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1301 Substantially Allowable Application, Special

When an application is in condition for allowance, except as to matters of form, the application will be considered special and prompt action taken to require correction of formal matters. See MPEP § 710.02(b).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure [R-3]

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole application meets all formal and substantive (i.e., statutory) requirements and that the language of the claims is enabled by, and finds adequate descriptive support in, the application disclosure as originally filed. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently, the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case, the examiner should require the applicant to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented (see 37 CFR 1.71 and 1.73). Of course, enough background should be included to make the invention clearly understandable. See MPEP § 608.01(c) and § 608.01(d). Form paragraphs 13.07 and 13.08 may be used.

¶ 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).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification.

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The claims should be renumbered as required by 37 CFR 1.126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. An examiner's amendment should be prepared if the order of the claims is changed. See MPEP § 608.01(j), § 608.01(n), and § 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosed invention. See MPEP § 608.01(b). The length of the abstract should be limited to 150 words. For changes to the abstract by examiner's amendment, see MPEP § 1302.04.

The title should also be checked. It should be as short and specific as possible. However, the title should be descriptive of the invention claimed, even though a longer title may result. If a satisfactory title is not supplied by the applicant, the examiner may change the title on or after allowance. See MPEP § 606 and § 606.01.

No pencil notes should be made in the application file by the examiner. Any notes in the file must be erased when the application is passed to issue.

All amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the application to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

Form paragraph 13.01 should be used when making such a requirement.

¶ 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.

1302.03 Notice of Allowability [R-3]

A Notice of Allowability form PTOL-37 is used whenever an application has been placed in condition for allowance. The date of any communication and/or interview which resulted in the allowance should be included in the notice.

In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of allowability of the claims by a Notice of Allowability PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Interview Summary PTO-413 should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment.

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Notice of Allowability	Application No.	Applicant(s)	
	Examiner	Art Unit	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to _____.
2. The allowed claim(s) is/are _____.
3. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some* c) None of the:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) hereto or 2) to Paper No./Mail Date _____.
 - (b) including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. <input type="checkbox"/> Notice of References Cited (PTO-892)	5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____.
3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____	7. <input type="checkbox"/> Examiner's Amendment/Comment
4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material	8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance
	9. <input type="checkbox"/> Other _____.

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1302.04 Examiner's Amendments and Changes [R-3]

Except by formal examiner's amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See 37 CFR 1.121.)

If the application file is a paper file, an informal examiner's amendment may be used for the correction of the following obvious errors and omissions only in the body of the written portions of the specification and may only be made with pen by the examiner of the application who will then initial in the margin and assume full responsibility for the change:

- (A) Misspelled words.
- (B) Disagreement of a noun with its verb.
- (C) Inconsistent "case" of a pronoun.
- (D) Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.

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(E) < Correction of reversed figure numbers. *Garrett v. Cox*, 233 F.2d 343, 345, 110 USPQ 52, 54 (CCPA 1956).

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(F) < Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.

*>

(G) < Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

Informal examiner's amendments are not permitted if the application is an Image File Wrapper (IFW) application. Any amendment of an IFW application must be by way of a formal examiner's amendment or be an amendment made by the applicant.

For continuing applications filed under 37 CFR 1.53(b), where a reference to the parent application has been inadvertently omitted by the applicant, an

examiner should not add a reference to the prior application without the approval of the applicant and a formal examiner's amendment since applicant may decide to delete the priority claim in the application filed under 37 CFR 1.53(b). Furthermore, a petition under 37 CFR 1.78 to accept an unintentionally delayed benefit claim may be required if the application is a utility or plant application filed on or after November 29, 2000. See MPEP § 201.11.

When correcting *originally filed* papers *>in< applications with a paper application file wrapper, clean red ink *must* be used (not blue or black ink).

A formal examiner's amendment may be used to correct all other informalities in the body of the written portions of the specification as well as all errors and omissions in the claims**>. The< formal examiner's amendment* >must be< signed by the primary examiner, placed in the file and a copy sent to applicant. The changes specified in the amendment are entered by the technical support staff in the regular way. A formal examiner's amendment should include form paragraph 13.02 and form paragraph 13.02.01. Form paragraph 13.02.02 should be used if an extension of time is required.

¶ 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].

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¶ 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 con-

sideration 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.

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Although 37 CFR 1.121 has been amended to require amendments to the specification/claims to be made in compliance with 37 CFR 1.121(b)(1), (b)(2), or (c), where appropriate, 37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without the need to comply with the requirements of 37 CFR 1.121(b)(1), (b)(2), or (c) in the interest of expediting prosecution and reducing cycle time. Examiners may continue to make additions or deletions of subject matter in the specification, including the claims, in examiner's amendments by instructions to make the change at a precise location in the specification and/or the claims. >Examiners may use an examiner's amendment to correct a non-compliant amendment filed by the applicant if the amendment would otherwise place the application in condition for allowance (e.g., a reply to a non-final Office action or an after-final amendment includes an incorrect status identifier). See MPEP § 714, subsection II.E. Examiner's Amendments.<

