

Chapter 1700 Miscellaneous

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1701 Office Personnel Not To Express Opinion on Validity*,>< Patentability>, or Enforceability< of Patent [R-3]

Every patent is presumed to be valid. 35 U.S.C. 282, first sentence. Public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

- (A) an examination of a reissue application of the patent,
- (B) a reexamination proceeding to reexamine the patent, or
- (C) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. >Likewise, the question of enforceability or unenforceability is exclusively a matter to be determined by a court.< Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the USPTO, including an employee of another U.S. Government agency, the answer to which might indicate that a particular patent

should not have issued. No USPTO employee may pursue a bounty offered by a private sector source for identifying prior art. The acceptance of payments from outside sources for prior art search activities may subject the employee to administrative disciplinary action.

When a field of search for an invention is requested, examiners should routinely inquire whether the invention has been patented in the United States. If the invention has been patented, no field of search should be suggested.

Employees of the USPTO, particularly patent examiners who examined an application which matured into a patent or a reissued patent or who conducted a reexamination proceeding, should not discuss or answer inquiries from any person outside the USPTO as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not a claim would have been allowed over that reference or other evidence had it been considered during the examination or proceeding. Likewise, *employees* are cautioned against answering any inquiry concerning any entry in the patent or reexamination file, including the extent of the field of search and any entry relating thereto. The record of the file of a patent or reexamination proceeding must speak for itself.

Practitioners **>shall not make< improper inquiries of members of the patent examining corps. Inquiries from members of the public relating to the matters discussed above must of necessity be refused and such refusal should not be considered discourteous or an expression of opinion as to validity *,>< patentability >or enforceability.

The definitions set forth in 37 CFR 104.1 and the exceptions in 37 CFR 104.21 are applicable to this section.<

1701.01 Office Personnel Not To Testify [R-3]

It is the policy of the United States Patent and Trademark Office (USPTO) that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in 37 CFR Part 104, Subpart C. >The definitions set forth in 37 CFR 104.1 and the exceptions in 37 CFR 104.21 are applicable to

this section.< Any employee who testifies contrary to this policy will be *dismissed or removed*.

Whenever an employee of the USPTO, including a patent examiner, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the USPTO General Counsel. Inquiries requesting testimony shall be also referred immediately to the Office of the USPTO General Counsel.

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Any individual desiring the testimony of an employee of the USPTO, including the testimony of a patent examiner or other quasi-judicial employee, must comply with the provisions of 37 CFR Part 104, Subpart C.

A request by a third party to take deposition testimony of a patent examiner in a pending *ex parte* reexamination proceeding will generally be denied in view of the *ex parte* nature of the reexamination proceeding.

A request for testimony of an employee of the USPTO should be made to the Office of the USPTO General Counsel at least **10 working days** prior to the date of the expected testimony.

>Patent examiners and other USPTO employees performing or assisting in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any patent.<

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions. *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions based thereon); *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner in acting upon a patent application). Employees will not be permitted to give testimony with respect to subject matter which is privileged. Several court decisions

limit testimony with respect to quasi-judicial functions performed by employees. Those decisions include *United States v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions which probe the examiner's technical knowledge of the subject matter of a patent); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. 134 since board members need not be skilled in the art to render obviousness decision); *Lange v. Commissioner*, 352 F. Supp. 166, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in 35 U.S.C. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the USPTO, the employee will not be permitted to give testimony in response to questions that the Office determines are impermissible. Impermissible questions include, but are not limited to, questions directed to discovering the mental processes or expertise of a quasi-judicial official, such as:

- (A) Information about that employee's:
 - (1) Background;
 - (2) Expertise;
 - (3) Qualifications to examine or otherwise consider a particular patent or trademark application;
 - (4) Usual practice or whether the employee followed a procedure set out in any Office manual of practice (including the MPEP or TMEP) in a particular case;
 - (5) Consultation with another Office employee;
 - (6) Understanding of:
 - (a) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file;

- (b) Prior art;
 - (c) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file;
 - (d) Any Office manual of practice;
 - (e) Office regulations;
 - (f) Patent, trademark, or other law; or
 - (g) The responsibilities of another Office employee;
- (7) Reliance on particular facts or arguments;
- (B) To inquire into the manner in and extent to which the employee considered or studied material in performing a quasi-judicial function; or
- (C) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the USPTO General Counsel shall comply with 37 CFR 104.22(c). All requests must be in *writing*. The need for a subpoena may be obviated where the request complies with 37 CFR 104.22(c) if the party requesting the testimony further meets the following conditions:

