider it desirable to employ the services of a professional patent draftsperson familiar with design practice. The U.S. Patent and Trademark Office cannot aid in the selection of a draftsperson.

Examiner Note:

This form paragraph should only be used in *pro se* applications where it appears that patentable subject matter is present and the disclosure of the claimed design complies with the requirements of [35 U.S.C. 112](#).

¶ 15.67 *Rationale for 35 U.S.C. 103(a) Rejection (Single Reference)*

It is well settled that it is unobviousness in the overall appearance of the claimed design, when compared with the prior art, rather than minute details or small variations in design as appears to be the case here, that constitutes the test of design patentability. See *In re Frick*, 275 F.2d 741, 125 USPQ 191 (CCPA 1960) and *In re Lamb*, 286 F.2d 610, 128 USPQ 539 (CCPA 1961).

¶ 15.68 *Rationale for 35 U.S.C. 103(a) Rejection (Multiple References)*

This modification of the primary reference in light of the secondary reference is proper because the applied references are so related that the appearance of features shown in one would suggest the application of those features to the other. See *In re Rosen*, 673 F.2d 388, 213 USPQ 347 (CCPA 1982); *In re Carter*, 673 F.2d 1378, 213 USPQ 625 (CCPA 1982), and *In re Glavas*, 230 F.2d 447, 109 USPQ 50 (CCPA 1956). Further, it is noted that case law has held that a designer skilled in the art is charged with knowledge of the related art; therefore, the combination of old elements, herein, would have been well within the level of ordinary skill. See *In re Antle*, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971) and *In re Nalbandian*, 661 F.2d 1214, 211 USPQ 782 (CCPA 1981).

¶ 15.69.01 *Remove Indefinite Language (“Or The Like”) by Examiner’s Amendment*

The phrase [1] in the claim following the title renders the claim indefinite. By authorization of [2] in a telephone interview on [3], the phrase has been cancelled from the claim and at each occurrence of the title throughout the papers, except the oath or declaration ([35 U.S.C. 112](#), second paragraph, and [37 CFR 1.153](#)). See *Ex parte Pappas*, 23 USPQ2d 1636 (Bd. Pat. App. & Inter. 1992).

Examiner Note:

In bracket 1, insert objectionable phrase, e.g., --or the like--, --or similar article--, etc.

¶ 15.70 *Preface, 35 U.S.C. 103(a) Rejection*

It would have been obvious to a designer of ordinary skill in the art at the time the invention was made to [1].

Examiner Note:

Insert explanation of the use of the reference applied in bracket 1.

¶ 15.72 *Quayle Action*

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm’r Pat. 1935).

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

¶ 15.73 *Corrected Drawing Sheets Required*

Failure to submit replacement correction sheets overcoming all of the deficiencies in the drawing disclosure set forth above, or an explanation why the drawing corrections or additional drawing views are not necessary will result in the rejection of the claim under 35 U.S.C. [112](#), first and second paragraphs, being made FINAL in the next Office action.

¶ 15.74 *Continuation-In-Part*

Reference to this design application as a continuation-in-part under [35 U.S.C. 120](#) is acknowledged. Applicant is advised that the design disclosed in the parent application is not the same design as the design disclosed in this application. Therefore, this application does not satisfy the written description requirement of [35 U.S.C. 112](#), first paragraph, under [35 U.S.C. 120](#) and is not entitled to benefit of the earlier filing date. However, unless the filing date of the earlier application is actually needed, such as to avoid intervening prior art, the entitlement to priority in this CIP application will not be considered. See *In re Corba*, 212 USPQ 825 (Comm’r Pat. 1981).

Examiner Note:

This form paragraph should be used to notify applicant that the C-I-P application is not entitled to the benefit of the parent application under [35 U.S.C. 120](#).

¶ 15.75 *Preface to Rejection in Alleged CIP Based on 35 U.S.C. 102(d)/172*

Reference to this design application as a continuation-in-part under [35 U.S.C. 120](#) is acknowledged. Applicant is advised that the design disclosed in the parent application is not the same design as the design disclosed in this application. Therefore, this application does not satisfy the written description

requirement of [35 U.S.C. 112](#), first paragraph, under [35 U.S.C. 120](#) and is not entitled to benefit of the earlier filing date.

The parent application claimed foreign priority under [35 U.S.C. 119\(a\) - \(d\)](#). Insofar as the foreign application has matured into a patent/registration more than six months before the filing date of the present application, it qualifies as prior art under 35 U.S.C. [102\(d\)/172](#).

Examiner Note:

This form paragraph should be followed with a rejection under [35 U.S.C. 102](#) or [103\(a\)](#) depending on the difference(s) between this claim and the design shown in the priority papers.

¶ *15.75.01 C-I-P Caution, Claim to Foreign Priority in Earlier Filed Application*

Reference to this application as a continuation-in-part under 35 U.S.C. [120](#) is acknowledged. Applicant is advised that the design disclosed in the parent application is not the same design as the design disclosed in this application. Therefore, this application does not satisfy the written description requirement of 35 U.S.C. [112](#), first paragraph, under 35 U.S.C. [120](#) and is not entitled to benefit of the earlier filing date.

However, unless the filing date of the earlier application is actually needed, such as to avoid intervening prior art, entitlement to priority in this CIP application will not be considered. See *In re Corba*, 212 USPQ 825 (Comm'r Pat. 1981).

The parent application claimed foreign priority under 35 U.S.C. [119\(a\) - \(d\)](#). Applicant is reminded that if the foreign application to which priority was claimed matured

into a form of patent protection prior to the filing of this application it qualifies as prior art under 35 U.S.C. [102\(d\)/172](#).

¶ *15.76 Trademark in Drawing*

The [1] forming part of the claimed design is a registered trademark of [2]. The specification must be amended to include a statement preceding the claim identifying the trademark material forming part of the claimed design and the name of the owner of the trademark.

Examiner Note:

1. In bracket 1, identify the trademark material.
2. In bracket 2, identify the trademark owner.

¶ *15.85 Undisclosed visible surface(s)/portion(s) of article not forming part of the claimed design*

The [1] of the article [2] not shown in the drawing or described in the specification. It is understood that the appearance of any part of the article not shown in the drawing or described in the specification forms no part of the claimed design. *In re Zahn*, 617 F.2d 261, 204 USPQ 988 (CCPA 1980). Therefore, the determination of patentability is based on the design for the article shown and described.

Examiner Note:

1. In bracket 1, insert surface or surfaces which are not shown.
2. In bracket 2, insert "is" or "are".

¶ *15.90 Indication of allowability withdrawn*

The indication of allowability set forth in the previous action is withdrawn and prosecution is reopened in view of the following new ground of rejection.

Chapter 1600 - Plant Patents

¶ 16.01 *Specification, Manner of Asexually Reproducing*

The application is objected to under [37 CFR 1.163\(a\)](#) because the specification does not “particularly point out where and in what manner the variety of plant has been asexually reproduced”. Correction is required.

¶ 16.02 *Colors Specified Do Not Correspond With Those Shown*

The disclosure is objected to under [35 U.S.C. 112](#), first paragraph, because the [1] colors specified fail to correspond with those shown.

¶ 16.03 *Rejection, 35 U.S.C. 112, 1st Paragraph, Non-Support for Colors*

The claim is rejected under [35 U.S.C. 112](#), first paragraph, as being unsupported by a clear and complete disclosure with regard to [1] colors, for the following reasons: [2].

¶ 16.04 *Rejection, 35 U.S.C. 102*

The claim is rejected under [35 U.S.C. 102](#) as failing to patentably distinguish over [1].

¶ 16.05 *Name or Denomination for Plant Missing*

The disclosure is objected to under [37 CFR 1.121\(e\)](#) because no “variety denomination” of the instant plant has been set forth in the disclosure. [37 CFR 1.163\(c\)\(4\)](#). Correction by adding such a name is required.

¶ 16.05.01 *Latin Name of Genus and Species of the Plant Claimed Missing*

The disclosure is objected to under [37 CFR 1.121\(e\)](#) because the Latin name of the genus and species of the instant plant has not been set forth in the disclosure. [37 CFR 1.163\(c\)\(4\)](#). Correction by adding such a name is required.

¶ 16.06 *Drawings Must Be in Duplicate*

The disclosure is objected to under [37 CFR 1.165\(b\)](#) because applicant has not provided copies of the drawing in duplicate. Correction is required.

¶ 16.07 *Drawing Figures Not Competently Executed*

The disclosure is objected to under [37 CFR 1.165\(a\)](#) because Fig. [1] not artistically and/or competently executed.

¶ 16.08 *Rejection, 35 U.S.C. 112*

The claim is rejected under [35 U.S.C. 112](#) [1] because [2].

¶ 16.09 *Specification, Less Than Complete Description*

The disclosure is objected to under [37 CFR 1.163\(a\)](#) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties. More specifically: [1].

¶ 16.10 *Specification, Location of Plant Not Disclosed*

The disclosure is objected to under [37 CFR 1.163\(a\)](#) because the specification does not particularly point out the location and character of the area where the plant was discovered.

¶ 16.11 *Drawings in Improper Scale*

The disclosure is objected to under [37 CFR 1.165\(a\)](#) because the drawings are of an inadequate scale to show the distinguishing features of the plant.

¶ 16.12 *Report From U.S. Dept. of Agriculture*

This application has been submitted to the U.S. Department of Agriculture for a report. Pertinent portions follow: [1]

¶ 16.13 *Specimens Are Required*

Applicant [1] required to submit [2] in accordance with [37 CFR 1.166](#).

Chapter 1800 - Patent Cooperation Treaty

¶ 18.01 Lacks Novelty

Claim [1] novelty under [PCT Article 33\(2\)](#) as being anticipated by [2].

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.

¶ 18.02 Lacks Inventive Step - One Reference

Claim [1] an inventive step under [PCT Article 33\(3\)](#) as being obvious over [2]. [3]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of prior art relied upon.
3. In bracket 3, add reasoning.

¶ 18.02.01 Lacks Inventive Step - Two References

Claim [1] an inventive step under [PCT Article 33\(3\)](#) as being obvious over [2] in view of [3]. [4]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, insert name of PRIMARY prior art relied upon.
3. In bracket 3, insert name of SECONDARY prior art relied upon.
4. In bracket 4, add reasoning.

