

# Chapter 700 Examination of Applications

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## 701 Statutory Authority for Examination

### 35 U.S.C. 131. Examination of application.

The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102 and 103.

### 35 U.S.C. 101. Inventions patentable.

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

Form Paragraph 7.04 copies 35 U.S.C. 101.

### 35 U.S.C. 100. Definitions.

When used in this title unless the context otherwise indicates —

- (a) The term “invention” means invention or discovery.
- (b) The term “ process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.
- (c) The terms “United States” and “this country” mean the United States of America, its territories and possessions.
- (d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

## 702 Requisites of the Application

When a new application is assigned in the examining group, the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111(a). Any matters affecting the

filing date or abandonment of the application, such as lack of an oath or declaration, filing fee, or claims should be checked before the application is placed in the storage racks to await the first action.

The examiner should be careful to see that the application meets all the requisites set forth in MPEP Chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

### 702.01 Obviously Informal Cases

When an application is reached for its first Office action and it is then discovered to be impractical to give a complete action on the merits because of an informal or insufficient disclosure, the following procedure may be followed:

(A) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention and claims and any apparently pertinent art cited. In the rare case in which the disclosure is so incomprehensible as to preclude a reasonable search the Office action should clearly inform applicant that no search was made;

(B) Informalities noted by the Office of Initial Patent Examination (OIPE) and deficiencies in the drawing should be pointed out by means of attachments to the Office action (see MPEP § 707.07(a));

(C) A requirement should be made that the specification be revised to conform to idiomatic English and United States practice;

(D) The claims should be rejected as failing to define the invention in the manner required by 35 U.S.C. 112 if they are informal. A blanket rejection is usually sufficient.

The examiner should attempt to point out the points of informality in the specification and claims. The burden is on the applicant to revise the application to render it in proper form for a complete examination.

If a number of obviously informal claims are filed in an application, such claims should be treated as being a single claim for fee and examination purposes.

It is obviously to applicant's advantage to *file* the application with an adequate disclosure and with claims which conform to the U.S. Patent and Trademark Office usages and requirements. This should be done whenever possible. If, however, due to the pressure of a Convention deadline or other reasons, this is not possible, applicants are urged to submit *promptly, preferably within 3 months after filing*, a preliminary amendment which corrects the obvious informalities. The informalities should be corrected to the extent that the disclosure is readily understood and the claims to be initially examined are in proper form, particularly as to

dependency, and otherwise clearly define the invention. “New matter” must be excluded from these amendments since preliminary amendments do not enjoy original disclosure status. See MPEP § 608.04(b).

Whenever, upon examination, it is found that the terms or phrases or modes of characterization used to describe the invention are not sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected, to enable the examiner to make the examination specified in 37 CFR 1.104, the examiner should make a reasonable search of the invention so far as it can be understood from the disclosure. The action of the examiner may be limited to a citation of what appears to be the most pertinent prior art found and a request that applicant correlate the terminology of the specification with art-accepted terminology before further action is made.

Use form paragraph 7.01 where the terminology is such that a proper search cannot be made.

#### ¶ 7.01 Use of Terminology, Cannot Be Examined

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

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

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

#### Examiner Note:

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

Use form paragraph 7.02 where the application is so incomprehensible that a reasonable search cannot be made.

#### ¶ 7.02 Disclosure Is Incomprehensible

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

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

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

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

#### Examiner Note:

1. Use this paragraph when a search cannot be made.

2. In bracket 1, indicate the page numbers and features which are not understood.
3. See form paragraphs 6.28 and 6.30 for improper idiomatic English.

Use form paragraph 7.03 where the invention cannot be understood because of illegible handwritten pages.

#### ¶ 7.03 Pages Are Illegible

The examiner cannot understand the invention because certain portions of the disclosure are illegible. The illegible portion(s) consist of [1].

Applicant is required to submit an appropriate amendment rectifying this deficiency. In the alternative, a substitute specification under 37 CFR 1.125(b), may be filed. The substitute specification must be accompanied by: (1) a statement that the substitute specification contains no new matter; and (2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

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

#### Examiner Note:

1. In bracket 1, identify the portions of the specification which are illegible.
2. This form paragraph is to be used only when the invention cannot be understood because of the illegible material, see MPEP § 702.01.
3. See Chapter 1700 for handwritten specifications filed by pro se applicants.
4. Use form paragraph 7.02 when the disclosure is incomprehensible.

For the procedure to be followed when only the drawing is informal, see MPEP § 608.02(a) and § 608.02(b).

## 703 “General Information Concerning Patents”

The pamphlet “General Information Concerning Patents” for use by applicants contemplating the filing or prosecution of their own applications, may be purchased from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. The pamphlet is also available from the PTO Web page at: <http://www.uspto.gov>.

## 704 Search [R-1]

After reading the specification and claims, the examiner searches the prior art. The subject of searching is more fully treated in MPEP Chapter 900. See especially MPEP § 904 through § 904.03. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution.

### PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear

error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See MPEP § 719.05.

## 705 Patentability Reports

Where an application, properly assigned to one examining group, is found to contain one or more claims, *per se*, classifiable in one or more other groups, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups concerned for a report as to the patentability of certain designated claims. This report is known as a Patentability Report (P.R.) and is signed by the primary examiner in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is only to be used in extraordinary circumstances. See MPEP § 705.01(e).

### 705.01 Instructions re Patentability Reports

When an application comes up for any action and the primary examiners involved (i.e., from both the requesting and the requested group) agree that a Patentability Report is necessary, and if the Group Director of the requesting group approves, the application is forwarded to the proper group with a memorandum attached, for instance, "For Patentability Report from group -- as to claims --."

#### 705.01(a) Nature of P.R., Its Use and Disposal

The primary examiner in the group from which the Patentability Report is requested, if he or she approves the request, will direct the preparation of the Patentability Report. This Patentability Report is written or typed on a memorandum form and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. When an examiner to whom an application has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he or she should so state. The Patentability Report when signed by the primary examiner in the reporting group will be returned to the group to which the application is regularly assigned and placed in the file wrapper.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the

examiner to whom the case is assigned to avoid duplication of work.

If the primary examiner in a reporting group is of the opinion that a Patentability Report is not in order, he or she should so advise the primary examiner in the forwarding group.

### DISAGREEMENT AS TO CLASSIFICATION

Conflict of opinion as to classification may be referred to a patent classifier for decision.

If the primary examiner in the group having jurisdiction of the application agrees with the Patentability Report, he or she should incorporate the substance thereof in his or her action, which action will be complete as to *all* claims. The Patentability Report in such a case is *not* given a paper number but is allowed to remain in the file until the application is finally disposed of by allowance or abandonment, at which time it should be removed.

### DISAGREEMENT ON PATENTABILITY REPORT

If the primary examiner does not agree with the Patentability Report or any portion thereof, he or she may consult with the primary examiner responsible for the report. If agreement as to the resulting action cannot be reached, the primary examiner having jurisdiction of the case need not rely on the Patentability Report but may make his or her own action on the referred claims, in which case the Patentability Report should be removed from the file.

### APPEAL TAKEN

When an appeal is taken from the rejection of claims, all of which are examinable in the group preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the application to said group should be made for the purpose of appeal only. The receiving group will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said group with its classification determined by the controlling claims remaining in the case.

#### 705.01(b) Sequence of Examination

In the event that the supervisory patent examiners concerned in a P.R. case cannot agree as to the order of examination by their groups, the supervisory patent examiner having jurisdiction of the application will direct that a complete search be made of the art relevant to his or her claims prior to referring the application to another group for report. The group to which the application is referred will be advised of the results of this search.

If the supervisory patent examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

### **705.01(c) Counting and Recording P.R.'s**

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding group. When the P.R. is completed and the application is ready for return to the forwarding group, it is not counted either as a receipt or action by transfer. Credit, however, is given for the time spent.

The date status of the application in the reporting group will be determined on the basis of the dates in the group of original jurisdiction. To ensure orderly progress in the reported dates, a timely reminder should be furnished to the group making the P.R.

### **705.01(d) Duplicate Prints of Drawings**

In Patentability Report applications having drawings, the examiner to whom the case is assigned will furnish to the group to which the application is referred, prints of such sheets of the drawings as are applicable, for interference search purposes. That this has been done may be indicated by a pencil notation on the file wrapper.

When an application that has had Patentability Report prosecution is passed for issue or becomes abandoned, NOTIFICATION of this fact will AT ONCE be given by the group having jurisdiction of the application to each group that submitted a Patentability Report. The examiner of each such reporting group will note the date of allowance or abandonment on the duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

### **705.01(e) Limitation as to Use**

The above outlined Patentability Report practice is not obligatory and should be resorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ in scope only, prosecution by Patentability Report is never proper.

Exemplary situation where Patentability Reports are ordinarily not proper are as follows:

(A) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(B) Where the claims are related as product and a process which involves merely the fact that a product having certain characteristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(C) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination, *per se*. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.

Where it can be shown that a Patentability Report will save total examiner time, one is permitted with the approval of the Group Director of the group to which the application is assigned. The "Approved" stamp should be impressed on the memorandum requesting the Patentability Report.

### **705.01(f) Interviews With Applicants**

In situations where an interview is held on an application in which a Patentability Report has been adopted, the reporting group may be called on for assistance at the interview when it concerns claims treated by them. See MPEP § 713 to § 713.10 regarding interviews in general.

## **706 Rejection of Claims**

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. The examiner then reviews all the evidence, including arguments and evidence responsive to any rejection before issuing the next Office action.

Although this part of the Manual explains the procedure in rejecting claims, the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention.

*37 CFR 1.104. Nature of examination.*

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(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

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**UNIFORM APPLICATION OF THE PATENTABILITY STANDARD**

The standards of patentability applied in the examination of claims must be the same throughout the Office. In every art, whether it be considered “complex,” “newly developed,” “crowded,” or “competitive,” all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and 103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a “picture” claim) is never, in itself, justification for the allowance of such a claim.

An application should not be allowed, unless and until issues pertinent to patentability have been raised and resolved in the course of examination and prosecution,

since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it “strictly adhere” to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. The standard to be applied in all cases is the “preponderance of the evidence” test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.

**DEFECTS IN FORM OR OMISSION OF A LIMITATION; CLAIMS OTHERWISE ALLOWABLE**

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

**PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED**

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

**RECONSIDERATION OF CLAIMS AFTER REPLY BY APPLICANT**

*37 CFR 1.112. Reconsideration before final action.*

After reply by applicant or patent owner (§ 1.111) to a non-final action, the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111, with or without amendment, unless such Office action indicates that it is made final (§ 1.113).

37 CFR 1.112 provides for the reconsideration and continued examination of an application or a patent under reexamination after reply by the applicant or the patent owner. If claims are rejected, or objections or requirements made, applicant or patent owner will be notified in the same manner as after the first examination. Applicant or patent owner may reply to such Office action in the same manner provided in 37 CFR 1.111, with or without amendment, unless such Office action indicates that it is made final (37 CFR 1.113).

## REJECTIONS IN STATUTORY INVENTION REGISTRATIONS

See MPEP Chapter 1100 for rejection of claims in an application for a Statutory Invention Registration.

### 706.01 Contrasted With Objections

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's action. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See MPEP § 608.01(n). The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner.

Similarly, the Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board. These formal matters should not be combined in appeals to the Board.

### 706.02 Rejection on Prior Art [R-1]

*35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent.*

A person shall be entitled to a patent unless -

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

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

(c) he has abandoned the invention, or

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

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

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

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(g)(1)during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the

invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

*35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.*

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

(b)(1)Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154

(3) For purposes of paragraph (1), the term 'biotechnological process' means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c) Subject matter developed by another person, which qualifies as prior art only under \*\*>one or more of subsections (e), (f), and (g)< of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed subject matter is either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See MPEP § 707.07(d).

**CHOICE OF PRIOR ART; BEST AVAILABLE**

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

(A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;

(B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or

(C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

See also MPEP § 707.05.

**REEXAMINATION**

For scope of rejections in reexamination proceedings see MPEP § 2258.

**DISTINCTION BETWEEN 35 U.S.C. 102 AND 103**

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP § 2131 - § 2146 for guidance on patentability determinations under 35 U.S.C. 102 and 103.

**DETERMINING THE EFFECTIVE FILING DATE OF THE APPLICATION**

The effective filing date of a U.S. application may be determined as follows:

(A) If the application is a continuation or divisional of one or more earlier U.S. applications and if the requirements of 35 U.S.C. 120 have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications.

(B) If the application is a continuation-in-part of an earlier U.S. application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully

supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.

(C) If the application claims foreign priority under 35 U.S.C. 119(a)-(d), the effective filing date is the filing date of the U.S. application, unless situation \*(A) or (B)< as set forth above applies. The filing date of the foreign priority document is not the effective filing date, although the filing date of the foreign priority document may be used to overcome certain references. See MPEP § 706.02(b) and § 2136.05.

(D) If the application is entitled to priority under 35 U.S.C. 119(e) from a provisional application, the effective filing date is the filing date of the provisional application.

See MPEP § 1893.03(b) for determining the effective filing date of an application filed under 35 U.S.C. 371. See MPEP § 201.11(a) and § 1895 for determining the effective filing date of a continuation, divisional, or continuation-in-part of a PCT application designating the U.S. See also MPEP § 1895.01 and § 1896 which discuss differences between applications filed under 35 U.S.C. 111(a) and 35 U.S.C. 371.

**706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent [R-1]**

Once the examiner conducts a search and finds a printed publication or patent which discloses the claimed invention, the examiner should determine whether the rejection should be made under 35 U.S.C. 102(a), (b), or (e).

In order to determine which section of 35 U.S.C. 102 applies, the effective filing date of the application must be determined and compared with the date of the reference. See MPEP § 706.02 regarding determination of effective filing date of the application.

**DETERMINING THE REFERENCE ISSUE OR PUBLICATION DATE**

The examiner must also determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made. Where the last day of the year dated from the date of publication falls on a Saturday, Sunday or Federal holiday, the publication is not a statutory bar under 35 U.S.C. 102(b) if the application was filed on the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960) (The Board in *Olah* held that 35 U.S.C. 21(b) is applicable to the filing of an original application for patent and that applicant's own activity will not bar a patent if the 1-year grace period expires on a Saturday, Sunday, or Federal holiday

and the application's U.S. filing date is the next succeeding business day.) Despite changes to 37 CFR 1.6(a)(2) and 1.10 which permit the PTO to accord a filing date to an application as of the date of deposit as "Express Mail" with the U.S. Postal Service in accordance with 37 CFR 1.10 (e.g., a Saturday filing date), the rule changes do not affect applicant's concurrent right to defer the filing of an application until the next business day when the last day for "taking any action" falls on a Saturday, Sunday, or Federal holiday (e.g., the last day of the 1-year grace period falls on a Saturday). It should also be noted that a magazine is effective as a printed publication under 35 U.S.C. 102(b) as of the date it reached the addressee and not the date it was placed in the mail. *Protein Foundation Inc. v. Brenner*, 260 F. Supp. 519, 151 USPQ 561 (D.D.C. 1966). See MPEP § 707.05(f). For foreign patents see MPEP § 901.05. See MPEP § 2124, § 2126, and § 2128 - § 2128.02 for case law relevant to reference date determination.

#### **DETERMINING WHETHER TO APPLY 35 U.S.C. 102(a), (b), or (e)**

First, the examiner should consider whether the reference qualifies as prior art under 35 U.S.C. 102(b) because this section results in a statutory bar to obtaining a patent. If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b).

If the publication or issue date of the reference is too recent for 35 U.S.C. 102(b) to apply, then the examiner should consider 35 U.S.C. 102(e). For 35 U.S.C. 102(e) to apply:

(A) The reference must be a U.S. Patent >(or SIR)< with a filing date earlier than the effective filing date of the application. >See MPEP § 2136.03.< Note that, for purposes of 35 U.S.C. 102(e), the filing date of the reference patent which has issued on an application entitled to priority from a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application, except for a patent granted on an international application (PCT) in which applicant has fulfilled the requirements of paragraphs (1), (2) and (4) of 35 U.S.C. 371. The filing date of a patent granted on such a 35 U.S.C. 371 application is the date on which paragraphs (1), (2) and (4) of 35 U.S.C. 371 have been fulfilled; and

(B) The inventive entity of the application must be different than that of the reference. Note that, where there are joint inventors, only one inventor need be different for the inventive entities to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some common inventors.

If 35 U.S.C. 102(e) does not apply, then the examiner should consider 35 U.S.C. 102(a). For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work.

#### **706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-1]**

A rejection based on 35 U.S.C. 102(b) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art; \*

(B) Amending the claims to patentably distinguish over the prior art >;or

(C) Perfecting priority under 35 U.S.C. 119(e) or 120 by amending the specification of the application to contain a specific reference to a prior application in accordance with 37 CFR 1.78(a).<

A rejection based on 35 U.S.C. 102(e) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent (or application in the case of a provisional rejection) claiming the same patentable invention as defined in 37 CFR 1.601(n). See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d). The foreign priority filing date must antedate

the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph; or

(F) Perfecting priority under 35 U.S.C. 119(e) >or 120< by amending the specification of the application to contain a specific reference to a \*>prior< application in accordance with 37 CFR \*>1.78(a)<.

A rejection based on 35 U.S.C. 102(a) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.131. See MPEP § 715 for information on the requirements of 37 CFR 1.131 affidavits.

(D) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by “another.” See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) as explained in reference to 35 U.S.C. 102(e) above;

(F) Perfecting priority under 35 U.S.C. 119(e) >or 120< by amending the specification of the application to contain a specific reference to a \*>prior< application in accordance with 37 CFR \*>1.78(a)<.

### **706.02(c) Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale**

An applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was sold by applicant or known by others in this country. The language “in this country” means in the United States only and does not include other WTO or NAFTA member countries. In these cases the examiner must determine if 35 U.S.C. 102(a) or 102(b) applies. See MPEP § 2133.03 for a discussion of case law treating the “public use” and “on sale” statutory bars.

If the activity is by an entity other than the inventors or assignee, such as sale by another, manufacture by another or disclosure of the invention by applicant to another then both 35 U.S.C. 102(a) and (b) may be applicable. If the

evidence only points to knowledge within the year prior to the effective filing date then 35 U.S.C. 102(a) applies. However, no rejection under 35 U.S.C. 102(a) should be made if there is evidence that applicant made the invention and only disclosed it to others within the year prior to the effective filing date.

35 U.S.C. 102(b) is applicable if the activity occurred more than 1 year prior to the effective filing date of the application. See MPEP § 2133.03 for a discussion of “on sale” and “public use” bars under 35 U.S.C. 102(b).

Note that as an aid to resolving public use or on sale issues, as well as to other related matters of 35 U.S.C. 102(b) activity, an applicant may be required to answer specific questions posed by the examiner and to explain or supplement any evidence of record. See 35 U.S.C. 132, 37 CFR 1.104(a)(2). Information sought should be restricted to that which is reasonably necessary for the examiner to render a decision on patentability.

A 1- or 2-month time period should be set by the examiner for any reply to the requirement, unless the requirement is part of an Office action having a shortened statutory period, in which case the period for reply to the Office action will also apply to the requirement. If applicant fails to reply in a timely fashion to a requirement for information, the application will be regarded as abandoned. 35 U.S.C. 133. See MPEP § 2133.03.

If there is not enough information on which to base a public use or on sale rejection, the examiner should make a requirement for more information. Form paragraph 7.104 can be used.

#### *¶ 7.104 Requirement for Information, Public Use or Sale*

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

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

#### **Examiner Note:**

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

### **706.02(d) Rejections Under 35 U.S.C. 102(c)**

Under 35 U.S.C. 102(c), abandonment of the “invention” (as distinguished from abandonment of an application) results in loss of right to a patent. See MPEP § 2134 for case law which sets forth the criteria for abandonment under 35 U.S.C. 102(c).

**706.02(e) Rejections Under 35 U.S.C. 102(d)**

35 U.S.C. 102(d) establishes four conditions which, if all are present, establish a statutory bar against the granting of a patent in this country:

(A) The foreign application must be filed more than 12 months before the effective filing date of the United States application. See MPEP § 706.02 regarding determination of the effective filing date of the application.

(B) The foreign and United States applications must be filed by the same applicant, his or her legal representatives or assigns.

(C) The foreign application must have actually issued as a patent or inventor's certificate (e.g., granted by sealing of the papers in Great Britain) before the filing in the United States. It need not be published but the patent rights granted must be enforceable.

(D) The same invention must be involved.

If such a foreign patent or inventor's certificate is discovered by the examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of statutory bar.

See MPEP § 2135.01 for case law which further clarifies each of the four requirements of 35 U.S.C. 102(d).

**SEARCHING FOR 35 U.S.C. 102(d) PRIOR ART**

The examiner should only undertake a search for an issued foreign patent for use as 35 U.S.C. 102(d) prior art if there is a reasonable possibility that a foreign patent covering the same subject matter as the U.S. application has been granted to the same inventive entity before the U.S. effective filing date, i.e., the time period between foreign and U.S. filings is greater than the usual time it takes for a patent to issue in the foreign country. Normally, the probability of the inventor's foreign patent issuing before the U.S. filing date is so slight as to make such a search unproductive. However, it should be kept in mind that the average pendency varies greatly between foreign countries. In Belgium, for instance, a patent may be granted in just a month after its filing, while in Japan the patent may not issue for a decade.

The search for a granted patent can be accomplished on an electronic database either by the examiner or by the staff of the Scientific and Technical Information Center. See MPEP § 901.06(a), paragraph IV.B., for more information on online searching. The document must be a patent or inventor's certificate and not merely a published or laid open application.

**706.02(f) Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application**

If a copending U.S. patent application discloses subject matter which would anticipate the claims in another pending U.S. application which has a different inventive entity, the examiner should determine whether a provisional 35 U.S.C. 102(e) rejection can be made.

**I. COPENDING U.S. APPLICATIONS HAVING AT LEAST ONE COMMON INVENTOR OR ARE COMMONLY ASSIGNED**

If (1) at least one common inventor exists between the applications or the applications are commonly assigned and (2) the effective filing dates are different, then a provisional rejection of the later filed application should be made. The provisional rejection is appropriate because if the earlier filed application becomes a patent it would constitute actual prior art under 35 U.S.C. 102. Since neither application is published at the time of the provisional rejection, the rejection must be made under 35 U.S.C. 102(e).

A provisional rejection under 35 U.S.C. 102(e) can be overcome in the same manner that a 35 U.S.C. 102(e) rejection can be overcome. See MPEP § 706.02(b). The provisional rejection can also be overcome by abandoning the applications and filing a new application containing the subject matter of both.

Form paragraph 7.15.01 should be used when making a provisional rejection under 35 U.S.C. 102(e).

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

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

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

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

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

**Examiner Note:**

1. This paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
2. If the claims are obvious over the invention disclosed in the other copending application, use paragraph 7.21.01.

3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.
5. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using paragraphs 8.30 and 8.32.
6. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using paragraphs 7.13 and/or 7.14 should also be made.

## II. COPENDING APPLICATIONS HAVING NO COMMON INVENTOR OR ASSIGNEE

If there is no common assignee or common inventor, the confidential status of applications under 35 U.S.C. 122 must be maintained and no rejection can be made relying on the earlier filed application as prior art under 35 U.S.C. 102(e). If the filing dates of the applications are within 6 months of each other (3 months for simple subject matter) then interference may be proper. See MPEP Chapter 2300. Otherwise, the application with the earliest effective U.S. filing date must be allowed to issue. After the allowed application is published, it can be used as a reference in a rejection under 35 U.S.C. 102(e) in the still pending application.

### 706.02(g) Rejections Under 35 U.S.C. 102(f)

35 U.S.C. 102(f) bars the issuance of a patent where an applicant did not invent the subject matter being claimed and sought to be patented. See also, 35 U.S.C. 101, which requires that whoever invents or discovers is the party who may obtain a patent for the particular invention or discovery. The examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and that applicant derived the invention from the true inventor.

See MPEP § 2137 - § 2137.02 for more information on the substantive requirements of rejections under 35 U.S.C. 102(f).

### 706.02(h) Rejections Under 35 U.S.C. 102(g) [R-1]

35 U.S.C. 102(g) bars the issuance of a patent where another made the invention in the United States before applicant and had not abandoned, suppressed, or concealed it. This section of 35 U.S.C. 102 forms a basis for interference practice. See MPEP Chapter 2300 for more information on interference procedure. See MPEP § 2138 - § 2138.06 for more information on the requirements of 35 U.S.C. 102(g).

### 706.02(i) Form Paragraphs for Use in Rejections Under 35 U.S.C. 102 [R-1]

The following form paragraphs should be used in making the appropriate rejections.

Note that the particular part of the reference relied upon to support the rejection should be identified.

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

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

A person shall be entitled to a patent unless --

#### **Examiner Note:**

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Paragraphs 7.07 to 7.14 are to be used ONLY ONCE in a given Office action.

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

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

#### **Examiner Note:**

This paragraph must be preceded by paragraph 7.07.

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

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

#### **Examiner Note:**

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

#### ¶ 7.10 *102(c), Invention Abandoned*

(c) he has abandoned the invention.

#### **Examiner Note:**

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

#### ¶ 7.11 *102(d), Foreign Patenting*

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

#### **Examiner Note:**

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

#### ¶ 7.12 *102(e), Patent to Another with Earlier Filing Date*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4)

of section 371(c) of this title before the invention thereof by the applicant for patent.

**Examiner Note:**

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

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

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

**Examiner Note:**

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

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

\*\*>

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

**Examiner Note:**

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

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

Claim [1] rejected under 35 U.S.C. 102([2]) as being [3] by [4].

**Examiner Note:**

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

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

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

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

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

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

**Examiner Note:**

1. This paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
2. If the claims are obvious over the invention disclosed in the other copending application, use paragraph 7.21.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.
5. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using paragraphs 8.30 and 8.32.
6. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using paragraphs 7.13 and/or 7.14 should also be made.

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

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

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

**Examiner Note:**

1. This paragraph is used to reject over a patent with an earlier filing date that discloses but does not claim the same invention. The patent must have either a common assignee or a common inventor.
2. In bracket 3, insert either --assignee-- or --inventor--.

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

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

**Examiner Note:**

1. This paragraph is used to reject over a patent with an earlier filing date that discloses but does not claim the same invention. The patent must have neither a common assignee nor a common inventor.
2. In bracket 2, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 3, insert the prior art relied upon.

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

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

**Examiner Note:**

1. This paragraph must be preceded either by paragraphs 7.07 and 7.09 or by paragraph 7.103.
2. A full explanation of the evidence establishing a public use or sale must be provided in bracket 2.

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

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

**Examiner Note:**

1. This paragraph must be preceded either by paragraph 7.07 and 7.10 or by paragraph 7.103.
2. In bracket 2, insert a full explanation of the evidence establishing abandonment of the invention. See MPEP § 2134.

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

Claim [1] rejected under 35 U.S.C. 102(d) as being barred by applicant's [2].

[3]

**Examiner Note:**

1. This paragraph must be preceded either by paragraphs 7.07 and 7.11 or by paragraph 7.103.
2. In bracket 3, insert an explanation of this rejection which must include appropriate dates and how they make the foreign patent available under 35 U.S.C. 102(d).
3. Refer to MPEP § 2135 for applicable 35 U.S.C. 102(d) prior art.

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

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

**Examiner Note:**

1. This paragraph must be preceded either by paragraphs 7.07 and 7.13 or by paragraph 7.103.
2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See MPEP § 2137.

### 706.02(j) Contents of a 35 U.S.C. 103 Rejection [R-1]

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) >- § 706.02(l)(3)< for a discussion of >prior art disqualified under< 35 U.S.C. 103(c).

### 706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103 [R-1]

>Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution

applications filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination of such an application. See MPEP § 706.02(l)(1) for additional information regarding disqualified prior art under 35 U.S.C. 102(e)/103.<

Where two applications of different inventive entities are copending and the filing dates differ, a provisional rejection under 35 U.S.C. 102(e)/103 should be made in the later filed application if the applications have a common assignee or a common inventor. >, unless the later application was filed on or after November 29, 1999 and the applications were commonly owned or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(3) for examination procedure with respect to 35 U.S.C. 103(c).< Otherwise the confidential status of applications under 35 U.S.C. 122 must be maintained. Such a rejection alerts the applicant that he or she can expect an actual rejection on the same ground if one of the applications issues and also lets applicant know that action must be taken to avoid the rejection.

This gives applicant the opportunity to analyze the propriety of the rejection and possibly avoid the loss of rights to desired subject matter. Provisional rejections of the obviousness type under 35 U.S.C. 102(e)/103 are rejections applied to copending applications having different effective filing dates wherein each application has a common assignee or a common inventor. The earlier filed application, if patented, would constitute prior art under 35 U.S.C. 102(e). The rejection can be overcome by:

(A) Arguing patentability over the earlier filed application;

(B) Combining the subject matter of the copending applications into a single application claiming benefit under 35 U.S.C. 120 of the prior applications and abandoning the copending applications (Note that a claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C.

120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiosgesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997).);

(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that any unclaimed invention disclosed in the copending application was derived from the inventor of the other application and is thus not invention “by another” (see MPEP § 715.01(a), § 715.01(c), and § 716.10); \*

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing a date of invention prior to the effective U.S. filing date of the copending application. See MPEP § 715>; or

(E) Filing a continuation application on or after November 29, 1999, and showing that the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.<

Where the applications are claiming the same patentable invention, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103 in a common ownership situation if the earlier filed application has matured into a patent. See MPEP § 718.

If a provisional rejection is made and the copending applications are combined into a single application and the resulting single application is subject to a restriction requirement, the divisional application would not be subject to a provisional or actual rejection under 35 U.S.C. 102(e)/103 since the provisions of 35 U.S.C. 121 preclude the use of a patent issuing therefrom as a reference against the other application. Additionally, the resulting continuation-in-part is entitled to 35 U.S.C. 120 benefit of each of the prior applications. This is illustrated in Example 2, below.

The following examples are instructive as to the application of 35 U.S.C. 102(e)/103 >in applications filed prior to November 29, 1999<:

**Example 1.** Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1.A invents X and later files application.	This is permissible.
2.B modifies X to XY. B files application before A's filing>.<	No 35 U.S.C. 102(f)/103 or 102(g)/103 rejection; provisional 35 U.S.C. 102(e)/103 rejection applies. Provisional double patenting rejection made.
3.B's patent issues.	A's claims rejected under 35 U.S.C. 102(e)/103 and double patenting.
4.A files 37 CFR 1.130 affidavit to disqualify B's patent as prior art where the same patentable invention is being claimed. Terminal disclaimer filed under 37 CFR 1.321(c).	Rejection under 35 U.S.C. 102(e)/103 may be overcome and double patenting rejection may be overcome if inventions X and XY are commonly owned and all requirements of 37 CFR 1.130 and 1.321 are met.

In situation (2.) above, the result is a provisional rejection by the examiner under 35 U.S.C. 102(e)/103. The rejection is provisional since the subject matter and the prior art are pending applications.

**Example 2.** Assumption: Employees A and B work for C, each with knowledge of the other's work, and with obligation to assign inventions to C while employed.

SITUATIONS	RESULTS
1.A invents X and files application.	This is permissible.
2.B modifies X to XY after A's application is filed. B files application establishing that A and B were both under obligation to assign inventions to C at the time the inventions were made.	Provisional 35 U.S.C. 102(e)/103 rejection made; provisional double patenting rejection made; no 35 U.S.C. 102(f)/103 or 102(g)/103 rejection made.
3.A and B file continuing application claiming priority to their earlier applications and abandon the earlier applications.	Assume it is proper that restriction be required between X and XY.
4.X is elected and patent issues on X with divisional application being timely filed on XY.	No rejection of divisional application under 35 U.S.C. 102(e)/103 in view of 35 U.S.C. 121.

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#### **EXAMINATION OF CONTINUING APPLICATION COMMONLY OWNED WITH ABANDONED PARENT APPLICATION TO WHICH BENEFIT IS CLAIMED UNDER 35 U.S.C. 120**

An application claiming the benefit of a prior filed copending national or international application under 35 U.S.C. 120 must name as an inventor at least one inventor named in the prior filed application. The prior filed application must also disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C.

112. This practice contrasts with the practice in effect prior to November 8, 1984 (the date of enactment of Public Law 98-622) where the inventorship entity in each of the applications was required to be the same for benefit under 35 U.S.C. 120.

So long as the applications have at least one inventor in common and the other requirements are met, the Office will permit a claim for 35 U.S.C. 120 benefit without any additional submissions or notifications from applicants regarding inventorship differences.

In addition to the normal examination conducted by the examiner, he or she must examine the earlier filed application to determine if the earlier and later applications have at

least one inventor in common and that the other 35 U.S.C. 120 requirements are met. The claim for 35 U.S.C. 120 benefit will be permitted without examination of the earlier application for disclosure and support of at least one claim of the later filed application under 35 U.S.C. 112, first paragraph unless it becomes necessary to do so, for example, because of an intervening reference.

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**706.02(I) Rejections Under 35 U.S.C. 102(f)/103 and 35 U.S.C. 102(g)/103; 35 U.S.C. 103(c) [R-1]**

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*35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.*

\*\*\*\*\*

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person

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Prior to November 29, 1999, 35 U.S.C. 103(c) provided< that subject matter developed by another which qualifies as “prior art” only under subsections 35 U.S.C. 102(f) or 35 U.S.C. 102(g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. \*\*>See MPEP § 706.02(1)(1) for information regarding when prior art under 35 U.S.C. 102(e)/ 103 is disqualified under 35 U.S.C. 103(c).

For applications filed prior to November 29, 1999, the< subject matter that is disqualified as prior art under 35 U.S.C. 103 is strictly limited to subject matter that A) qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and B) was commonly owned with the claimed invention at the time the invention was made. If the subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) was not commonly owned at the time of the invention, the subject matter is not disqualified as prior art under 35 U.S.C. 103. See *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04, 43 USPQ2d 1641, 1646 (Fed. Cir. 1997) (“We therefore hold that subject matter derived from another not only is itself unpatentable to the party who derived it under § 102(f), but, when combined with other prior art, may make a resulting obvious invention unpatentable to that party under a combination of §§ 102(f) and 103.”) If the subject matter qualifies as prior art under any other subsection (e.g., subsection

35 U.S.C. 102(a), 35 U.S.C. 102(b), or 35 U.S.C. 102(e)) it will not be disqualified as prior art under 35 U.S.C. 103(c).