- (A) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include the:
- (1) Style of the case;
 - (2) Civil action number;
 - (3) District in which the civil action is pending;
 - (4) Judge assigned to the case; and
 - (5) Name, address, and telephone number of counsel for all parties in the civil action.
- (B) The party agrees not to ask questions seeking information which is precluded by 37 CFR 104.23;
- (C) The party shall comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give 10 working days notice to the Office of the USPTO General Counsel prior to the date a deposition is desired. Fifteen working days notice is required for any deposition which is desired to be taken between November 15 and January 15;

(D) The party agrees to notice the deposition at a place convenient to the USPTO. The Conference Room in the Office of the USPTO General Counsel is deemed to be a place convenient to the Office; and

(E) The party agrees to supply a copy of the transcript of the deposition to the USPTO for its records.

Absent a written agreement meeting the conditions specified in paragraphs (A) through (E), a party must comply with the precise terms of 37 CFR 104.22(c) and the USPTO will not permit a deposition without issuance of a subpoena.

1702 Restrictions on ~~**>~~Practice in Patent Matters< [R-3]

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37 CFR 11.10. Restrictions on practice in patent matters.

(a) Only practitioners who are registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

- (i) Before the Office,
- (ii) In connection with any particular patent or patent application,
- (iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

- (i) Before the Office,
- (ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent* and *representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) *Particular patent or patent application* means any patent or patent application, including, but not limited to, a provisional, substitute, international, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, or interference based on the patent or patent application.

(iv) *Participate personally and substantially*. (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had “personal and substantial participation,” exercised “through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise.” To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee’s involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a “particular patent or patent application.” (See paragraph (b)(3)(iii) of this section.)

(B) Participation on ancillary matters. An Office employee’s participation on subjects not directly involving the substantive merits of a patent or patent application may not be “substantial,” even if it is time-consuming. An employee whose official responsibility is the review of a patent or patent application solely for compliance with administrative control or budgetary considerations and who reviews a particular patent or patent application for such a purpose should not be regarded as having participated substantially in the patent or patent application, except when such considerations also are the subject of the employee’s proposed representation.

(C) Role of official responsibility in determining substantial participation. *Official responsibility* is defined in paragraph (b)(3)(v) of this section. “Personal and substantial participation” is different from “official responsibility.” One’s responsibility may, however, play a role in determining the “substantiality” of an Office employee’s participation.

(v) *Official responsibility* means the direct administrative or operating authority, whether intermediate or final, and either exercisable alone or with others, and either personally or through subordinates, to approve, disapprove, or otherwise direct Government actions.

(A) Determining official responsibility. Ordinarily, those areas assigned by statute, regulation, Executive Order, job description, or delegation of authority determine the scope of an employee’s “official responsibility”. All particular matters under consideration in the Office are under the “official responsibility” of the Director of the Office, and each is under that of any intermediate supervisor having responsibility for an employee who actually participates in the patent or patent application within the

scope of his or her duties. A patent examiner would have “official responsibility” for the patent applications assigned to him or her.

(B) Ancillary matters and official responsibility. *Administrative* authority as used in paragraph (v) of this section means authority for planning, organizing and controlling a patent or patent application rather than authority to review or make decisions on ancillary aspects of a patent or patent application such as the regularity of budgeting procedures, public or community relations aspects, or equal employment opportunity considerations. Responsibility for such an ancillary consideration does not constitute official responsibility for the particular patent or patent application, except when such a consideration is also the subject of the employee’s proposed representation.

(C) Duty to inquire. In order for a former employee, *e.g.*, former patent examiner, to be barred from representing or assisting in representing another as to a particular patent or patent application, he or she need not have known, while employed by the Office, that the patent or patent application was pending under his or her official responsibility. The former employee has a reasonable duty of inquiry to learn whether the patent or patent application had been under his or her official responsibility. Ordinarily, a former employee who is asked to represent another on a patent or patent application will become aware of facts sufficient to suggest the relationship of the prior matter to his or her former office, *e.g.*, technology center, group or art unit. If so, he or she is under a duty to make further inquiry. It would be prudent for an employee to maintain a record of only patent application numbers of the applications actually acted upon by decision or recommendation, as well as those applications under the employee’s official responsibility which he or she has not acted upon.

(D) Self-disqualification. A former employee, *e.g.*, former patent examiner, cannot avoid the restrictions of this section through self-disqualification with respect to a patent or patent application for which he or she otherwise had official responsibility. However, an employee who through self-disqualification does not participate personally and substantially in a particular patent or patent application is not subject to the lifetime restriction of paragraph (b)(1) of this section.