¶ 18.02.02 Lacks Inventive Step - Additional Reference

Claim [1] an inventive step under [PCT Article 33\(3\)](#) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of [2]. [3]

Examiner Note:

1. This form paragraph may follow either 18.02 or 18.02.01.
2. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
3. In bracket 2, insert name of additional prior art relied upon.
4. In bracket 3, add reasoning.

¶ 18.03 Lacks Industrial Applicability

Claim [1] industrial applicability as defined by [PCT Article 33\(4\)](#). [2]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --lack-- or --lacks--, as appropriate.
2. In bracket 2, add reasoning.

¶ 18.04 Meets Novelty and Inventive Step

Claim [1] the criteria set out in [PCT Article 33\(2\)-\(3\)](#), because the prior art does not teach or fairly suggest [2].

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and insert the verb --meet-- or --meets--, as appropriate.
2. In bracket 2, insert the details of the claimed subject matter that render it unobvious over the prior art.
3. If the claims also meet the industrial applicability criteria set out in [PCT Article 33\(4\)](#), this form paragraph should be followed by form paragraph 18.04.01.
4. If the claims do not meet the industrial applicability criteria set out in [PCT Article 33\(4\)](#), this form paragraph should be followed by form paragraph 18.03.

¶ 18.04.01 Meets Industrial Applicability

Claim [1] the criteria set out in [PCT Article 33\(4\)](#), and thus [2] industrial applicability because the subject matter claimed can be made or used in industry.

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --meet-- or --meets--, as appropriate.
2. In bracket 2, insert --have-- or --has--, as appropriate.
3. If the claims meet all of the requirements of [PCT Article 33\(2\)-\(4\)](#), use form paragraph 18.04 before this form paragraph to provide positive statements for novelty and inventive step under [PCT Article 33\(2\)-\(3\)](#).
4. If the claims have industrial applicability but lack novelty and inventive step, use this form paragraph and additionally use form paragraph 18.01.
5. If the claims have industrial applicability and novelty but lack inventive step, use this form paragraph and additionally use one or more of form paragraphs 18.02, 18.02.01 and 18.02.02, as appropriate.
6. If the claims do not have industrial applicability, use form paragraph 18.03 instead of this form paragraph.

¶ 18.05 *Heading for Lack of Unity Action for PCT Applications During the International Phase (Including Species)*

REQUIREMENT FOR UNITY OF INVENTION

As provided in [37 CFR 1.475\(a\)](#), an international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an international application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See [37 CFR 1.475\(e\)](#).

When Claims Are Directed to Multiple Processes, Products, and/or Apparatuses:

Products, processes of manufacture, processes of use, and apparatuses are different categories of invention. When an application includes claims to more than one product, process, or apparatus, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the “main invention” in the claims. In the case of non-compliance with unity of invention and where no additional fees are timely paid, the international search and/or international preliminary examination, as appropriate, will be based on the main invention in the claims. See [PCT Article 17\(3\)\(a\)](#), [37 CFR 1.475\(d\)](#), [37 CFR 1.476\(c\)](#) and [37 CFR 1.488\(b\)\(3\)](#).

As provided in [37 CFR 1.475\(b\)](#), an international application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See [37 CFR 1.475\(c\)](#).

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under [PCT Rule 13.1](#).

Examiner Note:

- 1. Begin all Lack of Unity actions for PCT applications during the international phase (including species) with this heading.
- 2. Follow with form paragraphs 18.06 - 18.06.02, 18.07 - 18.07.03, as appropriate.
- 3. Use form paragraph 18.18 for lack of unity in U.S. national stage applications submitted under [35 U.S.C. 371](#).

¶ 18.06 *Lack of Unity - Three Groups of Claims*

Group [1], claim(s) [2], drawn to [3].

Group [4], claim(s) [5], drawn to [6].

Group [7], claim(s) [8], drawn to [9].

Examiner Note:

- 1. In brackets 1, 4 and 7, insert Roman numerals for each Group.
- 2. In brackets 2, 5 and 8, insert respective claim numbers.
- 3. In brackets 3, 6 and 9, insert respective names of grouped inventions.

¶ 18.06.01 *Lack of Unity - Two (or Additional) Groups of Claims*

Group [1], claim(s) [2], drawn to [3].

Group [4], claim(s) [5], drawn to [6].

Examiner Note:

This form paragraph may be used alone or following form paragraph 18.06.

¶ 18.06.02 *Lack of Unity - One Additional Group of Claims*

Group [1], claim(s) [2], drawn to [3].

Examiner Note:

This form paragraph may be used following either form paragraph 18.06 or 18.06.01.

¶ 18.07 Lack of Unity - Reasons Why Inventions Lack Unity

The groups of inventions listed above do not relate to a single general inventive concept under [PCT Rule 13.1](#) because, under [PCT Rule 13.2](#), they lack the same or corresponding special technical features for the following reasons:

Examiner Note:

Follow with form paragraphs 18.07.01 through 18.07.03, as appropriate.

¶ 18.07.01 Same or Corresponding Technical Feature Lacking Among Groups

[1] lack unity of invention because the groups do not share the same or corresponding technical feature.

Examiner Note:

1. This form paragraph may be used, for example, where the claims of Group I are directed to A + B, whereas the claims of Group II are directed to C + D, and thus the groups do not share a technical feature.

2. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or identify the species involved where species have been listed using form paragraph 18.20.

¶ 18.07.02 Shared Technical Feature Does Not Make a Contribution Over the Prior Art

[1] lack unity of invention because even though the inventions of these groups require the technical feature of [2], this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of [3]. [4]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) where inventions have been grouped using form paragraphs 18.06 - 18.06.02, or

identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, identify the technical feature shared by the groups.

3. In bracket 3, insert citation of prior art reference(s) demonstrating the shared technical feature does not make a contribution over the prior art. Whether a particular technical feature makes a “contribution” over the prior art, and, therefore, constitutes a “special technical feature,” is considered with respect to novelty and inventive step.

4. In bracket 4, explain how the shared technical feature lacks novelty or inventive step in view of the reference(s).

¶ 18.07.03 Heading – Chemical Compound Alternatives of Markush Group Are Not of a Similar Nature

Where a single claim defines alternatives of a Markush group, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, is considered met when the alternatives are of a similar nature. When the Markush grouping is for alternatives of chemical compounds, the alternatives are regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity; AND

(B) (1) a common structure is present, that is, a significant structural element is shared by all of the alternatives; OR

(B) (2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The phrase “significant structural element is shared by all of the alternatives” refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.

The phrase “recognized class of chemical compounds” means that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

Examiner Note:

1. This heading should be used when the chemical alternatives of a Markush group are determined to lack unity of invention.

2. Follow with form paragraphs listed using form paragraphs 18.07.03a - 18.07.03c, as appropriate.

¶ 18.07.03a *Alternatives Lack Common Property or Activity*

The chemical compounds of [1] are not regarded as being of similar nature because all of the alternatives do not share a common property or activity. [2]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, insert reasoning.

¶ 18.07.03b *Alternatives Share a Common Structure - However, the Common Structure is Not a Significant Structural Element and the Alternatives Do Not Belong to a Recognized Class*

Although the chemical compounds of [1] share a common structure of [2], the common structure is not a significant structural element because it represents only a small portion of the compound structures and does not constitute a structurally distinctive portion in view of [3]. Further, the compounds of these groups do not belong to a recognized class of chemical compounds. [4]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, identify common structure.

3. In bracket 3, insert citation of prior art reference(s) relied upon to demonstrate the commonly shared structure is not distinctive.

4. In bracket 4, explain why the compounds do not belong to a recognized class of chemical compounds.

¶ 18.07.03c *Alternatives Do Not Share a Common Structure or Belong to Recognized Class*

The chemical compounds of [1] are not regarded as being of similar nature because: (1) all the alternatives do not share a common structure and (2) the alternatives do not all belong to a recognized class of chemical compounds. [2]

Examiner Note:

1. In bracket 1: For **international applications in the international phase**, identify the groups involved by Roman numerals (e.g., “Groups I and II”) in accordance with the groups listed using form paragraphs 18.06 - 18.06.02. For **U.S. national stage applications under 35 U.S.C. 371**, identify the species involved where species have been listed using form paragraph 18.20.

2. In bracket 2, insert reasoning.

¶ 18.08 *Drawing - Defect in Form or Contents Thereof*

The drawings contain the following defect(s) in the form or content thereof: [1]

Examiner Note:

In bracket 1, insert identification of defects in drawings.

¶ 18.08.01 *Drawing Is Required*

The subject matter of this application admits of illustration by drawing to facilitate understanding of the invention. Applicant is required under [PCT Article 7\(1\)](#) to furnish a drawing.

¶ 18.09 *Description - Defect in Form or Contents Thereof*

The description contains the following defect(s) in the form or contents thereof: [1]

Examiner Note:

In bracket 1, insert the technical problem, e.g., misspelled word.

¶ 18.10 *Claims - Defect in Form or Contents Thereof*

Claim [1] contain(s) the following defect(s) in the form or contents thereof: [2]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, and insert claim no.(s).

2. In bracket 2, identify the technical deficiency.

¶ 18.11 *Drawing Objections - Lack Clarity*

The drawings are objected to under [PCT Article 7](#) as lacking clarity under [PCT Article 7](#) because: [1]

Examiner Note:

In bracket 1, insert reasons why the drawings lack clarity, e.g., inaccurate showing.

¶ 18.12.01 Claims Objectionable - Inadequate Written Description

Claim [1] objected to under [PCT Article 6](#) because the claim [2] not fully supported by the description. The application, as originally filed, did not describe: [3]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s), and the verb --is-- or --are--, as appropriate.
2. In bracket 2, pluralize “claim” if needed, and insert the verb --is-- or --are--.
3. In bracket 3, identify subject matter not described in the application as filed.

¶ 18.13.01 Claims Objectionable - Non-Enabling Disclosure

Claim [1] objected to under [PCT Article 6](#) because the claim [2] not fully supported by the description. The description does not disclose the claimed invention in a manner sufficiently clear and complete for the claimed invention to be carried out by a person skilled in the art as required by [PCT Article 5](#) because: [3]

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, insert the verb --is-- or --are--.
3. In bracket 3, identify the claimed subject matter that is not enabled and explain why it is not enabled.