It is important to recognize that 35 U.S.C. 103(c) applies only to consideration of prior art for purposes of obviousness under 35 U.S.C. 103. It does not apply to or affect subject matter which qualifies as prior art under 35 U.S.C. 102. A patent applicant urging that subject matter is disqualified has the burden of establishing that it was commonly owned at the time the claimed invention was made. Absent proper evidence of common ownership at the time the later invention was made, the appropriate rejection under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) as it applies through 35 U.S.C. 103 should be made. >See MPEP § 706.02(1)(2) for information pertaining to establishing common ownership.<

Information learned from or transmitted to persons outside the organization is not disqualified as prior art. The term “subject matter” will be construed broadly, in the same manner the term is construed in the remainder of 35 U.S.C. 103. The term “another” as used in 35 U.S.C. 103 means any inventive entity other than the inventor and would include the inventor and any other persons. The term “developed” is to be read broadly and is not limited by the manner in which the development occurred. The term “commonly owned” means wholly owned by the same person, persons, or organization at the time the invention was made. >See MPEP § 706.02(1)(2) .<

Inventors of subject matter not commonly owned at the time of the invention, but currently commonly owned, may file as joint inventors in a single application. However, the claims in such an application are not protected from a 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 rejection. Applicants in such cases have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made to enable the examiner to consider the applicability of a 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 rejection. The examiner will assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure.

Foreign applicants will sometimes combine the subject matter of two or more related applications with different inventors into a single U.S. application naming joint inventors. The examiner will make the assumption, absent contrary evidence, that the applicants are complying with their duty of disclosure if no information is provided relative to invention dates and common ownership at the time the later invention was made. Such a claim for 35 U.S.C. 119(a)-(d) benefit based upon the foreign filed applications is appropriate and 35 U.S.C. 119(a)-(d) benefit can be accorded based upon each of the foreign filed applications.

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**706.02(1)(1) Rejections Under 35 U.S.C.  
102(e)/103; 35 U.S.C.  
103(c) [R-1]**

35 U.S.C. 103. *Conditions for patentability; non-obvious subject matter.*

\*\*\*\*\*

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person

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Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination of such an application.

The mere filing of a continuing application on or after November 29, 1999 will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application. For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for which reissue is being sought. The recapture doctrine prevents the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.

35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. 102, including 35 U.S.C. 102(e), is not affected, and may still be used to reject claims as being anticipated.

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter.

See MPEP § 706.02(1)(2) for information regarding establishing common ownership. See MPEP § 706.02(1)(3) for examination procedure with respect to 35 U.S.C. 103. Non-statutory and statutory double patenting rejections, based on subject matter now disqualified as prior art in amended 35 U.S.C. 103(c), should still be made as appropriate. See MPEP § 804.<

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**706.02(1)(2) Establishing Common  
Ownership [R-1]**

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. See MPEP § 706.02(1) for 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 prior art disqualified under 35 U.S.C. 103(c). See MPEP § 706.02(1)(1) for 35 U.S.C. 102(e)/103 prior art disqualified under 35 U.S.C. 103(c).

**I. DEFINITION OF COMMON OWNERSHIP**

The term “commonly owned” is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person, persons, or organization at the time the claimed invention was made. If the person, persons, or organization owned less than 100 percent of the subject matter which would otherwise be prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist. Common ownership requires that the person, persons, or organization own 100 percent of the subject matter and 100 percent of the claimed invention. As long as principal ownership rights to either the subject matter or the claimed invention reside in different persons or organizations common ownership does not exist. A license of the claimed invention to another by the owner where basic ownership rights are retained would not defeat ownership.

The requirement for common ownership at the time the claimed invention was made is intended to preclude obtaining ownership of subject matter after the claimed invention was made in order to disqualify that subject matter as prior art against the claimed invention.

The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual or organization or a legal obligation to

assign both the subject matter and the claimed invention to the same individual or organization must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art. A moral or unenforceable obligation would not evidence common ownership.

Under 35 U.S.C. 103(c), an applicant's admission that subject matter was developed prior to applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art only under sections 35 U.S.C. 102(e), 35 U.S.C. 102(f) or 35 U.S.C. 102(g), and if the subject matter and the claimed invention were commonly owned at the time the invention was made. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982), for a decision involving an applicants' admission which was used as prior art against their application. If the subject matter and invention were not commonly owned, an admission that the subject matter is prior art would be usable under 35 U.S.C. 103.

The burden of establishing that subject matter is disqualified as prior art under 35 U.S.C. 103(c) is intended to be placed and reside upon the person or persons urging that the subject matter is disqualified. For example, a patent applicant urging that subject matter is disqualified as prior art under 35 U.S.C. 103(c), would have the burden of establishing that it was commonly owned at the time the claimed invention was made. The patentee in litigation would likewise properly bear the same burden placed upon the applicant before the Patent and Trademark Office. To place the burden upon the patent examiner or the defendant in litigation would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee.

In view of 35 U.S.C. 103(c), the Commissioner has reinstated in appropriate circumstances the practice of rejecting claims in commonly owned applications of different inventive entities on the grounds of double patenting. Such rejections can be overcome in appropriate circumstances by the filing of terminal disclaimers. This practice has been judicially authorized. See *In re Bowers*, 359 F.2d 886, 149 USPQ 57 (CCPA 1966). The use of double patenting rejections which then could be overcome by terminal disclaimers preclude patent protection from being improperly extended while still permitting inventors and their assignees to obtain the legitimate benefits from their contributions. See also MPEP § 804.

The following examples are provided for illustration only:

**Example 1**

Parent Company owns 100% of Subsidiaries A and B

- inventions of A and B are commonly owned.

**Example 2**

Parent Company owns 100% of Subsidiary A and 90% of Subsidiary B

- inventions of A and B not commonly owned.

**Example 3**

If same person owns subject matter and invention at time invention was made, license to another may be made without the subject matter becoming prior art.

**Example 4**

Different Government inventors retaining certain rights (e.g. foreign filing rights) in separate inventions owned by Government precludes common ownership of inventions.

**Example 5**

Company A and Company B form joint venture Company C. Employees of A while working for C with an obligation to assign inventions to C, invent invention #1, employees of B while working for C with an obligation to assign inventions to C, invent invention #2, with knowledge of #1.

Question: Are #1 and #2 commonly owned at the time the later invention was made so as to preclude a rejection under 35 U.S.C. 102(e), (f) or (g) in view of 35 U.S.C. 103?

Answer: Yes-An official of company C can sign an affidavit that C owned both inventions.

The examiner must examine the application as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103 only if the application file(s) establishes common ownership at the time the later invention was made. Thus, it is necessary to look to the time at which common ownership exists. If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103. An invention is "made" when conception is complete as defined in *Mergenthaler v. Scudder*, 11 App. D.C. 264, 81 O.G. 1417, 1897 C.D. 724 (D.C. Cir. 1897); *In re Tansel*, 253 F.2d 241, 117 USPQ 188 (CCPA 1958). See *Pfaff v. Wells*, 525 U.S. 55, 119 S. Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) ("the invention must be ready for patenting. . . . by proof that prior to the critical date the inventor had prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.") Common ownership at the time the invention was made for purposes of obviating a 35 U.S.C. 102(e)/35 U.S.C. 103, 35 U.S.C. 102(f)/35 U.S.C. 103 or 35 U.S.C. 102(g)/35 U.S.C. 103 rejection may be established irrespective of whether the invention

was made in the United States or abroad. The provisions of 35 U.S.C. 104, however, will continue to apply to other proceedings in the Patent and Trademark Office, e.g. in an interference proceeding, with regard to establishing a date of invention by knowledge or use thereof, or other activity with respect thereto, in a foreign country. The foreign filing date will continue to be used for interference purposes under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 365.

## II. EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP

It is important to recognize just what constitutes sufficient evidence to establish common ownership at the time the invention was made. The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

### A. Nature of the Showing

37 CFR 1.104. Nature of examination.

(a) Examiner's action.

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(5) Copending applications will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person if:

(i) The application files refer to assignments recorded in the Patent and Trademark Office in accordance with Part 3 of this chapter which convey the entire rights in the applications to the same person or organization; or

(ii) Copies of unrecorded assignments which convey the entire rights in the applications to the same person or organization are filed in each of the applications; or

(iii) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; or

(iv) Other evidence is submitted which establishes common ownership of the applications.

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37 CFR 1.104(a)(5) specifies the nature of the showing necessary before the examiner would consider copending applications to be owned by, or subject to an obligation of assignment to, the same person for purposes of 35 U.S.C. 102(e)/103, 35 U.S.C. 102(f)/103, 35 U.S.C. 102(g)/103 and 37 CFR 1.104(c)(4). If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103.

The rule permits the necessary showing to be made in different alternative ways. The necessary showing will be

considered by the examiner to be present if the application files refer to assignments which are recorded in the Patent and Trademark Office in accordance with 37 CFR Part 3 as long as the assignments conveyed the entire rights in the applications to the same person or organization.

A second alternative which can be used, if assignments have not been recorded, permits the examiner to consider copies of unrecorded assignments filed in each of the applications by the applicants as long as the unrecorded assignments convey the entire rights in the applications to the same person or organization. The submission of copies of assignment agreements that were filed in the Office and that were executed at the time the application was filed would not be sufficient to disqualify the earlier invention as potential prior art against the later invention unless the assignment document itself contained language which indicate the relevant dates involved and established that the inventions were commonly owned at the time the later invention was made. Absent specific language in the assignment document which would establish that the inventions claimed in the applications were commonly owned at the time the later invention was made, the attorney/applicants would have to supply additional evidence or showings establishing common ownership at the time the later invention was made. This additional evidence or showing might take the form of an affidavit or declaration by the common owner which refers to the assignment and further avers that the inventors of the subject matter of the applications were all under an obligation to assign the inventions to the common owner at the time the later invention was made, e.g., by virtue of employment agreements. The affidavit or declaration might also include copies of the employment agreements although the submission of the copies of the employment agreements would not be essential as long as unqualified averments are made that the inventions were commonly owned at the time the later invention was made.

A third alternative permits an affidavit or declaration to be filed by the common owner stating that there is common ownership and stating facts which explain why the affiant or declarant believes there is common ownership. Under this alternative, sufficient facts will have to be presented in order to enable the examiner to conclude that a *prima facie* case of common ownership exists. It is expected that the most common form of submission to establish common ownership at the time the later invention was made will be verified statements, i.e., oaths or declarations from the common owner. It should be emphasized that such oaths or declarations must be executed by the common owner or someone empowered to act on behalf of the common owner. In circumstances where the common owner is a corporation or other organization, an affidavit or declaration

averring ownership may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization.

The fourth alternative permits other evidence to be used which would establish common ownership of the applications, e.g., a court decision determining the owner.

**B. *Showing by Affidavit or Declaration; Who May Sign on Behalf of an Organization***

The terms “person” and “organization” in the rule would include circumstances where the ownership resided in more than one person and/or organization as long as the applications are owned jointly by the same owners. 37 CFR 1.104(a)(5)(iii) also provides that where the common owner is a corporation or other organization an affidavit or declaration averring common ownership may be signed by an official of the corporation or organization who is empowered to act on behalf of the corporation or organization. The requirements of 37 CFR 3.73(b) do not apply. A mere power of attorney to prosecute a patent application will not make an individual an official of the corporation or organization or empower the individual to act on behalf of the corporation or organization for purposes of averring common ownership. However, such an affidavit could be made by a patent attorney, patent agent, or other individual if the attorney, agent, or other individual has been appointed in writing by the corporation or organization as an official of the corporation or organization specifically empowered to make affidavits or declarations on its behalf averring to common ownership. In circumstances where such a written appointment has been given to a patent attorney, patent agent, or other individual, that person could then make affidavits or declarations averring to common ownership as long as the affidavit or declaration referred to an attached copy of the written appointment and averred that the authority is still in effect. Under this practice the original signed copy of the written appointment would be retained by the affiant or declarant unless the Patent and Trademark Office specifically required it to be filed. Unless some question arose as to the authority of the individual to make the averment as to common ownership, the Patent and Trademark Office would ordinarily not need to require the original signed copy of the written appointment. While this practice should simplify the establishing of common ownership by necessitating only one original signed written appointment, corporations and other organizations must exercise care that the written appointment is only given to those persons who are in a position to know that common ownership does in fact exist and can therefore properly make affirmative representations to that effect to the Patent and Trademark Office.<

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**706.02(1)(3) Examination Procedure With Respect to 35 U.S.C. 103(c) [R-1]**

Examiners should check the assignment records, which are available on the Patent Application Locating and Monitoring (PALM) system, for the patents and applications involved in any rejection to see if there is a possible common owner or assignee with the application being examined. The assignment records on PALM show the execution date of any recorded assignment. Since applicants are not required to record assignments, however, these records are not the exclusive means to determine whether there was common ownership at the time the invention was made.

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if:

(A) the assignment records for the application(s) and patent(s) on PALM show that there was common ownership or an obligation to assign to the same person at the time of invention;

(B) the applicant provides evidence that the application and patent files refer to assignments recorded in the PTO in accordance with 37 CFR 3.11 which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention;

(C) copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) at the time of the invention are filed in each of the applications and patents;

(D) an affidavit or declaration by the common owner is filed which states that there was common ownership at the time the invention was made and explains why the affiant believes there was common ownership; or

(E) other evidence is submitted which establishes common ownership of the applications and patents at the time the invention was made, e.g., a court decision determining the owner.

See MPEP § 706.02(1)(2) for additional information pertaining to establishing common ownership.

**EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES WHERE COMMON OWNERSHIP HAS NOT BEEN ESTABLISHED**

If the application file being examined does not establish that it and the reference patent(s) or application(s) are owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, the examiner will:

(A) assume the application(s) and patent(s) are not commonly owned;

(B) examine the application on all grounds other than any conflict between the reference patent(s) or application(s) arising from a possible 35 U.S.C. 103 rejection based on 35 U.S.C. 102(e), (f) and/or (g);

(C) consider the applicability of any references under 35 U.S.C. 103 based on 35 U.S.C. 102(e), (f) and/or (g), including provisional rejections under 35 U.S.C. 102(e)/103; and

(D) apply the best references against the claimed invention by rejections under 35 U.S.C. 102 and 103, including any rejections under 35 U.S.C. 103 based on 35 U.S.C. 102(e), (f) and/or (g), until such time that a statement is made that the application(s) and patent(s) were commonly owned, at the time the invention was made. When applying any 35 U.S.C. 102(e)/103 references against the claims in applications filed on or after November 29, 1999, the examiner should anticipate that an affidavit averring common ownership may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). See MPEP § 706.02(1)(1). If such an affidavit is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made.

#### **EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES FILED ON OR AFTER NOVEMBER 29, 1999 WHERE COMMON OWNERSHIP HAS BEEN ESTABLISHED**

If the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made, the examiner will:

(A) examine the applications as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103, including provisional rejections under 35 U.S.C. 102(e)/103;

(B) examine the applications for double patenting, including statutory and nonstatutory double patenting, and make a provisional rejection, if appropriate; and

(C) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate

#### **EXAMINATION OF APPLICATIONS OF DIFFERENT INVENTIVE ENTITIES FILED PRIOR TO NOVEMBER 29, 1999 WHERE COMMON OWNERSHIP HAS BEEN ESTABLISHED**

In applications filed prior to November 29, 1999, the disclosure of an earlier filed patent application which issues

as a patent continues to be prior art under 35 U.S.C. 102(e) against a later invented and filed application of another inventor even though the patent and the later invention were owned by, or subject to, an obligation of assignment to the same person at the time the later invention was made. See MPEP § 706.02(1)(1).

If the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made, the examiner will:

(A) examine the applications as to all grounds except 35 U.S.C. 102(f) and (g) as they apply through 35 U.S.C. 103;

(B) examine the applications for double patenting, including statutory and nonstatutory double patenting, and make a provisional rejection, if appropriate; and

(C) examine the later filed application under 35 U.S.C. 102(e) as it applies through 35 U.S.C. 103 and make a provisional rejection under 35 U.S.C. 102(e)/35 U.S.C. 103 in the later filed application, if appropriate; and

(D) invite the applicant to file a terminal disclaimer to overcome any provisional or actual nonstatutory double patenting rejection, if appropriate, and permit the applicant of the later filed application to file an affidavit or declaration under 37 CFR 1.131, or a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 if the same patentable invention is being claimed and the commonly owned application has issued as a patent (see MPEP § 715.05 and § 718), or an affidavit or declaration under 37 CFR 1.132 showing the invention is not “by another,” to overcome the provisional or actual 35 U.S.C. 102(e)/35 U.S.C. 103 rejection, if appropriate. An affidavit or declaration under 37 CFR 1.130 cannot be used to overcome a provisional 35 U.S.C. 102(e)/103 rejection. See MPEP § 718.

#### **DOUBLE PATENTING REJECTIONS**

Commonly owned applications of different inventive entities may be rejected on the ground of double patenting, even if the later filed application claims 35 U.S.C. 120 benefit to the earlier application. A rejection based on a pending application would be a provisional rejection. The practice of rejecting claims on the ground of double patenting in commonly owned applications of different inventive entities is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See MPEP § 804 for guidance on double patenting issues. In accordance with established patent law doctrines, double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the

existing provisions of 37 CFR 1.321, the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life. See MPEP § 804 and § 804.02.<

### 706.02(m) Form Paragraphs for Use in Rejections Under 35 U.S.C. 103 [R-1]

The following form paragraphs should be used in making the appropriate rejections under 35 U.S.C. 103.

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

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

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

#### Examiner Note:

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

#### ¶ 7.20.01 >For Applications filed Prior to November 29, 1999,< 103(a) Rejection Using Art Disqualified Under 102 (f) or (g)

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as [1] at the time this invention was made. Accordingly, [2] is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under >another< subsection \* of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

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

#### Examiner Note:

1. This paragraph must be included following paragraph 7.20 in all actions containing rejections under 35 U.S.C. 103(a) using art that is disqualified under 103(c) using 102(f) or (g), but which qualifies under another section of 35 U.S.C. 102.
2. In brackets 1 and 2, identify the commonly owned applied art (patent or co-pending application).  
\*\*>
3. Use this form paragraph only in applications filed prior to November 29, 1999. For applications filed on or after November 29, 1999, use form paragraph 7.20.03.

#### ¶ 7.20.03 For Applications Filed On Or After November 29, 1999, 103(a) Rejection Using Art Disqualified Under 102(e), (f) or (g)

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as [1] at the time this invention was made. Accordingly, [2] is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

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

#### Examiner Note:

1. This paragraph must be included following paragraph 7.20 in all actions containing rejection under 35 U.S.C. 103(a) using art that is disqualified under 103(c) using 102(e), (f) or (g), but which qualifies under another section of 35 U.S.C. 102..
2. In brackets 1 and 2, identify the commonly owned applied art (patent or co-pending application)..
3. Use this form paragraph only in applications filed on or after November 29, 1999. For applications filed prior to November 29, 1999, use form paragraph 7.20.01.<

#### ¶ 7.20.02 Joint Inventors, Common Ownership Presumed

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

#### Examiner Note:

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

#### ¶ 7.21 Rejection, 35 U.S.C. 103(a)

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

#### Examiner Note:

1. This paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.
3. If this rejection relies upon art that is disqualified under 35 U.S.C. 102(f) or (g) based upon the common ownership of the invention, paragraph 7.20.01 must follow this paragraph.
4. If this rejection is a provisional 35 U.S.C. 103(a) rejection based upon a copending application that would comprise prior art under 35 U.S.C. 102(e) if patented, use paragraph 7.21.01 instead of this paragraph.

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

Claim [1] provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. [2] which has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e)

if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. [4]

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. >For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2)<

#### Examiner Note:

1. This paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor. >This form paragraph should **not** be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made. See MPEP § 706.02(1)(3).<
2. If the claimed invention is fully disclosed in the copending application, use paragraph 7.15.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, insert explanation of obviousness.
5. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using paragraph 8.33 and 8.37.
6. If evidence indicates that the copending application is also prior art under 35 U.S.C. 102(f) or (g) and the copending application has **not** been disqualified as prior art in a 35 U.S.C. 103(a) rejection based upon common ownership, a rejection should additionally be made under 35 U.S.C. 103(a) using paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using paragraph 8.28).

#### ¶ 7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor

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

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). >For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2).< [4]

#### Examiner Note:

1. This paragraph is used to reject over a patent with an earlier filing date that discloses the claimed invention. The patent must have either a common assignee or at least one common inventor. >This form paragraph

should **not** be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent or application were owned by, or subject to an obligation or assignment to, the same person, at the time the invention was made. See MPEP § (1)(3).<

2. In bracket 3, insert either --assignee-- or --inventor--.
3. In bracket 4, insert explanation of obviousness.

#### ¶ 7.22 Rejection, 35 U.S.C. 103(a), Further in View Of

Claim [1] rejected under 35 U.S.C. 103(a) as being unpatentable over [2] as applied to claim [3] above, and further in view of [4].

#### Examiner Note:

1. This paragraph must be preceded by paragraph 7.21.
2. An explanation of the rejection applying the Graham v. Deere test must follow this form paragraph.

#### ¶ 7.23 Graham v. Deere, Test for Obviousness

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

#### Examiner Note:

This paragraph may be used, if appropriate, in response to an argument of the use of *Graham v. Deere*.

#### ¶ 7.27 Rejection, 35 U.S.C. 102 or 103(a)

Claim [1] rejected under 35 U.S.C. 102([2]) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over [3].

#### Examiner Note:

1. This paragraph is NOT intended to be commonly used as a substitute for a rejection under 35 U.S.C. 102. In other words, a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103(a) should be made whenever possible using appropriate form paragraphs 7.15 to 7.19, 7.21 and 7.22. Examples of circumstances where this paragraph may be used are as follows:
  - a. When the interpretation of the claim(s) is or may be in dispute, i.e., given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP §§ 2111- 2116.01 for guidelines on claim interpretation.
  - b. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02.
  - c. When the reference teaches a small genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), and the species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. 102. See MPEP §§ 2131.02 and 2144.08 for more information on anticipation and obviousness of species by a disclosure of a genus.
  - d. When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d

799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

e. When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent to the claimed element and therefore anticipatory, or whether the prior art element is an obvious variant of the claimed element. See MPEP §§ 2183- 2184.

f. When the ranges disclosed in the reference and claimed by applicant overlap in scope but the reference does not contain a specific example within the claimed range. See the concurring opinion in *Ex parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). See MPEP § 2131.03.

2. If the interpretation of the claim(s) renders the claim(s) indefinite, a rejection under 35 U.S.C. 112, 2nd paragraph, may be appropriate.

3. In bracket 2, insert the appropriate paragraph letter(s) in parenthesis.

4. A full explanation should follow this form paragraph.

5. This paragraph must be preceded by 7.07, one or more of paragraphs 7.08 to 7.14 as appropriate, and paragraph 7.20 or paragraph 7.103.

### 706.02(n) Biotechnology Process Applications; 35 U.S.C. 103(b)

35 U.S.C. 103. *Conditions for patentability; non-obvious subject matter.*

\*\*\*\*\*

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

\*\*\*\*\*

35 U.S.C. 103(b) is applicable to biotechnological processes only. 35 U.S.C. 103(b) precludes a rejection of process claims which involve the use or making of certain

nonobvious biotechnological compositions of matter under 35 U.S.C. 103(a).

35 U.S.C. 103(b) requires that:

(A) the biotechnological process and composition of matter be contained in either the same application or in separate applications having the same effective filing date;

(B) both the biotechnological process and composition of matter be owned or subject to an assignment to the same person at the time the process was invented;

(C) a patent issued on the process also contain the claims to the composition of matter used in or made by the process, or, if the process and composition of matter are in different patents, the patents expire on the same date;

(D) the biotechnological process falls within the definition set forth in 35 U.S.C. 103(b); and

(E) a timely election be made to proceed under the provisions of 35 U.S.C. 103(b).

An election to proceed under 35 U.S.C. 103(b) shall be made by way of petition under 37 CFR 1.182. The petition must establish that all the requirements set forth in 35 U.S.C. 103(b) have been satisfied.

An election will normally be considered timely if it is made no later than the earlier of either the payment of the issue fee or the filing of an appeal brief in an application which contains a composition of matter claim which has not been rejected under 35 U.S.C. 102 or 103.

In an application where at least one composition of matter claim has not been rejected under 35 U.S.C. 102 or 103, a 35 U.S.C. 103(b) election may be made by submitting the petition and an amendment requesting entry of process claims which correspond to the composition of matter claim.

For applications pending on or after November 1, 1995, in which the issue fee has been paid prior to March 26, 1996, the timeliness requirement for an election under 35 U.S.C. 103(b) will be considered satisfied if the conditions of 37 CFR 1.312(b) are met. However, if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b) without an election having been made as a result of error without deceptive intent, patentees may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment.

See MPEP § 2116.01 for a discussion of the Federal Circuit's decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) which address the general issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In view of the Federal Circuit's decisions in *Ochiai* and *Brouwer*, an applicant's need to rely upon 35 U.S.C. 103(b) should be rare. See also 1184 O G

86 (Comm'r Pat. 1996). See 35 U.S.C. 282 for the effect of a determination of nonobviousness under 35 U.S.C. 103(b)(1) on the presumption of validity.

### 706.03 Rejections Not Based on Prior Art

The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or “technical” rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Rejections based on nonstatutory subject matter are explained in MPEP § 706.03(a), § 2105, § 2106 - § 2106.02, and § 2107 - § 2107.02. Rejections based on subject matter barred by the Atomic Energy Act are explained in MPEP § 706.03(b). Rejections based on duplicate claims are addressed in MPEP § 706.03(k), and double patenting rejections are addressed in MPEP § 804. See MPEP § 706.03(o) for rejections based on new matter. Foreign filing without a license is discussed in MPEP § 706.03(s). Disclaimer, after interference or public use proceeding, *res judicata*, and reissue are explained in MPEP § 706.03(u) to § 706.03(x). Rejections based on 35 U.S.C. 112 are discussed in MPEP § 2161 - § 2174. IF THE LANGUAGE IN THE FORM PARAGRAPHS IS INCORPORATED IN THE LETTER TO STATE THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

#### 706.03(a) Rejections under 35 U.S.C. 101

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”

The term “process” as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

See MPEP § 2105 for patentability of microorganisms and MPEP § 2106 - § 2106.02 for patentability of mathematical algorithms or computer programs.

### LACK OF UTILITY

A rejection on the ground of lack of utility includes the more specific grounds of inoperativeness, involving perpetual motion, frivolous, fraudulent, and against public policy. The statutory basis for this rejection is 35 U.S.C. 101. See MPEP § 706.03(a)(1) for guidelines governing rejections for lack of utility. See MPEP § 2107 - § 2107.02 for legal precedent governing the utility requirement.

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the Statute follow:

#### PRINTED MATTER

For example, a mere arrangement of printed matter, though seemingly a “manufacture,” is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967).

#### NATURALLY OCCURRING ARTICLE

Similarly, a thing occurring in nature, which is substantially unaltered, is not a “manufacture.” A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).

#### SCIENTIFIC PRINCIPLE

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854).

This subject matter is further limited by the Atomic Energy Act explained in MPEP § 706.03(b). Use Form Paragraphs 7.04 through 7.05.03 to reject under 35 U.S.C. 101.

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

35 U.S.C. 101 reads as follows:

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

#### Examiner Note:

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

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

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

#### Examiner Note:

1. This form paragraph must be followed by any one of paragraphs 7.05.01- 7.05.03 or another appropriate reason.
2. Explain the rejection following the recitation of the statute and the use of form paragraphs 7.05.01-7.05.03 or other reason.
3. See MPEP §§ 706.03(a) and 2105- 2107.02 for other situations.

4. This paragraph must be preceded by paragraph 7.04 in first actions and final rejections.

¶ 7.05.01 *Rejection, 35 U.S.C. 101, Non-Statutory*  
the claimed invention is directed to non-statutory subject matter. [1]

**Examiner Note:**

In bracket 1, insert identification of non-statutory subject matter.

¶ 7.05.02 *Rejection, 35 U.S.C. 101, Utility Lacking*  
the claimed invention lacks patentable utility. [1]

**Examiner Note:**

In bracket 1, provide explanation of lack of utility, such as, for example, that which is frivolous, fraudulent, against public policy, or lacks proper chemical specificity, etc. See MPEP §§ 706.03(a) and 2105-2107.02.

¶ 7.05.03 *Rejection, 35 U.S.C. 101, Inoperative*  
the disclosed invention is inoperative and therefore lacks utility. [1]

**Examiner Note:**

In bracket 1, explain why invention is inoperative.

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

Claim [1] rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a [2] asserted utility or a well established utility. [3]

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

**Examiner Note:**

Format A:

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

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

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific asserted utility or a well established utility. Include within the insert the following statement: --Note, because the claimed invention is not supported by a specific asserted utility for the reasons set forth above, credibility cannot be assessed.--.

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

Format B:

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

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

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

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

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

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

(c) In bracket 3, insert the explanation as to why the claimed invention is not supported by either a specific asserted utility, a credible asserted utility or a well established utility. Each utility should be addressed. Include within the insert the following statement for those utilities which are not specific: --Note, because such a utility for the claimed invention is not specific for the reasons set forth above, credibility cannot be assessed for that utility.--.

1. In each case, a separate rejection under 35 U.S.C. 112, first paragraph, enablement should be made using the factors set forth in In re

Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988) and an undue experimentation analysis. See MPEP §§ 2164- 2164.08(c).

2. A utility that is inoperative should be treated as being not credible since a utility that is inoperative cannot be credible.

### 706.03(a)(1) Guidelines For Examination of Applications for Compliance With the Utility Requirement of 35 U.S.C. 101 and 35 U.S.C. 112

The following guidelines establish the policies and procedures to be followed by Office personnel when examining applications for compliance with the utility requirements of 35 U.S.C. 101 and 35 U.S.C. 112. The guidelines also address issues that may arise during examination of applications claiming protection for inventions in the field of biotechnology and human therapy. See MPEP § 2107 - § 2107.02 for a discussion of the legal precedent governing utility rejections.

#### GUIDELINES

Office personnel must adhere to the following procedures when reviewing applications for compliance with the useful invention (utility) requirement of 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph:

(A) Determine what the applicant has invented and is seeking to patent:

(1) Ensure that the claims define statutory subject matter (e.g., a process, a machine, a manufacture, or a composition of matter); and

(2) Review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims, and any specific utilities that have been asserted for the invention.

(B) Review the specification and claims to determine if the applicant has asserted any credible utility for the claimed invention.

(1) If the applicant has asserted that the claimed invention is useful for any particular purpose (i.e., a “specific utility”) and that assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility. Credibility is to be assessed from the perspective of one of ordinary skill in the art in view of any evidence of record (e.g., data, statements, opinions, references, etc.) that is relevant to the applicant's assertions. An applicant must provide only one credible assertion of specific utility for any claimed invention to satisfy the utility requirement.

(2) If the invention has a well-established utility, regardless of any assertion made by the applicant, do not impose a rejection based on lack of utility. An invention has a well-established utility if a person of ordinary skill in the art would immediately appreciate why the invention is

useful based on the characteristics of the invention (e.g., properties of a product or obvious application of a process).

(3) If the applicant has not asserted any specific utility for the claimed invention and it does not have a well-established utility, impose a rejection under 35 U.S.C. 101, emphasizing that the applicant has not disclosed a specific utility for the invention. Also impose a separate rejection under 35 U.S.C. 112, first paragraph, on the basis that the applicant has not shown how to use the invention due to lack of disclosure of a specific utility. The 35 U.S.C. 101 and 112 rejections should shift the burden to the applicant to:

- (i) explicitly identify a specific utility for the claimed invention, and
- (ii) indicate where support for the asserted utility can be found in the specification.

Review the subsequently asserted utility by the applicant using the standard outlined in paragraph (B)(1) above, and ensure that it is fully supported by the original disclosure.

(C) If no assertion of specific utility for the claimed invention made by the applicant is credible, and the claimed invention does not have a well-established utility, reject the claim(s) under 35 U.S.C. 101 on the grounds that the invention as claimed lacks utility. Also reject the claims under 35 U.S.C. 112, first paragraph, on the basis that the disclosure fails to teach how to use the invention as claimed. The 35 U.S.C. 112, first paragraph, rejection imposed in conjunction with a 35 U.S.C. 101 rejection should incorporate by reference the grounds of the corresponding 35 U.S.C. 101 rejection and should be set out as a rejection distinct from any other rejection under 35 U.S.C. 112, first paragraph, not based on lack of utility for the claimed invention.

To be considered appropriate by the Office, any rejection based on lack of utility must include the following elements:

(1) A *prima facie* showing that the claimed invention has no utility. A *prima facie* showing of no utility must establish that it is more likely than not that a person skilled in the art would not consider credible any specific utility asserted by the applicant for the claimed invention. A *prima facie* showing must contain the following elements:

- (i) a well-reasoned statement that clearly sets forth the reasoning used in concluding that the asserted utility is not credible;
- (ii) support for factual findings relied upon in reaching this conclusion; and

(iii) support for any conclusions regarding evidence provided by the applicant in support of an asserted utility.

(2) Specific evidence that supports any fact-based assertions needed to establish the *prima facie* showing. Whenever possible, Office personnel must provide documentary evidence (e.g., scientific or technical journals, excerpts from treatises or books, or U.S. or foreign patents) as the form of support used in establishing the factual basis of a *prima facie* showing of no utility according to items (1)(ii) and (1)(iii) above. If documentary evidence is not available, Office personnel shall note this fact and specifically explain the scientific basis for the factual conclusions relied on in sections (1)(ii) and (1)(iii).

(D) A rejection based on lack of utility should not be maintained if an asserted utility for the claimed invention would be considered credible by a person of ordinary skill in the art in view of all evidence of record.