(vi) *Pending* means that the matter was in fact referred to or under consideration by persons within the employee’s area of official responsibility.

(4) Measurement of the two-year restriction period. The two-year period under paragraph (b)(2) of this section is measured from the date when the employee’s official responsibility in a particular area ends, not from the termination of service in the Office, unless the two occur simultaneously. The prohibition applies to all particular patents or patent applications subject to such official responsibility in the one-year period before termination of such responsibility.

(c) *Former employees of the Office*. This section imposes restrictions generally parallel to those imposed in 18 U.S.C. 207(a) and (b)(1). This section, however, does not interpret these statutory provisions or any other post-employment restrictions that may apply to former Office employees, and such former employees should not assume that conduct not prohibited by this section is otherwise permissible. Former employees of the Office,

whether or not they are practitioners, are encouraged to contact the Department of Commerce for information concerning applicable post-employment restrictions.

(d) An employee of the Office may not prosecute or aid in any manner in the prosecution of any patent application before the Office.

(e) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.<

See also MPEP § 309.

1703 The Official Gazette [R-2]

The *Official Gazette of the United States Patent and Trademark Office (Official Gazette)* is published >electronically< every Tuesday in two sections, the *Official Gazette – Patents* and the *Official Gazette – Trademarks*. **

The *Official Gazette – Patents* reports the reexamination certificates, reissues, plant patents, utility patents, and design patents issued and statutory invention registrations (if any) published on that day. **>The *Official Gazette – Patents* (eOG:P) allows browsing through the issued patents for the week. The eOG:P can be browsed by classification or type of patent, for example, utility, design, and plant. Specific patents can be accessed by class/subclass or patentee name. Links are provided to the various pages of the eOG:P:

(A) *Browse by Class/Subclass* page to access patents by a specific classification;

(B) *Classification of Patents* page with links to patents by a range of classifications;

(C) *Browse Granted Patents* page to access a patent by patent number or link to patents by type;

(D) *Index of Patentees* page to browse by names of inventors and assignees in either a cumulative alphabetical index or individual indexes by type of patent. Each patentee listing contains a link to the patent;

(E) *Geographical Index of Inventors* to link to patents by the state or country of residence of the first listed inventor; and

(F) *Notices* page containing the text of important notices for the week.<

As to each patent, the following information is given:

- (A) Patent number;
- (B) Title of the invention;
- (C) Applicant's name;
- (D) Applicant's city and state of residence and, if unassigned, applicant's mailing address;
- (E) Assignee's name, city and state of residence, if assigned;
- (F) U.S. or PCT parent application data, if any;
- (G) Filing date;
- (H) Application number;
- (I) Foreign priority application data, if any;
- (J) International classification;
- (K) U.S. classification by class and subclass;
- (L) Number of claims;
- (M) Selected figure of the drawing, if any **;
- (N) A claim or claims; *
- (O) For reissue patents, the original patent number and issue date, and the original application number and filing date>; and
- (P) Patent Application Publication Number and Publication date, if any.<

The *Official Gazette – Trademarks* >is published electronically and< contains ** an illustration of each trademark published for opposition, an alphabetical list of registered trademarks, a classified list of registered trademarks, an index of registrants, a list of canceled trademark registrations, and a list of renewed trademark registrations.

**The information in the *Official Gazette* pertaining to each issued patent and each trademark registration can be obtained from the Patent Grants Database and the U.S. Trademark Electronic Search System (TESS) respectively, both also available on the USPTO web site.

>Regular and special notices of the United States Patent and Trademark Office are published in the *Official Gazette Notices*, both as part of the *Official Gazette – Patents* (eOG:P) and as a separate publication. The notices that are included in this publication include notices of patent and trademark suits, disclaimers filed, Certificates of Correction issued, lists of applications and patents available for license or sale, notices of 37 CFR 1.47 applications, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, registration of attorneys and agents, reprimands, suspensions, and exclusions of registered attorneys and

agents, and notices to parties not reached by mail. The *Official Gazette Notices* are available on the United States Patent and Trademark Office web site (www.uspto.gov). Paper copies of the *Official Gazette* ****** *Notices* are available from the Government Printing Office. Orders for the *Official Gazette Notices* should be addressed and subscriptions should be made payable to the Superintendent of Documents, Government Printing Office, Washington, D.C. 20402.