¶ 18.14.01 Claims Objectionable - Lack of Best Mode

Claim [1] objected to under [PCT Article 6](#) because the claim [2] not fully supported by the description. The description fails to set forth the best mode contemplated by the applicant for carrying out the claimed invention as required by [PCT Rule 5.1\(a\)\(v\)](#) because: [3].

Examiner Note:

1. In bracket 1, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 2, pluralize “claim” if needed, and insert the appropriate verb --is-- or --are--.
3. In bracket 3, insert the objection and reasons.

¶ 18.15 Claims Objectionable - Indefiniteness

Claim [1] objected to under [PCT Article 6](#) as lacking clarity because claim [2] indefinite for the following reason(s): [3]

Examiner Note:

1. In brackets 1 and 2, pluralize “claim” if needed, insert claim no.(s) and the appropriate verb --is-- or --are--.
2. In bracket 3, insert reasons.

¶ 18.18 Heading for Lack of Unity Action in National Stage Applications Submitted Under 35 U.S.C. 371 (Including Species)

REQUIREMENT FOR UNITY OF INVENTION

As provided in 37 CFR [1.475\(a\)](#), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Categories of Inventions:

As provided in 37 CFR [1.475\(b\)](#), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR [1.475\(c\)](#).

Examiner Note:

1. Begin all Lack of Unity actions in national stage applications submitted under 35 U.S.C. 371 (including species) with this heading.
2. Follow with form paragraph 18.19 or 18.20, as appropriate.
3. For lack of unity during the international phase, use form paragraph 18.05 instead of this form paragraph.

¶ *18.19 Restriction Requirement in National Stage Applications Submitted Under 35 U.S.C. 371*

Restriction is required under [35 U.S.C. 121](#) and [372](#).

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under [PCT Rule 13.1](#).

In accordance with [37 CFR 1.499](#), applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Examiner Note:

1. This form paragraph is to be used when making a restriction requirement in a national stage application submitted under [35 U.S.C. 371](#).
2. This form paragraph is to be followed by form paragraphs 18.06 - 18.06.02, as appropriate, and by form paragraphs 18.07 - 18.07.02, as appropriate.
3. All restriction requirements between a product/apparatus and a process of making the product/apparatus or between a product and a process of using the product should be followed by form paragraph 8.21.04 to notify the applicant that if all product/apparatus claims are found allowable, process claims that require all the limitations of the patentable product/apparatus should be considered for rejoinder.
4. When all of the claims directed to the elected invention are in condition for allowance, the propriety of the restriction requirement should be reconsidered to verify that the non-elected claims do not share a same or corresponding technical feature with the allowable claims.

¶ *18.20 Election of Species in National Stage Applications Submitted Under 35 U.S.C. 371*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under [PCT Rule 13.1](#).

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) are generic: **[2]**.

Examiner Note:

1. This form paragraph is to be used when making an election of species requirement in a national stage application submitted under [35 U.S.C. 371](#).
2. In bracket 1, identify the species from which an election is to be made.
3. In bracket 2, identify each generic claim by number or insert the word --NONE--.
4. This form paragraph is to be followed by form paragraphs 18.07 - 18.07.03, as appropriate.

¶ *18.21 Election by Original Presentation in National Stage Applications Submitted Under 35 U.S.C. 371*

Newly submitted claim **[1]** directed to an invention that lacks unity with the invention originally claimed for the following reasons: **[2]**

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim **[3]** withdrawn from consideration as being directed to a nonelected invention. See [37 CFR 1.142\(b\)](#) and [MPEP § 821.03](#).

¶ *18.22 Requirement for Election and Means for Traversal in National Stage Applications Submitted Under 35 U.S.C. 371*

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR [1.143](#)) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention ([37 CFR 1.475\(a\)](#)), applicant must provide reasons in support thereof. Applicant may

submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under [35 U.S.C. 103\(a\)](#) of the other invention.

Examiner Note:

1. This form paragraph should be used when requiring restriction (including an election of species) in an application that entered the national stage under 35 U.S.C. [371](#).
2. This form paragraph should follow form paragraph 8.23.01 when a telephone call was made that did not result in an election being made.

Chapter 1900 - Protest

¶ 19.01 Period for Comments on Protest by Applicant

A protest against issuance of a patent based upon this application has been filed under [37 CFR 1.291\(a\)](#) on [1], and a copy [2]. Any comments or reply applicant desires to file before consideration of the protest must be filed by [3].

Examiner Note:

1. Applicant is normally given one month to submit any comments, unless circumstances in the case would warrant a longer period.
2. A copy of this Office action is NOT sent to the protestor. See [37 CFR 1.291\(d\)](#).
3. In bracket 2, insert either-- has been served on applicant-- or-- is attached hereto--.

¶ 19.02 Requirement for Information

The protest under [37 CFR 1.291](#) filed on [1] has been considered. In order to reach a full and proper consideration of the issues raised therein, it is necessary to obtain additional information from applicant regarding these issues. In particular [2]. The failure to reply to this requirement for information within ONE MONTH or THIRTY DAYS, whichever is longer, of the mailing date of this requirement will result in abandonment of the application. This time period may be extended under the provisions of [37 CFR 1.136](#).

Examiner Note:

While the examiner normally should not need further information from applicant, this form paragraph may be used to request specific additional information from the applicant.

¶ 19.02.AE Requirement for Information – Application Under Accelerated Examination

The protest under 37 CFR [1.291](#) filed on [1] has been considered. In order to reach a full and proper consideration of the issues raised therein, it is necessary to obtain additional information from applicant regarding these issues. In particular [2]. The failure to reply to this requirement for information within **ONE (1) MONTH or THIRTY (30) DAYS**, whichever is longer, of the mailing date of this requirement will result in abandonment of the application. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. While the examiner normally should not need further information from applicant, this form paragraph may be used to request specific additional information from the applicant.
2. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).
3. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

Chapter 2200 - Citation of Prior Art and Ex Parte Reexamination of Patents

¶ 22.01 *New Question of Patentability*

A substantial new question of patentability affecting claim [1] of United States Patent Number [2] is raised by the request for *ex parte* reexamination.

Extensions of time under 37 CFR [1.136\(a\)](#) will not be permitted in these proceedings because the provisions of 37 CFR [1.136](#) apply only to “an applicant” and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. [305](#) requires that *ex parte* reexamination proceedings “will be conducted with special dispatch” (37 CFR [1.550\(a\)](#)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR [1.550\(c\)](#).

¶ 22.01.01 *Criteria for Applying Old Art as Sole Basis for Reexamination*

The above [1] is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. [303\(a\)](#) and [312\(a\)](#):

“The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., “old art,” does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on [2]. A discussion of the specifics now follows:

[3]

Examiner Note:

1. In bracket 1, insert “substantial new question of patentability” if the present form paragraph is used in an order granting reexamination (or a TC or CRU Director’s decision on petition of the denial of reexamination). If

this form paragraph is used in an Office action, insert “ground of rejection”.

2. In bracket 2, insert the old art that is being applied as the sole basis of the SNQ. For example, “the patent to Schor” or “the patent to Schor when taken with the Jones publication” or “the combination of the patent to Schor and the Smith publication” could be inserted. Where more than one SNQ is presented based solely on old art, the examiner would insert all such bases for SNQ.

3. In bracket 3, for each basis identified in bracket 2, explain how and why that fact situation applies in the proceeding being acted on. The explanation could be for example that the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

4. This form paragraph is only used the first time the “already cited/considered” art is applied, and is not repeated for the same art in subsequent Office actions.

¶ 22.02 *No New Question of Patentability*

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

¶ 22.03 *Issue Not Within Scope of Ex Parte Reexamination*

It is noted that an issue not within the scope of reexamination proceedings has been raised. [1]. The issue will not be considered in a reexamination proceeding. 37 CFR [1.552\(c\)](#). While this issue is not within the scope of reexamination, the patentee is advised that it may be desirable to consider filing a reissue application provided that the patentee believes one or more claims to be partially or wholly inoperative or invalid based upon the issue.

Examiner Note:

1. In bracket 1, identify the issues.
2. This paragraph may be used either when the patent owner or third party requester raises issues such as public use or on sale, conduct, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

¶ 22.04 *Papers To Be Submitted in Response to Action - Ex Parte Reexamination*

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR [1.116](#) after final rejection and [37 CFR 41.33](#) after appeal, which will be strictly enforced.

¶ 22.04.01 *Extension of Time in Reexamination*

Extensions of time under [37 CFR 1.136\(a\)](#) will not be permitted in these proceedings because the provisions of [37 CFR 1.136](#) apply only to “an applicant” and not to parties in a reexamination proceeding. Additionally, [35 U.S.C. 305](#) requires that reexamination proceedings “will be conducted with special dispatch” ([37 CFR 1.550\(a\)](#)). Extensions of time in *ex parte* reexamination proceedings are provided for in [37 CFR 1.550\(c\)](#).

¶ 22.05 *Reexamination (Ex Parte or Inter Partes) Based on Reissue Claims*

In view of the surrender of original Patent No. [1] and the granting of Reissue Patent No. [2] which issued on [3], all subsequent proceedings in this reexamination will be based on the reissue patent claims.

¶ 22.06 *Examiner’s Amendment Accompanying Notice of Intent To Issue Ex Parte Reexamination Certificate*

An examiner’s amendment to the record appears below. The changes made by this examiner’s amendment will be reflected in the reexamination certificate to issue in due course.

[1]

¶ 22.07 *Litigation Reminder (Patent Owner Request or Director Ordered Reexamination)*

The patent owner is reminded of the continuing responsibility under 37 CFR [1.565\(a\)](#), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. [1] throughout the course of this reexamination proceeding. See MPEP §§ [2207](#), [2282](#) and [2286](#).

Examiner Note:

This form paragraph is to be used when granting an *ex parte* reexamination request filed by a patent owner and in the first action in a Director Ordered reexamination.

¶ 22.08 *Litigation Reminder (Third Party Requester)*

The patent owner is reminded of the continuing responsibility under 37 CFR [1.565\(a\)](#), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. [1] throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ [2207](#), [2282](#) and [2286](#).

Examiner Note:

This form paragraph is to be used when granting an *ex parte* reexamination request filed by a third party requester.

¶ 22.09 *Ex Parte Reexamination - Action Is Final*

THIS ACTION IS MADE FINAL.

A shortened statutory period for response to this action is set to expire [1] from the mailing date of this action.