As an alternative, the examiner's amendment utilizing paragraph/claim replacement can be created by the examiner with authorization from the applicant. The examiner's amendment can also be created from a facsimile transmission or e-mailed amendment received by the examiner and referenced in the examiner's amendment and attached thereto. Any subject matter, in clean version form (containing no brackets or underlining), to be added to the specification/claims should be set forth separately by applicant in the e-mail or facsimile submission apart from the remainder of the submission. A clean version of a paragraph/claim, or portion of a paragraph/claim, submitted by applicant in a fax or e-mail, should be printed and attached to the examiner's amendment and may be relied on as part of the examiner's amendment. The examiner should mark "requested" on the entire attachment to indicate that the fax or e-mail was requested by the examiner, so as to not lead to a reduction in patent term adjustment (37 CFR

1.704(c)(8)). As the attachment is made part of the examiner's amendment, it does not get a separate PALM code and will not trigger any reduction in patent term adjustment. A paper copy of the entire e-mail or facsimile submission should be entered in the application file. Examiners are not required to electronically save any e-mails once any e-mails or attachments thereto are printed and become part of an application file record. The e-mail practice that is an exception for examiner's amendments is restricted to e-mails to the examiner from the applicant and should not be generated by the examiner to the applicant unless such e-mails are in compliance with all of the requirements set out in MPEP § 502.03.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his/her attorney or agent) in a telephone or personal interview. The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts or credit cards under special conditions.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to expedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared, the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (additional claims, etc.), and the deposit account number.

Charges can also be made against a credit card in an examiner's amendment. Once the examiner has informed applicant of the required charges, applicant must submit by facsimile, a properly completed and signed PTO-2038, authorizing the necessary charges. After completion of processing in the Office of Finance, form PTO-2038 will be removed from the record. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process or trademark process fee (as opposed to information product or service fees) to a credit card. Further iden-

tifying data, if deemed necessary and requested by the applicant, should also be included in the examiner's amendment.

Form paragraph 13.06 may be used to charge an extension of time fee in an examiner's amendment.

¶ 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.

At the time of allowance, substantive changes made by the examiner to the abstract must be done by a formal examiner's amendment after first obtaining approval from the applicant. As noted by the court in recent decisions, the abstract may be used to determine the meaning of claims. See *Pandrol USA, LP v. Airboss Railway Products, Inc.*, 320 F.3d 1354, 1363 n.1, 65 USPQ2d 1985, 1996 n.1 (Fed. Cir. 2003), *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.1, 54 USPQ2d 1437, 1443 n.1 (Fed. Cir. 2000). Since the abstract may be relied upon to determine the scope of the claimed invention, examiners should review the abstract for compliance with 37 CFR 1.72(b) and point out defects noted to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, so that applicant may make the necessary changes to the abstract.

No examiner's amendment, whether formal or informal, may make substantive changes to the written portions of the specification, including the abstract, without first obtaining applicant's approval.

The fact that applicant is entitled to an earlier U.S. effective filing date under 35 U.S.C. 120, 121, or 365(c) or 35 U.S.C. 119(e) is sometimes overlooked. To minimize this possibility, and for the claim to the benefit of the earlier filing date to be proper, the statement that, "This is a division (continuation, continuation-in-part) of Application Number -/---, filed ---" should appear as the first sentence>(s)< of the specifi-

cation, or in an application data sheet of applications other than CPAs claiming priority under 35 U.S.C. 120, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. The request for a CPA (note that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications) filed under 37 CFR 1.53(d) is itself the specific reference, as required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2), to every application assigned the same application number identified in the request. In the case of an application filed under 37 CFR 1.53(b) as a division, continuation or continuation-in-part of a CPA, there would be only one reference to the series of applications assigned the same application number with the filing date cited being that of the original non-continued application. In applications claiming priority under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --" should appear as the first sentence>(s)< of the specification or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 08/ - --, filed - --, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --." ** Any such statements appearing elsewhere in the specification should be relocated or made in an application data sheet.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant>, but foreign patent documents and non-patent literature will be scanned and added to the IFW for viewing and downloading by the applicant, if desired<. The references will be cited as usual on form PTO-892, a copy of which will be attached to the Notice of Allowability, form PTOL-37.

Where an application is ready for issue except for a slight defect in the drawing not involving a change in structure, the examiner will prepare a letter indicating the change to be made and, if necessary, including a marked-up copy of the drawing showing the addition or alteration to be made. See MPEP § 608.02(w).

No other changes may be made by any person in any record of the U.S. Patent and Trademark office

without the written approval of the Director of the United States Patent and Trademark Office.

In reviewing the application, all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time an application is being prepared for issue by the examiner and a copy of any formal examiner's amendment is sent to the applicant as an attachment to the Notice of Allowability, PTOL-37.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed. See generally *In re Willingham*, 282 F.2d 353, 356, 127 USPQ 211, 215 (CCPA 1960).

In all instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of a Notice of Allowability (PTOL-37). See MPEP § 714.13 and § 1302.03.

If after reviewing, screening, or surveying an allowed application in the Office of Patent Quality Assurance, an error or omission of the type noted in items (A) through (G) under the second paragraph of this section is noted, the error or omission may be corrected by the Review Quality Assurance Specialist in the same manner as set forth in the second paragraph. Since all other obvious informalities may only be corrected by a formal examiner's amendment, if the Office of Patent Quality Assurance discovers any such informality, the Review Quality Assurance Specialist will return the application to the Technology Center (TC) personnel via the TC Director suggesting, as appropriate, specific changes for approval and correction by the examiner through the use of an examiner's amendment.