Once a *prima facie* showing of no utility has been properly established, the applicant bears the burden of rebutting it. The applicant can do this by amending the claims, by providing reasoning or arguments, or by providing evidence in the form of a declaration under 37 CFR 1.132 or a printed publication, that rebuts the basis or logic of the *prima facie* showing. If the applicant replies to the *prima facie* rejection, Office personnel shall review the original disclosure, any evidence relied upon in establishing the *prima facie* showing, any claim amendments and any new reasoning or evidence provided by the applicant in support of an asserted utility. It is essential for Office personnel to recognize, fully consider and respond to each substantive element of any reply to a rejection based on lack of utility. Only where the totality of the record continues to show that the asserted utility is not credible should a rejection based on lack of utility be maintained.

If the applicant satisfactorily rebuts a *prima facie* rejection based on lack of utility under 35 U.S.C. 101, withdraw the 35 U.S.C. 101 rejection and the corresponding rejection imposed under 35 U.S.C. 112, first paragraph, per paragraph (C) above.

Office personnel are reminded that they must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided that shows that one of ordinary skill in the art would have a legitimate basis to doubt the credibility of such a statement. Similarly, Office personnel must accept an opinion from a qualified expert that is based upon relevant facts whose accuracy is not being questioned; it is improper to disregard the opinion solely because of a disagreement over the significance or meaning of the facts offered.

**706.03(b) Barred by Atomic Energy Act**

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181(a)) thereof reads in part as follows:

No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms “atomic energy” and “special nuclear material” are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181(c) and (d)) set up categories of pending applications relating to atomic energy that must be brought to the attention of the Department of Energy. Under 37 CFR 1.14(c), applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy and the Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by the Atomic Energy Act.

All applications received in the Patent and Trademark Office are screened by Group 3640 personnel, under 37 CFR 1.14(c), in order for the Commissioner to fulfill his responsibilities under section 151(d) (42 U.S.C. 2181(d)) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review in Group 3640.

All rejections based upon sections 151(a)(42 U.S.C. 2181(a)), 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by Group 3640 personnel.

**706.03(c) Rejections Under 35 U.S.C. 112, First Paragraph**

Rejections based on the first paragraph of 35 U.S.C. 112 are discussed in MPEP § 2161 - § 2165.04. For a discussion of the utility requirements of 35 U.S.C. 112, first paragraph, and 35 U.S.C. 101, see MPEP § 706.03(a)(1) and § 2107 - § 2107.02. The appropriate form paragraphs 7.30.01 and 7.31.01 through 7.33.01 should be used in making rejections under 35 U.S.C. 112, first paragraph.

*¶ 7.30.01 Statement of Statutory Basis, 35 U.S.C. 112, First Paragraph*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Examiner Note:**

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

*¶ 7.31.01 Rejection, 35 U.S.C. 112, 1st Paragraph, Description Requirement, Including New Matter Situations*

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, identify (by suitable reference to page and line numbers and/or drawing figures) the subject matter not properly described in the application as filed, and provide an explanation of your position. The explanation should include any questions the examiner asked which were not satisfactorily resolved and consequently raise doubt as to possession of the claimed invention at the time of filing.

Form Paragraph 7.31.02 should be used when it is the examiner's position that nothing within the scope of the claims is enabled. In such a rejection, the examiner should explain all the reasons why nothing within the scope of the claim is enabled. To make sure all relevant issues are raised, this should include any issues regarding the breadth of the claims relative to the guidance in the disclosure.

*¶ 7.31.02 Rejection, 35 U.S.C. 112, 1st Paragraph: Enablement*

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. If the problem is one of scope, form paragraph 7.31.03 should be used.
3. In bracket 2, identify the claimed subject matter for which the specification is not enabling along with an explanation as to why the specification is not enabling. The explanation should include any questions the examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.
4. Where an essential component or step of the invention is not recited in the claims, use form paragraph 7.33.01.

Form paragraph 7.31.03 should be used when it is the examiner's position that something within the scope of the claims is enabled but the claims are not limited to that scope.

¶ 7.31.03 *Rejection, 35 U.S.C. 112, 1st Paragraph: Scope of Enablement*

Claim [1] rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for [2], does not reasonably provide enablement for [3]. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to [4] the invention commensurate in scope with these claims. [5]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. This paragraph is to be used when the scope of the claims is not commensurate with the scope of the enabling disclosure.
3. In bracket 2, identify the claimed subject matter for which the specification is enabling. This may be by reference to specific portions of the specification.
4. In bracket 3, identify aspect(s) of the claim(s) for which the specification is not enabling.
5. In bracket 4, fill in only the appropriate portion of the statute, i.e., one of the following: --make--, --use--, or --make and use--.
6. In bracket 5, identify the problem along with an explanation as to why the specification is not enabling. The explanation should include any questions posed by the examiner which were not satisfactorily resolved and consequently raise doubt as to enablement.

¶ 7.31.04 *Rejection, 35 U.S.C. 112, 1st Paragraph: Best Mode Requirement*

Claim [1] rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon [2].

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, insert the basis for holding that the best mode has been concealed, e.g., the quality of applicant's disclosure is so poor as to effectively result in concealment.
3. Use of this form paragraph should be rare. See MPEP §§ 2165-2165.04.

Form paragraph 7.33.01 should be used when it is the examiner's position that a feature considered critical or essential by applicant to the practice of the claimed invention is missing from the claim.

¶ 7.33.01 *Rejection, 35 U.S.C. 112, 1st Paragraph, Essential Subject Matter Missing From Claims (Enablement)*

Claim [1] rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. [2] critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). [3]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.01 or 7.103.
2. In bracket 2, recite the subject matter omitted from the claims.
3. In bracket 3, give the rationale for considering the omitted subject matter critical or essential.
4. The examiner shall cite the statement, argument, date, drawing, or other evidence which demonstrates that a particular feature was considered essential by the applicant, is not reflected in the claims which are rejected.

## 706.03(d) Rejections Under 35 U.S.C. 112, Second Paragraph

Rejections under 35 U.S.C. 112, second paragraph, are discussed in MPEP § 2171 - § 2174. Form paragraphs 7.30.02 and 7.34 through 7.35.01 should be used to reject under 35 U.S.C. 112, second paragraph.

¶ 7.30.02 *Statement of Statutory Basis, 35 U.S.C. 112, Second Paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Examiner Note:**

1. The statute is no longer being re-cited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.
2. Paragraphs 7.30.01 and 7.30.02 are to be used ONLY ONCE in a given Office action.

¶ 7.34 *Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Claim Applicant's Invention*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim [2] fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. [3] filed [4]. In that paper, applicant has stated [5], and this statement indicates that the invention is different from what is defined in the claim(s) because [6].

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. This paragraph is to be used only where applicant has stated, somewhere other than in the application, as filed, that the invention is something different from what is defined in the claim(s).
3. In brackets 3 and 4, identify the submission by applicant (which is not the application, as filed, but may be in the remarks by applicant, in the brief, in an affidavit, etc.) by Paper No. and the date the paper was filed in the PTO.
4. In bracket 5, set forth what applicant has stated in the submission to indicate a different invention.
5. In bracket 6, explain how the statement indicates an invention other than what is being claimed.

¶ 7.34.01 *Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite)*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.2. This paragraph should be followed by one or more of the following form paragraphs 7.34.02 - 7.34.06, as applicable. If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied. Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See MPEP §§ 2171 - 2174 for guidance. See also form paragraph 17.07 for **Pro Se** applicants.

¶ 7.34.02 *Terminology Used Inconsistent with Accepted Meaning*

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term “[1]” in claim [2] is used by the claim to mean “[3]”, while the accepted meaning is “[4].”

**Examiner Note:**

1. In bracket 3, point out the meaning that is assigned to the term by applicant's claims, taking into account the entire disclosure.
2. In bracket 4, point out the accepted meaning of the term. Support for the examiner's stated accepted meaning should be provided through the citation of an appropriate reference source, e.g., textbook or dictionary. See MPEP § 2173.05(a).
3. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.03 *Relative Term - Term of Degree Rendering Claim Indefinite*

The term “[1]” in claim [2] is a relative term which renders the claim indefinite. The term “[1]” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. [3]

**Examiner Note:**

1. In bracket 3, explain which parameter, quantity, or other limitation in the claim has been rendered indefinite by the use of the term appearing in bracket 1.
2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.04 *Broader Range/Limitation And Narrow Range/Limitation in Same Claim*

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim [1] recites the broad recitation [2], and the claim also recites [3] which is the narrower statement of the range/limitation.

**Examiner Note:**

1. In bracket 2, insert the broader range/limitation and where it appears in the claim; in bracket 3, insert the narrow range/limitation and where it appears. This form paragraph may be modified to fit other instances of indefiniteness in the claims.
2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.05 *Lack of Antecedent Basis in the Claims*

Claim [1] recites the limitation [2] in [3]. There is insufficient antecedent basis for this limitation in the claim.

**Examiner Note:**

1. In bracket 2, insert the limitation which lacks antecedent basis, for example --said lever-- or --the lever--.

2. In bracket 3, identify where in the claim(s) the limitation appears, for example, --line 3--, --the 3<sup>rd</sup> paragraph of the claim--, --the last 2 lines of the claim--, etc.

3. This form paragraph should ONLY be used in aggravated situations where the lack of antecedent basis makes the scope of the claim indeterminate. It must be preceded by form paragraph 7.34.01.

¶ 7.34.06 *Use Claims*

Claim [1] provides for the use of [2], but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claim [3] is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

**Examiner Note:**

1. In bracket 2, insert what is being used. For example, insert --the monoclonal antibodies of claim 4--, where the claim recites “a method for using monoclonal antibodies of claim 4 to purify interferon.”
2. See MPEP § 2173.05(q).
3. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.07 *Claims Are a Literal Translation*

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.08 *Indefinite Claim Language: “For Example”*

Regarding claim [1], the phrase “for example” renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.09 *Indefinite Claim Language: “Or The Like”*

Regarding claim [1], the phrase “or the like” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.10 *Indefinite Claim Language: “Such As”*

Regarding claim [1], the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.11 *Modifier of “Means” Lacks Function*

Regarding claim [1], the word “means” is preceded by the word(s) “[2]” in an attempt to use a “means” clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding “means,” it is impossible to determine

the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

**Examiner Note:**

1. It is necessary for the words which precede “means” to convey a function to be performed. For example, the phrase “latch means” is definite because the word “latch” conveys the function “latching.” In general, if the phrase can be restated as “means for \_\_\_\_\_,” and it still makes sense, it is definite. In the above example, “latch means” can be restated as “means for latching.” This is clearly definite. However, if “conduit means” is restated as “means for conduiting,” the phrase makes no sense because the word “conduit” has no functional connotation, and the phrase is indefinite.
2. This form paragraph must be preceded by form paragraph 7.34.01.

¶ 7.34.12 *Essential Steps Omitted*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the steps omitted from the claims.
3. Give the rationale for considering the omitted steps critical or essential.

¶ 7.34.13 *Essential Elements Omitted*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the elements omitted from the claims.
3. Give the rationale for considering the omitted elements critical or essential.

¶ 7.34.14 *Essential Cooperative Relationships Omitted*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: [2]

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. In bracket 2, recite the structural cooperative relationships of elements omitted from the claims.
3. Give the rationale for considering the omitted structural cooperative relationships of elements being critical or essential.

¶ 7.35 *Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point Out And Distinctly Claim - Omnibus Claim*

Claim [1] rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

**Examiner Note:**

1. This rejection must be preceded by form paragraph 7.30.02 or 7.103.
2. Use this paragraph to reject an “omnibus” type claim. No further explanation is necessary.
3. See MPEP § 1302.04(b) for cancellation of such a claim by examiner’s amendment upon allowance.
4. An example of an omnibus claim is: “A device substantially as shown and described.”

¶ 7.35.01 *Trademark or Trade Name as a Limitation in the Claim*

Claim [1] contains the trademark/trade name [2]. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe [3] and, accordingly, the identification/description is indefinite.

**Examiner Note:**

1. In bracket 2, insert the trademark/trade name and where it is used in the claim.
2. In bracket 3, specify the material or product which is identified or described in the claim by the trademark/trade name.

## 706.03(k) Duplicate Claims

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant’s right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim.

Form paragraphs 7.05.05 and 7.05.06 may be used where duplicate claims are present in an application.

¶ 7.05.05 *Duplicate Claims, Warning*

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

**Examiner Note:**

1. Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.
2. If the claims are allowable, use form paragraph 7.05.06.

¶ 7.05.06 *Duplicate Claims, Objection*

Claim [1] objected under 37 CFR 1.75 as being a substantial duplicate of claim [2]. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the

other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

**Examiner Note:**

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

See MPEP § 804 for double patenting rejections of inventions not patentable over each other.

**706.03(m) Nonelected Inventions**

See MPEP § 821 to § 821.03 for treatment of claims held to be drawn to nonelected inventions.

**706.03(o) New Matter**

*35 U.S.C. 132. Notice of rejection; reexamination.*

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldemar Link, GmbH & Co. v. Osteonics Corp.* 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). See MPEP § 2163.06 - § 2163.07(b) for a discussion of the relationship of new matter to 35 U.S.C. 112, first paragraph. New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See MPEP § 608.04 to § 608.04(c). See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and MPEP § 2163.05 for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter.

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. 35 U.S.C. 132 should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting to add new disclosure to that originally disclosed on filing.

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See MPEP § 608.01(l).

If new matter is added to the specification, it should be objected to by using Form Paragraph 7.28.

*¶ 7.28 Objection to New Matter Added to Specification*

The amendment filed [1] is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: [2].

Applicant is required to cancel the new matter in the reply to this Office action.

**Examiner Note:**

1. This form paragraph is not to be used in reissue applications; use form paragraph 14.22.01 instead.
2. In bracket 2, identify the new matter by page and the line numbers and/or drawing figures and provide an appropriate explanation of your position. This explanation should address any statement by applicant to support the position that the subject matter is described in the specification as filed. It should further include any unresolved questions which raise a doubt as to the possession of the claimed invention at the time of filing.
3. If new matter is added to the claims, or affects the claims, a rejection under 35 U.S.C. 112, first paragraph, using form paragraph 7.31.01 should also be made. If new matter is added only to a claim, an objection using this paragraph should not be made, but the claim should be rejected using form paragraph 7.31.01. As to any other appropriate prior art or 35 U.S.C. 112 rejection, the new matter must be considered as part of the claimed subject matter and can not be ignored.

**706.03(s) Foreign Filing Without License**

*35 U.S.C. 182. Abandonment of invention for unauthorized disclosure.*

The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

*35 U.S.C. 184. Filing of application in foreign country.*

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been filed abroad through error and without deceptive intent and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

The scope of a license shall permit subsequent modifications, amendments, and supplements containing additional subject matter if the application upon which the request for the license is based is not, or was not,

required to be made available for inspection under section 181 of this title and if such modifications, amendments, and supplements do not change the general nature of the invention in a manner which would require such application to be made available for inspection under such section 181. In any case in which a license is not, or was not, required in order to file an application in any foreign country, such subsequent modifications, amendments, and supplements may be made, without a license, to the application filed in the foreign country if the United States application was not required to be made available for inspection under section 181 and if such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require the United States application to have been made available for inspection under such section 181.

#### 35 U.S.C. 185. Patent barred for filing without license.

Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid, unless the failure to procure such license was through error and without deceptive intent, and the patent does not disclose subject matter within the scope of section 181 of this title.

If, upon examining an application, the examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for 6 months, and if the invention apparently was made in this country, he shall refer the application to Licensing and Review Section of Group 3640, calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the examining group for prosecution on the merits. When it is otherwise in condition for allowance, the application will be again submitted to Licensing and Review Section of Group 3640 unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under 35 U.S.C. 185, Licensing and Review Section of Group 3640 will request transfer of the application to it.

#### 706.03(u) Disclaimer

Claims may be rejected on the ground that applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant's failure to:

(A) make claims suggested for interference with another application under 37 CFR 1.605 (See MPEP § 2305.02),

(B) copy a claim from a patent when suggested by the examiner (MPEP § 2305.02), or

(C) respond or appeal, within the time limit fixed, to the examiner's rejection of claims copied from a patent (see MPEP § 2307.02).

The rejection on disclaimer applies to all claims not patently distinct from the disclaimed subject matter as well as to the claims directly involved.

Rejections based on disclaimer should be made by using one of Form Paragraphs 7.48 and 7.49.

#### ¶ 7.48 Failure To Present Claims for Interference

Claim [1] rejected under 35 U.S.C. [2] based upon claim [3] of Patent No. [4].

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

#### Examiner Note:

1. This paragraph should be used only after applicant has been notified that interference proceedings must be instituted before the claims can be allowed and applicant has refused to copy the claims.
2. In bracket 2, insert --102(g)-- or --102(g)/103(a)--.
3. In bracket 4, insert the patent number, and --in view of \_\_\_\_\_-- if another reference is also relied upon. When the rejection is under 35 U.S.C. 103(a), the examiner's basis for a finding of obviousness should be included. Note that interferences may include obvious variants, see MPEP § 2306.

#### ¶ 7.49 Rejection, Disclaimer, Failure To Appeal

Claim [1] stand finally disposed of for failure to reply to or appeal from the examiner's rejection of such claim(s) presented for interference within the specified time. See 37 CFR 1.661 and 1.663.

#### 706.03(v) After Interference or Public Use Proceeding

For rejections following an interference, see MPEP § 2363.03.

The outcome of public use proceedings may also be the basis of a rejection. See 37 CFR 1.292 and *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

Upon termination of a public use proceeding including a case also involved in an interference, in order for a prompt resumption of the interference proceedings, a notice should be sent to the Board of Patent Appeals and Interferences notifying them of the disposition of the public use proceeding.

#### 706.03(w) Res Judicata

*Res judicata* may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of *res judicata* rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision.

The timely filing of a second application copending with an earlier application does not preclude the use of *res judicata* as a ground of rejection for the second application claims.

When making a rejection on *res judicata*, action should ordinarily be made also on the basis of prior art, especially in continuing applications. In most situations the same prior art which was relied upon in the earlier decision would again be applicable.

In the following cases a rejection of a claim on the ground of *res judicata* was sustained where it was based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

*In re Freeman*, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994).

*Edgerton v. Kingland*, 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947).

*In re Szwarc*, 319 F.2d 277, 138 USPQ 208 (CCPA 1963).

*In re Katz*, 467 F.2d 939, 167 USPQ 487 (CCPA 1970) (prior decision by District Court).

In the following cases for various reasons, *res judicata* rejections were reversed.

*In re Fried*, 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (differences in claims).

*In re Szwarc*, 319 F.2d 277, 138 USPQ 208 (CCPA 1963) (differences in claim).

*In re Hellbaum*, 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (differences in claims).

*In re Herr*, 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (same claims, new evidence, prior decision by CCPA).

*In re Kaghan*, 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner “to simplify the issue,” differences in claims; holding of waiver based on language in MPEP at the time).

*In re Craig*, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (Board of Appeals held second set of claims patentable over prior art).

*In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (difference in claims).

*In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (new evidence, rejection on prior art reversed by court).

*In re Ackermann*, 444 F.2d 1172, 170 USPQ 340 (CCPA 1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court).

*Plastic Contact Lens Co. v. Gottschalk*, 484 F.2d 837, 179 USPQ 262 (D.C. Cir. 1973) (follows *In re Kaghan*).

### 706.03(x) Reissue

The examination of reissue applications is covered in MPEP Chapter 1400.

35 U.S.C. 251 forbids the granting of a reissue “enlarging the scope of the claims of the original patent” unless the

reissue is applied for within 2 years from the grant of the original patent. This is an absolute bar and cannot be excused. This prohibition has been interpreted to apply to any claim which is broader in any respect than the claims of the original patent. Such claims may be rejected as being barred by 35 U.S.C. 251. However, when the reissue is applied for within 2 years, the examiner does not go into the question of undue delay.

The same section permits the filing of a reissue application by the assignee of the entire interest only in cases where it does not “enlarge the scope of the claims of the original patent.” Such claims which do enlarge the scope may also be rejected as barred by the statute. In *In re Bennett*, 766 F.2d 524, 226 USPQ 413 (Fed. Cir. 1985), however, the court permitted the erroneous filing by the assignee in such a case to be corrected.

A defective reissue oath affords a ground for rejecting all the claims in the reissue application. See MPEP § 1444.

Note that a reissue application is “special” and remains so even if applicant does not make a prompt reply.

### 706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm’r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm’r Pat. 1909).

#### PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.

Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her letter that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

#### ¶ 7.50 Claims Previously Allowed, Now Rejected, New Art

The indicated allowability of claim [1] is withdrawn in view of the newly discovered reference(s) to [2]. Rejection(s) based on the newly cited reference(s) follow.

#### Examiner Note:

1. In bracket 2, insert the name(s) of the newly discovered reference.
2. Any action including this form paragraph requires the signature of a Primary Examiner. MPEP § 1004.

### 706.05 Rejection After Allowance of Application

See MPEP § 1308.01 for a rejection based on a reference.

### 706.06 Rejection of Claims Copied From Patent

See MPEP § 2307.02.

### 706.07 Final Rejection

37 CFR 1.113. *Final rejection or action.*

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's or patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the case or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can

no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; *Ex parte Hoogendam*, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

### STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

#### ¶ 7.39 Action Is Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

The Office Action Summary Form PTOL-326 should be used in all Office actions up to and including final rejections.

For amendments filed after final rejection, see MPEP § 714.12 and § 714.13.

For final rejection practice in reexamination proceedings see MPEP § 2271.

### 706.07(a) Final Rejection, When Proper on Second Action [R-1]

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609 paragraph (B)(2). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

> When applying any 35 U.S.C. 102(e)/103 references against the claims of an application filed on or after November 29, 1999, the examiner should anticipate that an affidavit (or other adequate proof) averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such an affidavit (or other adequate proof) is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next

Office action final if a new rejection is made. See MPEP § 706.02(1)(3).<

See MPEP § 809.02(a) for actions which indicate generic claims as not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

Form Paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment.

#### ¶ 7.40 Action Is Final, Necessitated by Amendment

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

#### ¶ 7.40.01 Action Is Final, Necessitated by IDS With Fee

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on [1] prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This paragraph should **not** be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.
2. In bracket 1, insert the filing date of the information disclosure statement containing the identification of the item of information used in the new ground of rejection.

### 706.07(b) Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A first action final rejection should be made by using Form Paragraphs 7.41 or 7.41.03, as appropriate.

#### ¶ 7.41 Action Is Final, First Action

This is a [1] of applicant's earlier Application No. [2]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. In bracket 1, insert either --continuation-- or --substitute--, as appropriate.
2. If an amendment was refused entry in the parent case on the grounds that it raised new issues or new matter, this paragraph cannot be used. See MPEP § 706.07(b).
3. This paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP-1 or 2 months).
4. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

#### ¶ 7.41.03 Action Is Final, First Action Following Submission Under 37 CFR 1.53(d), Continued Prosecution Application (CPA)

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This form paragraph is for a first action final rejection in a Continued Prosecution Application filed under 37 CFR 1.53(d).
2. This form paragraph must be preceded by one of form paragraphs 2.30 or 2.35, as appropriate.

### 706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

### 706.07(d) Final Rejection, Withdrawal of, Premature [R-1]

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. >The finality of the Office action must be withdrawn while the application is still pending. The examiner cannot vacate the final rejection once the application is abandoned.<

Form Paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

#### ¶ 7.42 Withdrawal of Finality of Last Office Action

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### 706.07(e) Withdrawal of Final Rejection, General

See MPEP § 714.12 and § 714.13 for amendments after final rejection.

Once a final rejection that is not premature has been entered in an application/reexamination proceeding, it should not be withdrawn at the applicant's or patent owner's request except on a showing under 37 CFR 1.116(b). Further amendment or argument will be considered in certain instances. An amendment that will place the case either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

New grounds of rejection made in an Office action reopening prosecution after the filing of an appeal brief require the approval of the supervisory patent examiner. See MPEP § 1002.02(d).

### **706.07(f) Time for Reply to Final Rejection**

The time for reply to a final rejection is as follows:

(A) *All* final rejections setting a 3-month shortened statutory period (SSP) for reply should contain one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, or 7.41.03 advising applicant that if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established. In no event can the statutory period for reply expire later than 6 months from the date of the final rejection.

(B) If the form paragraph setting a variable reply period is inadvertently not included in the final Office action, the SSP for reply will end 3 months from the date of

the final Office action and cannot be extended other than by making a petition and paying a fee pursuant to 37 CFR 1.136(a). However, if an advisory action is mailed in such a case where the reply to the final action has been filed within 2 months, the examiner should vacate the original SSP and reset the period for reply to correspond with the Office policy set forth in the Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," 1027 O.G. 71 (Feb. 8, 1983). See paragraph (F) below.

(C) This procedure of setting a variable reply period in the final rejection dependent on when applicant files a first reply to a final Office action does not apply to situations where a SSP less than 3 months is set, e.g., reissue litigation applications (1-month SSP) or any reexamination proceeding.

### **ADVISORY ACTIONS**

(D) Where the final Office action sets a variable reply period as set forth in paragraph (A) above AND applicant files a complete first reply to the final Office action within 2 months of the date of the final Office action, the examiner must determine if the reply:

(1) places the application in condition for allowance — then the application should be processed as an allowance and no extension fees are due;

(2) places the application in condition for allowance except for matters of form which the examiner can change without authorization from applicant, MPEP § 1302.04 — then the application should be amended as required and processed as an allowance and no extension fees are due; or

(3) does not place the application in condition for allowance — then the advisory action should inform applicant that the SSP for reply expires 3 months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later, by checking the appropriate box at the top portion of the Advisory Action form, PTOL-303.

If PTOL-303 is not used, then use Form Paragraph 7.67.01 on all advisory actions where a first complete reply has been filed within 2 months of the date of the final Office action.

#### *¶ 7.67.01 Advisory After Final, Heading, 1st Reply Filed Within 2 Months*

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

**Examiner Note:**

1. This paragraph should be used in all advisory actions if:
  - a. it was the FIRST reply to the to the final rejection, and
  - b. it was filed within two months of the date of the final rejection.
2. If a notice of appeal has been filed, also use paragraph 7.68.
3. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(E) Where the final Office action sets a variable reply period as set forth in paragraph (A) above, and applicant does NOT file a complete first reply to the final Office action within 2 months, examiners should use Form Paragraph 7.67.

(F) Where the final Office action does not set a variable reply period as set forth in paragraph (A) above AND applicant does file a complete first reply to the final Office action within 2 months, and if an advisory action is necessary and cannot be mailed within 3 months of the final Office action, the examiner should vacate the original SSP and reset the reply period to expire on the mailing date of the advisory action by using form paragraph 7.67.02. In no case can the statutory period for reply expire later than 6 months from the date of the final Office action. Note that Form Paragraph 7.67.02 can be used with the advisory action (preferable) or after the advisory action is mailed to correct the error of not setting a variable reply period.

*¶ 7.67.02 Advisory After Final, Heading, No Variable SSP Set in Final*

Since the first reply to the final Office action was filed within TWO MONTHS of the mailing date of that action and the advisory action was not mailed within THREE MONTHS of that date, the THREE-MONTH shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the Official Gazette at 1027 O.G. 71, February 8, 1983. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

**Examiner Note:**

1. This paragraph should be used in all advisory actions where:
  - a. the reply is a first reply to the final action;
  - b. the reply was filed within two months of the mailing date of the final; and
  - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.
2. If the final action set a variable SSP, do not use this paragraph, use paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

(G) When an advisory action properly contains either form paragraph 7.67.01 or 7.67.02, the time for applicant to take further action (including the calculation of extension

fees under 37 CFR 1.136(a)) begins to run 3 months from the date of the final rejection, or from the date of the advisory action, whichever is later. Extension fees cannot be prorated for portions of a month. In no event can the statutory period for reply expire later than 6 months from the date of the final rejection. For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such case, any extension fee would then be calculated from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of the 3-month period, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee would be calculated from that date.

**EXAMINER'S AMENDMENTS**

(H) Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action. Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.

(I) Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner.

(J) An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g., when an examiner's amendment is necessary after the shortened statutory period for reply has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a

specified fee to a deposit account. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be given before the extended period expires. The authorization must be made of record in an examiner's amendment by indicating the name of the person making the authorization, when the authorization was given, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged to the deposit account. Form Paragraph 13.02.02 should be used.

¶ 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 Commissioner to charge Deposit Account No. [4] the required fee of \$ [5] for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

**Examiner Note:**

See MPEP § 706.07(f), item 10 which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

**PRACTICE AFTER FINAL**

(K) Replies after final should be processed and considered promptly by all Office personnel.

(L) Replies after final should not be considered by the examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 37 CFR 1.136(a)). See also MPEP § 710.02(e). This requirement also applies to supplemental replies filed after the first reply.

(M) Interviews may be conducted after the expiration of the shortened statutory period for reply to a final Office action but within the 6-month statutory period for reply *without* the payment of an extension fee.

(N) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an *Ex parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters — the correction of which had not yet been required by the examiner.

(O) If prosecution is to be reopened after a final Office action has been replied to, the finality of the previous Office action should be withdrawn to avoid the issue of abandonment and the payment of extension fees. For example, if a new reference comes to the attention of the exam-

iner which renders unpatentable a claim indicated to be allowable, the Office action should begin with a statement to the effect: "The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below." Form Paragraph 7.42 could be used in addition to this statement.

**706.07(g) Transitional After-Final Practice**

*37 CFR 1.129. Transitional procedures for limited examination after final rejection and restriction practice.*

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

\*\*\*\*\*

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

In order to facilitate the completion of prosecution of applications pending in the PTO as of June 8, 1995 and to ease the transition between a 17-year patent term and a 20-year patent term, Public Law 103-465 provided for the further limited reexamination of an application pending for 2 years or longer as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, or 365(c). The further limited reexamination permits applicants to present for consideration, as a matter of right upon payment of a fee, a submission after a final rejection has been issued on an application. An applicant will be able to take advantage of this provision on two separate occasions provided the submission and fee are presented prior to the filing of the Appeal Brief and prior to abandonment of the application. This will have the effect of enabling an applicant to essentially reopen prosecution of the pending application on two separate occasions by paying a fee for each occasion, and avoid the impact of refiling the application to obtain

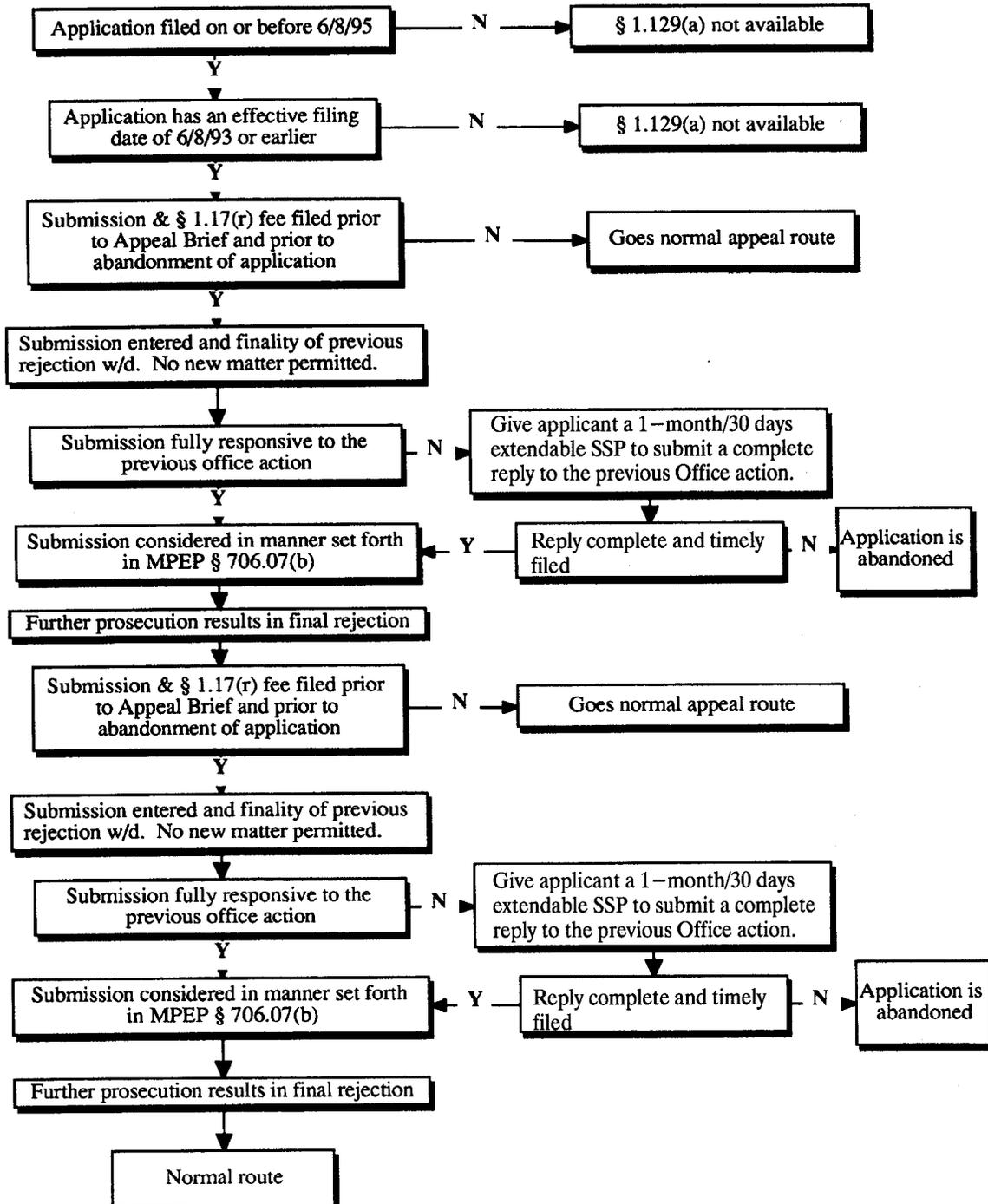
consideration of additional claims and/or information relative to the claimed subject matter. The transitional after-final practice is only available to applications filed on or

before June 8, 1995 and it is not available for reissue or design applications or reexamination proceedings.

The following flowchart illustrates the transitional after-final procedures set forth in 37 CFR 1.129(a).