Extensions of time under [37 CFR 1.136\(a\)](#) do not apply in reexamination proceedings. The provisions of [37 CFR 1.136](#) apply only to “an applicant” and not to parties in a reexamination proceeding. Further, in [35 U.S.C. 305](#) and in [37 CFR 1.550\(a\)](#), it is required that reexamination proceedings “will be conducted with special dispatch within the Office.”

Extensions of time in reexamination proceedings are provided for in [37 CFR 1.550\(c\)](#). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in [37 CFR 1.17\(g\)](#). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See [MPEP § 2265](#).

Examiner Note:

1. This form paragraph may be used only in reexamination proceedings.
2. In bracket 1, insert the appropriate period for response, which is normally TWO (2) MONTHS. In court sanctioned or stayed litigation situations a ONE (1) MONTH period should be set.

¶ 22.10 *Ex Parte Reexamination - Action Is Final, Necessitated by Amendment*

Patent owner's amendment filed [1] necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See [MPEP § 706.07\(a\)](#).

A shortened statutory period for response to this action is set to expire [2] from the mailing date of this action.

Extensions of time under [37 CFR 1.136\(a\)](#) do not apply in reexamination proceedings. The provisions of [37 CFR 1.136](#) apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in [35 U.S.C. 305](#) and in [37 CFR 1.550\(a\)](#), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in [37 CFR 1.550\(c\)](#). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in [37 CFR 1.17\(g\)](#). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See [MPEP § 2265](#).

Examiner Note:

1. This form paragraph may be used only in reexamination proceedings.
2. In bracket 1, insert filing date of amendment.
3. In bracket 2, insert the appropriate period for response, which is normally TWO (2) MONTHS. In court sanctioned or stayed litigation situations a ONE (1) MONTH period should be set.
4. As with all other Office correspondence on the merits in a reexamination proceeding, the final Office action must be signed by a primary examiner.

¶ 22.11 *Rejection, 35 U.S.C. 305, Claim Enlarges Scope of Patent - Ex Parte Reexamination*

Claim [1] rejected under 35 U.S.C. [305](#) as enlarging the scope of the claim(s) of the patent being reexamined. In 35 U.S.C. [305](#), it is stated that "[n]o 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 product 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](#).

¶ 22.12 *Amendments Proposed in a Reexamination - 37 CFR 1.530(d)-(j)*

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\(d\)-\(j\)](#), must be formally presented pursuant to [37 CFR 1.52\(a\)](#) and (b), and must contain any fees required by [37 CFR 1.20\(c\)](#).

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.

¶ 22.13 *Improper Amendment in an Ex Parte Reexamination - 37 CFR 1.530(d)-(j)*

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

A shortened statutory period for response to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. If patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, prosecution of the present *ex parte* 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\(d\)-\(j\)](#) 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.

¶ *22.14 Submission Not Fully Responsive to Non-Final Office Action - Ex Parte Reexamination*

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 ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing 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, prosecution of 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.

¶ *22.15 Lack of Service - 37 CFR 1.550(f)*

The submission filed on [1] is defective because it appears that the submission was not served on the [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 (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR [1.248](#). See [37 CFR 1.550\(f\)](#).

It is required that service of the submission be made, and a certificate of service be provided to the Office within a shortened statutory period of ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. If service of the submission is not timely made, 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.

¶ *22.16 Reasons For Patentability and/or Confirmation*

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: [1]

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Examiner Note:

This form paragraph may be used as an attachment to the Notice of Intent to Issue *Ex Parte* Reexamination Certificate, PTOL-469 (item number 2).

¶ *22.20 Claims Held Invalid By Court, No Longer Being Reexamined*

Claims [1] of the [2] patent are not being reexamined in view of the final decision of [3]. Claim(s) [1] was/were held invalid/unenforceable by the [4].

Examiner Note:

1. In bracket 1, insert the claim(s) held invalid.
2. In bracket 2, insert the patentee (e.g., Rosenthal, Schor et al).
3. In bracket 3, insert the decision (e.g., *ABC Corp. v. Smith*, 888 F. 3d 88, 999 USPQ2d 99 (Fed. Cir. 1999) or *XYZ Corp. v. Jones*, 888 F. Supp. 2d 88, 999 USPQ2d 1024 (N.D. Cal. 1999)).
4. In bracket 4, insert the name of the court (e.g., the Court of Appeals for the Federal Circuit, or the Federal District Court).

¶ 22.73 Correspondence and Inquiry as to Office Actions

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam

Central Reexamination Unit

Commissioner for Patents

United States Patent & Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to: (571) 273-9900

Central Reexamination Unit

By hand: Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication should be directed to [1] at telephone number [2].

Examiner Note:

1. This form paragraph is used at the end of *ex parte* reexamination communications.
2. In bracket 1, insert the name of the examiner having charge of the proceeding.
3. In bracket 2, insert the examiner's telephone number.

Chapter 2300 - Interference Proceedings

¶ 23.01 Request for Interference Premature; Examination Not Completed

The request for interference filed [1] is acknowledged. However, examination of this application has not been completed as required by [37 CFR 41.102\(a\)](#). Consideration of a potential interference is premature. See [MPEP § 2303](#).

¶ 23.02 Ex Parte Prosecution Is Resumed

Interference No. [1] has been terminated by a decision [2] to applicant. *Ex parte* prosecution is resumed.

Examiner Note:

1. In bracket 1, insert the interference number.
2. In bracket 2, insert whether favorable or unfavorable.

¶ 23.04 Requiring Applicant to Add Claim to Provoke Interference

The following allowable claim from [1] is required to be added for the purpose of an interference:

[2]

The claim must be copied exactly.

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to add the claim. Refusal to add a required claim will operate as a concession of priority for the subject matter of the required claim, but will **not** result in abandonment of this application. See [37 CFR 41.202\(c\)](#) and [MPEP § 2304.04\(b\)](#). THE PROVISIONS OF [37 CFR 1.136](#) DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

If the interference would be with a patent, applicant must also comply with [37 CFR 41.202\(a\)\(2\)](#) to (a)(6).

Examiner Note:

1. In bracket 1, insert the published application number if the claim is an allowed claim from a U.S. application publication or the patent number if the claim is from a U.S. patent.
2. In bracket 2, insert the claim which applicant is required to add to provoke an interference.

¶ 23.06 Applicant Suggesting an Interference

Applicant has suggested an interference pursuant to [37 CFR 41.202\(a\)](#) in a communication filed [1].

Examiner Note:

1. Use this form paragraph if applicant has suggested an interference under [37 CFR 41.202\(a\)](#) and applicant has failed to comply with one or more of paragraphs (a)(1) to (a)(6) of [37 CFR 41.202](#).
2. In bracket 1, insert the date of applicant's communication.
3. This form paragraph must be followed by one or more of form paragraphs 23.06.01 to 23.06.03 and end with form paragraph 23.06.04.

¶ 23.06.01 Failure to Identify the Other Application or Patent

Applicant failed to provide sufficient information to identify the application or patent with which the applicant seeks an interference. See [37 CFR 41.202\(a\)\(1\)](#) and [MPEP § 2304.02\(a\)](#).

¶ 23.06.02 Failure to Identify the Counts and Corresponding Claims

Applicant failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See [37 CFR 41.202\(a\)\(2\)](#) and [MPEP § 2304.02\(b\)](#).

¶ 23.06.03 Failure to Provide Claim Chart Comparing At Least One Claim

Applicant failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See [37 CFR 41.202\(a\)\(3\)](#) and [MPEP § 2304.02\(c\)](#).

¶ 23.06.04 Failure to Explain in Detail Why Applicant Will Prevail on Priority

Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See [37 CFR 41.202\(a\)\(4\)](#), (a)(6), (d) and [MPEP § 2304.02\(c\)](#).

¶ 23.06.05 Claim Added/Amended; Failure to Provide Claim Chart Showing Written Description

Claim [1] has been added or amended in a communication filed on [2] to provoke an interference. Applicant failed to provide a claim chart showing the written description for each claim in the applicant's specification. See [37 CFR 41.202\(a\)\(5\)](#) and [MPEP § 2304.02\(d\)](#).

¶ 23.06.06 Time Period for Reply

Applicant is given ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this communication to correct the deficiency(ies). THE PROVISIONS OF [37 CFR 1.136](#) DO NOT APPLY TO THE TIME SPECIFIED IN THIS ACTION.

¶ 23.14 *Claims Not Copied Within One Year of Patent Issue Date*

Claim [1] rejected under [35 U.S.C. 135\(b\)\(1\)](#) as not being made prior to one year from the date on which U.S. Patent No. [2] was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that [35 U.S.C. 135\(b\)](#) may be used as a basis for *ex parte* rejections.

¶ 23.14.01 *Claims Not Copied Within One Year Of Application Publication Date*

Claim [1] rejected under [35 U.S.C. 135\(b\)\(2\)](#) as not being made prior to one year from the date on which [2] was published under [35 U.S.C. 122\(b\)](#). See *In re McGrew*,

120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that [35 U.S.C. 135\(b\)](#) may be used as a basis for *ex parte* rejections.

Examiner Note:

1. In bracket 2, insert the publication number of the published application.
2. This form paragraph should only be used if the application being examined was filed after the publication date of the published application.

¶ 23.19 *Foreign Priority Not Substantiated*

Should applicant desire to obtain the benefit of foreign priority under [35 U.S.C. 119\(a\)](#)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action, [37 CFR 41.154\(b\)](#) and [41.202\(e\)](#).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Chapter 2400 - Biotechnology

¶ 24.01 Cover Letter for Use With Notice To Comply With Sequence Rules

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in [37 CFR 1.821\(a\)](#)(1) and (a)(2). However, this application fails to comply with the requirements of [37 CFR 1.821](#) through [1.825](#) for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. [1]

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, [37 CFR 1.821](#) - [1.825](#). Failure to comply with these requirements will result in ABANDONMENT of the application under [37 CFR 1.821\(g\)](#). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of [37 CFR 1.136\(a\)](#). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Examiner Note:

1. Use this form paragraph **only for the initial communication to the applicant**. Use either form paragraph 24.03 or 24.04 for subsequent communications.
2. In bracket 1, insert how the application fails to comply with the requirements of [37 CFR 1.821](#) through [1.825](#).
3. Conclude action with appropriate form paragraph(s) 7.100-7.102.
4. When mailing the Office action, attach a Notice To Comply With Requirements for Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures, along with a marked-up copy of the Raw Sequence Listing, if any.