1302.04(a) Title of Invention

Where the title of the invention is not specific to the invention as claimed, see MPEP § 606.01.

1302.04(b) Cancellation of Nonstatutory Claim

When a case is otherwise in condition for allowance the examiner may cancel an obviously nonstatutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Non-elected Invention

See MPEP § 821.01 and § 821.02.

1302.04(d) Cancellation of Claim Lost in Interference [R-3]

See MPEP *Chapter 2300*.

1302.04(e) Cancellation of Rejected Claims Following Appeal

See MPEP § 1214.06, § 1215.03, and § 1215.04.

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1302.04(g) Identification of Claims

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

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1302.04(h) Rejoinder of Claims [R-3]

Any previously withdrawn claims that are being rejoined and allowed must be listed in the index of claims and on the Notice of Allowability to avoid a printer query. The examiner should notify the applicant of the rejoinder. See MPEP § 821.04.<

1302.05 Correction of Drawing [R-3]

Where an application otherwise ready for issue requires correction of the drawing, the application is processed for allowance in the Technology Center and then forwarded to the Publishing Division. Any papers subsequently filed by the applicant, including *replacement* drawings, are forwarded to the Publishing Division in order to be matched with the application file. If the drawings that are received are still

not acceptable for publishing, the Publishing Division will mail a “Notice to File Corrected Application Papers,” giving the applicant a non-extendable period in which to file the corrected drawings.

1302.05(a) Original Drawings Cannot Be Located [R-3]

When the original drawings cannot be located and the application is otherwise in condition for allowance, no “Official Search” need be undertaken. A replacement drawing should be obtained from the Office of Initial Patent Examination’s records of the application as originally filed. If the reproduced drawings are not acceptable for publishing, applicant should be required to submit corrected drawings. An attachment to the Notice of Allowability should explain the problem and require the corrected drawings. If such an attachment is not included with the Notice of Allowability, the Publishing Division will mail a “Notice **>Regarding Drawings<,” giving the applicant a non-extendable period in which to file the corrected drawings.

1302.06 Prior Foreign Application

See MPEP § 201.14(c) and § 202.03.

1302.07 Use of Retention Labels to Preserve Abandoned Companion Applications

Related applications referred to in patent specifications are preserved from destruction by a retention label (form PTO-150) which is attached to the outside of the file wrapper. The technical support staff of the Technology Center (TC) prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification, oath, or declaration of the application ready for allowance (or in any Office letter therein).

If the application referred to is:

(A) Still pending: Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

(B) Abandoned for failure to pay issue fee: If file has been forwarded to Files Repository, fill in label and send it to Files Repository for attachment to the

wrapper. If not forwarded, treat the same as pending case.

(C) Abandoned: If file has been forwarded to the Files Repository, fill in label and send it to Files Repository for attachment to the wrapper. If not forwarded, treat the same as pending case. Add “abandoned” in red ink and initials to the allowable application.

(D) Already patented: No label is required. Insert patent number in specification if not already present. Formal examiner’s amendment not necessary if this is only change.

(E) In issue: Fill in label. Make no change in the specification of the allowable application.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add “et al.” to the application number cited thereon.

1302.08 Interference Search [R-3]

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>When an application is in condition for allowance, an interference search must be made by performing a text search of the “US-PGPUB” database in EAST or WEST directed to the comprehensive inventive features in the broadest claim. If the application contains a claim directed to a nucleotide or peptide sequence, the examiner must submit a request to STIC to perform an interference search of the sequence. The text search may make use of the “.CLM.” search symbol in order to limit the text search to the claims of the database references. If the search results identify any potential interfering subject matter, the examiner will review the application(s) with the potential interfering subject matter to determine whether interfering subject matter exists. If interfering subject matter does exist, the examiner will follow the guidance set forth in MPEP Chapter 2300. If there is no interfering subject matter then the examiner should prepare the application for issuance. A printout of only the database(s) searched, the query(ies) used in the interference search, and the date the interference search was performed must be made of record in the application file. The results of the interference search must not be placed in the application file. Completion of the interference search should be recorded in the “Interference Searched” section of the OACS “Search Notes” page with notation such as “PGPUB text search – March 1,

2005, see interference search printout” coupled with the examiner’s initials.<

An interference search may be required in TC Working Group 3640. Inspection of pertinent prints, drawings, brief cards, and applications in TC Working Group 3640 will be done on request by an examiner in TC Working Group 3640.

1302.09 Classification, Print Figure, and Other Notations [R-3]

The examiner preparing the application for issue ****>completes<** the Issue Classification sheet******.

**Examiners must review the data regarding prior U.S. applications to make sure that the information is correct when preparing the application for issue. If any claim to domestic priority under 35 U.S.C. 119(e), 120, 121, or 365(c) is added, deleted, and/or modified during prosecution of the application and such addition, deletion, and/or modification has been approved, the examiner must make sure that the information ** in the PALM database *>>is< current and up to date. If the PALM system has not been updated, the application must be forwarded ** to the Technology Center (TC) Legal Instrument Examiner, with an explanation of the correction to be made **. Examiners should also review the data regarding prior provisional and foreign applications for accuracy.