**Transitional After-Final Provision - 37 CFR 1.129(a)**

Starting June 8, 1995



Effective June 8, 1995, in any pending application having an actual or effective filing date of June 8, 1993 or earlier, applicant is entitled, under 37 CFR 1.129(a), to have a first submission after final rejection entered and considered on the merits, if the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an Appeal Brief under 37 CFR 1.192 and prior to abandonment. For an application entering national stage under 35 U.S.C. 371 or an application filed under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 of a PCT application designating the U.S., the PCT international filing date will be used to determine whether the application has been pending for at least 2 years as of June 8, 1995.

Form Paragraph 7.41.01 may be used to notify applicant that the application qualifies under 37 CFR 1.129(a).

*¶ 7.41.01 Transitional After Final Practice, First Submission (37 CFR 1.129(a))*

This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or 365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a first submission and the appropriate fee of \$ [1] for a [2] entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

**Examiner Note:**

1. This form paragraph may follow any of form paragraphs 7.39- 7.41, 7.67-7.67.02, 7.72-7.78 or 7.80 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under 35 U.S.C. 120, 121 or 365(c) to a previously filed application and no previous fee has been paid under 37 CFR 1.17(r).
2. This form paragraph should NOT be used in a design or reissue application, or in a reexamination proceeding.
3. In bracket 1, insert the current fee for a large or small entity, as appropriate.
4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.

The submission under 37 CFR 1.129(a) may comprise, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings, a new substantive argument and/or new evidence. No amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the

disclosure of the application 35 U.S.C. 132. In view of the fee set forth in 37 CFR 1.17(r), any information disclosure statement previously refused consideration in the application because of applicant's failure to comply with 37 CFR 1.97(c) or (d) will be treated as though it has been filed within one of the time periods set forth in 37 CFR 1.97(b) and will be considered without the petition and petition fee required in 37 CFR 1.97(d), if it complies with the requirements of 37 CFR 1.98.

If the application qualifies under 37 CFR 1.129(a), that is, it was filed on or before June 8, 1995 and the application has an effective U.S. filing date of June 8, 1993 or earlier, the examiner must check to see if the submission and 37 CFR 1.17(r) fee were filed prior to the filing of the Appeal Brief and prior to abandonment of the application. If an amendment was timely filed in reply to the final rejection but the fee set forth in 37 CFR 1.17(r) did not accompany the amendment, examiners will continue to consider these amendments in an expedited manner as set forth in MPEP § 714.13 and issue an advisory action notifying applicant whether the amendment has been entered. If the examiner indicated in an advisory action that the amendment has not been entered, applicant may then pay the fee set forth in 37 CFR 1.17(r) and any necessary fee to avoid abandonment of the application and obtain entry and consideration of the amendment as a submission under 37 CFR 1.129(a). If the submission and the fee set forth in 37 CFR 1.17(r) were timely filed in reply to the final rejection and no advisory action has been issued prior to the payment of the fee set forth in 37 CFR 1.17(r), no advisory action will be necessary. The examiner will notify applicant that the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.129(a). It is noted that if the submission is accompanied by a "conditional" payment of the fee set forth in 37 CFR 1.17(r), i.e., an authorization to charge the fee set forth in 37 CFR 1.17(r) to a deposit account in the event that the submission would not otherwise be entered, the PTO will treat the conditional payment as an unconditional payment of the 37 CFR 1.17(r) fee.

The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in 37 CFR 1.17(r). Upon the timely payment of the fee set forth in 37 CFR 1.17(r), all previously unentered submissions, submissions filed with the 37 CFR 1.17(r) fee, and any submissions filed prior to the mailing of the next Office action will be entered. Any conflicting amendments should be clarified for entry by the applicant upon payment of the 37 CFR 1.17(r) fee. Absent specific instructions for entry, all submissions filed as of the date of the withdrawal of the finality of the previous final action will be entered in the order in which they were filed. Form paragraph 7.42.01 should be used to notify

applicant that the finality of the previous Office action has been withdrawn.

*¶ 7.42.01 Withdrawal of Finality of Last Office Action - Transitional Application Under 37 CFR 1.129(a)*

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.129(a). Applicant's [1] submission after final filed on [2] has been entered.

**Examiner Note:**

Insert --first-- or --second-- in bracket 1.

If a Notice of Appeal and the appeal fee set forth in 37 CFR 1.17(b) were filed prior to or with the payment of the fee set forth 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a).

Upon the timely payment of the fee set forth in 37 CFR 1.17(r), if the examiner determines that the submission is not fully responsive to the previous Office action, e.g., if the submission only includes an information disclosure statement, applicant will be given a new shortened statutory period of 1 month or 30 days, whichever is longer, to submit a complete reply. Form Paragraph 7.42.02 should be used.

*¶ 7.42.02 Nonresponsive Submission Filed Under 37 CFR 1.129(a)*

The timely submission under 37 CFR 1.129(a) filed on [1] is not fully responsive to the prior Office action because [2]. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

**Examiner Note:**

The reasons why the examiner considers the submission not to be fully responsive must be set forth in bracket 2.

After submission and payment of the fee set forth in 37 CFR 1.17(r), the next Office action on the merits may be made final only under the conditions for making a first action in a continuing application final set forth in MPEP § 706.07(b).

Form Paragraph 7.42.03 may be used if it is appropriate to make the first action final following a submission under 37 CFR 1.129(a).

*¶ 7.42.03 Action Is Final, First Action Following Submission Under 37 CFR 1.129(a)*

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.129(a). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the submission under 37 CFR 1.129(a). See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner Note:**

Also use form paragraph 7.41.02 if this is a final rejection following a first submission under 37 CFR 1.129(a).

If a subsequent final rejection is made in the application, applicant would be entitled to have a second submission entered and considered on the merits under the same conditions set forth for consideration of the first submission. Form Paragraph 7.41.02 should be used.

*¶ 7.41.02 Transitional After Final Practice, Second Submission (37 CFR 1.129(a))*

Since the fee set forth in 37 CFR 1.17(r) for a first submission subsequent to a final rejection has been previously paid, applicant, under 37 CFR 1.129(a), is entitled to have a second submission entered and considered on the merits if, prior to abandonment, the second submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a second submission and the appropriate fee of \$ [1] for a [2] entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

**Examiner Note:**

1. This form paragraph is to follow any of form paragraphs 7.39- 7.41 in any application filed prior to June 9, 1995, which has been pending for at least two years as of June 8, 1995, taking into account any reference under 35 U.S.C. 120, 121 or 365(c) to a previously filed application and a first submission fee has been previously paid under 37 CFR 1.17(r).
2. This form paragraph should NOT be used in a design or reissue application or in a reexamination proceeding.
3. In bracket 1, insert the current fee for a large or small entity, as appropriate.
4. In bracket 2, insert --small-- or --large--, depending on the current status of the application.
5. If the fee set forth in 37 CFR 1.17(r) has been twice paid, the provisions of 37 CFR 1.129(a) are no longer available.

Any submission filed after a final rejection made in the application subsequent to the fee set forth in 37 CFR 1.17(r) having been twice paid will be treated in accordance with the current after-final practice set forth in 37 CFR 1.116.

## 707 Examiner's Letter or Action

### 37 CFR 1.104. Nature of examination.

#### (a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(5) Copending applications will be considered by the examiner to be owned by, or subject to an obligation of assignment to, the same person if:

(i) The application files refer to assignments recorded in the Patent and Trademark Office in accordance with Part 3 of this chapter which convey the entire rights in the applications to the same person or organization; or

(ii) Copies of unrecorded assignments which convey the entire rights in the applications to the same person or organization are filed in each of the applications; or

(iii) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; or

(iv) Other evidence is submitted which establishes common ownership of the applications.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

#### (c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(5) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter:

(i) Which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration; and

(ii) Which was the same subject matter waived in the statutory invention registration.

#### (d) Citation of references.

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(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 to file such a statement does not give rise to any implication that

the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

For Office actions in reexamination proceedings, see MPEP § 2260.

Under the current first action procedure, the examiner signifies on the Office Action Summary Form PTOL-326 certain information including the period set for reply, any attachments, and a "Summary of Action," which is the position taken on all the claims.

Current procedure also allows the examiner, in the exercise of his or her professional judgment to indicate that a discussion with applicant's or patent owner's representative may result in agreements whereby the application or patent under reexamination may be placed in condition for allowance and that the examiner will telephone the representative within about 2 weeks. Under this practice the applicant's or patent owner's representative can be adequately prepared to conduct such a discussion. Any resulting amendment may be made either by the applicant's or patent owner's attorney or agent or by the examiner in an examiner's amendment. It should be recognized that when extensive amendments are necessary it would be preferable if they were filed by the attorney or agent of record, thereby reducing the professional and clerical workload in the Office and also providing the file wrapper with a better record, including applicant's arguments for allowability as required by 37 CFR 1.111.

The list of references cited appears on a separate form, Notice of References Cited, PTO-892 (copy in MPEP § 707.05) attached to applicant's copies of the action. Where applicable, Notice of Draftsperson's Patent Drawing Revision, PTO-948 and Notice of Informal Patent Application, PTO-152 are attached to the first action.

The attachments have the same paper number and are to be considered as part of the Office action.

Replies to Office actions should include the 4-digit art unit number and the examiner's name to expedite handling within the Office.

In accordance with the patent statute, "Whenever, on examination, any claim for a patent is rejected, or any objection . . . made", notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included. For rejections under 35 U.S.C. 103, the way in which a reference is modified or plural references are combined should be set out.

In exceptional cases, as to satisfy the more stringent requirements under 37 CFR 1.104(c)(2), and in *pro se* cases

where the inventor is unfamiliar with patent law and practice, a more complete explanation may be needed.

Objections to the disclosure, explanation of references cited but not applied, indication of allowable subject matter, requirements (including requirements for restriction if applicable) and any other pertinent comments may be included. Office Action Summary form PTOL-326, which serves as the first page of the Office action (although a Form PTOL-90 may be used as a coversheet for the correspondence address and the mail date of the Office action), is to be used with all first actions and will identify any allowed claims.

One of Form Paragraphs 7.100, 7.101 should conclude all actions.

#### ¶ 7.100 Name And Number of Examiner To Be Contacted

Any inquiry concerning this communication should be directed to [1] at telephone number (703) [2].

#### Examiner Note:

1. This form paragraph, form paragraph 7.101, or form paragraph 7.102 should be used at the conclusion of all actions.
2. In bracket 1, insert the name of the examiner designated to be contacted first regarding inquiries about the Office action. This could be either the non-signatory examiner preparing the action or the signatory examiner.
3. In bracket 2, insert the individual phone number of the examiner to be contacted.

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

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is (703) [2]. The examiner can normally be reached on [3] from [4] to [5].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [6], can be reached on (703) [7]. The fax phone number for the organization where this application or proceeding is assigned is (703) [8].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [9].

#### Examiner Note:

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off every Friday.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 5:00 PM." Do not insert the core hours .
5. In bracket 6, insert your SPE's name.
6. In bracket 7, insert your SPE's phone number.
7. In bracket 8, insert the appropriate fax number for your organization.
8. In bracket 9, insert the telephone number for your receptionist.

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

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is (703) [2]. The examiner can normally be reached on [3] from [4] to [5]. The examiner can also be reached on alternate [6].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [7], can be reached on (703) [8]. The fax phone number for the organization where this application or proceeding is assigned is (703) [9].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [10].

**Examiner Note:**

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off on alternate Fridays.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 4:00 PM." Do not insert the core hours.
5. In bracket 6, insert the day in each pay-period that is your compressed day off, e.g. "Fridays" for an examiner on a 5/4/9 work schedule with the first Friday off.
6. In bracket 7, insert your SPE's name.
7. In bracket 8, insert your SPE's phone number.
8. In bracket 9, insert the appropriate fax number for your organization.
9. In bracket 10, insert the telephone number for your receptionist.

Where the text of sections of Title 35, U.S. Code was previously reproduced in an Office action, Form Paragraph 7.103 may be used.

*¶ 7.103 Statute Cited in Prior Action*

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

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Response**

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) \_\_\_\_\_ is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- Notice of References Cited, PTO-892
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Interview Summary, PTO-413
- Notice of Informal Patent Application, PTO-152
- Other \_\_\_\_\_

**Office Action Summary**

### 707.01 Primary Examiner Indicates Action for New Assistant

After the search has been completed, action is taken in the light of the references found. Where the assistant examiner has been in the Office but a short time, it is the duty of the primary examiner to go into the case thoroughly. The usual procedure is for the assistant examiner to explain the invention and discuss the references which he or she regards as most pertinent. The primary examiner may indicate the action to be taken, whether restriction or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, the examiner may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

\*>

### 707.02 <Applications Up for Third Action and 5-Year Applications [R-1]

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent official action with a view to finally concluding its prosecution.

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

### 707.05 Citation of References [R-1]

37 CFR 1.104. *Nature of examination.*

\*\*\*\*\*

#### (d) *Citation of references.*

(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as

specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

\*\*\*\*\*

During the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained.

The examiner must \* consider all the prior art references (alone and in combination) cited in the application or reexamination, including those cited by the applicant in a properly submitted Information Disclosure Statement.

Form Paragraph 7.96 may be used as an introductory sentence.

#### ¶ 7.96 *Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. [1]

#### **Examiner Note:**

When such prior art is cited, its relevance should be explained in bracket 1 in accordance with MPEP § 707.05.

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121 or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification to delete any references to prior applications. Therefore, examiners should search all applications based on the actual U.S. filing date of the application rather than on the filing date of any parent U.S. application for which priority is claimed. Examiners should cite of interest all material prior art having an effective filing date after the filing date of the U.S. parent application but before the actual filing date of the application being examined.

Allowed applications should generally contain a citation of pertinent prior art for printing in the patent, even if no claim presented during the prosecution was considered unpatentable over such prior art. Only in those instances where a proper search has not revealed any prior art relevant to the claimed invention is it appropriate to send a case to issue with no art cited. In the case where no prior art is cited, the examiner must write "None" on a form PTO-892 and insert it in the file wrapper. Where references have been cited during the prosecution of parent applications and a continuing application, having no newly cited references, is ready for allowance, the cited references of the parent applications should be listed on a form PTO-892.

The form should then be placed in the file of the continuing application. See MPEP § 1302.12. In a continued prosecution application filed under 37 CFR 1.53(d) or a file wrapper continuing application filed under former 37 CFR 1.62, it is not necessary to prepare a new form PTO-892 since the form from the parent application is in the same file wrapper and will be used by the printer.

In all continuation and continuation-in-part applications, the parent applications should be reviewed for pertinent prior art.

Applicants and/or applicants' attorney in PCT related national applications may wish to cite the material citations from the PCT International Search Report by an information disclosure statement under 37 CFR 1.97 and 1.98 in order to ensure consideration by the examiner.

In those instances where no information disclosure statement has been filed by the applicant and where documents are cited in the International Search Report but neither a copy of the documents nor an English translation (or English family member) is provided, the examiner may exercise discretion in deciding whether to take necessary steps to obtain the copy and/or translation.

Copies of documents cited will be provided as set forth in MPEP § 707.05(a). That is, copies of documents cited by the examiner will be provided to applicant *except* where the documents:

(A) are cited by applicant in accordance with MPEP § 609, § 707.05(b), and § 708.02;

(B) have been referred to in applicant's disclosure statement;

(C) are cited and have been provided in a parent application; or

(D) are U. S. Patents which are cited at allowance (MPEP § 1302.04).

### **707.05(a) Copies of Cited References**

Copies of cited references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the examiner during the prosecution.

Copies of references cited by applicant in accordance with MPEP § 609, § 707.05(b) and § 708.02 are *not* furnished to applicant with the Office action. Additionally, copies of references cited in continuation applications if they had been previously cited in the parent application are not furnished. The examiner should check the left hand col-

umn of form PTO-892 if a copy of the reference is not to be furnished to the applicant.

Copies of foreign patent documents and nonpatent literature (NPL) which are cited by the examiner at the time of allowance will be furnished to applicant with the Office action, and copies of the same will also be retained in the file. This will apply to all allowance actions, including first action allowances and *Ex Parte Quayle* actions.

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.

To assist in providing copies of references, the examiner should:

(A) Write the citation of the references on form PTO-892, "Notice of References Cited";

(B) Place the form PTO-892 in the front of the file wrapper;

(C) Include in the application file wrapper all of the references cited by the examiner which are to be furnished to the applicant and which have been obtained from the classified search file;

(D) Make two copies of each reference which is to be supplied and which has been located in a place other than the classified search file (e.g., textbooks, bound magazines, personal search material, etc.). Using red ink identify one copy as "File Copy" and the other copy as "Applicant's Copy". Both copies should be placed in the application file wrapper;

(E) Turn the application in to the Technical Support Staff for counting. Any application which is handed in without all of the required references will be returned to the examiner. The missing reference(s) should be obtained and the file returned to the Technical support Staff as quickly as possible.

In the case of design applications, procedures are the same as set forth in MPEP § 707.05 (a)-(g) except that less than the entire disclosure of a cited U.S. utility patent may be supplied with the action by the Design Group. Copies of all sheets of drawings relied on and of the first page of the specification are furnished without charge. Any other subject matter, including additional pages of specification relied on by the examiner will be provided without charge. Where an applicant desires a complete copy of a cited U.S. patent, it may be obtained through Patent and Trademark Copy Sales at the usual charge.

<b>Notice of References Cited</b>			Application No. 09/000,000	Applicant(s) Doe		
			Examiner Richard Stone	Group Art Unit 1234	Page 1 of 1	
<b>U.S. PATENT DOCUMENTS</b>						
	DOCUMENT NO.	DATE	NAME		CLASS	SUBCLASS
A	2,717,874	9-1955	VERAIN		422	20
B	2,572,144	10-1951	HEALY		340	467
C	2,137,376	11-1938	ALTORFER		422	307
D	T881002	12-1970	JONES		430	70
E	PP2400	5-1964	BOERNER		PLT	20
F	1,671,843	5-1928	SCOTT		15	104.011
G	D238404	1-1976	OWENS		D6	451
H	RE18406	4-1932	MARINSKY		24	413
I	3,035,319	5-1962	WOLFF		24	274WB
J						
K						
L						
M						
<b>FOREIGN PATENT DOCUMENTS</b>						
	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N	1,345,890	7-1963	GERMANY	MUTHER	19	6
O	683,125	3-1964	CANADA	FISHBOURNE	100	216
P						
Q						
R						
S						
T						
<b>NON-PATENT DOCUMENTS</b>						
	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)					DATE
U	"Chemical Abstracts," Vol. 75, No. 20, p. 163, Abstract No. 120718k. Skutulav, A. I., "Surface Effects During Metal Fatigue".					11/1971
V	Carbawax & Polyethylene Glycols, Carbide Chemical Corporation, p. 5.					1946
W						
X						

### **707.05(b) Citation of Related Art by Applicants**

MPEP § 609 sets forth positive guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the Patent and Trademark Office.

Submitted citations will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing pertinent prior art of which they may be aware, whether or not such art is cited by the applicant.

Prior art submitted by applicant in the manner provided in MPEP § 609 will not be supplied with an Office action.

### **707.05(c) Order of Listing**

In citing references for the first time, the identifying data of the citation should be placed on form PTO-892 "Notice of References Cited", a copy of which will be attached to the Office action. No distinction is to be made between references on which a claim is rejected and those formerly referred to as "pertinent". With the exception of applicant submitted citations, MPEP § 609 and § 708.02, it is recommended that the pertinent features of references which are not used as a basis for rejection, be pointed out briefly.

See MPEP § 1302.12.

### **707.05(d) Reference Cited in Subsequent Actions**

Where an applicant in an amendatory paper refers to a reference that is subsequently relied upon by the examiner, such reference shall be cited by the examiner in the usual manner using a form PTO-892, "Notice of References Cited", unless applicant has listed the reference on a PTO-1449 that has been initialled by the examiner.

### **707.05(e) Data Used in Citing References [R-1]**

37 CFR 1.104(d) (see also MPEP § 707.05 and § 901.05(a)) requires the examiner to give certain data when citing references. The patent number, patent date, name of the patentee, class and subclass are to be given in the citation of U.S. patents. This information is listed on the "Notice of References Cited" form PTO-892 (Copy at MPEP § 707.05). See MPEP § 901.04 for details concerning the various series of U.S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U.S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

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(a).

### **CROSS-REFERENCES**

Official cross-references should be marked "X".

### **FOREIGN PATENTS AND PUBLISHED APPLICATIONS**

In citing foreign patents, the patent number, citation date, name of the country, name of the patentee, and U.S. class and subclass, if appropriate, must be given. Foreign patents searched in those Examining Groups filing by International Patent Classification (IPC) will be cited using the appropriate IPC subclass/group/subgroup. On the file wrapper "Searched" box and PTO-892, the IPC subclass shall be cited in the space provided for "Class", and IPC group/subgroup shall be cited in the space provided for "Subclass".

In actions where references are furnished, and less than the entire disclosure is relied upon, the sheet and page numbers specifically relied upon and the total number of sheets of drawing and pages of specification must be included (except applicant submitted citations). If the entire disclosure is relied on, the total number of sheets and pages are not included, and the appropriate columns on the PTO-892 are left blank.

Publications such as German allowed applications and Belgian and Netherlands printed specifications should be similarly handled.

See MPEP § 901.05(a) for a chart in which foreign language terms indicative of foreign patent and publication dates to be cited are listed.

### **PUBLICATIONS**

See MPEP § 711.06(a) for citation of abstracts, abbreviations and defensive publications. See MPEP § 901.06(c) for citation of Alien Property Custodian publications. In citing a publication, sufficient information should be given to determine the identity and facilitate the location of the publication. For books, the data required by 37 CFR 1.104(d) (MPEP § 707.05) with the specific pages relied on identified together with the Scientific and Technical Information Center (STIC) call number will suffice. The call number appears on the "spine" of the book if the book is thick enough and, in any event, on the back of the title page. Books on interlibrary loan will be marked with the call numbers of the other library, of course. **THIS NUMBER SHOULD NOT BE CITED.** The same convention should be followed in citing articles from periodicals. The call number should be cited for periodicals owned by the Scientific Library, but not for periodicals borrowed from other libraries. In citing periodicals, information sufficient to identify the article includes the author(s) and title of the

article and the title, volume number issue number, date, and pages of the periodical. If the copy relied on is located only in the group making the action (there may be no call number), the additional information, “Copy in Group — —” should be given.

The following are examples of nonpatent bibliographical citations:

(A) *For books:*

Winslow, C. E. A. *Fresh Air and Ventilation*. N.Y., E. P. Dutton, 1926. p. 97-112. T117653.W5.

(B) *For parts of books:*

Smith, J. F. “Patent Searching.” in: Singer, T.E.R., *Information and Communication Practice in Industry* (New York, Reinhold, 1958), pp. 157-165. T 175.S5.

(C) *For encyclopedia articles:*

Calvert, R. “Patents (Patent Law).” in: *Encyclopedia of Chemical Technology* (1952 ed.), vol. 9, pp. 868-890. Ref. TP9.E68.

(D) *For sections of handbooks:*

*Machinery’s Handbook*, 16th ed. New York, International Press, 1959. pp. 1526-1527. TJ151.M3 1959.

(E) *For periodical articles:*

Noyes, W. A. *A Climate for Basic Chemical Research* *Chemical & Engineering News*, Vol. 38, no. 42 (Oct. 17, 1960), pp. 91-95. TP1.I418.

Titles of books and periodicals SHOULD NOT be abbreviated.

A citation to P.S.E.B.M. is meaningless. References are to be cited so that anyone reading a patent may identify and retrieve the publications cited. Give as much bibliographic information as possible, but at least enough to identify the publication. For books, minimal information includes the author, title and date. For periodicals, at least the title of the periodical, the volume number, date, and pages should be given. These minimal citations may be made ONLY IF the complete bibliographic details are unknown or unavailable.

>Where a nonpatent literature reference with a document identification number is cited, the identification number and the class and subclass should be included on form PTO-892. The citation should be as follows: (S00840001) Winslow, C.E.A. *Fresh Air and Ventilation* N.Y., E.P. Dutton, 1926, p. 97-112, TH 7653, W5, 315/22.<

If the original publication is located outside the Office, the examiner should immediately make or order a photocopy of at least the portion relied upon and indicate the class and subclass in which it will be filed, if any.

## >ELECTRONIC DOCUMENTS

An electronic document is one that can be retrieved from an online source (e.g., the Internet, online database,

etc.) or sources found on electronic storage media (e.g., CD-ROM, magnetic disk or tape, etc.). Many references in paper format may also be retrieved as electronic documents. Other references are retrievable only from electronic sources.

The Patent and Trademark Office follows the format recommended by World Intellectual Property Organization (WIPO) Standard ST.14, “Recommendation for the Inclusion of References Cited in Patent Documents.” The format for the citation of an electronic document is as similar as possible to the format used for paper documents of the same type, but with the addition of the following information in the locations indicated, where appropriate:

(A) the type of electronic medium provided in square brackets [ ] after the title of the publication or the designation of the host document, e.g., [online], [CD-ROM], [disk], [magnetic tape];

(B) the date when the document was retrieved from the electronic media in square brackets following after the date of publication, e.g., [retrieved on March 4, 1998], [retrieved on 1998-03-04]. The four-digit year must always be given.

(C) identification of the source of the document using the words “Retrieved from” and its address where applicable. This item will precede the citation of the relevant passages.

(D) specific passages of the text could be indicated if the format of the document includes pagination or an equivalent internal referencing system, or by the first and last words of the passage cited.

Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

If an electronic document is also available in paper form it does not need to be identified as an electronic document, unless it is considered desirable or useful to do so.

The following examples illustrate citations of electronic documents:

### Examples 1-4: Documents retrieved from online databases outside the Internet

#### Example 1:

SU 1511467 A (BRYAN MECH) 1989-09-30 (abstract) World Patents Index [online]. London, U.K.: Derwent Publications, Ltd. [retrieved on 1998-02-24]. Retrieved from: Questel/Orbit, Paris, France. DW9016, Accession No. 90-121923.

**Example 2:**

DONG, X. R. 'Analysis of patients of multiple injuries with AIS-ISS and its clinical significance in the evaluation of the emergency managements', *Chung Hua Wai Ko Tsa Chih*, May 1993, Vol. 31, No. 5, pages 301-302. (abstract) Medline [online]. Bethesda, MD, USA: United States National Library of Medicine [retrieved on 24 February 1998]. Retrieved from: Dialog Information Services, Palo Alto, CA, USA. Medline Accession no. 94155687, Dialog Accession No. 07736604.

**Example 3:**

JENSEN, B. P. 'Multilayer printed circuits: production and application II'. *Elektronik*, June-July 1976, No. 6-7, pages 8, 10,12,14,16. (abstract) INSPEC [online]. London, U.K.: Institute of Electrical Engineers [retrieved on 1998-02-24]. Retrieved from: STN International, Columbus, Ohio, USA. Accession No. 76:956632.

**Example 4:**

JP 3002404 (TAMURA TORU) 1991-03-13 (abstract). [online] [retrieved on 1998-09-02]. Retrieved from: EPO PAJ Database.

**Examples 5-11: Documents retrieved from the Internet****Example 5:****(Entire Work – Book or Report)**

WALLACE, S., and BAGHERZADEH, N. Multiple Branch and Block Prediction. Third International Symposium on High-Performance Computer Architecture [online], February 1997 [retrieved on 1998-05-20]. Retrieved from the Internet:<URL: <http://www.eng.uci.edu/comp.arch/papers-wallace/hpca3-block.ps>>.

**Example 6:****(Part of Work – chapter or equivalent designation)**

National Research Council, Board on Agriculture, Committee on Animal Nutrition, Subcommittee on Beef Cattle Nutrition. Nutrient Requirements of Beef Cattle [online]. 7th revised edition. Washington, DC: National Academy Press, 1996 [retrieved on 1998-06-10]. Retrieved from the Internet: < URL: <http://www2.nap.edu/htbin/docpage/title=Nutrient+Requirements+of+Beef+Cattle%3A+Seventh+Revised+Edition%2C+1996&dload=0&path=/ext5/extra&name=054265%2Erdo&docid=00805F50FE7b%3A840052612&colid=4%7C6%7C41&start=38>> Chapter 3, page 24, table 3-1.

**Example 7:****(Electronic Serial – articles or other contributions)**

Ajtai. Generating Hard Instances of Lattice Problems. *Electronic Colloquium on Computational Complexity*,

Report TR96-007 [online], [retrieved on 1996-01-30]. Retrieved from the Internet <URL: <ftp://ftp.eccc.univ-trier.de/pub/eccc/reports/1996/TR96-007/index.html>>

**Example 8:****(Electronic bulletin boards, message systems, and discussion lists – Entire System)**

BIOMET-L (A forum for the Bureau of Biometrics of New York) [online]. Albany (NY): Bureau of Biometrics, New York State Health Department, July, 1990 [retrieved 1998-02-24]. Retrieved from the Internet: <listserv@health.state.ny.us>, message: subscribe BIOMET-L your real name.

**Example 9:****(Electronic bulletin boards, message systems, and discussion lists – Contributions)**

PARKER, Elliott. 'Re: citing electronic journals'. In PACS-L (Public Access Computer Systems Forum) [online]. Houston (TX): University of Houston Libraries, November 24, 1989; 13:29:35 CST [retrieved on 1998-02-24]. Retrieved from the Internet: <URL:telnet://bruser@a.cni.org>.

**Example 10:****(Electronic mail)**

'Plumb design of a visual thesaurus'. The Scout Report [online]. 1998, vol. 5 no. 3 [retrieved on 1998-05-18]. Retrieved from Internet electronic mail: <listserv@cs.wisc.edu>, subscribe message: info scout-report. ISSN: 1092-3861\cf15.

**Example 11:****(Product Manual/Catalogue or other information obtained from a Web-site)**

Corebuilder 3500 Layer 3 High-function Switch. Datasheet [online]. 3Com Corporation, 1997 [retrieved on 1998-02-24]. Retrieved from the Internet: <URL: [www.3com.com/products/dsheets/400347.html](http://www.3com.com/products/dsheets/400347.html)>.

**Example 12:**

HU D9900111 Industrial Design Application, (HADJDUTEJ TEJIPARI RT, DEBRECEN) 1999-09-28, [online], [retrieved on 1999-10-26] Retrieved from the Industrial Design Database of the Hungarian Patent Office using Internet <URL: <http://www.hpo.hu/English/db/indigo/>>.

**Examples 13 and 14: Documents retrieved from CD-ROM products****Examples 13 and 14:**

JP 0800085 A (TORAY IND INC), (abstract), 1996-05-31. In: Patent Abstracts of Japan [CD-ROM].

**Examples 14:**

HAYASHIDA, O. et. al.: Specific molecular recognition by chiral cage-type cyclophanes having leucine, valine, and alanine residues. In: *Tetrahedron* 1955, Vol. 51 (31), p. 8423-36. In: CA on CD [CD-ROM]. Columbus, OH: CAS.\f5Abstract 124:9350.<

**707.05(f) Effective Dates of Declassified Printed Matter**

In using declassified material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. See *Ex parte Harris*, 79 USPQ 439 (Comm'r Pat. 1948). If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Department of Commerce.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit or declaration under 37 CFR 1.131.

**707.05(g) Incorrect Citation of References**

Where an error in citation of a reference is brought to the attention of the Office by applicant, a letter correcting the error, together with a correct copy of the reference, is sent to applicant. See MPEP § 710.06. Where the error is discovered by the examiner, applicant is also notified and the period for reply restarted. In either case, the examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his or her initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given. See MPEP § 710.06.

Form paragraphs 7.81-7.83 may be used to correct citations or copies of references cited.

*¶ 7.81 Correction Letter Re Last Office Action*

In response to applicant's [1] regarding the last Office action, the following corrective action is taken.

The period for reply of [2] MONTHS set in said Office action is restarted to begin with the mailing date of this letter.

**Examiner Note:**

1. In bracket 1, insert --telephone inquiry of \_\_\_\_-- or --communication dated \_\_\_\_--.
2. In bracket 2, insert new period for reply.
3. This paragraph must be followed by one or more of paragraphs 7.82, 7.82.01 or 7.83.
4. Before restarting the period, the SPE should be consulted.

*¶ 7.82 Correction of Reference Citation*

The reference [1] was not correctly cited in the last Office action. The correct citation is shown on the attached PTO-892.

**Examiner Note:**

1. Every correction MUST be reflected on a corrected or new PTO-892.
2. This paragraph must follow paragraph 7.81.
3. If a copy of the PTO-892 is being provided without correction, use paragraph 7.83 instead of this paragraph.
4. Also use form paragraph 7.82.01 if reference copies are being supplied.

*¶ 7.82.01 Copy of Reference(s) Furnished*

Copies of the following references not previously supplied are enclosed:

**Examiner Note:**

1. The reference copies being supplied must be listed following this paragraph.
2. This paragraph must be preceded by paragraph 7.81 and may also be used with paragraphs 7.82 or 7.83

*¶ 7.83 Copy of Office Action Supplied*

[1] of the last Office action is enclosed.

**Examiner Note:**

1. In bracket 1, explain what is enclosed. For example:
  - a. "A corrected copy"
  - b. "A complete copy"
  - c. A specific page or pages, e.g., "Pages 3-5"
  - d. "A Notice of References Cited, Form PTO-892"
2. This paragraph should follow paragraph 7.81 and may follow paragraphs 7.82 and 7.82.01.

In any case otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by examiner's amendment accompanying the Notice of Allowability form PTOL-37.

If a FOREIGN patent is incorrectly cited: for example, the wrong country is indicated or the country omitted from the citation, the General Reference Branch of the Scientific and Technical Library may be helpful. The date and number of the patent are often sufficient to determine the correct country which granted the patent.

**707.06 Citation of Decisions, Orders Memorandums, and Notices**

In citing court decisions, the USPQ citation should be given and, when it is convenient to do so, the U.S., CCPA or Federal Reporter citation should also be provided.

The citation of manuscript decisions which are not available to the public should be avoided.

It is important to recognize that a federal district court decision that has been reversed on appeal cannot be cited as authority.

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Patent Appeals and Interferences which has not been published but which is available to the public in the patented file should be cited, as “ *Ex parte* — — , decision of the Board of Patent Appeals and Interferences, Patent No. — — — , paper No. — — — , — — — pages.”