1704 Application Records and Reports [R-2]

The PALM (Patent Application Locating and Monitoring) System is the automated data management system used by the United States Patent and Trademark Office (USPTO) for the retrieval and/or online updating of the computer record of each patent application. The PALM System also maintains examiner time, activity, docket, and technical support staff backlog records.

Information retrieval from PALM is by means of ****** the PALM intranet. ****** Transactions are entered via bar code readers, by keyed entries, or by making an appropriate choice in a drop down menu. Among other items, classification, examiner docket, attorney, inventor, and prosecution history data as well as the location of each application can be retrieved and updated online with PALM.

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I. < DOCKET REPORTS

The recording of changes to examiner dockets is accomplished by PALM simultaneously with the recording of incoming and outgoing communications, transfers of applications to and from dockets, and other types of updating of the application record. The status of each examiner's docket can be determined by means of ****** the PALM intranet and is supplemented by periodic printed reports. Docket reports that are generated by PALM include the individual examiner new, special, and amended docket which lists applications in priority order; the individual examiner rejected application docket; the individual examiner new application profile, which lists the totals of new applications in each docket, sorted by month of filing; and various summaries of the above

reports at the art unit, Technology Center (TC), and corps levels.

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II. < BIWEEKLY TIME AND ACTIVITY REPORTS

All reporting of examiner time and activity is on a biweekly basis. Each examiner's examining and non-examining time, as listed on the examiner's Biweekly Time Worksheet, PTO-690E, is entered into PALM for use in the computation of productivity data. The biweekly reports produced include the individual Biweekly Examiner Time and Activity Report which lists, by application number, all applications for which actions have been counted during the biweekly period. The type of action counted for each application is also indicated on the report. This report also includes examiner time data, an action summary, and cumulative summaries to date for the current quarter and fiscal year. Various summary reports at the Art Unit, TC, and Corps levels are also produced.

1705 Examiner Docket, Time, and Activity Recordation [R-2]

Actions prepared by examiners are submitted to their respective legal instrument examiners for processing in accordance with the procedures set forth below.

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I. < PROCEDURES FOR REPORTING AN EXAMINER'S ACTION

(A) The examiner completes an Examiner's Case Action Worksheet, Form PTO-1472, which identifies the type of action prepared. The worksheet is attached to the application if the application is maintained in a paper file, or placed in an Action folder with the Office action if the application is an Image File Wrapper (IFW) application for processing by the legal instrument examiner;

(B) The legal instrument examiner checks the worksheet to verify that the examiner provided all necessary information relating to that action;

(C) The legal instrument examiner enters the type of action and the count date thereof on the Contents

flap of the file wrapper >if the application is maintained in a paper file, or has the action added to the IFW (see IFW Manual)<; and

(D) The legal instrument examiner enters the examiner's action for the application directly into PALM **.

Each examiner's action that is counted and reported to the PALM system will be listed by application number on the Biweekly Examiner Time and Activity Report. The examiner should check his/her Biweekly Examiner Time and Activity Report to verify that all

applications worked on for the biweekly report period are properly listed.

Examples of examiner's actions that are reported to PALM by the legal instrument examiner, but are not listed on the Biweekly Examiner Time and Activity Report, include examiner's amendments, actions in reexamination proceedings, interview summaries, transfers of applications, and supplemental Office actions and miscellaneous Office letters which do not set a period for reply.

**>

FORM PTO-1472
(Rev. 4-2002)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

EXAMINER'S CASE ACTION WORKSHEET

Application No. _____	Legal Instrument Examiner _____
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CHECK TYPE OF ACTION

DATE OF COUNT

<input type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ <small>(Approval for Disposal)</small>	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ <small>(initial)</small>
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal <small>(use only after FAOM)</small>	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter <small>(With Shortened Statutory Period Set)</small>	<input type="checkbox"/> Notice of Non-Responsive Amendment <small>(With One Month Time Period set)</small>	<input type="checkbox"/> Miscellaneous Office Letter <small>(No Response Period Set)</small>
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action <small>(excluding Examiner's Answer)</small>	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response <small>(e.g., Missing References)</small>	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ <small>(Initial)</small>
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other Specify: _____

Examiner's Name:

AU:

II. < COUNTING OF FIRST ACTION ON THE MERITS (FAOM) >

Office actions on the merits consist of rejections (final and non-final), *Ex parte Quayle* actions, and allowances.

The first time an examiner performs one of the above merit actions, he/she receives credit for a First Action on the Merits (FAOM) on the production reports.