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See MPEP § 202.02 for notation as to parent or prior U.S. application, including provisional application, to be placed *>>in the< file *>>history<.

See MPEP § 202.03 for notation as to foreign patent application to be placed *>>in the< file *>>history<.

See MPEP § 1302.13 for name of examiner.

Examiners, when preparing **>an< application for issue, are to record the number of the claim selected for printing in the *Official Gazette* in the box labeled “PRINT CLAIM”** on the Issue Classification Sheet.

The claim or claims should be selected in accordance with the following instructions:

(A) The broadest claim should be selected.

(B) Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.

(C) A dependent claim should not be selected unless the independent claim on which it depends is also printed. In the case where a multiple dependent claim is selected, the entire chain of claims for one embodiment should be listed.

(D) In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

- (A) Write the claim number clearly in black ink.
- (B) If multiple claims are selected, the claim numbers should be separated by commas.
- (C) The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number

Examiners, when preparing **>an< application for issue, are to record the figure selected for printing in the *Official Gazette* in the box labeled “Print Fig.” ** on the Issue Classification sheet. It is no longer necessary for drawings to be stamped approved or for the examiner to write this information in the space provided by the Draftsperson’s stamp on the margin of the sheet of drawing.

Ordinarily a single figure is selected for printing. This figure should be consistent with the claim to be printed in the *Official Gazette*. The figure to be printed in the *Official Gazette* must not be one that is labeled “prior art.” If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. “None” may be written in the box labeled “Print Fig.”** on the Issue Classification Sheet.

1302.10 Issue Classification Notations [R-3]

See MPEP § 903.07, § 903.07(b) and § 903.09 for notations to be applied ** on the Issue Classification sheet.

In all reissue applications, the number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant’s name.

1302.11 Reference to Assignment Division

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See MPEP § 303.

1302.12 Listing of References [R-3]

All references which have been cited by the examiner during the prosecution, including those appearing in Board of Patent Appeals and Interferences decisions or listed in the reissue oath, must be listed on either a form PTO-892 or on an Information Disclo-

sure Statement (PTO/SB/08, old PTO-1449) and initialed. All such reference citations will be printed in the patent. References listed by a patent examiner on a “Notice of References Cited,” form PTO-892, will be indicated with an asterisk in the “References Cited” section of the front page of a patent document. An example of how the “References Cited” section of the patent will appear is as follows:

[56] **References Cited**

U.S. PATENT DOCUMENTS

2,234,192 * 7/1955 Greene..... 75/507
 4,991,048 8/1990 Larkin.....206/207
 5,000,186 12/1991 Amis.....267/340
 5,000,993 * 12/1991 Thomas et al.....75/507

FOREIGN PATENT DOCUMENTS

9500000 * 6/1995 Belgium.....75/507
 200000 * 6/1990 Japan75/507
 9400000 9/1994 United Kingdom.

OTHER PUBLICATIONS

Hill, “Ferrous Precipitation,” *Journal of the American Defenestration Association*, Jan. 1989, Pages 34–46.* Clymerhill-Irons, “Ferrous Ascension for the Eighties,” *Proceedings of the International Ferrous Ascension Society*, Jan.– Mar. 1979, Pages 1111–1163.

* cited by examiner

Indication of whether a reference was listed by the examiner will be helpful in compiling statistical data related to prior art submissions so that the USPTO can better consider whether changes are required to the rules governing prior art statements.

Indication of a reference with an asterisk should not be considered to reflect any significance other than that the reference was listed on a “Notice of References Cited,” form PTO-892. When an examiner lists references on a form PTO-892, the examiner lists references that are relied upon in a prior art rejection or mentioned as pertinent. See MPEP § 707.05(c). The examiner does not list references which were previously cited by the applicant (and initialed by an examiner) on an Information Disclosure Statement, for example, on a PTO/SB/08. See MPEP § 609 and § 707.05(b), (c) and (d). No distinction will be made in the “References Cited” section for other sources of references. Thus, references cited in a protest, by an attorney or agent not acting in a representative capacity but on behalf of a single inventor, and by the applicant will not be distinguished.

At time of allowance, the examiner may cite pertinent art in an examiner’s amendment or statement of reasons for allowance. Such pertinent art should be listed as usual on form PTO-892, a copy of which is attached to the Notice of Allowability form PTOL-37. Such pertinent art ** is not sent to the applicant>, but foreign patent documents and non-patent literature will be scanned and added to the Image File Wrapper (IFW) for viewing and downloading by the applicant, if desired<. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See MPEP § 707.05 and § 707.05(a).

When preparing an application for allowance, the technical support staff will verify that there is at least one list of references (PTO-892 or PTO/SB/08 (old PTO-1449)) in the application. The technical support staff will also verify that each reference on the Information Disclosure Statement has either been initialed by the examiner or lined-through by the examiner. All lists of references are maintained in the **>application file<.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which were pertinent to any preliminary motions and which were discussed in the decision on motion.

In any application, otherwise ready for issue, in which an erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner’s amendment. See MPEP § 707.05(g).