¶ 24.01.AE Cover Letter for Use With Notice To Comply With Sequence Rules – Application Under Accelerated Examination

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR [1.821\(a\)](#)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR [1.821](#) through [1.825](#) for the reason(s) set forth below or on the attached Notice To Comply With Requirements For Patent Applications

Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. [1]

Applicant is given **ONE (1) MONTH, or THIRTY (30) DAYS**, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR [1.821](#) - [1.825](#). Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR [1.821\(g\)](#). Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice To Comply with the reply.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. Use this form paragraph **only for the initial communication to the applicant**. Use either form paragraph 24.03 or 24.04 for subsequent communications.
2. In bracket 1, insert how the application fails to comply with the requirements of 37 CFR [1.821](#) through [1.825](#).
3. Conclude action with appropriate form paragraph(s) 7.100-7.102.
4. When mailing the Office action, attach a Notice To Comply With Requirements for Patent Applications Containing Nucleotide And/Or Amino Acid Sequence Disclosures, along with a marked-up copy of the Raw Sequence Listing, if any.
5. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)](#)(2) or (d).
6. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)](#)(1) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 24.02 Cover Letter for Use with CRF Diskette Problem Report

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in [37 CFR 1.821\(a\)](#)(1) and (a)(2). A computer readable form (CRF) of the sequence listing was submitted. However, the CRF could not be processed by the Scientific and Technical Information Center (STIC) for the reason(s) set forth on the attached CRF Diskette Problem Report.

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, [37 CFR 1.821](#) - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under [37 CFR 1.821\(g\)](#). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of [37 CFR 1.136\(a\)](#). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached CRF Diskette Problem Report with the reply.

Examiner Note:

1. Use this form paragraph **only for the initial communication to the applicant**. Use either form paragraph 24.03 or 24.04 for subsequent communications.
2. Conclude action with appropriate form paragraph(s) 7.100-7.102.
3. When mailing the Office action, attach the CRF Diskette Problem Report.

¶ 24.02.AE Cover Letter for Use with CRF Diskette Problem Report – Application Under Accelerated Examination

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR [1.821](#)(a)(1) and (a)(2). A computer readable form (CRF) of the sequence listing was submitted. However, the CRF could not be processed by the Scientific and Technical Information Center (STIC) for the reason(s) set forth on the attached CRF Diskette Problem Report.

Applicant is given **ONE (1) MONTH, or THIRTY (30) DAYS**, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR [1.821](#) - [1.825](#). Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR [1.821](#)(g). Since this application has been granted special status under the accelerated

examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

Direct the reply to the undersigned. Applicant is requested to return a copy of the attached CRF Diskette Problem Report with the reply.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. Use this form paragraph **only for the initial communication to the applicant**. Use either form paragraph 24.03 or 24.04 for subsequent communications.
2. Conclude action with appropriate form paragraph(s) 7.100-7.102.
3. When mailing the Office action, attach the CRF Diskette Problem Report.
4. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102](#)(c)(2) or (d).
5. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102](#)(c)(1) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ 24.03 Compact Disc/CRF Submission Is Not Fully Responsive, Bona Fide Attempt

The reply filed [1] is not fully responsive to the Office communication mailed [2] for the reason(s) set forth below or on the attached Notice To Comply With The Sequence Rules or CRF Diskette Problem Report.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER [37 CFR 1.136\(a\)](#).**

Examiner Note:

1. This form paragraph may be used whether or not the six-month period for reply has expired. It is intended for use whenever a **bona fide** reply has been submitted. This

practice does not apply where there has been a deliberate omission of some necessary part of a complete reply or where the reason the reply is incomplete cannot be characterized as an apparent oversight or apparent inadvertence. Under such cases the examiner has no authority to grant an extension if the six-month period for reply has expired. Use form paragraph 24.04 under such circumstances.

2. In bracket 1, insert the date of the reply and in bracket 2, insert the mail date of the communication requiring compliance.
3. When mailing the Office action, attach a Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures, if any, along with a marked-up copy of the Raw Sequence Listing, or CRF Diskette Problem Report.

4. See [37 CFR 1.135\(c\)](#), 1.821(g); [MPEP §§ 710.02\(c\), 711.02\(a\), 714.02](#) and [714.03](#).

¶ *24.03.AE Compact Disc/CRF Submission Is Not Fully Responsive, Bona Fide Attempt – Application Under Accelerated Examination*

The reply filed [1] is not fully responsive to the Office communication mailed [2] for the reason(s) set forth below or on the attached Notice To Comply With The Sequence Rules or CRF Diskette Problem Report.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR [1.136\(a\)](#) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Examiner Note:

1. This form paragraph may be used whether or not the six-month period for reply has expired. It is intended for use whenever a **bona fide** reply has been submitted. This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply or where the reason the reply is incomplete cannot be

characterized as an apparent oversight or apparent inadvertence. Under such cases the examiner has no authority to grant an extension if the six-month period for reply has expired. Use form paragraph 24.04 under such circumstances.

2. In bracket 1, insert the date of the reply and in bracket 2, insert the mail date of the communication requiring compliance.
3. When mailing the Office action, attach a Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures, if any, along with a marked-up copy of the Raw Sequence Listing, or CRF Diskette Problem Report.
4. See 37 CFR [1.135\(c\)](#), [1.821\(g\)](#); MPEP §§ [710.02\(c\)](#), [711.02\(a\)](#), [714.02](#) and [714.03](#).
5. This form paragraph may only be used in an application filed on or after August 25, 2006, that has been granted special status under the accelerated examination program or other provisions under 37 CFR [1.102\(c\)\(2\)](#) or (d).

6. This form paragraph should not be used for an application that has been granted special status under 37 CFR [1.102\(c\)\(1\)](#) on the basis of applicant's health or age, or the Patent Prosecution Highway pilot program.

¶ *24.04 Compact Disc/CRF Submission Is Not Fully Responsive*

The communication filed [1] is not fully responsive to the communication mailed [2] for the reason(s) set forth below or on the attached Notice To Comply With The Sequence Rules or CRF Diskette Problem Report.

If a complete reply has not been submitted by the time the shortened statutory period set in the communication mailed [3] has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under [37 CFR 1.136\(a\)](#). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period.

Examiner Note:

1. This form paragraph may not be used when the six month period for reply has expired. Use this form paragraph in the situation where, in the reply (within the six-months), there has been a deliberate omission of some necessary part of a complete reply. When the reply appears to be *bona fide*, but through an apparent oversight or inadvertence failed to provide a complete reply, use form paragraph 24.03.
2. In bracket 1, insert the date of the reply and in brackets 2 and 3, insert the mail date of the communication requiring compliance.

3. When mailing the Office action, attach a Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures, if any, along with a marked-up copy of the Raw Sequence Listing, or CRF Diskette Problem Report.

¶ 24.05 CD-ROM/CD-R Requirements (Missing Sequence Listing/CRF Statement)

This application is objected to because it does not include the statement “the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing” and, where applicable, includes no new matter, as required by 37 CFR [1.821\(e\)](#), [1.821\(f\)](#), [1.821\(g\)](#), [1.825\(b\)](#) or [1.825\(d\)](#). Correction is required.

Examiner Note:

Use this form paragraph when there is no statement in the transmittal letter stating that the sequence listing

information recorded in the CRF is identical to the written sequence listing

¶ 24.05.01 CD-ROM/CD-R Requirements (Missing Sequence Listing/CRF Statement in an Amendment Filed with a CRF)

The amendment filed [1] is objected to because it does not include the statement “the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing” and, where applicable, a statement that the submission includes no new matter, as required by 37 CFR [1.821\(e\)](#), [1.821\(f\)](#), [1.821\(g\)](#), [1.825\(b\)](#) or [1.825\(d\)](#). A statement that the sequence listing information is identical is required.

Examiner Note:

1. Use this form paragraph when there is no statement in the transmittal letter stating that the sequence listing information recorded in the CRF is identical to the written sequence listing.
2. In bracket 1, insert the date of the amendment.

Chapter 2600 - Optional Inter Partes Reexamination

¶ 26.01 Reasonable likelihood established

The present request for *inter partes* reexamination establishes a reasonable likelihood that requester will prevail with respect to claim [1] of United States Patent Number [2].

Extensions of time under [37 CFR 1.136\(a\)](#) will not be permitted in *inter partes* reexamination proceedings because the provisions of [37 CFR 1.136](#) apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, [35 U.S.C. 314\(c\)](#) requires that *inter partes* reexamination proceedings “will be conducted with special dispatch” ([37 CFR 1.937](#)). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in [37 CFR 1.956](#). Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner’s response is set by statute. [35 U.S.C. 314\(b\)\(2\)](#).

¶ 26.02 No reasonable likelihood established

For the reasons set forth below, the present request for *inter partes* reexamination fails to establish a reasonable likelihood that requester will prevail with respect to at least one of the challenged claims of United States Patent Number [1].

¶ 26.03 Issue Not Within Scope of Inter Partes Reexamination

It is noted that an issue not within the scope of reexamination proceedings has been raised. [1]. The issue will not be considered in a reexamination proceeding. [37 CFR 1.906\(c\)](#). While this issue is not within the scope of reexamination, the patentee is advised that it may be desirable to consider filing a reissue application provided that the patentee believes one or more claims to be partially or wholly inoperative or invalid.

Examiner Note:

1. In bracket 1, identify the issues.
2. This paragraph may be used either when the patent owner or the third party requester raises issues such as (but not limited to) public use or on sale, conduct, or abandonment of the invention. Such issues should not be raised independently by the patent examiner.

¶ 26.03.01 Rejection, 35 U.S.C. 314(a), Claim Enlarges Scope of Patent

Claim [1] rejected under 35 U.S.C. [314\(a\)](#) as enlarging the scope of the claims of the patent being reexamined. 35 U.S.C. [314\(a\)](#) states that “no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted” in an *inter partes* reexamination proceeding. A claim presented in a reexamination “enlarges the scope” of the patent claims where the claim is broader than the claims of the 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 § [2658](#).

¶ 26.04 First Action Not Mailed With Order

An Office action on the merits does not accompany this order for *inter partes* reexamination. An Office action on the merits will be provided in due course.

¶ 26.05 Papers To Be Submitted in Response to Action

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by [37 CFR 1.116\(b\) and \(d\)](#), which will be strictly enforced.