A second/subsequent but FAOM usually occurs when the first action is a restriction/election action and the second action is an action on the merits. The examiner indicates the type of second action on the Examiner's Case Action Worksheet, and the PALM system will automatically determine if it is a FAOM. If the second action is a FAOM, the action will be listed and credited on the Biweekly Examiner Time and Activity Report as a Second/Subsequent FAOM.

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III. < COUNTING OF DISPOSALS

An examiner receives a "disposal" count for the following actions:

- (A) Allowance;
- (B) Abandonment;
- (C) Examiner's Answer;
- (D) International Preliminary Examination Report;
- (E) Statutory Invention Registration (SIR) disposal (only after a FAOM; see MPEP § 1101); and
- (F) Interference wherein the application would be in condition for allowance but for the interference.

These same items constitute the "disposals" for performance evaluation of examining art units and TCs. However, disposals at the Office level consist only of allowances and abandonments.

For either an allowance or an abandonment after an Examiner's Answer or decision by a court or the Board of Patent Appeals and Interferences, no disposal credit is received, though these actions are indicated on the Biweekly Examiner Time and Activity Report.

IV. < CORRECTION INFORMATION

(A) If any information is either missing from or incorrect on the Biweekly Examiner Time and Activity Report, the examiner should promptly notify the legal instrument examiner by providing all the pertinent information necessary to make the changes to the PALM system (e.g., examining hours, application number, type of action, etc.).

(B) The legal instrument examiner will report the necessary changes and corrections directly into PALM. These changes will be listed on the next Biweekly Examiner Time and Activity Report.

(C) If any information is missing from the last Biweekly Examiner Time and Activity Report of a quarter (except at the end of a fiscal year) or is incorrect, the examiner should promptly notify the legal instrument examiner and his/her supervisory patent examiner (SPE). The legal instrument examiner will make the appropriate changes directly into the PALM system. The changes will be listed on the next Biweekly Examiner Time and Activity Report. However, these changes will not be reflected in the last Quarter's Report; the examiner's SPE may manually make an adjustment to the records to show these changes.

(D) In order to ensure that all PALM reports are correct at the end of the fiscal year (rating period), a special correction cycle is provided on the PALM system. If any information is missing from or is incorrect on the last Biweekly Examiner Time and Activity Report, the examiner should immediately notify the legal instrument examiner and his/her SPE. These changes will be reflected in the examiner's final biweekly report for the entire fiscal year.

1706 Disclosure Documents [R-3]

A service provided by the United States Patent and Trademark Office (USPTO) is the acceptance and preservation for two years of "Disclosure Documents" as evidence of the date of conception of an invention. However, inventors are strongly encouraged to file a provisional patent application instead of a Disclosure Document. A provisional application for patent is a U.S. national application for patent filed in the USPTO under 35 U.S.C. 111(b). It allows filing without a formal patent claim, oath or declaration, or any

information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a non-provisional patent application filed under 35 U.S.C. 111(a). It also allows the term "Patent Pending" to be applied to products for which a patent application has been filed. A provisional application has a pendency lasting 12 months from the date the provisional application is filed. The 12-month pendency period cannot be extended. Unlike a Disclosure Document, the benefit of the filing date of the provisional application may be relied upon pursuant to 35 U.S.C. 119(e) in a corresponding non-provisional application or for foreign priority purposes when filing a patent application on the invention in other countries. See MPEP § 201.04(b) and § 601.01(b).

I. THE PROGRAM

A paper disclosing an invention (called a Disclosure Document) and signed by the inventor or inventors may be forwarded to the USPTO by the inventor (or by any one of the inventors when there are joint inventors), by the owner of the invention, or by the attorney or agent of the inventor(s) or owner. The Disclosure Document will be retained for two years, and then be destroyed unless it is referred to in a separate letter in a related patent application filed within those two years.

THE DISCLOSURE DOCUMENT IS NOT A PATENT APPLICATION, AND THE DATE OF ITS RECEIPT IN THE USPTO WILL NOT BECOME THE EFFECTIVE FILING DATE OF ANY PATENT APPLICATION SUBSEQUENTLY FILED. THESE DOCUMENTS WILL BE KEPT IN CONFIDENCE BY THE USPTO.

This program does not diminish the value of the conventional, witnessed, permanently bound, and page-numbered laboratory notebook or notarized records as evidence of conception of an invention.