Any new reference cited when the application is in issue, under the practice of MPEP § 1308.01, should be added by way of a PTO-892 or PTO/SB/08.

All copies of references placed in the file wrapper during prosecution should be retained therein when the allowed application is forwarded to the Publishing Division.

1302.13 Signing [R-3]

The primary examiner and the assistant examiner involved in the allowance of an application will ** type their names on the Issue Classification sheet. The

assistant examiner shall place his or her initials after his or her typed ** name. The primary examiner will place his or her signature in the appropriate box ** on the Issue Classification sheet so that the typed ** name can still be easily read. A primary examiner who prepares an application for issue types ** his or her name and signs the file wrapper *only* in the “Primary Examiner” box ** on the Issue Classification sheet. A line should be drawn through the “Assistant Examiner” box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the primary examiner and the assistant examiner appearing on ** the Issue Classification Sheet will be listed in the printed patent.

1302.14 Reasons for Allowance [R-2]

37 CFR 1.104. *Nature of examination.*

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

REASONS FOR ALLOWANCE

One of the primary purposes of 37 CFR 1.104(e) is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new, and the rule merely formalizes the examiner’s existing authority to do so and provides applicants or patent owners an opportunity to comment upon any such statement of the examiner.

It should be noted that the setting forth of reasons for allowance is not mandatory on the examiner’s part. However, in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his or her responsibility to the

public, to see that the file history is as complete as is reasonably possible.

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.

Prior to allowance, the examiner may also specify allowable subject matter and provide reasons for indicating such allowable subject matter in an Office communication.

In determining whether reasons for allowance should be recorded, the primary consideration lies in the first sentence of 37 CFR 1.104(e) which states:

If the examiner believes that the record of the prosecution *as a whole* does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. (Emphasis added).

In most cases, the examiner’s actions and the applicant’s replies make evident the reasons for allowance, satisfying the “record as a whole” proviso of the rule. This is particularly true when applicant fully complies with 37 CFR 1.111 (b) and (c) and 37 CFR 1.133(b). Thus, where the examiner’s actions clearly point out the reasons for rejection and the applicant’s reply explicitly presents reasons why claims are patentable over the reference, the reasons for allowance are in all probability evident from the record and **no** statement should be necessary. Conversely, where the record is not explicit as to reasons, but allowance is in order, then a logical extension of 37 CFR 1.111 and 1.133 would dictate that the examiner should make reasons of record and such reasons should be specific.

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible * effects. Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or

impliedly state that all the reasons for allowance are set forth. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation__in all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. >It is improper to use a statement of reasons for allowance to attempt to narrow a claim by providing a special definition to a claim limitation which is argued by applicant, but not supported by a special definition in the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Cf. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741, 62 USPQ2d 1705, 1714 (2002).< The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's replies make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Under the rule, the examiner must make a judgment of the individual record to determine whether or not reasons for allowance should be set out in that record. These guidelines, then, are intended to aid the examiner in making that judgment. They comprise illustrative examples as to applicability and appropriate content. They are not intended to be exhaustive.

EXAMPLES OF WHEN IT IS LIKELY THAT A STATEMENT SHOULD BE ADDED TO THE RECORD

(A) Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits pre-

sented, and a statement is necessary to identify which of these were persuasive, for example:

(1) When the arguments are presented in an appeal brief.

(2) When the arguments are presented in an ordinary reply, with or without amendment of claims.

(3) When both an affidavit under 37 CFR 1.131 and arguments concerning rejections under 35 U.S.C. 102 and 103 are presented.

(B) First action issue:

(1) Of a noncontinuing application, wherein the claims are very close to the cited prior art and the differences have not been discussed elsewhere.

(2) Of a continuing application, wherein reasons for allowance are not apparent from the record in the parent case or clear from preliminary filed matters.

(C) Withdrawal of a rejection for reasons not suggested by applicant, for example:

(1) As a result of an appeal conference.

(2) When applicant's arguments have been misdirected or are not persuasive alone and the examiner comes to realize that a more cogent argument is available.

(3) When claims are amended to avoid a rejection under 35 U.S.C. 102, but arguments (if any) fail to address the question of obviousness.

(D) Allowance after remand from the Board of Patent Appeals and Interferences.

(E) Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover:

(1) When reference is found and cited (but not argued) by applicant.

(2) When reference is found and cited by examiner.

(F) Where the reasons for allowance *are* of record but, in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them.

(G) Allowance based on a claim interpretation which might not be readily apparent, for example:

(1) Article claims in which method limitations impart patentability.

(2) Method claims in which article limitations impart patentability.

(3) Claim is so drafted that “nonanalogous” art is not applicable.

(4) Preamble or functional language “breathes life” into claim.

(H) Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia.

The reasons for allowance should refer to and incorporate the briefs and the court decision.

>

(I) Where the claims are considered patentable over the X and/or Y references cited in a search report of a corresponding PCT application and the reasons for allowance are not apparent from the record.<

EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

(A) The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant’s second affidavit in example 5 shows unexpected results from this restricted range.

(B) During two telephonic interviews with applicant’s attorney, Mr..... on 5/6 and 5/10/77, the examiner stated that applicant’s remarks about the placement of the primary teaching’s grid member were persuasive, but he pointed out that applicant did not claim the member as being within the reactor. Thus, an amendment doing such was agreed to.