Decisions found only in patented files should be cited only when there is no published decision on the same point.

When a Commissioner’s order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such as a specific issue of the *Journal of the Patent and Trademark Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

## 707.07 Completeness and Clarity of Examiner’s Action

37 CFR 1.104. *Nature of examination.*

\*\*\*\*\*

(b) *Completeness of examiner’s action.* The examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

\*\*\*\*\*

Form Paragraphs 7.37 through 7.38 may be used where applicant’s arguments are not persuasive or are moot.

### ¶ 7.37 *Arguments Are Not Persuasive*

Applicant’s arguments filed [1] have been fully considered but they are not persuasive. [2]

#### **Examiner Note:**

1. The examiner must address all arguments which have not already been responded to in the statement of the rejection.
2. In bracket 2, provide explanation as to non-persuasiveness.

### ¶ 7.38 *Arguments Are Moot Because of New Ground(s) of Rejection*

Applicant’s arguments with respect to claim [1] have been considered but are moot in view of the new ground(s) of rejection.

#### **Examiner Note:**

The examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied.

### ¶ 7.37.01 *Unpersuasive Argument: Age of Reference(s)*

In response to applicant’s argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

#### **Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

### ¶ 7.37.02 *Unpersuasive Argument: Bodily Incorporation*

In response to applicant’s argument that [1], the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

#### **Examiner Note:**

1. In bracket 1, briefly restate applicant’s arguments with respect to the issue of bodily incorporation.
2. This form paragraph must be preceded by form paragraph 7.37.

### ¶ 7.37.03 *Unpersuasive Argument: Hindsight Reasoning*

In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### **Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

### ¶ 7.37.04 *Unpersuasive Argument: No Suggestion To Combine*

In response to applicant’s argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, [1].

#### **Examiner Note:**

1. In bracket 1, explain where the motivation for the rejection is found, either in the references, or in the knowledge generally available to one of ordinary skill in the art.
2. This form paragraph must be preceded by form paragraph 7.37.

### ¶ 7.37.05 *Unpersuasive Argument: Nonanalogous Art*

In response to applicant’s argument that [1] is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, [2].

#### **Examiner Note:**

1. In bracket 1, enter the name of the reference which applicant alleges is nonanalogous.
2. In bracket 2, explain why the reference is analogous art.

3. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.06 *Unpersuasive Argument: Number of References*

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.07 *Unpersuasive Argument: Applicant Obtains Result Not Contemplated by Prior Art*

In response to applicant's argument that [1], the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

**Examiner Note:**

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of results not contemplated by the prior art.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.08 *Unpersuasive Argument: Arguing Limitations Which Are Not Claimed*

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., [1]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**Examiner Note:**

1. In bracket 1, recite the features upon which applicant relies, but which are not recited in the claim(s).
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.09 *Unpersuasive Argument: Intended Use*

In response to applicant's argument that [1], a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

**Examiner Note:**

1. In bracket 1, briefly restate applicant's arguments with respect to the issue of intended use.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.10 *Unpersuasive Argument: Limitation(s) in Preamble*

In response to applicant's arguments, the recitation [1] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

**Examiner Note:**

1. In bracket 1, briefly restate the recitation about which applicant is arguing.
2. This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.11 *Unpersuasive Argument: General Allegation of Patentability*

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.12 *Unpersuasive Argument: Novelty Not Clearly Pointed Out*

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

¶ 7.37.13 *Unpersuasive Argument: Arguing Against References Individually*

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**Examiner Note:**

This form paragraph must be preceded by form paragraph 7.37.

## 707.07(a) Complete Action on Formal Matters

Forms are placed in informal applications listing informalities noted by the Draftsperson (form PTO-948) and the Office of Initial Patent Examination (form PTO-152). Each of these forms comprises an original for the file record and a copy to be mailed to applicant as a part of the examiners first action. They are specifically referred to as attachments to the action and are marked with its paper number. In every instance where these forms are to be used, they should be mailed with the examiner's *first* action, and any additional formal requirements which the examiner desires to make should be included in the *first* action.

When any formal requirement is made in an examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to 37 CFR 1.111(b) and state that a complete reply must either comply with all formal requirements or specifically traverse each requirement not complied with.

¶ 7.43.03 Allowable Subject Matter, Formal Requirements Outstanding

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

**Examiner Note:**

This paragraph would be appropriate when changes must be made prior to allowance. For example, when there is a requirement for drawing corrections that have to be submitted for approval or when corrections to the specification have to be made prior to allowance.

**707.07(b) Requiring New Oath**

See MPEP § 602.02.

**707.07(c) Draftsperson's Requirement**

See MPEP § 707.07(a); also MPEP § 608.02(a), (e), and (s).

**707.07(d) Language To Be Used In Rejecting Claims**

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

See MPEP § 706.02 (i), (j), and (m) for language to be used.

Everything of a personal nature must be avoided. Whatever may be the examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he or she should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he or she express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

The examiner should, as a part of the first Office action on the merits, identify any claims which he or she judges, as presently recited, to be allowable and/or should suggest any way in which he or she considers that rejected claims may be amended to make them allowable. If the examiner does not do this, then by implication it will be understood by the applicant or his or her attorney or agent that in the examiner's opinion, as presently advised, there appears to

be no allowable claim nor anything patentable in the subject matter to which the claims are directed.

**IMPROPERLY EXPRESSED REJECTIONS**

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

**707.07(e) Note All Outstanding Requirements**

In taking up an amended application for action the examiner should note in every letter all the requirements outstanding against the application. Every point in the prior action of an examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the *requirement*.

As soon as allowable subject matter is found, correction of all informalities then present should be *required*.

**707.07(f) Answer All Material Traversed**

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

**ANSWERING ASSERTED ADVANTAGES**

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that

the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised.

The importance of answering such arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed Cir. 1995) (Office failed to rebut applicant's argument).

### 707.07(g) Piecemeal Examination [R-1]

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03<.) Major technical rejections on grounds such as lack of proper disclosure, undue breadth, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

(A) Where an application is too informal for a complete action on the merits. See MPEP § 702.01;

(B) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination. See MPEP § 2173.05(n);

(C) Where there is a misjoinder of inventions and there has been no successful telephone request for election. See MPEP § 803, § 806.02, § 812.01;

(D) Where disclosure is directed to perpetual motion. See *Ex parte Payne*, 1904 C.D. 42, 108 O.G. 1049 (Comm'r Pat. 1903). However, in such cases, the best prior

art readily available should be cited and its pertinency pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of *res judicata*, no *prima facie* showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accompanied by rejection on all other available grounds.

### 707.07(h) Notify of Inaccuracies in Amendment

See MPEP § 714.23.

### 707.07(i) Each Claim To Be Mentioned in Each Letter

In every letter, each pending claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the application, its history through successive actions is thus easily traceable. Each action should conclude with a summary of all claims presented for examination.

Claims retained under 37 CFR 1.142 and claims retained under 37 CFR 1.146 should be treated as set out in MPEP § 821 to § 821.03 and § 809.02(c).

See MPEP § 2363.03 for treatment of claims in the application of losing party in interference.

The Index of Claims should be kept up to date as set forth in MPEP § 719.04.

### 707.07(j) State When Claims Are Allowable

#### INVENTOR FILED APPLICATIONS

When, during the examination of a *pro se* application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent. Although this practice may be desirable and is permissible in any case deemed appropriate by the examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

#### ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission

of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

### EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

Form paragraphs 7.43, 7.43.01, and 7.43.02 may be used to indicate allowable subject matter.

#### ¶ 7.43 *Objection to Claims, Allowable Subject Matter*

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ¶ 7.43.01 *Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Independent Claim*

Claim [1] would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### **Examiner Note:**

This form paragraph is to be used only when the noted independent claim(s) have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended to overcome the rejection.

#### ¶ 7.43.02 *Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Dependent Claim*

Claim [1] would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### **Examiner Note:**

This form paragraph is to be used only when the noted dependent claim(s) have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended as indicated.

Form Paragraph 7.97 may be used to indicate allowance of claims.

#### ¶ 7.97 *Claims Allowed*

Claim [1] allowed.

### 707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the letter consecutively. This facilitates their identification in the future prosecution of the case.

### 707.07(l) Comment on Examples

The results of the tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims should be rejected as being based on an insufficient disclosure under 35 U.S.C. 112, first paragraph. *In re Borkowski*, 422 F.2d 904, 164 USPQ 642 (CCPA 1970). The applicant must reply to the rejection or it will be repeated, for example, by providing the results of an actual test or example which has been conducted, or by providing relevant arguments that there is strong reason to believe that the result would be as predicted. Care should be taken that new matter is not entered into the application.

If questions are present as to operability or utility, consideration should be given to the applicability of a rejection under 35 U.S.C. 101.

### 707.08 Reviewing and Initialing by Assistant Examiner

The full surname of the examiner who prepares the Office action will, in all cases, be typed at the end of the action. The telephone number below this should be called if the application is to be discussed or an interview arranged. Form paragraph 7.100, 7.101 or 7.102 should be used.

#### ¶ 7.100 *Name And Number of Examiner To Be Contacted*

Any inquiry concerning this communication should be directed to [1] at telephone number (703) [2].

#### **Examiner Note:**

1. This form paragraph, form paragraph 7.101, or form paragraph 7.102 should be used at the conclusion of all actions.
2. In bracket 1, insert the name of the examiner designated to be contacted first regarding inquiries about the Office action. This could be either the non-signatory examiner preparing the action or the signatory examiner.
3. In bracket 2, insert the individual phone number of the examiner to be contacted.

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

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is (703) [2]. The examiner can normally be reached on [3] from [4] to [5].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [6], can be reached on (703) [7]. The fax phone number for the organization where this application or proceeding is assigned is (703) [8].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [9].

**Examiner Note:**

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off every Friday.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 5:00 PM." Do not insert the core hours .
5. In bracket 6, insert your SPE's name.
6. In bracket 7, insert your SPE's phone number.
7. In bracket 8, insert the appropriate fax number for your organization.
8. In bracket 9, insert the telephone number for your receptionist.

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

Any inquiry concerning this communication or earlier communications from the examiner should be directed to [1] whose telephone number is (703) [2]. The examiner can normally be reached on [3] from [4] to [5]. The examiner can also be reached on alternate [6].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [7], can be reached on (703) [8]. The fax phone number for the organization where this application or proceeding is assigned is (703) [9].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) [10].

**Examiner Note:**

1. In bracket 1, insert your name.
2. In bracket 2, insert your individual phone number.
3. In bracket 3, insert the days that you work every week, e.g. "Monday-Thursday" for an examiner off on alternate Fridays.
4. In brackets 4 and 5, insert your normal duty hours, e.g. "6:30 AM - 4:00 PM." Do not insert the core hours.
5. In bracket 6, insert the day in each pay-period that is your compressed day off, e.g. "Fridays" for an examiner on a 5/4/9 work schedule with the first Friday off.
6. In bracket 7, insert your SPE's name.
7. In bracket 8, insert your SPE's phone number.
8. In bracket 9, insert the appropriate fax number for your organization.
9. In bracket 10, insert the telephone number for your receptionist.

After the action is typed, the examiner who prepared the action reviews it for correctness. The surname or initials of the examiner who prepared the action and the date on which the action was typed should appear below the action. If this examiner does not have the authority to sign the action, he or she should initial above the typed name or initials, and forward the action to the authorized signatory examiner for signing.

**707.09 Signing by Primary or Other Authorized Examiner**

Although only the original is signed, the word "Examiner" and the name of the signer should appear on the original and copies.

All letters and issues should be signed promptly.

**707.10 Entry**

The original, signed by the authorized examiner, is the copy which is placed in the file wrapper. The character of

the action, its paper number and the date of mailing are entered in black ink on the outside of the file wrapper under "Contents".

**707.11 Date**

The mailing date should not be typed when the letter is written, but should be stamped or printed on all copies of the letter after it has been signed by the authorized signatory examiner and the copies are about to be mailed.

**707.12 Mailing**

Copies of the examiner's action are mailed by the group after the original, initialed by the assistant examiner and signed by the authorized signatory examiner, has been placed in the file. After the copies are mailed the original is returned for placement in the file.

**707.13 Returned Office Action**

Letters are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. The examiner should use every reasonable means to ascertain the correct address and forward the letter again, after stamping it "remailed" with the date thereof and redirecting it if there be any reason to believe that the letter would reach applicant at such new address. If the Office letter was addressed to an attorney, a letter may be written to the inventor or assignee informing him or her of the returned letter. The period running against the application begins with the date of re mailing. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. If the period dating from the re mailing elapses with no communication from applicant, the case is forwarded to the Abandoned Files Repository.

**708 Order of Examination [R-1]**

Nonprovisional applications filed in the Patent and Trademark Office and accepted as complete applications are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Nonprovisional applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to 37 CFR 1.102. See 37 CFR 1.496 and MPEP § 1893.03 for order of examination of international applications in the national stage.

Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended

applications) shall be taken up for action in such order as shall be determined by the Commissioner.

Each examiner will give priority to that application in his or her docket, whether amended or new, which has the *oldest effective U.S. filing date*. Except as rare circumstances may justify Group Directors in granting individual exceptions, this basic policy applies to all applications.

The actual filing date of a continuation-in-part application is used for docketing purposes. However, the examiner may act on a continuation-in-part application by using the effective filing date, if desired.

If at any time an examiner determines that the “effective filing date” status of any application differs from what the records show, the technical support staff should be informed, who should promptly amend the records to show the correct status, with the date of correction.

The order of examination for each examiner is to give priority to reissue applications and to reexamination proceedings, with top priority to reissue applications in which litigation has been stayed (MPEP § 1442.03) and to reexamination proceedings involved in litigation (MPEP § 2261), then to those special cases having a fixed 30-day due date, such as examiner’s answers and decisions on motions. Most other cases in the “special” category (for example, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U.S. filing date among them normally controlling priority.

All amendments before final rejection should be responded to within two months of receipt.

### 708.01 List of Special Cases [R-1]

#### *37 CFR 1.102. Advancement of examination.*

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant’s age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

Certain procedures by the examiners take precedence over actions even on special cases.

For example, all papers typed and ready for signature should be completed and mailed.

All issue cases returned with a “Printer Waiting” slip must be processed and returned within the period indicated.

Reissue applications, particularly those involved in stayed litigation, should be given priority.

Applications in which practice requires that the examiner act within a set period, such as 2 months after appellants brief to furnish the examiner’s answers (MPEP § 1208), necessarily take priority over special cases without specific time limits.

If an examiner has a case in which he or she is satisfied that it is in condition for allowance, or in which he or she is satisfied will have to be finally rejected, he or she should give such action forthwith instead of making the case await its turn.

The following is a list of special cases (those which are advanced out of turn for examination):

(A) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders (37 CFR 1.102).

(B) Applications made special as a result of a petition. (See MPEP § 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the Commissioner or an Assistant Commissioner) will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board of Patent Appeals and Interferences.

(C) Applications for reissues, particularly those involved in stayed litigation (37 CFR 1.176).

(D) Applications remanded by an appellate tribunal for further action.

(E) An application, once taken up for action by an examiner according to its effective filing date, should be treated as special by an examiner, art unit or group to which it may subsequently be transferred; exemplary situations include new cases transferred as the result of a telephone election and cases transferred as the result of a timely reply to any official action.

(F) Applications which appear to interfere with other applications previously considered and found to be allowable, or which will be placed in interference with an unexpired patent or patents.

(G) Applications ready for allowance, or ready for allowance except as to formal matters.

(H) Applications which are in condition for final rejection.

(I) Applications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years. See MPEP § 707.02.

(J) Reexamination proceedings, MPEP § 2261.

See also MPEP § 714.13, § 1207 and § 1309.

## 708.02 Petition To Make Special [R-1]

*37 CFR 1.102. Advancement of examination.*

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

New applications ordinarily are taken up for examination in the order of their effective United States filing dates. Certain exceptions are made by way of petitions to make special, which may be granted under the conditions set forth below.

### I. MANUFACTURE

An application may be made special on the ground of prospective manufacture upon the filing of a petition accompanied by the fee under 37 CFR 1.17(i) and a statement by the applicant, assignee or an attorney/agent registered to practice before the Office alleging:

(A) The possession by the prospective manufacturer of sufficient presently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) to manufacture the invention in quantity or that sufficient capital and facilities will be made available if a patent is granted;

If the prospective manufacturer is an individual, there must be a corroborating statement from some responsible party, as for example, an officer of a bank, showing that said individual has the required available capital to manufacture;

(B) That the prospective manufacturer will not manufacture, or will not increase present manufacture, unless certain that the patent will be granted;

(C) That the prospective manufacturer obligates himself, herself or itself, to manufacture the invention, in the

United States or its possessions, in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities; and

(D) That the applicant or assignee has made or caused to be made a careful and thorough search of the prior art, or has a good knowledge of the pertinent prior art.

Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

### II. INFRINGEMENT

Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon payment of the fee under 37 CFR 1.17(i) and the filing of a petition accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office alleging:

(A) That there is an infringing device or product actually on the market or method in use;

(B) That a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and

(C) That he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.

Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

Models or specimens of the infringing product or that of the application should not be submitted unless requested.

### III. APPLICANT'S HEALTH

An application may be made special upon a petition by applicant accompanied by any evidence showing that the state of health of the applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate. No fee is required for such a petition. See 37 CFR 1.102(c).

### IV. APPLICANT'S AGE

An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or

applicant's statement. No fee is required with such a petition. See 37 CFR 1.102(c).

## V. ENVIRONMENTAL QUALITY

The Patent and Trademark Office will accord "special" status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements, i.e., air, water, and soil.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. Such petitions should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the \*Office< explaining how the inventions contribute to the restoration or maintenance of one of these life-sustaining elements. No fee is required for such a petition. See 37 CFR 1.102(c).

## VI. ENERGY

The Patent and Trademark Office will, on petition, accord "special" status to all patent applications for inventions which materially contribute to (A) the discovery or development of energy resources, or (B) the more efficient utilization and conservation of energy resources. Examples of inventions in category (A) would be developments in fossil fuels (natural gas, coal, and petroleum), nuclear energy, solar energy, etc. Category (B) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. Such petitions should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or an attorney/agent registered to practice before the \*Office< explaining how the invention materially contributes to category (A) or (B) set forth above. No fee is required for such a petition, 37 CFR 1.102(c).

## VII. INVENTIONS RELATING TO RECOMBINANT DNA

In recent years revolutionary genetic research has been conducted involving recombinant deoxyribonucleic acid ("recombinant DNA"). Recombinant DNA research appears to have extraordinary potential benefit for mankind. It has been suggested, for example, that research in this field might lead to ways of controlling or treating cancer and hereditary defects. The technology also has possible applications in agriculture and industry. It has been likened in importance to the discovery of nuclear fission and fusion. At the same time, concern has been expressed

over the safety of this type of research. The National Institutes of Health (NIH) has released guidelines for the conduct of research concerning recombinant DNA. These "Guidelines for Research Involving Recombination DNA Molecules," were published in the *Federal Register* of July 7, 1976, 41 FR 27902-27943. NIH is sponsoring experimental work to identify possible hazards and safety practices and procedures.

In view of the exceptional importance of recombinant DNA and the desirability of prompt disclosure of developments in the field, the Patent and Trademark Office will accord "special" status to patent applications relating to safety of research in the field of recombinant DNA. Upon appropriate petition and payment of the fee under 37 CFR 1.17(i), the Office will make special patent applications for inventions relating to safety of research in the field of recombinant DNA. Petitions for special status should be accompanied by statements under 37 CFR 1.102 by the applicant, assignee, or statements by an attorney/agent registered to practice before the \*Office< explaining the relationship of the invention to safety of research in the field of recombinant DNA research. The fee set forth under 37 CFR 1.17(i) must also be paid.

## VIII. SPECIAL EXAMINING PROCEDURE FOR CERTAIN NEW APPLICATIONS — ACCELERATED EXAMINATION

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent case. Each such application must meet on its own all requirements for the new special status;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

The special examining procedure of VIII (accelerated examination) involves the following procedures:

(A) The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The examiner's search will be restricted to the *subject matter encompassed by the claims*. A first action rejection will set a 3-month shortened period for reply.

(B) During the 3-month period for reply, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. In order to afford the examiner time for reflective consideration before the interview, applicant or his or her representative should cause to be placed in the hands of the examiner at least one working day prior to the interview, a

copy (clearly denoted as such) of the amendment that he proposes to file in response to the examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

(C) Subsequent to the interview, or responsive to the examiner's first action if no interview was had, applicant will file the "record" reply. The reply at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as an improper reply.

(D) The examiner will, within 1 month from the date of receipt of applicant's formal reply, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a 3-month period for reply, or a notice of allowance. The examiner's reply to any amendment submitted after final rejection should be prompt and by way of form PTOL-303 or PTOL-327, by passing the case to issue, or by an examiner's answer should applicant choose to file an appeal brief at this time. The use of these forms is not intended to open the door to further prosecution. Of course, where relatively minor issues or deficiencies might be easily resolved, the examiner may use the telephone to inform the applicant of such.

(E) A personal interview after a final Office action will not be permitted unless requested by the examiner. However, telephonic interviews will be permitted where appropriate for the purpose of correcting any minor outstanding matters.

After allowance, these applications are given top priority for printing. See MPEP § 1309.

## IX. SPECIAL STATUS FOR PATENT APPLICATIONS RELATING TO SUPERCONDUCTIVITY

In accordance with the President's mandate directing the Patent and Trademark Office to accelerate the processing of patent applications and adjudication of disputes involving superconductivity technologies when requested by the applicant to do so, the Patent and Trademark Office will, on request, accord "special" status to all patent applications for inventions involving superconductivity materials. Examples of such inventions would include those directed to superconductive materials themselves as well as to their manufacture and application. In order that the Patent and Trademark Office may implement this procedure, we invite all applicants desiring to participate in this program to request that their applications be accorded "special" status. Such requests should be accompanied by a statement under 37 CFR 1.102 that the invention involves superconductive materials. No fee is required.

## **X. INVENTIONS RELATING TO HIV/AIDS AND CANCER**

In view of the importance of developing treatments and cures for HIV/AIDS and cancer and the desirability of prompt disclosure of advances made in these fields, the Patent and Trademark Office will accord “special” status to patent applications relating to HIV/AIDS and cancer.

Applicants who desire that an application relating to HIV/AIDS or cancer be made special should file a petition and the fee under 37 CFR 1.17(i) requesting the Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to the diagnosis, treatment or prevention of HIV/AIDS or cancer.

## **XI. INVENTIONS FOR COUNTERING TERRORISM**

In view of the importance of developing technologies for countering terrorism and the desirability of prompt disclosure of advances made in these fields, the Patent and Trademark Office will accord “special” status to patent applications relating to counter-terrorism inventions.

International terrorism as defined in 18 U.S.C. 2331 includes “activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (i) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping...” The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.

Applicants who desire that an application relating to inventions for countering terrorism be made special should file a petition with the petition fee under 37 CFR 1.17(i) requesting the Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism.

## **XII. SPECIAL STATUS FOR APPLICATIONS RELATING TO BIOTECHNOLOGY FILED BY APPLICANTS WHO ARE SMALL ENTITIES**

Applicants who are small entities may request that their biotechnology applications be granted “special” status. Applicant must file a petition with the petition fee under 37 CFR 1.17(i) requesting the special status and must:

(A) state that small entity status has been established or include a statement establishing small entity status;

(B) state that the subject of the patent application is a major asset of the small entity; and

(C) state that the development of the technology will be significantly impaired if examination of the patent application is delayed, including an explanation of the basis for making the statement.

## **FORMAL REQUIREMENTS OF PETITION TO MAKE SPECIAL**

Any petition to make special should:

(A) be in writing; and

(B) identify the application by application number and filing date.

## **HANDLING OF PETITIONS TO MAKE SPECIAL**

Applications which have been made special will be advanced out of turn for examination and will continue to be treated as special throughout the entire prosecution in the \*>Office<.

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is made of record in the application file, together with the decision thereon. The part of the Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the “Contents” of the file. The decision will be accorded a separate paper number and similarly entered. To ensure entries in the “Contents” in proper order, the technical support staff in the examining group will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. Note MPEP § 1002.02 (s).

Petitions to make special are decided by the Special Program Examiner of the patent examining group to which the application is assigned.

## **708.03 Examiner Tenders Resignation**

Whenever an examiner tenders his or her resignation, the supervisory patent examiner should see that the remaining time as far as possible is used in winding up the old complicated cases or those with involved records and getting as many of his or her amended cases as possible ready for final disposition.

If the examiner has considerable experience in his or her particular art, it is also advantageous to the Office if he or she indicates (in pencil) in the file wrappers of application

in his or her docket, the field of search or other pertinent data that he or she considers appropriate.

## 709 Suspension of Action

### 37 CFR 1.103. Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i). Action will not be suspended when a reply by applicant to an Office action is required.

(b) If action by the Office on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons thereof.

(c) Action on applications in which the Office has accepted a request to publish a defensive publication will be suspended for the entire pendency of these applications except for purposes relating to patent interference proceeding under Subpart E.

(d) Action on applications in which the Office has accepted a request to publish a defensive publication will be suspended for the entire pendency of these applications except for purposes relating to patent interference proceedings under Subpart E.

Suspension of action (37 CFR 1.103) should not be confused with extension of time for reply (37 CFR 1.136). It is to be noted that a suspension of action applies to an impending Office action by the examiner whereas an extension of time for reply applies to action by the applicant. In other words, the action cannot be suspended in an application which contains an outstanding Office action or requirement awaiting reply by the applicant. It is only the action by the examiner which can be suspended under 37 CFR 1.103.

A request that action in an application be delayed will be granted only under the provisions of 37 CFR 1.103, which provides for "Suspension of Action." A petition for suspension of action must be presented as a separate paper accompanied by the petition fee, must request a specific and reasonable period of suspension not greater than 6 months, and must present good and sufficient reasons why the suspension is necessary. If the requirements of 37 CFR 1.103 are not met, applicants should except that their applications, whether new or amended, will be taken up for action by the examiner in order provided in MPEP § 708, Order of Examination.

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

In new applications, the mere inclusion in the transmittal form letter of a request that action be delayed cannot be relied upon to avoid immediate action in the application. Many group art units and examiners have short pendency to first action, and new applications may be taken up for action before preliminary amendments are filed in those

applications. Where a preliminary amendment and petition to suspend action have been filed, it would be helpful to telephone the examiner in that regard to avoid having the amendment and the first office action cross in the mail.

37 CFR 1.103(b) provides for a suspension of Office action by the examiner on his or her own initiative, as in MPEP § 709.01 and § 2315.01. The primary examiner may grant an initial suspension of action for a maximum period of 6 months. This time limitation applies to both suspensions granted at the request of the applicant and suspensions imposed *sua sponte* by the examiner. Any second or subsequent suspension of action in patent applications under 37 CFR 1.103 are decided by the Group Director. See MPEP § 1003.

Suspension of action under 37 CFR 1.103(c) is decided by the Director of Group 3640.

The following form paragraphs should be used in actions relating to suspension of action.

### ¶ 7.52 Suspension of Action, Awaiting New Reference

A reference relevant to the examination of this application may soon become available. *Ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

#### Examiner Note:

1. Maximum period for suspension is six months.
2. The Group Director must approve all second or subsequent suspensions, see MPEP § 1003.

### ¶ 7.53 Suspension of Action, Possible Interference

All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS from the mailing date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

#### Examiner Note:

1. Maximum period for suspension is 6 months.
2. The Group Director must approve all second or subsequent suspensions, see MPEP § 1003.
3. Director's approval must appear on the letter granting any second or subsequent suspension.

### ¶ 7.54 Suspension of Action, Applicant's Request

Pursuant to applicant's request filed on [1], action by the Office is suspended on this application under 37 CFR 1.103(a) for a period of [2] months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP § 709.

#### Examiner Note:

1. Maximum period for suspension is 6 months.
2. Only the Group Director can grant second or subsequent suspensions, see MPEP § 1003. Such approval must appear on the Office letter.

### ¶ 7.56 Request for Suspension, Denied, Outstanding Office Action

Applicant's request filed [1], for suspension of action in this application under 37 CFR 1.103(a), is denied as being improper. Action cannot

be suspended in an application awaiting a reply by the applicant. See MPEP § 709.

### 709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee

Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant. See *Ex parte Jones*, 1924 C.D. 59, 327 O.G. 681 (Comm'r Pat. 1924).

Because of this, where one of several applications of the same inventor which contain overlapping claims gets into an interference, it was formerly the practice to suspend action by the Office on the applications not in the interference in accordance with *Ex parte McCormick*, 1904 C.D. 575, 113 O.G. 2508 (Comm'r Pat 1924).

However, the better practice would appear to be to reject claims in an application related to another application in interference over the counts of the interference and in the event said claims are not canceled in the outside application, prosecution of said application should be suspended pending the final determination of priority in the interference.

If, on the other hand, applicant wishes to prosecute the outside application, and presents good reasons in support, prosecution should be continued. *Ex parte Bullier*, 1899 C.D. 155, 88 O.G. 1161 (Comm'r Pat 1899); *In re Seebach*, 88 F.2d 722, 33 USPQ 149 (CCPA 1937); *In re Hammell*, 332 F.2d 796, 141 USPQ 832 (CCPA 1964). See MPEP § 804.03.

## 710 Period for Reply

35 U.S.C. 133. *Time for prosecuting application.*

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

35 U.S.C. 267. *Time for taking action in Government applications.*

Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

See MPEP Chapter 1200 for period for reply when appeal is taken or court review sought.

Extension of time under 35 U.S.C. 267 is decided by the Director of Group 3640.

## 710.01 Statutory Period

37 CFR 1.135. *Abandonment for failure to reply within time period.*

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

The maximum statutory period for reply to an Office action is 6 months, 35 U.S.C. 133. Shortened periods are currently used in practically all cases, see MPEP § 710.02(b).

37 CFR 1.135 provides that if no reply is filed within the time set in the Office action under 37 CFR 1.134 or as it may be extended under 37 CFR 1.136, the application will be abandoned unless an Office action indicates that another consequence, such as disclaimer, will take place.

37 CFR 1.135(b) has been amended to clarify that: (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.135(c) has been amended to change the practice of providing a non-statutory time limit (generally 1 month) during which an applicant may supply an omission to a previous reply. Under the new practice, the examiner may set a shortened statutory time period (generally 1 month) during which an applicant must supply the omission to the previous reply to avoid abandonment.

The prior practice under 37 CFR 1.135(c) was to set a time limit during which the applicant could supply the omission to the previous reply. Failure to supply the omission resulted in the abandonment of the application as of the due date for the previous reply. Filing a new application during the time limit, but beyond the due date for the previous reply, could have caused a loss of patent rights due to the lack of copendency between the applications.

37 CFR 1.135(c) now authorizes the examiner to accept a reply to a non-final Office action that is *bona fide* and is substantially complete but for an inadvertent omission as an adequate reply to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135. When a *bona fide* attempt to reply includes an inadvertent omission that precludes action on

the merits of the application (e.g., an amendment is unsigned or improperly signed, or presents an amendment with additional claims so as to require additional fees pursuant to 37 CFR 1.16(b), (c), or (d)), the examiner may consider that reply adequate to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135, and give the applicant a shortened statutory time period of 1 month to correct the omission (e.g., provide a duplicate paper or ratification, or submit the additional claims fees or cancel the claims so that no fee is due). The failure to timely supply the omission will result in abandonment under 35 U.S.C. 133 and 37 CFR 1.135. Extensions of time under 37 CFR 1.136(a) or (b) will be available, unless the action setting the shortened statutory period indicates otherwise.

When a *bona fide* attempt to reply includes an omission that does not preclude action on the merits of the application (e.g., a reply fails to address a rejection or objection), the examiner may waive the deficiency in the reply and act on the application. The examiner may repeat and make final the rejection, objection, or requirement that was the subject of the omission. Thus, a reply to a non-final Office action that is *bona fide* but includes an omission may be treated by: (A) issuing an Office action that does not treat the reply on its merits but requires the applicant to supply the omission to avoid abandonment; or (B) issuing an Office action that does treat the reply on its merits (and which can also require the applicant to supply the omission to avoid abandonment).

Finally, whether a 1-month shortened statutory time period is provided to the applicant to supply the omission to the previous reply is within the discretion of the examiner. Where the examiner determines that the omission was not inadvertent (e.g., the applicant is abusing the provisions of 37 CFR 1.135(c) to gain additional time to file a proper reply or to delay examination of the application), the examiner should notify the applicant of the omission in the reply and advise the applicant that the omission to the previous reply must be supplied within the period for reply to the prior action, including extensions of time under 37 CFR 1.136(a), if permitted. See also MPEP § 714.03.

### 710.01(a) Statutory Period, How Computed

The actual time taken for reply is computed from the date stamped or printed on the Office action to the date of receipt by the Office of applicant's reply. No cognizance is taken of fractions of a day and applicant's reply is due on the corresponding day of the month 6 months or any lesser number of months specified after the Office action.

For example, reply to an Office action with a 3-month shortened statutory period, dated November 30 is due on

the following February 28 (or 29 if it is a leap year), while a reply to an Office action dated February 28 is due on May 28 and not on the last day of May. *Ex parte Messick*, 7 USPQ 57 (Comm'r Pat. 1930).

A 1-month extension of time extends the time for reply to the date corresponding to the Office action date in the following month. For example, a reply to an Office action mailed on January 31 with a 3-month shortened statutory period would be due on April 30. If a 1-month extension of time were given, the reply would be due by May 31. The fact that April 30 may have been a Saturday, Sunday, or Federal holiday has no effect on the extension of time. Where the period for reply is extended by some time period other than "1-month" or an even multiple thereof, the person granting the extension should indicate the *date* upon which the extended period for reply will expire.

When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired. In the above example where May 31 is not a Saturday, Sunday, or Federal holiday and no further extensions of time are obtained prior to the end of the 6-month statutory period, the application would be abandoned as of June 1. The fact that June 1 may be a Saturday, Sunday, or Federal holiday does not change the abandonment date since the reply was due on May 31, a business day. See MPEP § 711.04(a) regarding the pulling and forwarding of abandoned applications.