¶ 26.05.01 Improper Amendment in an Inter Partes Reexamination - 37 CFR 1.530(d)-(j)

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

A shortened statutory period for response to this letter is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. If the patent owner fails to timely correct this informality, the amendment will be held not to be an appropriate response, and the consequences set forth in [37 CFR 1.957\(b\)](#) or (c) will result. See MPEP § [2666.10](#)

Examiner Note:

This paragraph may be used for any 37 CFR [1.530](#)(d)-(j) informality as to a proposed amendment submitted in a reexamination proceeding.

¶ *26.06 Submission Not Fully Responsive to Office Action*

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 supply the omission or correction to thereby provide a full response to the prior Office action.

A shortened statutory period for response to this letter is set to expire (a) ONE MONTH, or THIRTY DAYS (whichever is longer), from the mailing date of this letter, or (b) after the due date for response to the last Office action, whichever of (a) or (b) is longer. THE PERIOD FOR RESPONSE SET IN THIS LETTER MAY BE EXTENDED UNDER 37 CFR [1.956](#).

If patent owner fails to timely supply the omission or correction and thereby provide a full response to the prior Office action, the consequences set forth in 37 CFR [1.957](#)(b) or (c) will result. See MPEP § [2666.10](#).

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 clearly indicate what is needed to correct the omission.
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 § [2666.30](#).
3. This practice does not apply where there has been a deliberate omission of some necessary part of a complete response. See MPEP § [2666.30](#).

¶ *26.07 Action Closing Prosecution*

This is an ACTION CLOSING PROSECUTION (ACP); see MPEP § [2671.02](#).

(1) Pursuant to 37 CFR [1.951](#)(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 CFR [1.116](#) as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed

amendment, the third party requester may once file comments under 37 CFR [1.951](#)(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR [1.951](#)(a), then the third party requester is precluded from filing comments under 37 CFR [1.951](#)(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

¶ *26.08 Right of Appeal Notice*

This is a RIGHT OF APPEAL NOTICE (RAN); see MPEP § [2673.02](#) and § [2674](#). The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. [37 CFR 1.953](#)(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in [37 CFR 1.981](#) or as permitted by [37 CFR 41.77](#)(b)(1). [37 CFR 1.116](#)(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR [41.20](#)(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR [41.20](#)(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR [41.20](#)(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR [41.20](#)(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR [1.997](#) in accordance with this Office action.

¶ *26.09 Brief is Defective and/or is Not Complete*

The [1] brief filed [2] by [3] is defective and/or is not complete as to the provisions of 37 CFR [41.67](#)(a) and (c) (for appellant brief) or 37 CFR [41.68](#)(a) and (b) (for respondent brief) for the following reasons:

Examiner Note:

1. In bracket 1, fill in either “appellant” or “respondent”.
2. In bracket 2, fill in the date the brief was filed.
3. In bracket 3, fill in either “the patent owner” or “the third party requester”.
4. This form paragraph should be followed by a statement of all instances of non-compliance and all defects, and an explanation detailed enough for the party to understand how to deal with each non-compliance and defect noted in the letter.
5. One of form paragraphs 26.10 or 26.11 should be used at the end of this action.

¶ *26.10 Informal Appellant Brief-Period for Response Under 37 CFR 41.67(d)*

Appellant, [1] is required to comply with the provisions of 37 CFR [41.67](#)(a) and (c) and to correct all defects noted in this letter as to the appellant brief. Appellant, [2] is given a period of ONE MONTH from the date of this letter or the time remaining in the original two month period (whichever is the longer) for filing an amended complete appellant brief. If an amended complete brief that fully complies with the requirements of this letter is not timely submitted, the appellant’s appeal will be dismissed as of the date of expiration of the presently set time period. THE PERIOD FOR RESPONSE SET IN THIS LETTER CANNOT BE EXTENDED. 37 CFR [41.67](#)(d).

Examiner Note:

In brackets 1 and 2, fill in either “the patent owner” or “the third party requester”.

¶ *26.11 Informal Respondent Brief-Period for Response Under 37 CFR 41.68(c)*

Respondent, [1] is required to comply with the provisions of 37 CFR [41.68](#)(a) and (b) and to correct all defects noted in this letter as to the respondent brief. Respondent [2] is given a period of ONE MONTH from the date of this letter for filing an amended complete respondent brief. If an amended complete brief that fully complies with the requirements of this letter is not timely submitted, the respondent brief will not be formally received into the record and will not be considered. THE PERIOD FOR RESPONSE SET IN THIS LETTER CANNOT BE EXTENDED. 37 CFR [41.68](#)(c).

Examiner Note:

1. In brackets 1 and 2, fill in either “the patent owner” or “the third party requester”.
2. In the case of the respondent brief, the new one month period will always extend longer than the original one month period, thus the longer of the two need not be given, as was done in form paragraph 26.10 where the original period for the appellant brief is two months.

¶ *26.50 Heading for Examiner’s Answer*

EXAMINER’S ANSWER

This is in response to the following appellant (and respondent) brief(s) on appeal: [1]

Examiner Note:

In bracket 1, identify for each brief (a) the party (patent owner or third party requester), (b) the type of brief (appellant or respondent), and (c) the date it was filed. Where there is one third party requester (the usual situation), indicate “third party requester”; where there are two or more third party requesters (a merged proceeding), indicate “third party requester” followed by the name of the third party requester (e.g., “third party requester Smith” or “third party requester XYZ Corporation”).

¶ *26.50.01 Real Party in Interest*

(1) Real Party in Interest

Examiner Note:

Follow this paragraph with one or more of form paragraphs 26.50.02 and/or 26.50.03.

¶ *26.50.02 Acknowledgment of Identification of a Real Party in Interest in a Brief*

A statement identifying the real party in interest is contained in [1] brief(s).

Examiner Note:

In bracket 1, identify the brief or briefs containing a statement identifying the real party in interest. For example, “the appellant third party requester Jones” or “the appellant patent owner and the respondent third party requester Smith” or “all of the” can be used where appropriate.

¶ 26.50.03 *No Identification of a Real Party in Interest in the Briefs*

In the present appeal, [1] brief(s) does/do not contain a statement identifying the real party in interest. It is presumed that the party named in the caption of the brief(s) is the real party in interest at the time the brief was filed. The Board of Patent Appeals and Interferences, however, may subsequently exercise its discretion to require an explicit statement as to the real party in interest.

Examiner Note:

In bracket 1, identify the brief or briefs not containing a statement identifying the real party in interest. For example, “the appellant third party requester Jones” or “the appellant patent owner and the respondent third party requester Smith” or “all of the” can be used where appropriate.

¶ 26.50.04 *Related Appeals and Interferences*

(2) Related appeals and interferences

Examiner Note:

Follow this paragraph with form paragraph 26.50.05 or 26.50.06.

¶ 26.50.05 *Identification of the Related Appeals and Interferences*

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal:

Examiner Note:

1. Follow this form paragraph with an identification by application, patent, appeal or interference number of all other prior and pending appeals, interferences or judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.
2. Include a copy of all court and Board decisions identified in this section in a related proceeding(s) appendix using form paragraphs 26.61.01 and 26.61.03.

¶ 26.50.06 *No Related Appeals and Interferences Identified*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

¶ 26.51 *Status of Claims*

(3) Status of claims

Examiner Note:

Follow form paragraph 26.51 with one or more of form paragraphs 26.51.01 and/or 26.51.02.

¶ 26.51.01 *Agreement With Statement of Status of Claims*

The statement of the status of claims contained in the [1] brief(s) is correct.

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the correct status of the claims. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Use form paragraph 26.51.02 where there is a disagreement with the statement of status of the claims stated in the brief(s).

¶ 26.51.02 *Disagreement With Statement of Status of Claims Stated in Briefs*

The statement of the status of claims contained in the [1] briefs is incorrect. [2].

A correct statement of the status of the claims is as follows: [3]

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the status of the claims. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. In bracket 2, identify the area of disagreement with each brief and the reasons for the disagreement.
3. For bracket 3, see form paragraphs 12.151.03 - 12.151.10 for the type of material that should be included. Remember that a “final rejection” is not made in a reexamination. Thus, use “Action Closing Prosecution” and “Right of Appeal Notice” where each is appropriate.

¶ 26.52 *Status of Amendments*

(4) Status of Amendments After Action Closing Prosecution

Examiner Note:

Identify status of all amendments submitted after Action Closing Prosecution. Use one or more of form paragraphs 26.52.01 - 26.52.05, if appropriate.

¶ 26.52.01 Agreement With Statement of the Status of Amendments After Action Closing Prosecution

The statement of the status of amendments after Action Closing Prosecution contained in the [1] brief(s) is correct.

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the correct statement of the status of amendments after Action Closing Prosecution. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. Use form paragraph 26.52.02 where there is a disagreement with the statement of the status of the amendments after ACP stated in the brief(s).

¶ 26.52.02 Disagreement With Statement of the Status of Amendments After Action Closing Prosecution Stated in Briefs

The statement of the status of amendments after Action Closing Prosecution contained in the [1] brief(s) is incorrect. [2]

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the status of amendments after Action Closing Prosecution. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. In bracket 2, identify the area of disagreement with each brief and the reasons for the disagreement.

¶ 26.52.03 Amendment After Action Closing Prosecution Entered

The amendment after Action Closing Prosecution filed on [1] has been entered.

Examiner Note:

In bracket 1, insert the date of any entered amendment.

¶ 26.52.04 Amendment After Action Closing Prosecution Not Entered

The amendment after Action Closing Prosecution filed on [1] has not been entered.

Examiner Note:

In bracket 1, insert the date of any amendment denied entry.

¶ 26.52.05 No Amendment After Action Closing Prosecution

No amendment after Action Closing Prosecution has been filed.

¶ 26.53 Summary of Claimed Subject Matter

(5) Summary of Claimed Subject Matter

Examiner Note:

Follow form paragraph 26.53 with either form paragraphs 26.53.01 or 26.53.02.

¶ 26.53.01 Agreement With the Summary of Claimed Subject Matter in Brief(s)

The summary of claimed subject matter contained in the [1] brief(s) is correct.

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect summary of claimed subject matter. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. Use form paragraph 26.53.02 where there is disagreement as to the summary.

¶ 26.53.02 Disagreement With the Summary of Claimed Subject Matter in Brief(s)

The summary of claimed subject matter contained in the [1] brief(s) is deficient because [2].