(C) The * >claims in the< application * >are< deemed to be directed to an nonobvious improvement over the invention patented in Pat. No. 3,953,224. The **>claims comprise< baffle means 12 whose effective length in the extraction tower may be varied so as to optimize and to control the extraction process.

(D) Upon reconsideration, this application has been awarded the effective filing date of application number -/---. Thus the rejection under 35 U.S.C. 102(d) and 103 over Belgium Patent No. 757,246 is withdrawn.

(E) The specific limitation as to the pressure used during compression was agreed to during the telephone interview with applicants’ attorney. During said interview, it was noted that applicants contended in their amendment that a process of the combined applied teachings could not result in a successful article within a particular pressure range (see page 3, bot-

tom, of applicant’s amendment). The examiner agreed and allowed the application after incorporating the pressure range into the claim.

(F) In the examiner’s opinion, it would not have been obvious to a person of ordinary skill in the art first to eliminate one of top members 4, second to eliminate plate 3, third to attach remaining member 4 directly to tube 2 and finally to substitute this modified handle for the handle 20 of Nania (see Fig. 1) especially in view of applicant’s use of term “consisting.”

(G) The application is allowable for the reasons set forth on page -- of the decision of the Court of Appeals for the Federal Circuit, which is hereby incorporated by reference. As noted therein, and as argued on page -- of Appellant’s brief, the claimed invention requires a one piece tubular member whereas the closest prior art requires a multiple piece assembly which does not teach or suggest the claimed invention.

EXAMPLES OF STATEMENTS THAT ARE NOT SUITABLE AS TO CONTENT

(A) The 3-roll press couple has an upper roll 36 which is swingably adjustable to vary the pressure selectively against either of the two lower rolls. (NOTE: The significance of this statement may not be clear if no further explanation is given.)

(B) The main reasons for allowance of these claims are applicant’s remarks in the appeal brief and an agreement reached in the appeal conference.

(C) The instant composition is a precursor in the manufacture of melamine resins. A thorough search of the prior art did not bring forth any composition which corresponds to the instant composition. The examiner in the art also did not know of any art which could be used against the instant composition.

(D) Claims 1-6 have been allowed because they are believed to be both novel and nonobvious.

The examiner should *not* include in his or her statement any matter which does not relate directly to the reasons for allowance. For example:

(E) Claims 1 and 2 are allowed because they are patentable over the prior art. If applicants are aware of better art than that which has been cited, they are required to call such to the attention of the examiner.

(F) The reference Jones discloses and claims an invention similar to applicant's. However, a comparison of the claims, as set forth below, demonstrates the conclusion that the inventions are noninterfering.

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases, the examiner should (a) check the appropriate box on the form PTOL-37 and (b) attach thereto a paper containing the examiner's statement of reasons for allowance. Such a statement should be typewritten. The paper should identify the application number and be clearly labeled "Statement of Reasons for Allowance." It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee.

Form paragraph 13.03 may be used for this purpose.

**>

¶ 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.

<

A statement may be sent to applicant with other communications, where appropriate, but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the data indicated above.

Form paragraph 13.13.01 may be used to specify the reasons for indicating allowable subject matter in a communication prior to allowance.

¶ 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.

APPLICANT'S COMMENTS ON THE REASONS FOR ALLOWANCE

The examiner's statement of reasons for allowance is an important source of prosecution file history. See *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996). **>The examiner's statement of reasons for allowance is the personal opinion of the examiner as to why the claims are allowable. The examiner's statement should not create an *estoppel*. Only applicant's statements should create an *estoppel*. The failure of applicant to comment on the examiner's statement of reasons for allowance should not be treated as acquiescence to the examiner's statement. Any inferences or presumption are to be determined on a case-by-case basis by a court reviewing the patent, the USPTO examining the patent in a reissue application or a reexamination proceeding, the Board of Patent Appeals and Interferences reviewing the patent in an interference proceeding, etc.< Applicant may set forth his or her position if he or she disagrees with the examiner's reasons for allowance.

Comments filed by the applicant on the examiner's statement of reasons for allowance, should preferably be submitted no later than the payment of the issue fee, to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance." Comments will be entered in the application file by the Office of Publication with an appropriate notation on the "Contents" list on the file wrapper.

The application file generally will not be returned to the examiner after the entry of such comments made by applicant on the examiner's statement of reasons for allowance. Therefore, the absence of an examiner's response to applicant's comments does not mean that the examiner agrees with or acquiesces in the reasoning of such comments. See 37 CFR 1.104(e). While the examiner may review and comment upon such a submission, the examiner has no obligation to do so.

1303 Notice of Allowance [R-3]

37 CFR 1.311. Notice of Allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) ***>*An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:

- (1) An incorrect issue fee or publication fee; or
- (2) A fee transmittal form (or letter) for payment of issue fee or publication fee.<

A Notice of Allowance is prepared and mailed, and the mailing date appearing thereon is recorded on the paper or image file wrapper table of contents.