A 30-day period for reply in the Office means 30 calendar days including Saturdays, Sundays, and federal holidays. However, if the period ends on a Saturday, Sunday, or Federal holiday, the reply is timely if it is filed on the next succeeding business day. If the period for reply is extended, the time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

The date of receipt of a reply to an Office action is given by the "Office date" stamp which appears on the reply paper.

In some cases the examiner's letter does not determine the beginning of a statutory reply period. In all cases where the statutory reply period runs from the date of a previous action, a statement to that effect should be included.

Since extensions of time are available pursuant to 37 CFR 1.136(a), it is incumbent upon applicants to recognize the date for reply so that the proper fee for any extension will be submitted. Thus, the date upon which any reply is due will normally be indicated only in those instances where the provisions of 37 CFR 1.136(a) are not available. See MPEP Chapter 2200 for reexamination proceedings.

## 710.02 Shortened Statutory Period and Time Limit Actions Computed

### 37 CFR 1.136. Extensions of time.

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or
- (v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extension of time in reexamination proceedings; and § 1.645 for extension of time in interference proceedings.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extension of time in interference proceedings; and § 1.550(c) for extension of time in reexamination proceedings.

37 CFR 1.136 implements 35 U.S.C. 41(a)(8) which directs the Commissioner to charge fees for extensions of time to take action in patent applications.

Under 37 CFR 1.136 (35 U.S.C. 133) an applicant may be required to reply in a shorter period than 6 months, not

less than 30 days. Some situations in which shortened periods for reply are used are listed in MPEP § 710.02(b).

In other situations, for example, the rejection of a copied patent claim, the examiner may require applicant to reply on or before a specified date. These are known as time limit actions and are established under authority of 35 U.S.C. 6. Some situations in which time limits are set are noted in MPEP § 710.02(c). The time limit requirement should be typed in capital letters where required.

An indication of a shortened time for reply should appear prominently on the first page of all copies of actions in which a shortened time for reply has been set so that a person merely scanning the action can easily see it.

Shortened statutory periods are subject to the provisions of 37 CFR 1.136(a) unless applicant is notified otherwise in an Office action. See MPEP § 710.02(e) for a discussion of extensions of time. See Chapter 2200 for reexamination proceedings.

### 710.02(b) Shortened Statutory Period: Situations In Which Used

Under the authority given him by 35 U.S.C. 133, the Commissioner has directed the examiner to set a shortened period for reply to every action. The length of the shortened statutory period to be used depends on the type of reply required. Some specific cases of shortened statutory periods for reply are given below. These periods may be changed under special, rarely occurring circumstances.

A shortened statutory period may not be less than 30 days (35 U.S.C. 133).

#### 1 MONTH (NOT LESS THAN 30 DAYS)

(A) Requirement for restriction or election of species only (no action on the merits) ..... MPEP § 809.02(a) and § 817.

(B) When a reply by an applicant for a nonfinal Office action is *bona fide* but includes an inadvertent omission, the examiner may set a 1 month (not less than 30 days) shortened statutory time period to correct the omission .... MPEP § 710.01 and § 714.03.

#### 2 MONTHS

(A) Winning party in a terminated interference to reply to an unanswered Office action ..... MPEP § 2363.02.

Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered Office action, final rejection or any other action, the primary examiner notifies the applicant of this fact. In this case reply to the Office action is required within a shortened statutory period running from the date of such notice. See *Ex parte Peterson*, 49 USPQ 119, 1941 C.D. 8, 525 O.G. 3 (Comm'r Pat. 1941).

(B) To reply to an *Ex parte Quayle* Office action ..... MPEP § 714.14.

When an application is in condition for allowance, except as to matters of form, such as correction of the specification, a new oath, etc., the application will be considered special and prompt action taken to require correction of formal matters. Such action should include an indication on the Office Action Summary form PTOL-326 that prosecution on the merits is closed in accordance with the decision in *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). A 2-month shortened statutory period for reply should be set.

(C) Multiplicity rejection — no other rejection ..... MPEP § 2173.05(n).

### 3 MONTHS

To reply to any Office action on the merits.

### PERIOD FOR REPLY RESTARTED

Incorrect citation by examiner — regardless of time remaining in original period .... MPEP § 710.06.

### 710.02(c) Specified Time Limits: Situations In Which Used

There are certain situations in which the examiner specifies a time for the applicant to take some action, and the applicant's failure to timely take the specified action results in a consequence other than abandonment. Situations in which a specified time limit for taking an action is set are as follows:

(A) Where a member of the public files a petition under 37 CFR 1.14(e) for access to an application, the PTO may give the applicant a specified time (usually 3 weeks) within which to state any objections to the granting of the petition for access and the reasons why it should be denied. The failure to timely reply will not affect the prosecution of the application (assuming that it is still pending), but will result in the PTO rendering a decision on the petition for access without considering any objections by the applicant. See MPEP § 103.

(B) Where an information disclosure statement complies with the requirements set forth in 37 CFR 1.97 (including the requirement for fees or statement under 37 CFR 1.97(e) based upon the time of filing), but part of the content requirement of 37 CFR 1.98 has been inadvertently omitted, the examiner may set a 1-month time limit for completion of the information disclosure statement. The failure to timely comply will not result in abandonment of the application, but will result in the information disclosure statement being placed in the application file with the

noncomplying information not being considered. See MPEP § 609.

(C) Where an application is otherwise allowable but contains a traverse of a restriction requirement, the applicant may be given a specified time (e.g., a 1-month time limit) to cancel claims to the nonelected invention or species or take other appropriate action (i.e., petition the restriction requirement under 37 CFR 1.144). The failure to timely file a petition under 37 CFR 1.144 (or cancel the claims to the nonelected invention or species) will not result in abandonment of the application, but will be treated as authorization to cancel the claims to the non-elected invention or species, and the application will be passed to issue. See 37 CFR 1.141 and 1.144, and MPEP § 809.02(c) and § 821.01.

(D) A portion of 37 CFR 1.605(a) provides that in suggesting claims for interference:

The applicant to whom the claim is suggested shall amend the application by presenting the suggested claim within a time specified by the examiner, not less than one month. Failure or refusal of an applicant to timely present the suggested claim shall be taken without further action as a disclaimer by the applicant of the invention defined by the suggested claim.

The failure to timely present the suggested claim will not result in abandonment of the application, but will be treated as a disclaimer by the applicant of the invention defined by the suggested claim. See MPEP § 2305.02.

Where the failure to take the specified action may result in abandonment (e.g., filing a new complete appeal brief correcting the deficiencies in a prior appeal brief), a time period should be set for taking the specified action. Where the condition of the application requires that such action not be subject to extensions under 37 CFR 1.136, the action should specify that the provisions of 37 CFR 1.136 (or 1.136(a)) do not apply to the time period for taking action (i.e., a specified time limit should not be set simply to exclude the possibility of extending the period for reply under 37 CFR 1.136).

### 710.02(d) Difference Between Shortened Statutory Periods for Reply and Specified Time Limits [R-1]

Examiners and applicants should not lose sight of the distinction between a specified time for a particular action and a shortened statutory period for reply under 35 U.S.C. 133:

(A) The penalty attaching to failure to take a particular action within a specified time is a loss of rights in regard to the particular matter (e.g., the failure to timely copy suggested claims results in a disclaimer of the involved subject matter). On the other hand, a failure to reply within the set

statutory period under 35 U.S.C. 133 results in abandonment of the entire application. Abandonment of an application is not appealable, but a petition to revive may be granted if the delay was unavoidable (37 CFR 1.137(a)) or unintentional (37 CFR 1.137(b)).

(B) As a specified time or time limit is not a shortened statutory period under 35 U.S.C. 133, the Office may specify a time for taking action (or a time limit) of less than the 30 day minimum specified in 35 U.S.C. 133. See MPEP § 103.

(C) Where an applicant replies a day or two after the specified time, the delay may be excused by the examiner if satisfactorily explained. The examiner may use his or her discretion to request an explanation for the delay if the reason for the delay is not apparent from the reply. A reply 1 day late in an application carrying a shortened statutory period under 35 U.S.C. 133, no matter what the excuse, results in abandonment. Extensions of the statutory period under 35 U.S.C. 133 may be obtained under 37 CFR 1.136, provided the extension does not go beyond the 6-month statutory period from the date of the Office action (35 U.S.C. 133).

The 2-month time period for filing an appeal brief on appeal to the Board of Patent Appeals and Interferences (37 CFR 1.192(a)) and the 1-month time period for filing a new appeal brief to correct the deficiencies in a defective appeal brief (37 CFR 1.192(d)) are time periods, but are not (shortened) statutory periods for reply set pursuant to 35 U.S.C. 133. Thus, these periods are, unless otherwise provided, extendable by up to 5 months under 37 CFR 1.136(a), and, in an exceptional situation, further extendable under 37 CFR 1.136(b) (i.e., these periods are not statutory periods subject to the 6-month maximum set in 35 U.S.C. 133). In addition, the failure to file an appeal brief (or a new appeal brief) within the time period set in 37 CFR 1.192(a) (or (d)) results in dismissal of the appeal. The dismissal of an appeal results in abandonment, unless there is any allowed claim(s) (see MPEP § 1215.04), in which case the examiner should cancel the nonallowed claims and issue the application.

>The 2-month time period for reply to A Notice to File Missing Parts of an Application is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions of time of up to 5 months under 37 CFR 1.136(a), followed by additional time under 37 CFR 1.136(b), when appropriate, are permitted.<

### 710.02(e) Extension of Time [R-1]

*37 CFR 1.136. Extensions of time.*

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by stat-

ute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 1.193(b);
- (iii) The reply is a request for an oral hearing submitted pursuant to § 1.194(b);
- (iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or
- (v) The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. A reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application (§ 1.135), but in no situation may an applicant reply later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197; § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extension of time in reexamination proceedings; and § 1.645 for extension of time in interference proceedings.

(3) A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission.

(b) When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.645 for extension of time in interference proceedings; and § (c) for extension of time in reexamination proceedings.

37 CFR 1.136 provides for two distinct procedures to extend the period for action or reply in particular situations. The procedure which is available for use in a particular situation will depend upon the circumstances. 37 CFR 1.136(a) permits an applicant to file a petition for extension of time and a fee as set forth in 37 CFR 1.17(a) up to 5 months after the end of the time period set to take action except:

- (A) where prohibited by statute,
- (B) where prohibited by one of the items listed in the rule, or

(C) where applicant has been notified otherwise in an Office action.

The petition and fee must be filed within the extended time period for reply requested in the petition and can be filed prior to, with, or without the reply. The filing of the petition and fee will extend the time period to take action up to 5 months dependent on the amount of the fee paid except in those circumstances noted above. 37 CFR 1.136(a) will effectively reduce the amount of paperwork required by applicants and the Office since the extension will be effective upon filing of the petition and payment of the appropriate fee and without acknowledgment or action by the Office and since the petition and fee can be filed with or without the reply. 37 CFR 1.136(b) provides for requests for extensions of time upon a showing of sufficient cause when the procedure of 37 CFR 1.136(a) is not available. Although the petition and fee procedure of 37 CFR 1.136(a) will normally be available within 5 months after a set period for reply has expired, an extension request for cause under 37 CFR 1.136(b) must be filed during the set period for reply. Extensions of time in interference proceedings are governed by 37 CFR 1.645.

It should be very carefully noted that neither the primary examiner nor the Commissioner has authority to extend the shortened statutory period unless a petition for the extension is filed. While the shortened period may be extended within the limits of the statutory 6 months period, no extension can operate to extend the time beyond the 6 months.

Any request under 37 CFR 1.136(b) for extension of time for reply must state a reason in support thereof. Such extensions will only be granted for sufficient cause and must be filed prior to the end of the set period for reply.

Extensions of time with the payment of a fee pursuant to 37 CFR 1.136 are possible in reply to most Office actions of the examiner. Exceptions include:

(A) all extensions in a reexamination proceeding (see 37 CFR 1.550(c) and MPEP § 2265);

(B) all extensions during an interference proceeding (but not preparatory to an interference where a claim is suggested for interference);

(C) those specific situations where an Office action states that the provisions of 37 CFR 1.136(a) are not applicable (e.g., in reissue applications associated with litigation, or where an application in allowable condition has nonelected claims and time is set to cancel such claims); and

(D) those limited instances where applicant is given a specified time limit to take certain actions.

The fees for extensions of time are set forth in 37 CFR 1.17(a) and are subject to a 50% reduction for persons or concerns qualifying as small entities. The fees itemized at

37 CFR 1.17(a) are cumulative. Thus, if an applicant has paid an extension fee in the amount set forth in 37 CFR 1.17(a)(1) for a 1-month extension of time and thereafter decides that an additional 1 month is needed, the proper fee would be the amount set forth in 37 CFR 1.17(a)(2) less the amount set forth in 37 CFR 1.17(a)(1) which was previously paid.

37 CFR 1.136(a)(3) provides that:

(A) a written request may be submitted in an application that is an authorization to treat any concurrent or future reply that requires a petition for an extension of time under 37 CFR 1.136(a) to be timely, as incorporating a petition for extension of time for the appropriate length of time;

(B) an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under 37 CFR 1.136(a) to be timely; and

(C) submission of the fee set forth in 37 CFR 1.17(a) will be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under 37 CFR 1.136(a) to be timely.

This is a change in practice, in that applicants were previously required to file a petition (some writing that manifested an intent to obtain an extension of time) in reply to the Office action for which the extension was requested.

37 CFR 1.136(a)(3) is a “safety net” to avoid a potential loss of patent rights for applicants who inadvertently omitted a petition, but who had:

(A) previously filed a written request to treat a reply requiring an extension of time as incorporating a petition for such extension of time;

(B) previously filed an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees; or

(C) submitted the fee set forth in 37 CFR 1.17(a) with the reply.

The Office strongly recommends including a written petition for any desired extension of time in reply to the Office action for which the extension was requested to avoid processing delays.

A proper petition may be a mere sentence such as

The applicant herewith petitions the Commissioner of Patents and Trademarks to extend the time for reply to the Office action dated \_\_\_\_ for \_\_\_\_ month(s) from \_\_\_\_ to \_\_\_\_ . Submitted herewith is a check for \$\_\_\_\_ to cover the cost of the extension [Please Charge my deposit account number \_\_\_\_ , in the amount of \$ \_\_\_\_ to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.]

37 CFR 1.136(a)(2) provides, in part, that “[t]he date on which the petition and the fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee.” Thus, a petition under 37 CFR 1.136(a) need not be accompanied by a reply (e.g., in situations in which the extension is necessary for copendency with a continuing application). 37 CFR 1.136(a)(2), however, clarifies that “[a] reply must be filed prior to the expiration of the period of extension to avoid abandonment of the application” under 35 U.S.C. 133 and 37 CFR 1.135 (e.g., where the extension is obtained solely for the purpose of copendency with a continuing application, and no reply is filed, the application will become abandoned upon expiration of the so-extended period for reply).

>While a petition for an extension of time under 37 CFR 1.136(a) must be filed within the extended period for reply, the petition need not be filed within the original shortened statutory period for reply. If a petition for an extension of time under 37 CFR 1.136(a) (with or without a reply) requests an insufficient period of extension such that the petition would be filed outside the so-extended period for reply, but the period for reply could be further extended under 37 CFR 1.136(a) such that the petition would be filed within the further extended period for reply, it is Office practice to simply treat the petition for extension of time as requesting the period of extension necessary to make the petition filed within the further extended period for reply if the petition or application contains an authorization to charge extension fees or fees under 37 CFR 1.17 to a deposit account. That is, in such situations a petition for an extension of time under 37 CFR 1.136(a) is simply construed as requesting the appropriate period of extension. For example, if a petition (and requisite fee) for a two-month extension of time containing an authorization to charge fee deficiencies to a deposit account are filed in an application four and one-half months after the date a notice of appeal was filed in that application, it is Office practice to treat the petition as requesting the period of extension (three months) necessary to make the petition filed within the extended period for reply. This practice applies even if no further reply (appeal brief or continued prosecution application (CPA) under 37 CFR 1.53(d) ) is filed in the application to be treated as a constructive petition for an extension of time under 37 CFR 1.136(a)(3).<

To facilitate processing, any petition for an extension of time (or petition to revive under 37 CFR 1.137) in which a continuing application is filed in lieu of a reply should specifically refer to the filing of the continuing application and also should include an express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

Applicants are cautioned that an extension of time will not be effected in the prior application by filing a petition for an extension of time, extension fee, or fee authorization, in the continuing application. This is because the petition for an extension of time (or constructive petition under 37 CFR 1.136(a)(3)) must be directed toward and filed in the application to which it pertains in accordance with 37 CFR 1.4 and 1.5.

Where a reply is filed after the set period for reply has expired and no petition or fee accompanies it, the reply will not be accepted as timely until the petition (which may be a constructive petition under 37 CFR 1.136(a)(3)) and the appropriate fee are submitted. For example, if an Office action sets a 3-month period for reply and applicant replies in the 4th month and includes only the petition for a 1-month extension of time, the reply is not acceptable until the fee is filed. If the fee is not filed until the 5th month, an additional fee for the 2nd month extension would also be required in order to render the reply timely.

An extension of time under 37 CFR 1.136 is not necessary when submitting a supplemental reply to an Office action if a complete first reply was timely filed in reply to the Office action.

When the provisions of 37 CFR 1.136(a) are not applicable, extensions of time for cause pursuant to 37 CFR 1.136(b) are possible. Any such extension must be filed on or before the day on which the reply is due. The mere filing of such a request will not effect any extension. All such requests are to be decided by the Group Director. No extension can operate to extend the time beyond the 6-month statutory period.

If a request for extension of time under 37 CFR 1.136(b) is filed in duplicate and accompanied by a stamped return-addressed envelope, the Office will indicate the action taken on the duplicate and return it promptly in the envelope. Utilization of this procedure is optional on the part of applicant. In this procedure, the action taken on the request should be noted on the original and on the copy which is to be returned. The notation on the original, which becomes a part of the file record, should be signed by the person granting or denying the extension, and the name and title of that person should also appear in the notation on the copy which is returned to the person requesting the extension.

When the request is granted, no further action by the Office is necessary. When the request is granted in part, the extent of the extension granted will be clearly indicated on both the original and on the copy which is to be returned. When the request is denied, the reason for the denial will be indicated on both the original and on the copy which is to be returned or a formal decision letter giving the reason for the denial will be forwarded promptly after the mailing of the duplicate.

If the request for extension of time is granted, the due date is computed from the date stamped or printed on the action, as opposed to the original due date. See MPEP § 710.01(a). For example, a reply to an action with a 3-month shortened statutory period, dated November 30, is due on the following February 28 (or 29, if it is a leap year). If the period for reply is extended an additional month, the reply becomes due on March 30, not on March 28.

For purposes of convenience, a request for an extension of time may be personally delivered and left with the appropriate area to become an official paper in the file without routing through the Mail Center. The person who accepts the request for an extension of time will have it date stamped.

If duplicate copies of a request for an extension of time under 37 CFR 1.136(b) are hand delivered to an examining group, both copies are dated, either stamped approved or indicated as being approved in part or denied, and signed. The duplicate copy is returned to the delivering person regardless of whether the request was signed by a registered attorney or agent, either of record or acting in a representative capacity, the applicant or the assignee of record of the entire interest.

If the request for extension under 37 CFR 1.136(b) is not presented in duplicate, the applicant should be advised promptly by way of form PTOL-327 regarding action taken on the request so that the file record will be complete.

Form Paragraph 7.98 may be used where a reply is filed late but an extension of time is possible.

*¶ 7.98 Reply Is Late, Extension of Time Suggested*

Applicant's reply was received in the Office on [1], which is after the expiration of the period for reply set in the last Office action mailed on [2]. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office action under 37 CFR 1.136(a).

**Examiner Note:**

Since the provisions of 37 CFR 1.136(a) do not apply to reexamination proceedings or to litigation related reissue applications, do not use this paragraph in these cases.

**FINAL REJECTION — TIME FOR REPLY**

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection.

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

See also MPEP § 706.07(f).

**EXTENSIONS OF TIME TO SUBMIT AFFIDAVITS AFTER FINAL REJECTION**

Frequently, applicants request an extension of time, stating as a reason therefor that more time is needed in which to submit an affidavit. When such a request is filed after final rejection, the granting of the request for extension of time is without prejudice to the right of the examiner to question why the affidavit is now necessary and why it was not earlier presented. If applicant's showing is insufficient, the examiner may deny entry of the affidavit, notwithstanding the previous grant of an extension of time to submit it. The grant of an extension of time in these circumstances serves merely to keep the case from becoming abandoned while allowing the applicant the opportunity to present the affidavit or to take other appropriate action. Moreover, prosecution of the application to save it from abandonment must include such timely, complete and proper action as required by 37 CFR 1.113. The admission of the affidavit for purposes other than allowance of the application, or the refusal to admit the affidavit, and any proceedings relative thereto, shall not operate to save the application from abandonment.

Implicit in the above practice is the fact that affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection. *In re*

*Affidavit Filed After Final Rejection*, 152 USPQ 292 (Comm'r Pat. 1966).

Failure to file a reply during the shortened statutory period results in abandonment of the application.

Extensions of time to appeal to the courts under 37 CFR 1.304 is covered in MPEP § 1216.

## **EXTENSION OF TIME AFTER PAYMENT OF ISSUE FEE**

The statutory (nonextendable) time period for payment of the issue fee is 3 months from the date of the Notice of Allowance (35 U.S.C. 151). In situations where informalities such as drawing corrections or submission of supplemental or corrected declarations are outstanding at the time of allowance, applicants will be notified on the PTOL-37 (Notice of Allowability) of such informalities. While extensions of time under 37 CFR 1.136(a) are available to correct such informalities, the issue fee must be paid within the 3-month period.

### **710.04 Two Periods Running**

There sometimes arises a situation where two different periods for reply are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception involving suggested claims, see MPEP § 2305.03.

#### **710.04(a) Copying Patent Claims**

Where, in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for reply are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for reply to the rejection (either first or final). The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. See *Ex parte Milton*, 63 USPQ 132 (P.O. Super Exam. 1938). See also MPEP § 2305.02.

#### **710.05 Period Ending on Saturday, Sunday, or a Federal Holiday**

35 U.S.C. 21. *Filing date and day for taking action.*

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(b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia the

action may be taken, or the fee paid, on the next succeeding secular or business day.

37 CFR 1.7. *Times for taking action; Expiration on Saturday, Sunday, or Federal holiday.*

Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

The Federal holidays are New Year's Day, January 1; Martin Luther King's birthday, the third Monday in January; Washington's Birthday, the third Monday in February; Memorial Day, the last Monday in May; Independence Day, July 4; Labor Day, the first Monday in September; Columbus Day, the second Monday in October; Veteran's Day, November 11; Thanksgiving Day, the fourth Thursday in November; Christmas Day, December 25; Inauguration day (January 20, every 4 years). Whenever a Federal holiday falls on a Sunday, the following day (Monday) is also a Federal holiday. Exec. Order No. 10,358, 17 Fed. Reg., 5269; 5 U.S.C. 6103.

When a Federal holiday falls on a Saturday, the preceding day, Friday, is considered to be a Federal holiday and the Patent and Trademark Office will be closed for business on that day (5 U.S.C. 6103). Accordingly, any action or fee due on such a Federal holiday Friday or Saturday is to be considered timely if the action is taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

When an amendment is filed a day or two later than the expiration of the period fixed by statute, care should be taken to ascertain whether the last day of that period was Saturday, Sunday, or a Federal holiday and if so, whether the amendment was filed or the fee paid on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday.

An amendment received on such succeeding day which was due on Saturday, Sunday, or Federal holiday is endorsed on the file wrapper with the date of receipt. The Saturday, Sunday, or Federal holiday is also indicated.

### **710.06 Situations When Reply Period Is Reset or Restarted**

Where the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of

the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to refile any action (MPEP § 707.13), the action should be correspondingly redated, as it is the refile date that establishes the beginning of the period for reply. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be restarted and any appropriate extension fee will be required to render a reply timely. The Office letter correcting the error will note that the time period for reply remains as set forth in the previous Office action.

See MPEP § 505, § 512, and § 513 for Patent and Trademark Office practice on date stamping documents.

In the event that correspondence from the Office is received late (A) due to delays in the U.S. Postal Service, or (B) because the mail was delayed in leaving the PTO (the postmark date is later than the mail date printed on the correspondence), applicants may petition to reset the period for reply, which petition shall be evaluated according to the guidelines which follow. Where the PTO action involved in the petition was mailed by an examining group, the authority to decide such petitions has been delegated to the Group Director. See Notice entitled "Petition to reset a period for response due to late receipt of a PTO action," 1160 O.G. 14 (March 1, 1994).

#### **PETITIONS TO RESET A PERIOD FOR REPLY DUE TO LATE RECEIPT OF A PTO ACTION**

The PTO will grant a petition to restart the previously set period for reply to a PTO action to run from the date of receipt of the PTO action at the correspondence address when the following criteria are met:

(A) the petition is filed within 2 weeks of the date of receipt of the PTO action at the correspondence address;

(B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g., at least 1 month of a 2- or 3-month reply period had elapsed); and

(C) the petition includes (1) evidence showing the date of receipt of the PTO action at the correspondence address (e.g., a copy of the PTO action having the date of receipt of the PTO action at the correspondence address stamped thereon, a copy of the envelope (which contained the PTO action) having the date of receipt of the PTO action at the correspondence address stamped thereon, etc.), and (2) a statement setting forth the date of receipt of the PTO action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the PTO action at the correspondence address.

There is no statutory requirement that a shortened statutory period of longer than 30 days to reply to a PTO action be reset due to delay in the mail or in the PTO. However, when a substantial portion of the set reply period had elapsed on the date of receipt at the correspondence address (e.g., at least 1 month of a 2- or 3-month period had elapsed), the procedures set forth above for late receipt of a PTO action are available. Where a PTO action was received with less than 2 months remaining in a shortened statutory period of 3 months the period may be restarted from the date of receipt. Where the period remaining is between 2 and 3 months, the period will be reset only in extraordinary situations, e.g., complex PTO action suggesting submission of comparative data.

#### **PETITIONS TO RESET A PERIOD FOR REPLY DUE TO A POSTMARK DATE LATER THAN THE MAIL DATE PRINTED ON A PTO ACTION**

The PTO will grant a petition to restart the previously set period for reply to a PTO action to run from the postmark date shown on the PTO mailing envelope which contained the PTO action when the following criteria are met:

(A) the petition is filed within 2 weeks of the date of receipt of the PTO action at the correspondence address;

(B) the reply period was for payment of the issue fee, or the reply period set was 1 month or 30 days; and

(C) the petition includes (1) evidence showing address (e.g., copy of the PTO action having the date of receipt of the PTO action at the correspondence address stamped thereon, etc.), (2) a copy of the envelope which contained the PTO action showing the postmark date, and (3) a statement setting forth the date of receipt of the PTO action at the correspondence address and stating that the PTO action was received in the postmarked envelope.

The provisions of 37 CFR 1.8 and 1.10 apply to the filing of the above-noted petitions with regard to the requirement that the petition be filed within 2 weeks of the date of receipt of the PTO action.

The showings outlined above may not be sufficient if there are circumstances that point to a conclusion that the

PTO action may have been delayed after receipt rather than a conclusion that the PTO action was delayed in the mail or in the PTO.

## 711 Abandonment

*37 CFR 1.135. Abandonment for failure to reply within time period.*

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

*37 CFR 1.138. Express abandonment.*

An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant and the assignee of record, if any, and identifying the application. An application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application, in accordance with 37 CFR 1.135 and 1.138, is one which is removed from the Office docket of pending applications through:

### (A) formal abandonment

(1) by the applicant (acquiesced in by the assignee if there is one), or

(2) by the attorney or agent of record including an associate attorney or agent appointed by the principal attorney or agent and whose power is of record but not including a registered attorney or agent acting in a representative capacity under 37 CFR 1.34(a) except where a continuing application is filed; or

(B) failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the application.

Where an applicant, himself or herself, formally abandons an application and there is a corporate assignee, the acquiescence must be made through an officer whose official position is indicated.

## 711.01 Express or Formal Abandonment [R-1]

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.

A letter of abandonment properly signed becomes effective when an appropriate official of the Office takes action thereon. When so recognized, the date of abandonment may be the date of recognition or a different date if so specified in the letter itself. For example, where a continuing application is filed with a request to abandon the prior application as of the filing date accorded the continuing application, the date of the abandonment of the prior application will be in accordance with the request once it is recognized.

Action in recognition of an express abandonment may take the form of an acknowledgment by the examiner or by the Publishing Division of the receipt of the express abandonment, indicating that it is in compliance with 37 CFR 1.138.

It is suggested that divisional applications be reviewed before filing to ascertain whether the prior application should be abandoned. Care should be exercised in situations such as these as the Office looks on express abandonments as acts of deliberation, intentionally performed.

Applications may be expressly abandoned as provided for in 37 CFR 1.138. When a letter expressly abandoning an application (not in issue) is received, the examiner should acknowledge receipt thereof, and indicate whether it does or does not comply with the requirements of 37 CFR 1.138.

The filing of a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) or a file wrapper continuing application under former 37 CFR 1.62(g) is considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application.

Form paragraph 7.88 may be used to acknowledge proper express abandonments.

### ¶ 7.88 Acknowledge Express Abandonment

This application is abandoned in view of the letter of express abandonment complying with 37 CFR 1.138 filed on [1].

**Examiner Note:**

1. With the exception of express abandonments resulting from the filing of a continued prosecution application under 37 CFR 1.53(d) or a file wrapper continuation application under former 37 CFR 1.62 or when filed with a continuing application, all express abandonments must be signed by all of the inventors, the owners of the entire interest, or an attorney or agent of record.
2. The provisions of 37 CFR 1.34 do **not** apply to express abandonments unless filed with a continuing application.

If the letter expressly abandoning the application does comply with 37 CFR 1.138, the examiner should respond by using a “Notice of Abandonment” form PTO-1432, and by checking the appropriate box(es). The examiner’s signature should appear at the bottom of the form. If such a letter does not comply with the requirements of 37 CFR 1.138, a fully explanatory letter should be sent.

Form Paragraph 7.89 may be used to acknowledge improper express abandonments.

¶ 7.89 *Letter of Express Abandonment, Improper*

The letter filed on [1] does not comply with the requirements of 37 CFR 1.138, and therefore is not a proper letter of express abandonment.

**Examiner Note:**

The reasons why the letter fails to comply with 37 CFR 1.138 must be fully explained, e.g., the individual signing the express abandonment is not of record. See the “Examiner Note” of form paragraph 7.88.

A letter of express abandonment which is not timely filed (because it was not filed within the period for reply), is not acceptable to expressly abandon the application. The letter of express abandonment should be endorsed on the file wrapper and placed in the application file but not formally entered.

The application should be pulled for abandonment after expiration of the minimum permitted period for reply (see MPEP § 711.04(a)) and applicant notified of the abandonment for failure to reply within the statutory period. See MPEP § 711.02 and § 711.04(c).

In view of the doctrine set forth in *Ex parte Lasscell*, 1884 C.D. 66, 29 O.G. 861 (Comm’r Pat. 1884), an amendment >filed after the filing date of an application< canceling all of the claims, even though said amendment is signed by the applicant himself/herself and the assignee, is not an express abandonment. Such an amendment is regarded as nonresponsive and should not be entered, and applicant

should be notified as explained in MPEP § 714.03 to § 714.05.

An attorney or agent not of record in an application may file a withdrawal of an appeal under 37 CFR 1.34(a) except in those instances where such withdrawal would result in abandonment of the application. In such instances the withdrawal of appeal is in fact an express abandonment.

**AFTER NOTICE OF ALLOWANCE**

Letters of abandonment of allowed applications are acknowledged by the Publishing Division.

37 CFR 1.313 provides that an allowed application will not be withdrawn from issue except by approval of the Commissioner, and that after the issue fee has been paid, it will not be withdrawn for any reason except:

- (A) mistake on the part of the Office;
- (B) a violation of 37 CFR 1.56 or illegality in the application;
- (C) unpatentability of one or more claims;
- (D) for interference; or
- (E) for abandonment to permit consideration of an information disclosure statement under 37 CFR 1.97 in a continuing application.

See MPEP § 711.05 and § 1308. In cases where 37 CFR 1.313 precludes giving effect to an express abandonment, the appropriate remedy is a petition, with fee, under 37 CFR 1.183, showing an extraordinary situation where justice requires suspension of 37 CFR 1.313.

**APPLICATION IN INTERFERENCE**

A written declaration of abandonment of the application signed only by an attorney or agent of record, when the application sought to be expressly or formally abandoned is the subject of an interference proceeding under 35 U.S.C. 135, is not effective to terminate the interference, and will not be considered until after *ex parte* prosecution is resumed. In order to be effective to terminate an interference proceeding, an abandonment of the application must be signed by the inventor with the written consent of the assignee where there has been an assignment.

A copy of an appropriate form for use in filing an express abandonment under 37 CFR 1.138 in favor of a continuing application is reproduced below.

EXAMINATION OF APPLICATIONS

711.01

PTO/SB/24 (12-97)  
Approved for use through 9/30/00. OMB 0651-0031  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>EXPRESS ABANDONMENT UNDER 37 CFR 1.138</b>		Docket Number (Optional)
In re Application of		
Application Number		Filed
For		
Group Art Unit	Examiner	
<p>To Assistant Commissioner for Patents Washington, DC 20231</p> <p>I request that the above-identified application be expressly abandoned.</p> <p><input type="checkbox"/> The above-identified application is expressly abandoned in favor of a continuing application.</p> <p>I am the</p> <p><input type="checkbox"/> applicant.</p> <p><input type="checkbox"/> assignee of record of the entire interest.</p> <p><input type="checkbox"/> attorney or agent of record.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a) (May act only if the box above, stating that the application is expressly abandoned in favor of a continuing application, is checked. ) Attorney or agent registration number if acting under 37 CFR 1.34(a) _____ (Attorney or agent registration number)</p> <p style="text-align: center;">_____ Signature</p> <p style="text-align: center;">_____ Date</p> <p style="text-align: center;">_____ Typed or printed name</p>		

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

## 711.02 Failure To Take Required Action During Statutory Period

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant “fails to reply” to an office action within the fixed statutory period. This failure may result either from (A) failure to reply within the statutory period, or (B) insufficiency of reply, i.e., failure to file a “complete and proper reply, as the condition of the case may require” within the statutory period (37 CFR 1.135(b)).