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect summary of invention. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.

2. In bracket 2, explain the deficiency of the summary of claimed subject matter. Include a correct summary of the invention if necessary for a clear understanding of the claimed invention.

¶ 26.54 Grounds of Rejection to be Reviewed on Appeal

(6) Grounds of Rejection to be Reviewed on Appeal

Examiner Note:

Follow form paragraph 26.54 with form paragraph 26.54.01 or 26.54.02.

¶ 26.54.01 Agreement With Statement of the Grounds of Rejection on Appeal

The statement of the grounds of rejection contained in the [1] brief(s) is correct.

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the correct statement of the grounds of rejection on appeal. For example, “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Follow this form paragraph with form paragraph 26.54.011 if there are grounds of rejection that have not been withdrawn and that have not been presented by an appellant for review.
3. Follow this form paragraph with form paragraph 26.54.012 to list any non-appealable issues in the brief(s).
4. Use form paragraph 26.54.02 where there is disagreement as to the statement of the grounds of rejection on appeal.

¶ 26.54.011 Grounds of Rejection Not on Review

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, and they have not been presented by an appellant for review. [1].

Examiner Note:

In bracket 1, identify each ground of rejection that has not been withdrawn and has not been presented by an appellant for review.

¶ 26.54.012 Nonappealable Issue in Brief

NON-APPEALABLE ISSUE(S)

The [1] brief presents arguments relating to [2]. This issue relates to petitionable subject matter under 37 CFR [1.181](#) and not to appealable subject matter. See MPEP § [1002](#) and § [1201](#).

Examiner Note:

1. In bracket 1, identify the brief containing the petitionable issues. For example, “appellant third party requester Jones” or “appellant patent owner” can be used where appropriate.
2. When more than one brief has a petitionable issue, this form paragraph should be used for each of these briefs.

¶ 26.54.02 Disagreement With Statement of the Grounds of Rejection on Appeal

The [1] brief(s) does/do not provide a correct statement of the grounds of rejection to be reviewed on appeal. [2] The grounds of rejection to be reviewed on appeal are as follows: [3].

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the grounds of rejection on appeal.
2. In bracket 2, indicate the area of disagreement and the reasons for the disagreement.
3. In bracket 3 set forth the correct statement of the grounds of rejection on appeal.

¶ 26.55 Findings of Patentability to be Reviewed on Appeal

(7) Findings of Patentability to be Reviewed on Appeal

Examiner Note:

Follow form paragraph 26.55 with form paragraph 26.55.01 or 26.55.02.

¶ 26.55.01 Agreement With Statement of the Findings of Patentability on Appeal

The statement of the findings of patentability contained in the [1] brief(s) is correct.

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the correct statement of the findings of patentability on appeal. For example “appellant third party requester Jones” or “appellant patent owner and respondent third party requester Smith” can be used where appropriate.
2. Follow this form paragraph with form paragraph 26.55.011 if there are findings of patentability that have not been withdrawn and that have not been presented by an appellant for review.
3. Form paragraph 26.54.012 may be used to list any non-appealable issues in the brief(s).
4. Use form paragraph 26.55.02 where there is disagreement as to the statement of the findings of patentability on appeal.

¶ 26.55.011 Findings of Patentability Not on Review

FINDINGS OF PATENTABILITY NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, and they have not been presented by an appellant for review. [1].

Examiner Note:

1. In bracket 1, identify each ground of rejection that has not been withdrawn and has not been presented by an appellant for review.

¶ 26.55.02 *Disagreement With Statement of the Findings of Patentability on Appeal*

The [1] brief(s) does/do not provide a correct statement of the findings of patentability to be reviewed on appeal. [2] The findings of patentability to be reviewed on appeal are as follows: [3].

Examiner Note:

1. In bracket 1, identify the brief or briefs containing the incorrect statement of the findings patentability on appeal.
2. In bracket 2, indicate the area of disagreement and reasons for the disagreement.
3. In bracket 3, set forth the correct statement of the patentability to be reviewed on appeal.

¶ 26.56 *Claims Appendix*

(8) Claims Appendix

Examiner Note:

Follow form paragraph 26.56 with form paragraphs 26.56.01, 26.56.02, and/or 26.56.03, as is appropriate.

¶ 26.56.01 *Copy of the Appealed Claims in the Appendix of Appellant Brief is Correct*

The copy of the appealed claims [1] is contained in the Appendix to the appellant brief of [2] is correct.

Examiner Note:

1. In bracket 1, identify the claims appealed found in the appellant brief.
2. In bracket 2, identify the appellant brief containing the claims appealed. For example, “third party requester,” “third party requester Smith” or “patent owner” can be used where appropriate.
3. This paragraph is for appellant briefs; not for respondent briefs.
4. Where there is more than one appellant brief, the patent examiner may choose any appellant brief that has a correct copy of claims appealed. The examiner may use this form paragraph more than once, as needed to set forth each claim or group of claims appealed by the appellants. Where a claim is correct in one appellant brief but is incorrect in another appellant brief, the examiner will draw a diagonal line in pencil through the incorrect claim in the Appendix of the incorrect appellant brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.

¶ 26.56.02 *Copy of the Appealed Claims in the Appendix of Appellant Brief is Substantially Correct*

A substantially correct copy of the appealed claim(s) is contained in the Appendix of the appellant brief of [1]. Claim(s) [2] appear on pages [3] of the appendix contain minor errors. The minor errors are as follows: [4]

Examiner Note:

1. Use this paragraph where all appellant briefs contain errors in the claim(s) but at least one appellant brief is substantially correct and contains only minor errors.
2. In bracket 1, identify the appellant brief containing the substantially correct copy of the appealed claims. For example, “third party requester Smith” or “patent owner” can be used where appropriate.
3. In bracket 2, indicate the claim or claims with the minor errors.
4. In bracket 3, identify the page(s) in the Appendix where the substantially correct appealed claims appear.
5. In bracket 4, indicate the nature of the errors.
6. This paragraph is for appellant briefs; not for respondent briefs.
7. Where there is more than one appellant brief having the same claim recited incorrectly but at least one appellant brief is substantially correct and contains only minor errors, the examiner can apply the present form paragraph to the brief that has only minor errors in the appealed claim. If the application is still a paper file, the examiner should draw a diagonal line in pencil through the incorrect claim in any other (incorrect) appellant brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.

¶ 26.56.03 *Copy of the Appealed Claims in the Appendix Contains Substantial Errors*

Claim(s) [1] contain(s) substantial errors as presented in the Appendix to all the appellant briefs. Accordingly, claim(s) [2] is/are correctly written in the Appendix to the examiner’s answer.

Examiner Note:

1. This form paragraph is used where all appellants fail to include a correct copy of an appealed claim or claims in the Appendix to the brief.
2. Attach a correct copy of the claims incorrect in all the appellant briefs as an Appendix to the examiner’s answer; and if the application is still a paper file, draw a diagonal line in pencil through the incorrect claim in the Appendix of each appellant’s appeal brief, and place the date, the word “Incorrect,” and the examiner’s initials in the margin.

3. In brackets 1 and 2, identify the claims that contain substantial errors.
4. Rather than using this form paragraph, if the errors in the claim(s) are significant, appellant(s) should be required to submit a corrected brief (amended brief). Where the brief includes arguments based upon the incorrect version of the claims (i.e., argument directed toward the errors in the claims), a corrected brief should always be required.

¶ 26.57 Evidence Relied Upon - Heading

(9) Evidence Relied Upon

Examiner Note:

Follow form paragraph 26.57 with one or more of form paragraphs 26.57.01 - 26.57.03.

¶ 26.57.01 No Evidence Relied Upon in the Examiner's Answer

No evidence is relied upon by the examiner in this appeal.

¶ 26.57.02 Listing of the Evidence Relied Upon by Examiner

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon by the examiner in the rejection of claims under appeal.

Examiner Note:

1. Use the following format for providing information on each reference cited: Number Name Date
2. The following are example formats for listing reference citations: 2,717,847 VARIAN 9-1955 1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963(Figure 2 labeled as Prior Art in this document)
3. See MPEP § 707.05(e) for additional examples.

¶ 26.57.03 Listing of the Art of Record Relied Upon by Requester

The following is a listing of the evidence relied upon by the third party requester(s) in the proposed rejection of claims which were not made by the examiner, and are now under appeal.

Examiner Note:

1. Use the following format for providing information on each reference cited: Number Name Date
2. The following are example formats for listing reference citations: 2,717,847 VARIAN 9-1955 1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963(Figure 2 labeled as Prior Art in this document)
3. See MPEP § 707.05(e) for additional examples.

¶ 26.59 Grounds of Rejection

(10) Grounds of rejection

The following ground(s) of rejection are applicable to the appealed claims. [1].

Examiner Note:

In bracket 1, explain each ground of rejection clearly and completely as set forth in the appropriate paragraphs i-vi below:

(i) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer shall explain why the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any, (a) do not describe the subject matter defined by each of the rejected claims, and/or (b) would not enable a person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation including a consideration of the undue experimentation factors set forth in MPEP § 2164.01(a).

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer shall explain why the claims do not particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the examiner's answer shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the examiner's answer shall state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection, shall identify any difference between the rejected claims and the prior art relied on (i.e., the primary reference) and shall explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter.

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (iii) and (iv) above, shall compare at least one of the rejected claims feature-by-feature with the prior art relied upon in the

rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number and quotation from the reference, as appropriate.

(vi) For each rejection, other than those referred to in paragraphs (i) to (v) of this section, the examiner's answer shall specifically explain the basis for the particular rejection.

¶ 26.59.01 Findings of Patentability

(11) Findings of Patentability

The following findings of patentability, i.e., determinations of inapplicability of a proposed rejection, are applicable to the appealed claims.

[1]

Examiner Note:

In bracket 1, explain each determination of inapplicability of a proposed rejection, or refer to the RAN if it clearly and completely sets forth the determination of inapplicability of a proposed rejection and complies with appropriate paragraphs i-vi below:

(i) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. [112](#), first paragraph; the examiner's answer shall explain how the first paragraph of 35 U.S.C. [112](#) is complied with, including, as appropriate, how the specification and drawings, if any, (a) do describe the subject matter defined by each of the claims proposed for rejection, and/or (b) would in fact enable any person skilled in the art to make and use the subject matter defined by each of the claims proposed for rejection without undue experimentation.