If an application is subject to publication under 37 CFR 1.211, the Notice of Allowance will require both the issue fee and the publication fee. See 37 CFR 1.211(e). The Notice of Allowance and Issue Fee Due form (PTOL-85) has been revised and the revised form is entitled “Notice of Allowance and Fee(s) Due.” Revision of the form was necessary to include the amount of any required publication fee, as provided in 37 CFR 1.211(e) and 1.311, and to more clearly communicate the amount of any patent term extension or adjustment earned under 35 U.S.C. 154(b). As revised, the PTOL-85 form is three pages long, with all three pages being mailed to the applicant and a duplicate being retained in the application file. The first two pages of the revised form include an indication that the publication fee is due, if the application was subject to publication and the publication fee has not already been paid. Part B of the revised form (PTOL-85B) should be returned to the Office with the payment of the issue fee. The PTOL-85B is labeled at the bottom of the form “TRANSMIT THIS

FORM WITH FEE(S).” Applicants are reminded to transmit an extra copy of the PTOL-85B when payment of the issue fee is by way of authorization to debit a Deposit Account. See MPEP § 509.01.

There are three versions of page three of the revised PTOL-85 form, depending upon the filing date of the application:

(A) For applications filed before June 8, 1995, page three will state that “This application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment applies.” Utility and plant applications filed before June 8, 1995 are eligible for a 17 year term and thus are not eligible for patent term extension or adjustment under 35 U.S.C. 154(b).

(B) For applications filed on or after June 8, 1995 and before May 29, 2000, page three will state that “The patent term extension is _ days. Any patent to issue from the above identified application will include an indication of the _ extension on the front page. If a continued prosecution application (CPA) was filed in the above identified application, the filing date that determines patent term extension is the filing date of the most recent CPA.” Utility and plant applications filed on or after June 8, 1995 and before May 29, 2000 may be eligible for patent term extension. See 35 U.S.C. 154(b), effective June 8, 1995, and 37 CFR 1.701.

(C) For applications filed on or after May 29, 2000, page three will state that “The patent term adjustment to date is _ days. If the issue fee is paid on a date that is three months after the mailing date of this notice, and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the term adjustment will be _ days. If a continued prosecution application (CPA) was filed in the above identified application, the filing date that determines patent term extension is the filing date of the most recent CPA.” Utility and plant applications filed on or after May 29, 2000 may be eligible for patent term adjustment. See 35 U.S.C. 154(b), effective May 29, 2000, and 37 CFR 1.702 - 1.705, especially 37 CFR 1.705(a).

For more information about eighteen month publication, publication fees, and patent term adjustment, visit the USPTO Internet web site at www.uspto.gov.

**>



UNITED STATES PATENT AND TRADEMARK OFFICE

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 United States Patent and Trademark Office
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 Alexandria, Virginia 22313-1450
 www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TITLE OF INVENTION:

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
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THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
- B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 or Fax (571) 273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

TITLE OF INVENTION:

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
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EXAMINER	ART UNIT	CLASS-SUBCLASS
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<p>1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).</p> <p><input type="checkbox"/> Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.</p> <p><input type="checkbox"/> "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.</p>	<p>2. For printing on the patent front page, list</p> <p>(1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____</p> <p>(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____</p> <p>3 _____</p>
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3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE _____ (B) RESIDENCE: (CITY and STATE OR COUNTRY) _____

Please check the appropriate assignee category or categories (will not be printed on the patent): Individual Corporation or other private group entity Government

<p>4a. The following fee(s) are enclosed:</p> <p><input type="checkbox"/> Issue Fee</p> <p><input type="checkbox"/> Publication Fee (No small entity discount permitted)</p> <p><input type="checkbox"/> Advance Order - # of Copies _____</p>	<p>4b. Payment of Fee(s):</p> <p><input type="checkbox"/> A check in the amount of the fee(s) is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).</p>
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5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above. NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)
 (application filed prior to June 8, 1995)

This patent application was filed prior to June 8, 1995, thus no Patent Term Extension or Adjustment applies.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Determination of Patent Term Extension under 35 U.S.C. 154 (b)
 (application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is day(s). Any patent to issue from the above-identified application will include an indication of the day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
 (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

1303.01 Amendment Received After Allowance [R-3]

If the amendment is filed under 37 CFR 1.312, see MPEP § 714.15 to § 714.16(e). If the amendment contains claims copied from a patent, see MPEP Chapter 2300. Any submissions of replacement drawings filed after allowance should be forwarded to the Office of Patent Publication.

Reference to an Issue Batch Number is no longer necessary because the Office no longer stores and tracks applications according to issue batches.

Any paper filed after receiving the Issue Notification should include the indicated patent number, unless the application has been withdrawn from issue.

1303.02 Undelivered [R-2]

In case a Notice of Allowance is returned, and a new notice is sent (see MPEP § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing. If the application is an Image File Wrapper (IFW) application, the original document, a copy of the returned document with any markings, and the remailed document should be retained in the application so that the file history is clear.

1303.03 Not Withheld Due to Death of Inventor

The Notice of Allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See MPEP § 409.01(f).

1304 Amendments After D-10 Notice

For amendments received after D-10 Notice, see MPEP § 130.

1304.01 Withholding From Issue of “Secrecy Order” Applications

“Secrecy Order” applications are not sent to issue even when all of the claims have been allowed. Instead of mailing a Notice of Allowance, a D-10 Notice is sent. See MPEP § 130.