When an amendment is filed after the expiration of the statutory period, the application is abandoned and the remedy is to petition to revive it. The examiner should notify the applicant or attorney at once that the application has been abandoned by using form PTOL-1432. The proper boxes on the form should be checked and the blanks for the dates of the proposed amendment and the Office action completed. The late amendment is endorsed on the file wrapper but not formally entered. See MPEP § 714.17.

Form Paragraph 7.90 may also be used.

### ¶ 7.90 Abandonment, Failure to Reply

This application is abandoned in view of applicant’s failure to submit a proper reply to the Office action mailed on [1] within the required period for reply.

#### Examiner Note:

1. A letter of abandonment should not be mailed until after the period for requesting an extension of time under 37 CFR 1.136(a) has expired.
2. In **pro se** cases see form paragraph 17.10.

To pass on questions of abandonment, it is essential that the examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant’s reply must reach the Office within the set shortened statutory period for reply dating from the date stamped or printed on the Office letter or within the extended time period obtained under 37 CFR 1.136. (See MPEP § 710 to § 710.06.)

For a petition to withdraw a holding of abandonment based upon failure to receive an Office action, see MPEP § 711.03(c).

### 711.02(a) Insufficiency of Reply

Abandonment may result from a situation where applicant’s reply is within the period for reply but is not fully responsive to the Office action. But see MPEP § 710.02(c). See also MPEP § 714.02 to § 714.04.

### ¶ 7.91 Reply Is Not Fully Responsive, Extension of Time Suggested

The reply filed on [1] is not to be fully responsive to the prior Office action because: [2]. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

#### Examiner Note:

1. In bracket 2, set forth why the examiner considers there to be a failure to take “complete and proper action” within the statutory period.
2. If the reply appears to be a **bona fide** attempt to respond with an inadvertent omission, do not use this paragraph; instead use form paragraph 7.95.

### 711.02(b) Special Situations Involving Abandonment [R-1]

The following situations involving questions of abandonment often arise, and should be specially noted:

(A) Copying claims from a patent when not suggested by the Patent and Trademark Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

(B) An application may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Patent Appeals and Interferences. See MPEP § 1215.01 to § 1215.04.

(C) An application may become abandoned through dismissal of appeal to the Court of Appeals for the Federal Circuit or civil action, where there was not filed prior to such dismissal an amendment putting the case in condition for issue or fully responsive to the Board’s decision. Abandonment results from failure to perfect an appeal as required by the Court of Appeals for the Federal Circuit. See MPEP § 1215.04 and § 1216.01.

(D) Where claims are suggested for interference near the end of the period for reply running against the case, see MPEP § 2305.

(E) Where an FWC application under former 37 CFR 1.62 was filed. See MPEP § 201.06(b) and § 711.01.

(F) Where a continued prosecution application (CPA) under 37 CFR 1.53(d) is filed. See MPEP § 201.06(d) and § 711.01.

### 711.02(c) Termination of Proceedings

“Termination of proceedings” is an expression found in 35 U.S.C. 120. As there stated, a second application is considered to be copending with an earlier application if it is filed before

- (A) the patenting,
- (B) the abandonment of, or

(C) termination of proceedings on the earlier application.

“Before” has consistently been interpreted, in this context, to mean “not later than.”

In each of the following situations, proceedings are terminated:

(A) When the issue fee is not paid and the application is abandoned for failure to pay the issue fee, proceedings are terminated as of the date the issue fee was due and the application is the same as if it were abandoned after midnight on that date (but if the issue fee is later accepted, on petition, the application is revived). See MPEP § 711.03(c).

(B) If an application is in interference wherein all the claims present in the application correspond to the counts and the application loses the interference as to all the claims, then proceedings on that application are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

(C) Proceedings are terminated in an application after decision by the Board of Patent Appeals and Interferences as explained in MPEP § 1214.06.

(D) Proceedings are terminated after a decision by the court as explained in MPEP § 1216.01.

### **711.03 Reconsideration of Holding of Abandonment; Revival**

When advised of the abandonment of his or her application, applicant may either ask for reconsideration of such holding, if he or she disagrees with it on the basis that there is no abandonment in fact; or petition for revival under 37 CFR 1.137.

#### **711.03(a) Holding Based on Insufficiency of Response**

Applicant may deny that the reply was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for reply, he or she may reverse his or her holding as to whether or not an amendment received during such period was responsive and act on a case of such character which he or she has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. See also MPEP § 714.03.

#### **711.03(b) Holding Based on Failure To Reply Within Period**

When an amendment reaches the Patent and Trademark Office after the expiration of the period for reply and there

is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the examiner and the applicant may disagree as to the date on which the period for reply commenced to run or ends. In this situation, as in the situation involving sufficiency of reply, the applicant may take issue with the examiner and point out to him or her that his or her holding was erroneous.

### **711.03(c) Petitions Relating to Abandonment [R-1]**

*37 CFR 1.135. Abandonment for failure to reply within time period.*

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

*37 CFR 1.137. Revival of abandoned application or lapsed patent.*

(a) *Unavoidable.* Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

(b) *Unintentional.* Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

(c) In a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995, any petition to revive pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any terminal disclaimer pursuant to this paragraph must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought. The provisions of this paragraph do not apply to lapsed patents.

(d) Any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of § 1.136.

(e) A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section so as to be pending for a period of no longer than twelve months from its filing date. Under no circumstances will a provisional application be regarded as pending after twelve months from its filing date.

#### 37 CFR 1.181. *Petition to the Commissioner.*

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

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(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings.

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## I. PETITION TO WITHDRAW HOLDING OF ABANDONMENT

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed \*within< 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), **subject to such other requirements as may be imposed**). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(c) because abandonment of an application is a *per se* failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a *per se* failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned.

In any event, where the record indicates that the applicant intentionally delayed the filing of a petition to withdraw the holding of abandonment, the Office may simply dismiss the petition as untimely (37 CFR 1.181(f)) solely on the basis of such intentional delay in taking action in the

application without further addressing the merits of the petition. Obviously, intentional delay in seeking the revival of an abandoned application precludes relief under 37 CFR 1.137(a) or (b) (discussed below).

## II. PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. >For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.< See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid

abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

## III. PETITIONS TO REVIVE AN ABANDONED APPLICATION, OR ACCEPT LATE PAYMENT OF ISSUE FEE

37 CFR 1.137 provides for the revival of abandoned applications and lapsed patents for the failure:

- (A) to timely reply to an Office requirement in a provisional application;
- (B) to timely prosecute in a nonprovisional application;
- (C) to timely pay the issue fee for a design application;
- (D) to timely pay the issue fee for a utility or plant application; and
- (E) to timely pay any outstanding balance of the issue fee (lapsed patents).

A petition under 37 CFR 1.137(a) requires:

- (A) the required reply, unless previously filed;
- (B) the petition fee as set forth in 37 CFR 1.17(l);
- (C) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (D) any terminal disclaimer required pursuant to 37 CFR 1.137(c).

A petition under 37 CFR 1.137(b) requires:

- (A) the required reply, unless previously filed;
- (B) the petition fee as set forth in 37 CFR 1.17(m);
- (C) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- (D) any terminal disclaimer required pursuant to 37 CFR 1.137(c).

The Commissioner may require additional information where there is a question whether the delay was unintentional.

#### A. Reply Requirement

Unlike a petition to withdraw the holding of abandonment, a petition to revive under 37 CFR 1.137 must be accompanied by, *inter alia*, the required reply. See *Ex parte Richardson*, 1906 Dec. Comm'r Pat. 83 (1905) (“This Office has no authority to revive a case upon which no action has been taken within [the period for reply], but merely has authority to determine after an action is taken whether the delay in presenting it was unavoidable.”). Generally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

#### 1. Abandonment for Failure to Pay the Issue Fee

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR 1.137, the statutory provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive. See *Brenner v. Ebbert*, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968). 35 U.S.C. 151 authorizes the acceptance of a delayed payment of the issue fee, if the issue fee “is submitted ... and the delay in payment is shown to have been unavoidable.” 35 U.S.C. 41(a)(7) likewise authorizes the acceptance of an “unintentionally delayed payment of the fee for issuing each patent.” Thus, 35 U.S.C. 41(a)(7) and 151 each require payment of the issue fee as a condition of reviving an application abandoned or patent lapsed for failure to pay the issue fee. Therefore, the filing of a continuing application without payment of the issue fee or any outstanding balance thereof is not an acceptable reply in an application abandoned or patent lapsed for failure to pay the issue fee or any portion thereof.

The Notice of Allowance requires the timely payment of the issue fee in effect on the date of its mailing to avoid abandonment of the application. In instances in which there is an increase in the issue fee by the time of payment of the issue fee required in the Notice of Allowance, the Office will mail a notice requiring payment of the balance of the issue fee then in effect. See *In re Mills*, 12 USPQ2d 1847, 1848 (Comm'r Pat. 1989). The phrase “for failure to pay the issue fee or any portion thereof” applies to those instances in which the applicant fails to pay either the issue fee required in the Notice of Allowance or the balance of the issue fee required in a subsequent notice. In such instances, the reply must be the issue fee then in effect, if no portion of the issue fee was previously submitted, or any

outstanding balance of the issue fee then in effect, if a portion of the issue fee was previously submitted.

#### 2. Abandonment for Failure to Reply in a Nonprovisional Application

A reply to a non-final action in a nonprovisional application abandoned for failure to prosecute may be either an argument or an amendment under 37 CFR 1.111, whereas a reply under 37 CFR 1.113 to a final action “must include cancellation of, or appeal from the rejection of, each claim so rejected.” Accordingly, in a nonprovisional application abandoned for failure to reply to a final action, the reply required for consideration of a petition to revive must be:

- (A) a Notice of Appeal (and appeal fee);
- (B) an amendment that cancels all the rejected claims or otherwise *prima facie* places the application in condition for allowance; or
- (C) the filing of a continuing application.

When a notice of appeal is the reply filed pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1), the time period under 37 CFR 1.192 for filing the appeal brief will be set by the Commissioner in the decision granting the petition. In those situations where abandonment occurred because of the failure to file an appeal brief, the reply required pursuant to 37 CFR 1.137(a)(1) or 1.137(b)(1) must be either: (A) an appeal brief in compliance with 37 CFR 1.192(c) (and appeal brief fee); or (B) the filing of a continuing application.

In a nonprovisional application abandoned for failure to prosecute, the filing of a continuing application is a permissive reply. An applicant in a nonprovisional application abandoned for failure to prosecute may file a reply under 37 CFR 1.111 to a non-final Office action or a reply under 37 CFR 1.113 (e.g., Notice of Appeal) to a final Office action, or may simply file a continuing application as the required reply. The Office, however, may require the filing of a continuing application (or request for further examination pursuant to 37 CFR 1.129(a)) to meet the reply requirement of 37 CFR 1.137(a)(1) (or 37 CFR 1.137(b)(1)) where, under the circumstances of the application, treating a reply under 37 CFR 1.111 or 1.113 would place an inordinate burden on the Office. Exemplary circumstances of when treating a reply under 37 CFR 1.111 or 1.113 may place an inordinate burden on the Office are where:

- (A) an application has been abandoned for an inordinate period of time;
- (B) an application file contains multiple or conflicting replies to the last Office action; and

(C) the reply or replies submitted under 37 CFR 1.137(a)(1) (or 37 CFR 1.137(b)(1)) are questionable as to compliance with 37 CFR 1.111 or 1.113.

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the examining group to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The patent examiner is instructed that if the reply places the application in condition for allowance, the patent examiner should write in the margin of the reply "OK to enter upon revival." If, on the other hand, the reply would not place the application in condition for allowance, the patent examiner is instructed to complete form PTOL-303 and return the **unmailed** form to the Office of Petitions with the application. If the petition is otherwise grantable and the patent examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If such an amendment does not place the application into condition for allowance, the petition will not be granted. A copy of the form PTOL-303 is not mailed with the decision on the petition but merely serves as an advisory to the Office of Petitions regarding the decision of the patent examiner on the amendment after final rejection.

The grant of a petition under 37 CFR 1.137 is not a determination that any reply under 37 CFR 1.111 is complete. Where the proposed reply is to a non-final Office action, the petition may be granted if the reply appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect. In this limited situation, the patent examiner should send out a letter giving a 1-month shortened statutory period under 37 CFR 1.135(c) for correction of the error or omission. Extensions of time under 37 CFR 1.136(a) are permitted. If applicant does not correct the omission within the shortened statutory period (including any extension), the application is again abandoned.

### B. *Petition Fee Requirement*

35 U.S.C. 41(a)(7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by \*the\* petition fee \*\* set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is \*\* set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory

prerequisite to revival of the abandoned application, and cannot be waived.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

The phrase "unless the petition is filed under [35 U.S.C.] 133 or 151" signifies that petitions to revive filed on the basis of "unavoidable" delay (under 35 U.S.C. 133 or 151) are a subset of petitions to revive filed on the basis of unintentional delay. That is, "unavoidable" delay and "unintentional" delay are not alternatives; "unavoidable" delay is the epitome of "unintentional" delay. Any petition to revive an abandoned application or lapsed patent must meet the minimal "unintentional" delay threshold, and an applicant need only pay the fee specified in 37 CFR 1.17(l) (rather than the fee specified in 37 CFR 1.17(m)) if the petition is also accompanied by an adequate showing that the entire delay in filing the required reply, from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a), was unavoidable.

### C. *Unintentional and Unavoidable Delay*

>Petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file and are evaluated under the less stringent "unintentional delay" standard. Applicants determining whether to file a petition to revive an application under 37 CFR 1.137(b) or 1.137(a) should take the following into account:

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR 1.137(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent

resulting from the application. See *Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished)(patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether “the entire delay...was unintentional” on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to “unavoidable delay” within the meaning of 37 CFR 1.137(a).

Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually must render a number of interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b).<

### 1. Unintentional Delay

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), reveals that the purpose of 35 U.S.C. 41(a)(7) is to permit the Office to have more discretion than

in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion stating that “[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable.” H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an “unintentional” delay within the meaning of 37 CFR 1.137(b).

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm’r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm’r Pat. 1988).

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an “unintentional” delay within the meaning of 37 CFR 1.137(b) because:

(A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;

(B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;

(C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;

(D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or

(E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render “unintentional” the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue

the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

\*\*>In order to expedite treatment, applicants filing a petition under 37 CFR 1.137(b) to revive an abandoned application are advised to include the statement “the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional,” even if applicant chooses to include a statement of the facts concerning the delay. Applicants may use the forms provided by the Office (PTO/SB/64 or PTO/SB/64PCT).<

PTO/SB/64 (2-98)  
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<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)</b>	Docket Number (Optional)
<p>First named inventor:</p> <p>Application No.: _____ Group Art Unit: _____</p> <p>Filed: _____ Examiner: _____</p> <p>Title: _____</p> <p>Attention: Office of Petitions                  Assistant Commissioner for Patents                  Box DAC                  Washington, D.C. 20231</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9282.</p> <p>The above-identified application became abandoned for failure to file a timely and proper reply to the Office action mailed on _____, which set a _____ month/day period for reply. The abandonment date of this application is _____ (i.e., the day after the expiration date of the period set for reply plus any extensions of time obtained therefor).</p> <p style="text-align: center;">APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</p> <p>NOTE: A grantable petition requires the following items:</p> <ul style="list-style-type: none"> <li>(1) Petition fee;</li> <li>(2) Reply and/or issue fee;</li> <li>(3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995, and for all design applications; and</li> <li>(4) Statement that the entire delay was unintentional.</li> </ul> <p>1. Petition fee</p> <ul style="list-style-type: none"> <li><input type="checkbox"/> Small entity - fee \$ _____ (37 CFR 1.17(m))</li> <li><input type="checkbox"/> Small entity statement enclosed herewith.</li> <li><input type="checkbox"/> Small entity statement previously filed.</li> <li><input type="checkbox"/> Other than small entity - fee \$ _____ (37 CFR 1.17(m))</li> </ul> <p>2. Reply and/or fee</p> <p>A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):</p> <ul style="list-style-type: none"> <li><input type="checkbox"/> has been filed previously on _____.</li> <li><input type="checkbox"/> is enclosed herewith.</li> </ul> <p>B. The issue fee of \$ _____</p> <ul style="list-style-type: none"> <li><input type="checkbox"/> has been paid previously on _____.</li> <li><input type="checkbox"/> is enclosed herewith.</li> </ul>	

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Burden Hour Statement: This form is estimated to take 1.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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3. Terminal disclaimer with disclaimer fee

- Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$\_\_\_\_\_ for a small entity or \$\_\_\_\_\_ for other than a small entity) equivalent to the number of months from abandonment to the filing of this petition is enclosed herewith.

4. Statement. The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Where a petition under 37 CFR 1.137(b) is filed:

- (1) more than three months from the date the applicant is first notified that the application is abandoned, explain (on an attached sheet) in detail the cause of the delay in filing the petition;
- (2) more than one year from the date of abandonment, explain (on an attached sheet) in detail how the delay in discovering the abandoned status occurred and indicate the date that applicant first became aware of the date of abandonment.

_____	_____
Date	Signature
Telephone Number: (____) _____	_____
	Typed or printed name
	_____
	Address
	_____

- Enclosures:  Reply
- Fee Payment
- Terminal Disclaimer Form
- Small Entity Status Form
- \_\_\_\_\_

By completing the Certificate of Mailing, below, the date mailed will be considered the date this correspondence is filed.

**CERTIFICATE OF MAILING [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, DC 20231.

_____	_____
Date	Signature
	_____
	Typed or printed name of person signing Certificate

## 2. Unavoidable Delay

As discussed above, “unavoidable” delay is the epitome of “unintentional” delay. Thus, an intentional delay precludes revival under 37 CFR 1.137(a) (“unavoidable” delay) or 37 CFR 1.137(b) (“unintentional” delay). See *Maldague*, 10 USPQ2d at 1478.

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

*In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Pratt*, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff’d*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See *In re Egbers*, 6 USPQ2d 1869, 1872 (Comm’r Pat. 1988), *rev’d on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg*, 10 USPQ2d 1787 (D.D.C. 1988); *In re Katrapat*, 6 USPQ2d 1863, 1867-68 (Comm’r Pat. 1988). For example,

where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of “unavoidable” delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

- (A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;
- (B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or
- (C) the lack of notification, or belated notification, to the Patent and Trademark Office of the change in correspondence address.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute “unavoidable” delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm’r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not “unavoidable” when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. Likewise, as a “reasonably prudent person” would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the PTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant’s failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute “unavoidable” delay. See *Krahn*, 15 USPQ2d at 1825. Finally, a delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered “unavoidable” due to: (A) the applicant’s reliance upon oral advice from PTO employees; or (B) the PTO’s failure to advise the applicant

of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

35 U.S.C. 133 and 151 each require a showing that the "delay" was "unavoidable," which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See *In re Application of Takao*, 17 USPQ2d 1155 (Comm'r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under 37 CFR 1.137(a) "promptly" upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. The removal of the language in 37 CFR 1.137(a) requiring that any petition thereunder be "promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment" should **not** be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment

of the application, to delay the filing of a petition under 37 CFR 1.137(a); or (B) changing (or modifying) the result in *In re Application of S*, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under 37 CFR 1.137(a) was denied due to the applicant's deliberate deferral in filing a petition under 37 CFR 1.137. An applicant who deliberately chooses to delay the filing of a petition under 37 CFR 1.137 (as in *Application of S*, 8 USPQ2d at 1632) will not be able to show that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 CFR 1.137(a)] was unavoidable" or even make an appropriate statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [ 37 CFR 1.137(b)] was unintentional."

The dismissal or denial of a petition under 37 CFR 1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 CFR 1.137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 CFR 1.137(a) indicates otherwise). In such an instance, a petition under 37 CFR 1.137(b) may be filed accompanied by the fee set forth in 37 CFR 1.17(m), the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and any terminal disclaimer required by 37 CFR 1.137(c).

Form PTO/SB/61 may be used to file a petition for revival of an unavoidably abandoned application.

PTO/SB/61 (2-98)  
Approved for use through 9/30/00. OMB 0651-0031  
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)</b>	Docket Number (Optional)
<p>First named inventor: _____ Group Art Unit: _____</p> <p>Application Number: _____ Examiner: _____</p> <p>Filed: _____</p> <p>Title: _____</p> <p>Attention: Office of Petitions Assistant Commissioner for Patents Box DAC Washington, D.C. 20231</p> <p style="text-align: center;">NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703)305-9282.</p> <p>The above-identified application became abandoned for failure to file a timely and proper reply to the Office action mailed on _____, which set a ____ month/day period for reply. The abandonment date of this application is _____ (i.e., the day after the expiration date of the period set for reply plus any extensions of time obtained therefor).</p> <p style="text-align: center;"><b>APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION</b> NOTE: A grantable petition requires the following items:</p> <ol style="list-style-type: none"> <li>(1) Petition fee;</li> <li>(2) Reply and/or issue fee;</li> <li>(3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995, and for all design applications; and</li> <li>(4) Adequate showing of the cause of unavoidable delay</li> </ol> <p>1. Petition fee</p> <p><input type="checkbox"/> small entity - fee \$ _____ (37 CFR 1.17(l)).</p> <p style="padding-left: 40px;"><input type="checkbox"/> small entity statement enclosed herewith.</p> <p style="padding-left: 40px;"><input type="checkbox"/> small entity statement previously filed.</p> <p><input type="checkbox"/> other than small entity - fee \$ _____ (37 CFR 1.17(l)).</p> <p>2. Reply and/or fee</p> <p>A. The reply to the above-noted Office action</p> <p><input type="checkbox"/> in the form of _____ (identify the type of reply): was previously filed on _____.</p> <p><input type="checkbox"/> is enclosed herewith.</p> <p>B. The issue fee of \$ _____</p> <p><input type="checkbox"/> was previously paid on _____.</p> <p><input type="checkbox"/> is enclosed herewith.</p>	

[Page 1 of 3]

Burden Hour Statement: This form is estimated to take 1.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
 UNAVOIDABLY UNDER 37 CFR 1.137(a)**

3. Terminal disclaimer with disclaimer fee

- Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$\_\_\_\_\_ for a small entity or \$\_\_\_\_\_ for other than a small entity) equivalent to the number of months from abandonment to the filing of this petition is enclosed herewith.

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

\_\_\_\_\_  
 Date

\_\_\_\_\_  
 Signature

Telephone  
 Number: (\_\_\_\_) \_\_\_\_\_

\_\_\_\_\_  
 Typed or printed name

\_\_\_\_\_  
 Address

- Enclosures:  Additional sheets containing statements establishing unavoidable delay
- Fee Payment
  - Reply
  - Terminal Disclaimer Form
  - Small Entity Status Form
  - \_\_\_\_\_

By completing the Certificate of Mailing, below, the date mailed will be considered the date this correspondence is filed.

**CERTIFICATE OF MAILING [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

\_\_\_\_\_  
 Date

\_\_\_\_\_  
 Signature

\_\_\_\_\_  
 Typed or printed name of person signing Certificate

PTO/SB/61 (2-98)  
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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)**

**NOTE:** The following showing of the cause of unavoidable delay must be signed by all applicants and by any other party who is presenting statements concerning the cause of delay.

\_\_\_\_\_ Date

\_\_\_\_\_ Signature

\_\_\_\_\_ Typed or printed name

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply)

*(Please attach additional sheets if additional space is necessary)*

**D. Delay Until the Filing of a Grantable Petition**

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

(A) the delay in reply that originally resulted in the abandonment;

(B) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and

(C) the delay in filing a **grantable** petition pursuant to 37 CFR 1.137 to revive the application.

As discussed above, the abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See *Application of G*, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as “unintentional” within the meaning of 37 CFR 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

(A) the correctness of the applicant’s (or applicant’s representative’s) decision to abandon the application or not to seek or persist in seeking revival of the application;

(B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or

(C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an “unavoidable” or “unintentional” delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldaque*, 10 USPQ2d at 1478.

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to 37 CFR 1.137(a) or (b), when such petition is filed: (A) within 3 months of the date the applicant is first notified that the application is abandoned; **and** (2) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to 37 CFR 1.137 within 3 months of the first notification

that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application).

Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 3 months of the date the applicant is first notified that the application is abandoned, the Office will consider there to be a question as to whether the delay was unavoidable or unintentional. In such instances, \*\*

(A) >the Office will require< a showing as to how the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(a) petition was filed was “unavoidable”; or

(B) >the Office may require< further information as to the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a 37 CFR 1.137(b) petition was filed, and how such delay was “unintentional.”

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within 3 months of the date the applicant was first notified that the application was abandoned, applicants should include a showing as to how the delay between the date the applicant was first notified by the Office that the application was abandoned and the filing of a petition under 37 CFR 1.137 was (A) “unavoidable” in a petition under 37 CFR 1.137(a); or (B) “unintentional” in a petition under 37 CFR 1.137(b).

Where a petition pursuant to 37 CFR 1.137(a) or (b) is not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment) the Office will require:

(A) further information as to when the applicant (or the applicant’s representative) first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant’s representative) (see *Pratt*, 1887 Dec. Comm’r Pat. at 32-33).

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(a) or (b) in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

(A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the

exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

#### **E. Party Whose Delay is Relevant**

The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See *Kim v. Quigg*, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party has reassigned the application to the applicant prior to the due date for the reply. *Id.*

Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See *Winkler*, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See *Futures Technology Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

#### **F. Burden of Proof to Establish Unavoidable or Unintentional Delay**

37 CFR 1.137(a)(3) requires a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the fil-

ing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. Therefore, the Office will require the applicant in every petition under 37 CFR 1.137(a) to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unavoidable. See *Haines*, 673 F. Supp. at 316-17, 5 USPQ2d at 1131-32.

37 CFR 1.137(b)(3) requires that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, but also provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." While the Office will generally require only the statement that the entire delay in providing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, the Office may require an applicant to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) where there is a question whether the entire delay was unintentional. See *Application of G*, 11 USPQ2d at 1380.

#### **G. Terminal Disclaimer Requirement**

37 CFR 1.137(c) requires that a petition under either 37 CFR 1.137(a) or 1.137(b) be accompanied by a terminal disclaimer (and fee), regardless of the period of abandonment, in:

- (A) a design application;
- (B) a nonprovisional utility application filed before June 8, 1995; or
- (C) a nonprovisional plant application filed before June 8, 1995.

The terminal disclaimer must dedicate to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application, and must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought. The terminal disclaimer requirement of 37 CFR 1.137(c) does not apply to lapsed patents.

The filing of a terminal disclaimer is not a substitute for unavoidable or unintentional delay. See *Application of Takao*, 17 USPQ2d at 1159. The requirement that the entire delay have been unavoidable (37 CFR 1.137(a)) or at least unintentional (37 CFR 1.137(b)) is distinct from the requirement for a terminal disclaimer. Therefore, the filing of a terminal disclaimer cannot excuse an intentional delay

in filing a petition or renewed petition to revive an abandoned application. Likewise, an unavoidable or unintentional delay in filing a petition or renewed petition to revive an abandoned application will not warrant waiver of the terminal disclaimer requirement of 37 CFR 1.137(c).

In the event that an applicant considers the requirement for a terminal disclaimer to be inappropriate under the circumstances of the application at issue, the applicant should file a petition under 37 CFR 1.183 (and petition fee) to request a waiver of this requirement of 37 CFR 1.183. Such a petition may request waiver of this requirement *in toto*, or to the extent that such requirement exceeds the period considered by applicant as the appropriate period of disclaimer. The grant of such a petition, however, is strictly limited to situations wherein applicant has made a showing of an “extraordinary situation” in which “justice requires” the requested relief. Such situations are namely when:

(A) the abandonment of the application caused no actual delay in prosecution (e.g., application revived solely for copendency with a continuing application whose prosecution was unaffected by the abandonment, or an application awaiting decision by the Board of Appeals and Interferences during period of abandonment); or

(B) the patent term is otherwise capped by the 20-year patent term as set forth in 35 U.S.C. 154(b) (e.g., revival of an application is sought solely for purposes of copendency with an application (other than for a design patent) filed on or after June 8, 1995, or the 20-year patent term provided by 35 U.S.C. 154(b) would be longer than 17 years from grant less the period of abandonment).

Forms PTO/SB/62 and PTO/SB/63 may be used when filing a terminal disclaimer in accordance with 37 CFR 1.137(c).

PTO/SB/62 (12-97)  
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<b>TERMINAL DISCLAIMER TO ACCOMPANY PETITION</b> (Period Specified)	Docket Number (Optional)						
<p>In re Application of:</p> <p>Name:</p> <p>Application Number:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____ of ___ percent interest in the above-identified application hereby disclaims the terminal _____ months of any patent granted on the above-identified application or on any application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to this application. This disclaimer is binding upon the grantee, its successors or assigns.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g. corporation, partnership, university, government agency, etc.), the person signing is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney of record.</p> <div style="text-align: center; margin-top: 20px;"> <table style="margin: auto; border: none;"> <tr> <td style="border-top: 1px solid black; width: 60%;"></td> <td style="border-top: 1px solid black; width: 20%;"></td> </tr> <tr> <td style="text-align: center;">Signature</td> <td style="text-align: center;">Date</td> </tr> <tr> <td colspan="2" style="border-top: 1px solid black; text-align: center; padding-top: 5px;">                     Typed or printed name                 </td> </tr> </table> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p>* Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>				Signature	Date	Typed or printed name	
Signature	Date						
Typed or printed name							

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



### H. Request For Reconsideration

37 CFR 1.137(d) requires that any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent must be filed within 2 months of the decision refusing to revive or within such time as set in the decision. 37 CFR 1.137(d) further provides that, unless a decision indicates otherwise, this time period for requesting reconsideration or review may be extended under the provisions of 37 CFR 1.136.

37 CFR 1.137(d) specifies a time period within which a renewed petition pursuant to 37 CFR 1.137 must be filed to be considered timely. Where an applicant files a renewed petition, request for reconsideration, or other petition seeking review of a prior decision on a petition pursuant to 37 CFR 1.137 outside the time period specified in 37 CFR 1.137(d), the Office may require, *inter alia*, a specific showing as to how the entire delay was “unavoidable” (37 CFR 1.137(a)) or “unintentional” (37 CFR 1.137(b)). As discussed above, a delay resulting from the applicant deliberately choosing not to persist in seeking the revival of an abandoned application cannot be considered “unavoidable” or “unintentional” within the meaning of 37 CFR 1.137, and the correctness or propriety of the decision on the prior petition pursuant to 37 CFR 1.137, the correctness of the applicant's (or the applicant's representative's) decision not to persist in seeking revival, the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision to not persist in seeking revival are immaterial to such intentional delay caused by the deliberate course of action chosen by the applicant.

### I. Provisional Applications

37 CFR 1.137 is applicable to a provisional application abandoned for failure to reply to an Office requirement. A petition under 37 CFR 1.137(a) or (b) must be accompanied by any outstanding reply to an Office requirement, since 37 CFR 1.137(a)(1) and 1.137(b)(1) permit the filing of a continuing application in lieu of the required reply only in a nonprovisional application.

35 U.S.C. 111(b)(5) provides that a provisional application shall be regarded as abandoned 12 months after its filing date and shall not be subject to revival thereafter. Thus, 37 CFR 1.137(e) provides that a provisional application “may be revived pursuant to this section so as to be pending for a period of no longer than twelve months from its filing date” and that “[u]nder no circumstances will a provisional application be regarded as pending after twelve months from its filing date.”

A provisional application may be abandoned prior to 12 months from its filing date for failure to reply to an Office requirement (e.g., failure to submit the filing fee

and/or cover sheet). Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than 12 months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than 12 months from the filing date of the provisional application but only to revive the application for the 12-month period following the filing of the provisional application. Thus, even if the petition were granted to establish the pendency up to the end of the 12-month period, the provisional application would not be considered pending after 12 months from its filing date.

### 711.03(d) Examiner’s Statement on Petition To Set Aside Examiner’s Holding

37 CFR 1.181 states that the examiner “may be directed by the Commissioner to furnish a written statement within a specific time setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.” Unless requested, however, such a statement should not be prepared. See MPEP § 1002.01.

### 711.04 Disposition of Abandoned Applications

37 CFR 1.14(b) states that “Complete applications (§ 1.51(a)) which are abandoned may be destroyed and hence may not be available for access or copies as permitted by paragraph (a)(3)(iv) of this section after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation.”

As explained in MPEP § 1302.07, a retention label is used to indicate applications not to be destroyed.

### 711.04(a) Pulling and Forwarding Abandoned Applications

The files of abandoned applications are pulled and forwarded to the Files Repository on a biweekly basis 1 month after the full 6-month statutory period has expired. However, the date of abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired.

The applications should be carefully scrutinized by the appropriate examiner to verify that they are actually abandoned. A check should be made of files containing a decision of the Board of Patent Appeals and Interferences for the presence of allowed claims to avoid their being erroneously sent to the Files Repository.

Although the abandoned files are not pulled until the maximum permissible period for which an extension of time under 37 CFR 1.136(a) plus 1 month has expired, the date of the abandonment is after midnight of the date the period for reply actually expired. This is normally the end of the 3-month shortened statutory period.

#### **711.04(b) Ordering of Patented and Abandoned Files**

In examination of an application it is sometimes necessary to inspect the application papers of a previously patented or abandoned application. It is always necessary to do so in the examination of a reissue application.

Recently patented and abandoned files are stored at the Files Repository located near the other PTO buildings in Crystal City (Arlington, VA). Older files are housed in warehouses located off site (outside of Crystal City).

Patented and abandoned files are ordered by means of a PALM video display transaction. To place such an order, the examiner is required to input his/her PALM location code, employee number, and patent number(s) and/or application number(s) of the file(s) that are needed. After transmission of the request transaction by the examiner, a “response” screen appears on the video display terminal which informs him/her of the status of the request for each file. The examiner is informed that the request is:

- (A) accepted;
- (B) accepted, but for which the file is stored at a warehouse off site (in which case delivery time is increased);
- (C) not accepted since the file is not located at the repository or warehouse;
- (D) not accepted since a previous request for the file has not yet been filled; or
- (E) not accepted since the patent or application number inputted is not valid.