(ii) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. [112](#), second paragraph; the examiner's answer shall explain how the claims do particularly point out and distinctly claim the subject matter which "applicant" regards as the invention.

(iii) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. [102](#); the examiner's answer shall explain why the claims proposed for rejection are not anticipated and patentable under 35 U.S.C. [102](#), pointing out which limitations recited in the claims proposed for rejection are not found in the prior art relied upon in the proposed rejection.

(iv) For each determination of inapplicability of a proposed rejection of the appealed claims under 35 U.S.C. [103](#); the examiner's answer shall point out which limitations recited in the patentable claims are not found in the prior art relied upon in the proposed rejection, shall identify the difference between the patentable claims and the prior art relied upon by the third party requester and shall explain why the claimed subject matter is patentable over the prior art relied on by the third party requester. If the third party requester's proposed rejection is based upon a combination of references, the examiner's answer shall explain the rationale for not making the combination.

(v) For each third party requester proposed rejection under 35 U.S.C. [102](#) or [103](#) where there are questions as to how limitations in the claims define over features in the prior art even after the examiner complies with the requirements of (iii) and (iv) above, the examiner shall compare at least one of the claims proposed for rejection feature-by-feature with the prior art relied on in the proposed rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page or column, line number, drawing reference number, and quotation from the reference, as appropriate.

(vi) For each determination of inapplicability of a proposed rejection, other than those referred to in paragraphs (i) to (v) of this section, the examiner's answer shall specifically explain why there is insufficient basis for making the particular proposed rejection.

¶ 26.60 No New Ground of Rejection; No New Finding of Patentability

(12) No new ground of rejection; no new finding of patentability

This examiner's answer does not contain any new ground of rejection. This examiner's answer does not contain any new finding of patentability (i.e., no new determination of inapplicability of a proposed rejection).

Examiner Note:

An examiner's answer may not include a new ground of rejection. See 37 CFR [41.69](#)(b). An examiner's answer also may not include a new determination not to make a proposed rejection. See 37 CFR [41.69](#)(c). If a new ground of rejection or new determination not to make a proposed rejection is made, prosecution must be reopened. See 37 CFR [41.69](#)(d). See also MPEP § [2677](#).

¶ 26.61 Response to Argument

(13) Response to argument

Examiner Note:

A statement of whether the examiner disagrees with each of the contentions of appellants and respondents in their briefs with respect to the issues presented, and an explanation of the reasons for disagreement with any such contentions. If any ground of rejection or inapplicability of proposed rejection is not argued and responded to by the appropriate party, the examiner shall point out each claim affected.

¶ 26.61.01 *Related Proceeding(s) Appendix*

(14) Related Proceeding(s) Appendix

Examiner Note:

Follow form paragraph with either form paragraph 26.62.01 or 26.62.02.

¶ 26.61.02 *No Related Proceeding Identified*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

¶ 26.61.03 *Copies Related to Proceeding*

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

¶ 26.62 *Notification Regarding Rebuttal Brief*

(15) Period for providing a Rebuttal Brief

Appellant(s) is/are given a period of ONE MONTH from the mailing date of this examiner's answer within which to file a rebuttal brief in response to the examiner's answer. Prosecution otherwise remains closed.

The rebuttal brief of the patent owner may be directed to the examiner's answer and/or any respondent brief. The rebuttal brief of the third party requester(s) may be directed to the examiner's answer and/or the respondent brief of the patent owner. The rebuttal brief must (1) clearly identify each issue, and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent brief.

The time for filing the rebuttal brief may not be extended. No further submission (other than the rebuttal brief(s)) will be considered, and any such submission will be treated in accordance with 37 CFR [1.939](#).

¶ 26.63 *Request to Present Oral Arguments*

The examiner requests the opportunity to present arguments at the oral hearing.

Examiner Note:

1. Use this form paragraph only if:
 - a. an oral hearing has been requested by a party to the appeal; and
 - b. the primary examiner intends to present an oral argument.
2. This form paragraph must be included as a separate letter on a form PTOL-90. See MPEP § [1209](#).

¶ 26.64 *Examiner's Answer, Conclusion*

(16) Conclusion

For the above reasons, it is believed that the rejections and/or findings of patentability discussed above should be sustained.

Respectfully submitted,

¶ 26.65 *Acknowledgment of Rebuttal Brief*

The rebuttal brief filed [1] by [2] has been entered.

Examiner Note:

1. Use a separate form paragraph 26.65 for each rebuttal brief that is received.
2. In bracket 1, insert the date the rebuttal brief was filed.
3. In bracket 2, insert the party that filed the rebuttal brief.

¶ 26.65.01 *No Further Response*

No further response by the examiner is appropriate. Any further reply/comments by any party will be not be considered, and may be returned to the party that submitted it. The reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

¶ 26.66 *Defective Rebuttal Brief-Opportunity to Correct*

A rebuttal brief must (1) clearly identify each issue and (2) point out *where* the issue was raised in the examiner's answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner's answer or in the respondent brief. The rebuttal brief of Appellant [1] is defective because [2].

Appellant [3] is given a period of ONE MONTH from the mailing date of this examiner's answer within which

to file an amended rebuttal brief in response to this letter. Prosecution otherwise remains closed. The time for filing the amended rebuttal brief may not be extended.

If the amended rebuttal brief filed in response to the this letter does not remedy the defect or raises a new one, appellant will be so notified, but will not be given a second opportunity to file an amended rebuttal brief.

Examiner Note:

1. In brackets 1 and 3, insert the “patent owner” or the appropriate third party requester. Where there is one third party requester (the usual situation) insert “third party requester”; where there are two or more third party requesters (a merged proceeding), insert “third party requester” followed by the name of the third party requester (e.g., “third party requester Smith” or “third party requester XYZ Corporation”).
2. This form paragraph is to be used once for each appellant filing a defective **original** rebuttal brief, to provide notification thereof.
3. For an appellant filing a defective **amended** rebuttal brief, use form paragraph 26.66.01.

¶ 26.66.01 *Defective Amended Rebuttal Brief-No Opportunity to Correct*

A rebuttal brief must (1) clearly identify each issue and (2) point out *where* the issue was raised in the examiner’s answer and/or in the respondent brief. In addition, the rebuttal brief must be limited to issues raised in the examiner’s answer or in the respondent brief. The amended rebuttal brief of Appellant [1] is defective because [2].

The original and amended rebuttal briefs have been placed in the file but will not be considered. There is **no** opportunity to file a second amended rebuttal brief, and any such submission will be returned.

Examiner Note:

1. In bracket 1, insert the “patent owner” or the appropriate third party requester. Where there is one third party requester (the usual situation) insert “third party requester”; where there are two or more third party requesters (a merged proceeding), insert “third party requester” followed by the name of the requester (e.g., “third party requester Smith” or “third party requester XYZ Corporation”).
2. This form paragraph is to be used once for each defective **amended** rebuttal brief, to provide notification thereof. The notification letter should conclude with form paragraph 26.66.02, unless such is inappropriate for some reason.

3. For an appellant filing a defective **original** rebuttal brief, use form paragraph 26.66.

¶ 26.66.02 *Forward to the Board for Decision*

The reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

¶ 26.67 *No Receipt of Rebuttal Brief(s)*

Appellant(s) was given a period of one month from the mailing date of the examiner’s answer within which to file a rebuttal brief in response to the examiner’s answer. No rebuttal brief has been received within that time period. Accordingly, the reexamination proceeding is being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal(s).

Prosecution remains closed. Any further reply/comments by any party will not be considered, and may be returned to the party that submitted it.

Central Reexamination Unit

¶ 26.67.01 *Periods for Seeking Court Review or Rehearing Have Lapsed*

The periods for seeking court review of, or a rehearing of, the decision of the Board of Patent Appeals and Interferences rendered [1] have expired and no further action has been taken by any party to the appeal. Accordingly, the appeal in this reexamination proceeding is considered terminated; see 37 CFR 1.979(b). The present Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) is issued in accordance with MPEP § 2687 in order to terminate the present reexamination prosecution.

Examiner Note:

In bracket 1, enter the date of the Board decision.

¶ 26.68 *Lack of Service in inter partes examination-37 CFR 1.903*

The submission filed [1] is defective because it appears that the submission was not served on [2]. After the filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two third party requester proceedings are merged) in the *inter partes* reexamination

proceeding in the manner provided in 37 CFR [1.248](#). See 37 CFR [1.903](#).

It is required that service of the submission be made, and a certificate of service be provided to the Office, within ONE MONTH from the date of this letter or within the time remaining in the response period of the last Office action (if applicable), whichever is longer.

Examiner Note:

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

¶ 26.69 *Examiner’s Amendment Accompanying Notice of Intent to Issue Reexamination Certificate*

An examiner’s amendment to the record appears below. The changes made by this examiner’s amendment will be reflected in the reexamination certificate to issue in due course.

[1]

¶ 26.70 *Reasons for Patentability and/or Confirmation in Inter Partes Reexamination*

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner’s statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: [1]

Any comments considered necessary by the PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: “Comments on Statement of Reasons for Patentability and/or Confirmation” and will be placed in the reexamination file.

Examiner Note:

This form paragraph may be used as an attachment to the Notice of Intent to Issue *Inter Partes* Reexamination Certificate, PTOL-2068 (item number 3).

¶ 26.73 *Correspondence and Inquiry as to Office Actions*

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam

Attn: Central Reexamination Unit

Commissioner for Patents

United States Patent & Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to: (571) 273-9900

Central Reexamination Unit

By hand: Customer Service Window

Randolph Building

401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

¶ 26.80 *Claims Held Invalid by Court, No Longer Being Reexamined*

Claims [1] of the [2] patent are not being reexamined in view of the final decision of [3]. Claims [1] were held invalid by the [4].

Examiner Note:

1. In bracket 1, insert the claims held invalid.
2. In bracket 2, insert the patentee (e.g., Rosenthal, Schor et al).
3. In bracket 3, insert the decision (e.g., *ABC Corp. v. Kery Fries*, 888 F. 3d 88, 999 USPQ2d 99 (Fed. Cir. 1999) or *XYZ Corp. v. Jones*, 888 F. Supp. 2d 88, 999 USPQ2d 1024 (N.D. Cal. 1999)).
4. In bracket 4, insert the name of the court (e.g., the Court of Appeals for the Federal Circuit, or the Federal District Court).