If the “Secrecy Order” in an application is withdrawn after the D-10 notice is mailed, the application should then be treated like an ordinary application in condition for allowance.

1305 Jurisdiction [R-2]

Jurisdiction of the application remains with the primary examiner until the Notice of Allowance is mailed. However, the examiner may make examiner’s amendments correcting obvious errors, as when brought to the attention of the examiner by the printer, and also may admit amendments under 37 CFR 1.312 which are confined to matters of form in the specification or claims, or to the cancellation of a claim or claims. The examiner’s action on other amendments under 37 CFR 1.312 consists of a recommendation to the Director.

To regain jurisdiction over the application, the examiner must write a letter to the Director requesting it. See MPEP § 1308 and § 1308.02.

Once the patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

1306 Issue Fee [R-2]

The issue fee and any required publication fee are due 3 months from the date of the Notice of Allowance. The amount of the issue fee and any required publication fee are shown on the Notice of Allowance, which will reflect any issue fee previously paid in the application. For example, if the application was allowed and the issue fee paid, but applicant withdrew the application from issue and filed a Request for Continued Examination (RCE) and the application was later allowed, the Notice of Allowance will reflect an issue fee amount that is due that is the difference between the current issue fee amount and the issue fee that was previously paid. Had applicant filed a Continued Prosecution Application (CPA) instead of an RCE, the issue fee required would be the current issue fee amount and would not reflect any issue fee paid before the CPA was filed because the issue fee was paid in a prior application. Note that because the amount of the fees due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the fees, the amount due at the time the fee(s) are paid may differ from the amount indicated on the Notice of Allowance. Accordingly, applicants are encouraged, at the time of submitting payment of

the **>fees(s)<**, to determine whether the amount of the issue fee due **>**or any required publication fee has changed to avoid the patent lapsing for failure to pay the balance of the issue fee due (37 CFR 1.317) or becoming abandoned for failure to pay the publication fee<. The amounts due under 35 U.S.C. 41(a) **>**(i.e., the issue fee, but not the publication fee)< are reduced by 50 per centum for small entities.

Applicants and their attorneys or agents are urged to use the **>Fee(s) Transmittal<** form (PTOL-85B) provided with the Notice of Allowance when submitting their payments. **>**Unless otherwise directed<, all post allowance correspondence should be addressed **>Mail Stop< Issue Fee.**”

>Where it is clear that an applicant actually intends to pay the issue fee and required publication fee, but the proper fee payment is not made, for example, an incorrect issue fee amount is supplied, or a PTOL-85B Fee(s) Transmittal form is filed without payment of the issue fee, a general authorization to pay fees or a specific authorization to pay the issue fee, submitted prior to the mailing of a notice of allowance, will be allowed to act as payment of the correct issue fee. 37 CFR 1.311(b). In addition, where the deposit account information is added to the Fee(s) Transmittal form (PTOL-85B), but the check box authorizing that the deposit account be charged the issue fee is not checked, the deposit account will still be charged the required issue fee and any required publication fee.<

Technology Center personnel should forward all post allowance correspondence to the **>Office of Initial Patent Examination (OIPE)<**. The papers received by the **>OIPE** will be scanned and< matched with the appropriate application and the entire application will be forwarded to the appropriate Technology Center for processing.

The payment of the issue fee due may be simplified by using a U.S. Patent and Trademark Office Deposit Account or a credit card payment with form PTO-2038 for such a fee. See MPEP **>**§< 509. However, any such payment must be specifically authorized by reference to the “issue fee” or “fees due under 37 CFR 1.18.”

The **>fee(s) due<** will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34(a).

The **>Director<** has no authority to extend the time for paying the issue fee. Intentional failure to pay the issue fee within the 3 months permitted by 35 U.S.C. 151 does not amount to unavoidable or unintentional delay in making payment.

1306.01 Deferring Issuance of a Patent [R-2]

37 CFR 1.314. Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

There is a public policy that the patent will issue in regular course once the issue fee is timely paid. 37 CFR 1.314. It has been the policy of the U.S. Patent and Trademark Office to defer issuance of a patent, upon request, for a period of up to 1 month only, in the absence of extraordinary circumstances or requirement of the regulations (e.g., 37 CFR 1.177) which would dictate a longer period. Situations like negotiation of licenses, time for filing in foreign countries, collection of data for filing a continuation-in-part application, or a desire for simultaneous issuance of related applications are not considered to amount to extraordinary circumstances.

A petition to defer issuance of a patent is not appropriate until the issue fee is paid. Issuance of a patent cannot be deferred after an allowed application receives a patent number and issue date unless the application is withdrawn from issue under 37 CFR 1.313(b) **>**or (c)<. The petition to defer is considered at the time the petition is correlated with the application file before the appropriate deciding official (MPEP § 1002.02(b)). In order to facilitate consideration of a petition for deferment of issue, the petition should be firmly attached to the Issue Fee Transmittal form (PTOL-85B) and clearly labeled as a Petition to Defer Issue; Attention: Office of **>**Petitions<.

1306.02 Simultaneous Issuance of Patents [R-2]

Where applications have been allowed and a Notice of Allowance and **>Fee(s)< Due** (PTOL-85) has been mailed in each application, a request for simulta-