II. CONTENT OF DISCLOSURE

The benefits afforded by the Disclosure Document will depend directly upon the adequacy of the disclosure. It is strongly recommended that the document contain a clear and complete explanation of the manner and process of making and using the invention in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and

use the invention. When the nature of the invention permits, a drawing or sketch should be included. The use or utility of the invention should be described, especially in chemical inventions. Where the invention is directed to a design, the appearance presented by the object should be described.

III. PREPARATION OF THE DOCUMENT

A standard format for the Disclosure Document is required to facilitate the USPTO's electronic data capture and storage. The Disclosure Document (including drawings or sketches) must be on white letter-size (8 1/2 by 11-inch) or A4 (21.0 by 29.7 cm) paper, written on one side only, with each page numbered. Text and drawings must be sufficiently dark to permit reproduction with commonly used office copying machines. Oversized papers, even if foldable to the above dimensions, will not be accepted. Attachments such as videotapes and working models will not be accepted and will be returned.

IV. OTHER ENCLOSURES

The Disclosure Document must be accompanied by a separate cover letter signed by the inventor stating that he or she is the inventor and requesting that the material be received under the Disclosure Document Program. The inventor's request may take the following form:

The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years.

A Disclosure Document Deposit Request form (PTO/SB/95) can also be used as a cover letter. This form is available at the USPTO's Internet site or by calling the USPTO **>Contact Center< (see MPEP § 1730).

A notice with an identifying number and date of receipt in the USPTO will be mailed to the customer, indicating that the Disclosure Document may be relied upon only as evidence of conception and that a patent application should be diligently filed if patent protection is desired. The USPTO prefers that applicants send two copies of the cover letter or Disclosure Document Deposit Request form and one copy of the Disclosure Document, along with a self-addressed stamped envelope. The second copy of the cover letter or form will be returned with the notice. It

is not necessary to submit more than one copy of the document in order for it to be accepted under the Disclosure Document Program.

V. DISPOSITION

The Disclosure Document will be preserved by the USPTO for two years after its receipt. It will then be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-year period. The separate letter filed in the related patent application must identify not only the patent application, but also the Disclosure Document by its title, number, and date of receipt in the USPTO. Acknowledgment of such letters will be made in the next official communication or in a separate letter from the USPTO.

VI. ACKNOWLEDGMENT

When a paper referring to a Disclosure Document is filed in a patent application within 2 years after the filing of a Disclosure Document, the examining Technology Center (TC) technical support staff member will prepare either (1) a memorandum indicating that a reference to Disclosure Document No. -- has been made in Patent Application No. --, or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the Customer Contact Team of the Office of Initial Patent Examination (OIPE).

Upon receipt, the Customer Service Branch of the OIPE prepares a retention label (PTO-150) and attaches it to the Disclosure Document, and indicates such on the forwarded memo or copy, and returns the memo or copy to the TC. The returned memo or copy is stapled to the inside left flap of the file wrapper if the application is maintained in a paper file, or added to the Image File Wrapper (IFW) if the application is an IFW application, so that the examiner's attention is directed to it when the next Office action is prepared. If prosecution before the examiner has been concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the examining TC technical support staff member.

After the acknowledging letter is mailed, the paper number of the acknowledgment is noted in the application file. The returned memo or copy is retained

with the original paper referring to the Disclosure Document in the file wrapper.

VII. FEE

A fee of \$10, as set forth in 37 CFR 1.21(c), in the form of a check or money order made payable to "Commissioner for Patents" must accompany the Disclosure Document when it is submitted to the USPTO. Documents not accompanied by the full fee will be returned. Mail the Disclosure Document along with the fee to:

Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants can request a copy of their Disclosure Document as filed in the USPTO if they are the original submitters of the document. The request must be made in writing and accompanied by a fee for \$25.

Fees are subject to change annually. To confirm current fees, contact the **>USPTO Contact Center< or visit the USPTO's Internet site (see MPEP § 1730).

VIII. NOTICE TO INVENTORS

The two-year retention period is not a "grace period" during which the inventor can wait to file his or her patent application without possible loss of benefits. As explained above, it may be advisable to file a provisional application instead of a Disclosure Document. It must be recognized that, in order to establish priority of invention, an affidavit or testimony referring to a Disclosure Document must usually also establish diligence in completing the invention or in filing the patent application after the filing of the Disclosure Document.

Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a U.S. patent on it. See 35 U.S.C. 102(b). Foreign patent laws in this regard may be much more restrictive than U.S. laws.

The USPTO advises inventors who are not familiar with the requirements of U.S. patent law and procedures to consult an attorney or agent registered to practice before the USPTO. A list of *Attorneys and*