Periodically each day, personnel at the Files Repository perform a PALM print transaction which produces a list of all accepted requests in patent number order and, for requests for abandoned files, in application number order. The printed record of each request is detached from the list when its associated file is found. It is then stapled to it. Throughout the day, periodic deliveries of files are made directly to the offices of their requestors by Files Repository personnel. Upon delivery of files at the various locations, files that are ready to be returned to the repository are picked up.

With the exception of certain older files, the drawings of patented and abandoned files, if any, are now stored within their respective application file wrappers. Since it is desired not to separate one from the other, both the file and its drawings are delivered when a file is ordered.

#### **711.04(c) Notifying Applicants of Abandonment**

The Patent Examining Corps currently mails to the correspondence address of record, a Notice of Abandonment form PTOL-1432 in all applications which become abandoned in the Corps for failure to prosecute. However, in no case will mere failure to receive a notice of abandonment affect the status of an abandoned application.

This procedure should enable applicants to take appropriate and diligent action to reinstate an application inadvertently abandoned for failure to timely reply to an official communication. In most cases, a petition to revive under 37 CFR 1.137 will be the appropriate remedy. It may be that a reply to the Office action was mailed to the Office with a certificate of mailing declaration as a part thereof (MPEP § 512) but was not received in the Office. In this instance, adequate relief may be available by means of a petition to withdraw the holding of abandonment.

In any instance, if action is not taken promptly after receiving the notice of abandonment, appropriate relief may not be granted. If a lack of diligent action is predicated on the contention that neither the Office action nor the notice of abandonment was received, one may presume that there is a problem with the correspondence address of record. Accordingly, attention is directed to MPEP § 402 and § 601.03 dealing with changes of address. In essence, it is imperative that a paper notifying the Office of a change of address be filed promptly in each application in which the correspondence address is to be changed (except as provided for under Customer Number practice — see MPEP § 403).

#### **711.05 Letter of Abandonment Received After Application is Allowed**

Receipt of a letter of abandonment while an application is allowed is acknowledged by the Publishing Division.

An express abandonment arriving after the issue fee has been paid will not be accepted without a showing of one of the reasons indicated in 37 CFR 1.313(b), or else a showing under 37 CFR 1.183 justifying suspension of 37 CFR 1.313.

#### **711.06 Abstracts, Abbreviations, and Defensive Publications**

Abstracts were prepared and published in accordance with the Notice of January 25, 1949, 619 O.G. 258. Each abstract includes a summary of the disclosure of the abandoned application, and in applications having drawings, a figure of the drawing. The publication of such abstracts was discontinued in 1953.

**ABBREVIATURES**

Abbreviations were prepared and published in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviation contains a specific portion of the disclosure of the abandoned application, preferably a detailed representative claim, and, in applications having drawings, a figure of the drawing. The publication of such abbreviations was discontinued in 1965.

**DEFENSIVE PUBLICATIONS**

The Defensive Publication Program, which provided for the publication of the abstract of the technical disclosure of a pending application if the applicant waived his or her rights to an enforceable patent, was removed from the rules effective May 8, 1985, in view of the applicant's ability to obtain a Statutory Invention Registration.

An application was laid open for public inspection laid open under the Defensive Publication Program and the applicant provisionally abandoned the application, retaining rights to an interference for a limited period of 5 years from the earliest effective U.S. filing date.

The defensive publication of an application precluded a continuing application (divisional, continuation-in-part, or continuation) filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application unless a continuing application was filed within 30 months after the earliest effective U.S. Filing date. Where a similar application was not filed until after expiration of the 30month period, the application was examined, but it was not entitled to claim the benefit of the earlier filing date of the defensive publication application.

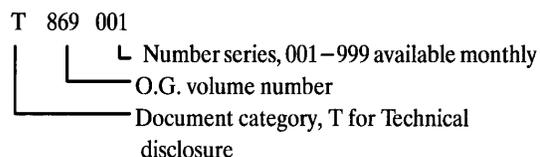
If a first continuing application was filed within 30 months from the earliest U.S. effective filing date of the application published under the Defensive Publication Program, later copending continuing applications (such as divisions if restriction is required during the prosecution of the first continuing application) were not barred and could be filed during the pendency of the first continuing application, even though beyond the 30 month period, without loss of the right to claim the benefit of the filing date of the Defensive Publication application.

The Defensive Publication Abstract and a selected figure of the drawing, if any, were published in the *Official Gazette*. Defensive Publication Search Copies, containing the defensive publication abstract and suitable drawings, if any, were provided for the application file, the Patent Search Room and the examiner's search files.

The defensive publication application files are maintained in the File Information Unit (Record Room).

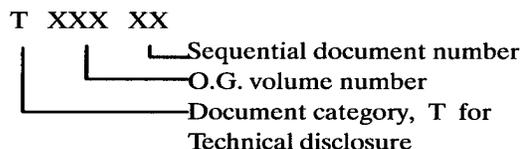
**Defensive Publication Number**

Distinct numbers are assigned to all Defensive Publications published December 16, 1969 through October 1980, for example.

T 869 001  


For Defensive Publications published on and after November 4, 1980, a different numbering system is used.

The revised numbering system is as follows:

T XXX XX  


Defensive Publications are included in subclass lists and subscription orders. The distinct numbers are used for all official reference and document copy requirements.

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687.

**711.06(a) Citation and Use of Abstracts, Abbreviations, and Defensive Publications as References**

It is important that abstracts, abbreviations, and defensive publications (O.G. Defensive Publication and Defensive Publication Search Copy) be referred to as publications.

These printed publications are cited as prior art under 35 U.S.C. 102(a) or 102(b) effective from the date of publication in the *Official Gazette*. See *Ex parte Osmond*, 191 USPQ 334 (Bd. App. 1973) and *In re Osmond*, 191 USPQ 340 (Bd. App. 1976).

An application or portion thereof from which an abstract, abbreviation or defensive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 U.S.C.102(a), effective from the actual date of filing in the United States.

These publications may be used alone or in combination with other prior art in rejecting claims under 35 U.S.C. 102 and 103.

Defensive Publications are listed with "U.S. Patent Documents." Abstracts and Abbreviations are listed under "Other References" in the citation thereof as follows:

(A) Abstracts and Abbreviations

Brown, (abstract or abbreviation) of Serial No. ...., filed ....., published in O.G. ...., on ....., (list classification).

(B) Applications or designated portions thereof, abstracts, abbreviations, and defensive publications

Jones, Application Serial No. ...., filed ....., laid open to public inspection on ..... as noted at ..... O.G. (portion of application relied on), (list classification, if any).

### 713 Interviews [R-1]

The personal appearance of an applicant, attorney, or agent before the examiner or a telephone conversation or video conference >or electronic mail< between such parties presenting matters for the examiner's consideration is considered an interview.

#### 713.01 General Policy, How Conducted [R-1]

37 CFR 1.133. *Interviews.*

(a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

Interviews are permissible on any working day except during periods of overtime work.

#### >SPECIAL PROCEDURES FOR USING INTERNET ELECTRONIC MAIL

Internet e-mail shall NOT be used to conduct an exchange or communications similar to those exchanged during telephone or personal interviews unless a written authorization has been given to use Internet e-mail. See MPEP § 502.03. In such cases, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form is entered. <

### VIDEO CONFERENCE CENTER

In the interest of providing better service to its customers, the Patent and Trademark Office (PTO) has established a Video Conference Center (VCC) to expedite patent and trademark prosecution. The VCC is presently administered by the Patent Academy and is available for authorized official business during normal business hours (8:30 AM - 5:00 PM, EST). The VCC equipment includes a high resolution document camera, direct computer input, VCR display capability, and a high speed, high resolution G-4 facsimile machine. The Patent and Trademark Depository Library Program office maintains a current list of all the off-site locations where a video conference may be held. At this time, use of the VCC will be limited to our partnership Patent and Trademark Depository Libraries (PTDLs) located at Sunnyvale, Calif. and the Great Lakes Patent and Trademark Center at the Detroit Public Library, which have duplicate video equipment. Customers wishing to utilize the facilities at the above noted PTDLs, rather than coming to the PTO for a face-to-face interview, should contact the patent examiner or trademark examining attorney and identify two alternative dates and times for a video conference. The patent examiner or trademark examining attorney will then contact Patent Academy personnel who will, in turn, make all the arrangements. The customer will be notified as to the date and time of the video conference.

### SCHEDULING AND CONDUCTING AN INTERVIEW

An interview should normally be arranged for in advance, as by letter, facsimile, >electronic mail,< telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present and available in the Office. An interview in the Video Conference Center must be arranged at least 3 days in advance. When a second art unit is involved (Patentability Report), the availability of the second examiner should also be checked. (See MPEP § 705.01(f).) An appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington or off-site video conferencing locations in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be made.

When a telephone call is made to an examiner and it becomes evident that a lengthy discussion will ensue or that the examiner needs time to restudy the situation, the call should be terminated with an agreement that the examiner will call back at a specified time. Such a call and all other calls originated by the examiner should be made through

the FTS (Federal Telecommunications System) even though a collect call had been authorized. It is helpful if amendments and other papers, such as the letter of transmittal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examiner may well justify his or her refusal of the interview at that time, particularly in an involved case.

An examiner's suggestion of allowable subject matter may justify indicating the possibility of an interview to accelerate early agreement on allowable claims.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus, the attorney when presenting himself or herself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted. It is desirable that the attorney or applicant indicate in advance what issues he or she desires to discuss at the interview by submitting, in writing, a proposed amendment. This would permit the examiner to prepare in advance for the interview and to focus on the matters set forth in the proposed amendment.

Examiners should avoid unnecessary interruptions during interviews with attorneys or inventors. In this regard, examiners should notify their receptionist, immediately prior to an interview, to not complete incoming telephone calls unless such are of an emergency nature. As appropriate, examiners should familiarize themselves with the status and existing issues in an application or reexamination proceeding before an interview.

The examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the examiner. However, the examiner should attempt to identify issues and resolve differences during the interview as much as possible.

It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than 30 minutes. It is the duty of the primary examiner to see that an interview is not extended beyond a reasonable period even when he or she does not personally participate in the interview.

During an interview with an applicant who is prosecuting his or her own case and is not familiar with Office procedure the examiner may make suggestions that will advance the prosecution of this case; this lies wholly within his or her discretion. Too much time, however, should not be allowed for such interviews.

Examiners may grant one interview after final rejection. See MPEP § 713.09.

Where the reply to a first complete action includes a request for an interview, a telephone consultation to be initiated by the examiner or a video conference, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he or she has considered the effect of the reply, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Consideration of a filed amendment may be had by hand delivery of a duplicate copy of said amendment.

Early communication of the results of the consideration should be made to applicant; if requested, indicate on attorney's copy any agreement; initial and date both copies.

Although entry of amendatory matter usually requires actual presence of the original paper, examiner and technical support staff processing should proceed as far as practicable based on the duplicate copy. The extent of processing will depend on each amendment.

The substance of any interview, whether in person, by video conference, >by electronic mail< or by telephone must be made of record in the application. See MPEP >§ 502.03 and <§ 713.04.

### **VIEWING OF VIDEO TAPES DURING INTERVIEWS**

The Patent and Trademark Office has video tape equipment available in the facilities of the Patent Academy for viewing video tapes from applicants during interviews with patent examiners.

The video tape equipment may use VHS and UHS (3/4-inch tape) cassettes.

Attorneys or applicants wishing to show a video tape during an examiner interview must be able to demonstrate that the content of the video tape has a bearing on an outstanding issue in the application and its viewing will

advance the prosecution of the application. Prior approval of viewing of a video tape during an interview must be granted by the supervisory patent examiner. Also, use of the room and equipment must be granted by the Training Manager to avoid any conflict with the Patent Academy.

Requests to use video tape viewing equipment for an interview should be made at least 1 week in advance to allow the Patent Academy staff sufficient time to ensure the availability and proper scheduling of both a room and equipment.

Interviews using Office video tape equipment will be held only in the Patent Academy facilities located in Crystal Square Four, Suite 700. Attorneys or applicants should not contact the Patent Academy directly regarding availability and scheduling of video equipment. All scheduling of rooms and equipment should be done through and by the examiner conducting the interview. The substance of the interview, including a summary of the content of the video tape must be made of record in the application. See MPEP § 713.04.

#### **EXAMINATION BY EXAMINER OTHER THAN THE ONE WHO CONDUCTED THE INTERVIEW**

Sometimes the examiner who conducted the interview is transferred to another group or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See MPEP § 812.01 for a statement of telephone practice in restriction and election of species situations.

#### **713.02 Interviews Prior to First Official Action**

Prior to filing, no interview is permitted. However, in the examiner's discretion, a limited amount of time may be spent in indicating the field of search to an attorney, searcher or inventor.

A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral. 37 CFR 1.133(a).

#### **SEARCHING IN GROUP**

Search in the group art unit should be permitted only with the consent of a primary examiner.

#### **EXPOUNDING PATENT LAW**

The Patent and Trademark Office cannot act as an expounder of the patent law, nor as a counsellor for individuals.

#### **713.03 Interview for "Sounding Out" Examiner Not Permitted**

Interviews that are solely for the purpose of "sounding out" the examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

#### **713.04 Substance of Interview Must Be Made of Record [R-1]**

A complete written statement as to the substance of any face-to-face, video conference, >electronic mail< or telephone interview with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See 37 CFR 1.133(b), MPEP >§ 502.03 and< § 713.01.

*37 CFR 1.133. Interviews*

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(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

*37 CFR 1.2. Business to be transacted in writing.*

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions

regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in MPEP § 812.01, or pointing out typographical errors in Office actions or the like, are excluded from the interview recordation procedures below. Where a complete record of the interview has been incorporated in an examiner's amendment, it will not be necessary for the examiner to complete an Interview Summary form.

The Interview Summary form PTOL 413 shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. In a personal interview, the duplicate copy of the Interview Summary form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic, electronic mail or video conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. In addition, a copy of the form may be faxed to applicant (or applicant's attorney or agent) at the conclusion of the interview. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Interview Summary form should be mailed promptly after the telephonic, electronic mail or video conference interview rather than with the next official communication.

The PTOL-413 form provides for recordation of the following information:

- (A) application number;
- (B) name of applicant;
- (C) name of examiner;
- (D) date of interview;
- (E) type of interview (personal, telephonic, electronic mail or video conference);
- (F) name of participant(s) (applicant, attorney, or agent, etc.);
- (G) an indication whether or not an exhibit was shown or a demonstration conducted;
- (H) an identification of the claims discussed;
- (I) an identification of the specific prior art discussed;
- (J) an indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.);
- (K) the signature of the examiner who conducted the interview;
- (K) names of other Patent and Trademark Office personnel present.

The PTOL 413 form also contains a statement reminding the applicant of his or her responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Interview Summary form or in an attachment to the form, the examiner will check a box at the bottom of the form informing the applicant that he or she need not supplement the form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary form will not be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

The complete and proper recordation of the substance of any interview should include at least the following applicable items:

- (A) a brief description of the nature of any exhibit shown or any demonstration conducted;
- (B) identification of the claims discussed;
- (C) identification of specific prior art discussed;
- (D) identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner;
- (E) the general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner;
- (F) a general indication of any other pertinent matters discussed; \*
- (G) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary form completed by the examiner\*;>; and
- (H) in the case of an interview via electronic mail, a paper copy of the Internet e-mail contents MUST be made and placed in the patent application file as required by the Federal Records Act in the same manner as an Examiner Interview Summary Form, PTOL 413, is entered.<

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner may give the applicant a 1-month time period to complete the reply under 37 CFR 1.135(c) where the record of the substance of the interview is in a reply to a nonfinal Office action.

*¶ 7.84 Amendment Is Non-Responsive to Interview*

The reply filed on [1] is not fully responsive to the prior Office action because it fails to include a complete or accurate record of the substance of the [2] interview. [3] Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the >mailing< date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

**Examiner Note:**

1. In bracket 2, insert the date of the interview.
2. In bracket 3, explain the deficiencies.

**EXAMINER TO CHECK FOR ACCURACY**

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him or her.

If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

**713.05 Interviews Prohibited or Granted, Special Situations [R-1]**

Saturday interviews, see MPEP § 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after an application has been passed to issue.

An interview may be appropriate before applicant's first reply when the examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Office employees are forbidden to hold either oral or written communication with an unregistered or a suspended or excluded attorney or agent regarding an application unless it is one in which said attorney or agent is the applicant. See MPEP § 105.

Interviews are frequently requested by persons whose credentials are of such informal character that there is serious question as to whether such persons are entitled to any information under the provisions of 37 CFR 1.14. In gen-

eral, interviews are not granted to persons who lack proper authority from the applicant or attorney of record in the form of a paper on file in the application or do not have in their possession a copy of the application file. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

However, interviews may be granted to registered individuals who are known to be the local representatives of the attorney in the application, even though a power of attorney to them is not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. See MPEP § 408.

If a registered individual seeking the interview has in his or her possession a copy of the application file, the examiner may accept his or her statement that he or she is authorized to represent the applicant under 37 CFR 1.34 or is the person named as the attorney of record.

Interviews normally should not be granted unless the requesting party has authority to bind the principal concerned.

The availability of personal interviews in the "Conference Period," which is the time between the filing of applicant's thorough first reply and a concluding action by the examiner, for attorneys resident or frequently in the Washington, D.C. area is obvious. For others, more remote, telephone >, electronic mail,< or video conference interviews may prove valuable. However, present Office policy places great emphasis on telephone interviews initiated by the examiner to attorneys and agents of record. See MPEP § 408.

The examiner, by making a telephone call, may be able to suggest minor, probably quickly acceptable changes which would result in allowance. If there are *major* questions or suggestions, the call might state them concisely, and suggest a further telephone >, electronic mail,< or personal interview, at a prearranged later time, giving applicant more time for consideration before discussing the points raised.

For an interview with an examiner who does not have negotiation authority, arrangements should always include an examiner who does have such authority, and who is familiar with the case, so that authoritative agreement may be reached at the time of the interview.

**GROUPED INTERVIEWS**

For attorneys remote from the Washington, D.C. area who prefer personal or video conference interviews, the grouped interview practice is effective. If in any case there is a prearranged interview, *with agreement to file a prompt supplemental amendment putting the case as nearly as may*

*be in condition for concluding action*, prompt filing of the supplemental amendment gives the application special status, and brings it up for immediate special action.

### **713.06 No *Inter Partes* Questions Discussed *Ex Parte***

The examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties.

### **713.07 Exposure of Other Cases**

Prior to an interview in the examiner's room, the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See MPEP § 101.

### **713.08 Demonstration, Exhibits, Models**

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney which complies with 37 CFR 1.91 and which is made part of the application record must be properly recorded on the "Contents" portion of the application file wrapper. See MPEP § 608.03 and § 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. If the model or exhibit is merely used for demonstration purpose and is not made part of the record (does not comply with 37 CFR 1.91), a full description as to what was demonstrated/exhibited must be made of record in the application. See 37 CFR 1.133(b). Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office (in the Washington, D.C. area) with the approval of the supervisory patent examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

### **713.09 Finally Rejected Application**

Normally, one interview after final rejection is permitted. However, prior to the interview, the intended purpose and content of the interview should be presented briefly, preferably in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See MPEP § 714.13.

Interviews may be held after the expiration of the shortened statutory period and prior to the maximum permitted statutory period of 6 months without an extension of time. See MPEP § 706.07(f).

A second or further interview after a final rejection may be held if the examiner is convinced that it will expedite the issues for appeal or disposal of the application.

### **713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312**

After an application is sent to issue, it is technically no longer under the jurisdiction of the primary examiner. 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under 37 CFR 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases where a notice of allowance has been mailed should be granted only with specific approval of the Group Director upon a showing in writing of extraordinary circumstances.

### **714 Amendments, Applicant's Action**

The applicant may amend:

- (A) before or after the first examination and action and also after the second or subsequent examination or reconsideration as specified in 37 CFR 1.112;
- (B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; and
- (C) when and as specifically required by the examiner.

In patent-owner-filed reexaminations, the patent owner may amend at the time of the request for reexamination in accordance with 37 CFR 1.510(e). In any reexamination proceeding, no amendment or response can be filed between the date of the request for reexamination and the order for reexamination. See 37 CFR 1.530(a). Following the order for reexamination under 37 CFR 1.525 and prior to the examination phase of a reexamination proceeding, an amendment may be filed only with the patent owner's statement under 37 CFR 1.530(b). During the examination phase of the reexamination proceeding, an amendment may be filed:

- (A) after the first examination as specified in 37 CFR 1.112;

(B) after final rejection, if the amendment meets the criteria of 37 CFR 1.116; and

(C) when and as specifically required by the examiner.

See also MPEP § 714.12.

For amendments in reexamination proceedings see MPEP § 2250 and § 2266.

## 714.01 Signatures to Amendments

An amendment must be signed by a person having authority to prosecute the application. An unsigned or improperly signed amendment will not be entered. See MPEP § 714.01(a).

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature.

### 714.01(a) Unsigned or Improperly Signed Amendment [R-1]

37 CFR 1.33. *Correspondence respecting patent applications, reexamination proceedings, and other proceedings*

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(b) Amendments and other papers filed in the application must be signed by:

(1) An attorney or agent of record appointed in compliance with § 1.34(b);

(2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);

(3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;

(4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or

(5) All of the applicants (§§ 1.42, 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.

\*\*\*\*\*

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies, for instance, where the amendment is signed by >only< one \* of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies of papers which require an original signature as set forth in 37 CFR 1.4(e) are filed, the signature must be applied after the copies are made. MPEP § 714.07.

When an unsigned or improperly signed amendment is received the amendment will be listed on the file wrapper, but not entered. The examiner will notify applicant of the status of the application, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. In an application not under final

rejection, applicant should be given a 1-month time period in which to ratify the previously filed amendment (37 CFR 1.135(c)).

Applicants may be advised of unsigned amendments by use of Form Paragraph 7.84.01.

#### ¶ 7.84.01 Paper Is Unsigned

The proposed reply filed on [1] has not been entered because it is unsigned. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney of record, since he or she may have the authority to sign the amendment.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR 10.11 is not entered. The file and unentered amendment are submitted to the Office of Enrollment and Discipline for appropriate action.

### 714.01(c) Signed by Attorney Not of Record

See MPEP § 405. A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he does not have a power of attorney in the application. See MPEP § 402.

### 714.01(d) Amendment Signed by Applicant But Not by Attorney of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other directly to the applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

## 714.02 Must Be Fully Responsive

37 CFR 1.111. *Reply by applicant or patent owner.*

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific

distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See §§ 1.135 and 1.136 for time for reply.)

In all cases where reply to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of a case may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(a)(2) and (b)(2). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsible for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment attempting to "rewrite" a claim in the manner set forth in 37 CFR 1.121(a)(2)(ii) and (b)(2)(i)(C) may be held not fully responsible if it uses parentheses, ( ), where brackets, [ ], are called for. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

### 714.03 Amendments Not Fully Responsive Action To Be Taken [R-1]

37 CFR 1.135. *Abandonment for failure to reply within time period.*

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(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is

insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being “inadvertently omitted.” For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a “*bona fide* attempt to advance the application to final action” (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR

1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant’s reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment.

The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a *bona fide* reply does **not** apply after a final Office action. Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment should be denied entry if some point necessary for a complete reply under 37 CFR 1.113 (after final) was omitted, even if the omission was through an apparent oversight or inadvertence. Where a submission after a final Office action or appeal (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (e.g., whether the amendment raises new issues, or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to file another or supplemental amendment in order to supply the omission.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner’s amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the finality of the last Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution on the merits in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 435 O.G. 213 (Comm’r Pat. 1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant’s responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113.

Where there is an informality as to the fee in connection with an amendment to a **non-final** Office action presenting additional claims, the applicant is notified by the technical support staff on form PTOL-319. See MPEP § 607 and § 714.10.

Form paragraph 7.95 may be used where a *bona fide* reply is not fully responsive.

#### ¶ 7.95 Bona Fide, Non-Responsive Amendments

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. \* >See< 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

#### Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See paragraph 7.91.

### 714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. See 37 CFR 1.111 and MPEP § 714.02.

An amendment failing to point out the patentable novelty which the applicant believes the claims present in view of the state of the art disclosed by the references cited or the objections made may be held to be not fully responsive and a time period set to furnish a proper reply if the statutory period has expired or almost expired (MPEP § 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

### 714.05 Examiner Should Immediately Inspect

Actions by applicant, especially those filed near the end of the period for reply, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the reply within the period. See MPEP § 714.03.

All amended applications put on the examiner's desk should be inspected at once to determine the following:

(A) If the amendment is properly signed (MPEP § 714.01(a)).

(B) If the amendment has been filed within the statutory period, set shortened period, or time limit (MPEP § 710 - § 710.05).

(C) If the amendment is fully responsive (MPEP § 714.03 and § 714.04).

(D) If the changes made by the amendment warrant transfer (MPEP § 903.08(d)).

(E) If the case is special (MPEP § 708.01).

(F) If claims suggested to applicant for interference purposes have been copied.

(G) If there is a traverse of a requirement for restriction (MPEP § 818.03(a)).

(H) If "easily erasable" paper or other nonpermanent method of preparation or reproduction has been used (MPEP § 714.07).

(I) If applicant has cited references (MPEP § 707.05(b) and § 1302.12).

(J) If a terminal disclaimer has been filed (MPEP § 508.01, § 804.02, § 804.03, and § 1490).

(K) If any matter involving security has been added (MPEP § 115).

#### ACTION CROSSES AMENDMENT

A supplemental action is usually necessary when an amendment is filed on or before the mailing date of the regular action but reaches the examining group later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for reply runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)."

### 714.06 Amendments Sent to Wrong Group

See MPEP § 508.01.

### 714.07 Amendments Not in Permanent Ink

37 CFR 1.52(a) requires "permanent dark ink or its equivalent" to be used on papers which will become part of the record and *In re Benson*, 122 USPQ 279, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959), holds that documents on so-called "easily erasable" paper violate the requirement. The fact that 37 CFR 1.52(a) has not been complied with may be discovered as soon as the amendment reaches the examining group or later when the application is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered and is required to file a permanent copy within 1 month or to order a copy to be made by the Patent and Trademark Office at his or her

expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate reply within the 1-month limit, a copy is made by the Patent and Trademark Office, applicant being notified and required to remit the charges or authorize charging them to his or her deposit account.

In the second instance, when the nonpermanence of the amendment is discovered only when the application is reached for action, similar steps are taken, but action on the application is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

A good direct or indirect copy, such as photocopy or facsimile transmission, on satisfactory paper is acceptable. But see *In re Application Papers Filed Jan. 20, 1956*, 706 O.G. 4 (Comm'r Pat. 1956). Although a good copy is acceptable, signatures must be applied after the copy is made if the papers require an original signature as set forth in 37 CFR 1.4(e).

See MPEP § 608.01 for more discussion on acceptable copies.

#### **714.08 Telegraphic Amendment**

When a telegraphic amendment is received, the telegram is placed in the file but not entered. Applicant will be notified that the telegram is not accepted as a reply to the previous Office action and is not entered. The time period for reply to the Office action continues to run and is extendable under 37 CFR 1.136.

#### **714.09 Amendments Before First Office Action**

An amendment filed before the first Office action, but not filed along with the original application, does not enjoy the status of part of the original disclosure. See MPEP § 608.04(b). However, an application will be accorded a filing date based upon the submission of a complete specification including claims and any required drawings. The oath or declaration and/or filing fee can be submitted later. Thus, in the instance where an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. A subsequently filed oath or declaration must refer to both the application and the amendment. Any copy of the application as filed must include a copy of the amendment as well, particularly where certified copies for priority purposes are requested.

Amendments should either accompany the application or be filed after the application has received its application number and filing date. See MPEP § 502.

Any amendment canceling claims in order to reduce the filing fee should be filed with the application. Since only

amendments canceling claims are entered before the filing fee is calculated, any other changes to the claims and/or specification should be part of a separate amendment. See MPEP § 506.

#### **714.10 Claims Added in Excess of Filing Fee**

The patent statute provides for the presentation of claims added in excess of the filing fee. On payment of an additional fee (see MPEP § 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action.

#### **714.11 Amendment Filed During Interference Proceedings**

See MPEP § 2364.01.

#### **714.12 Amendments After Final Rejection or Action**

*37 CFR 1.116. Amendments after final action or appeal.*

(a) After a final rejection or other final action (§ 1.113), amendments may be made cancelling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

Once a final rejection that is not premature has been entered in a case, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1207.

*The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional*

circumstances, a second personal interview may be initiated by the *examiner* if in his or her judgment this would materially assist in placing the application in condition for *allowance*.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

### **714.13 Amendments After Final Rejection or Action, Procedure Followed**

#### **FINAL REJECTION — TIME FOR REPLY**

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection:

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of Form Paragraphs 7.39, 7.40, 7.40.01, 7.41 and 7.41.03. Form Paragraph 7.39 appears in MPEP § 706.07. Form paragraphs 7.40 and 7.40.01 appear in MPEP § 706.07(a). Form Paragraphs 7.41 and 7.41.03 appear in MPEP § 706.07(b).

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated

from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date. In the event that a first reply is not filed within 2 months of the mailing date of the final rejection, any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the end of the reply period set in the final rejection.

Failure to file a reply during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

#### **ENTRY NOT A MATTER OF RIGHT**

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to: (A) an amendment complying with 37 CFR 1.116; or (B) a Notice of Appeal (and appeal fee). Further examination of the application, however, may be obtained by filing a continued prosecution application (CPA) under 37 CFR 1.53(d), if appropriate. See MPEP § 201.06(d).

An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

See also MPEP § 1207 and § 1211.

The Patent and Trademark Office does not recognize “conditional” authorizations to charge an appeal fee if an amendment submitted after a final Office action is not entered. Any “conditional” authorization to charge an appeal fee set forth in 37 CFR 1.17(b) will be treated as an unconditional payment of the fee set forth in 37 CFR 1.17(b).

#### **ACTION BY EXAMINER**

See also MPEP § 706.07(f).

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be

arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(B) The claims, if amended as proposed, would raise the issue of new matter.

(C) The claims as amended present new issues requiring further consideration or search.

(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper.

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Advisory Action form PTOL-303 should be used to acknowledge receipt of a reply from applicant after final rejection where such reply is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection

should be mailed within 30 days of the date the amendment is received by the Office. 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 the allowability of the claims by a Notice of Allowability form 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 PTOL-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. Every effort should be made to mail the letter before the period for reply expires.

If no appeal has been filed within the period for reply and no amendment has been submitted to make the application allowable or which can be entered in part (see MPEP § 714.20), the application stands abandoned.

It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See MPEP § 1207 for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under 37 CFR 1.131 and 1.132, see MPEP § 715.09 and § 716.

Form paragraphs 7.67-7.80 are to be used when issuing advisory actions after a final rejection.

#### ¶ 7.67 *Advisory After Final, Heading, Before Appeal*

The period for reply [1] to run [2] MONTHS from the mailing date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 must be timely filed to avoid abandonment of this application.

#### **Examiner Note:**

1. This paragraph should appear as a heading in all advisory actions prior to appeal. After appeal, use paragraph 7.68.
2. In bracket 1, insert --continues-- if applicant has not submitted a petition for an extension of time along with the appropriate fee under 37 CFR 1.136. If a proper extension has been requested under 37 CFR 1.136, insert --is extended-- in bracket 1.
3. In bracket 2, insert the full statutory period resulting from any extensions of time which have been granted, e.g., --FOUR-- months.
4. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
5. Follow with form paragraph 7.41.01 *if* transitional provisions of 37 CFR 1.129(a) are applicable.

#### ¶ 7.67.01 *Advisory After Final, Heading, 1st Reply Filed Within 2 Months*

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this

advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

**Examiner Note:**

1. This paragraph should be used in all advisory actions if:
  - a. it was the FIRST reply to the final rejection, and
  - b. it was filed within two months of the date of the final rejection.
2. If a notice of appeal has been filed, also use paragraph 7.68.
3. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

*¶ 7.67.02 Advisory After Final, Heading, No Variable SSP Set in Final*

Since the first reply to the final Office action was filed within TWO MONTHS of the mailing date of that action and the advisory action was not mailed within THREE MONTHS of that date, the THREE-MONTH shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the Official Gazette at 1027 O.G. 71, February 8, 1983. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

**Examiner Note:**

1. This paragraph should be used in all advisory actions where:
  - a. the reply is a first reply to the final action;
  - b. the reply was filed within two months of the mailing date of the final; and
  - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.
2. If the final action set a variable SSP, do not use this paragraph, use paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

*¶ 7.68 Advisory After Final, Heading, After Appeal*

An appeal under 37 CFR 1.191 was filed in this application on [1]. Appellant's brief is due on [2] in accordance with 37 CFR 1.192(a).

**Examiner Note:**

1. This paragraph must precede paragraph 7.70 if the amendment is entered.
2. This paragraph must precede paragraph 7.71 if the amendment is not entered.

*¶ 7.69 Advisory After Final, Before Appeal, Amendment To Be Entered*

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

**Allowed claim(s):** [2]

**Rejected claim(s):** [3]

**Claim(s) objected to:** [4]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02.
2. In brackets 2-4 indicate the status of all claims.
3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.69.01 for each group of claims subject to the same rejection.

*¶ 7.69.01 Advisory Action, Proposed Rejection of Claims, Before Appeal*

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon appeal and entry of the amendment:

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

**Examiner Note:**

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (i.e., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

*¶ 7.70 Advisory After Final, After Appeal, Amendment Entered*

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

**Allowed claim(s):** [2]

**Rejected claim(s):** [3]

**Claim(s) objected to:** [4]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.68.
2. In brackets 2-4 indicate the status of all pending claims.
3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.70.01 for each group of claims subject to the same rejection.
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

*¶ 7.70.01 Advisory Action, Proposed Rejection of Claims, After Appeal*

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

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

**Examiner Note:**

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (i.e., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

*¶ 7.71 Advisory After Final, Amendment Not Entered*

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02 if an appeal has not been taken, or by paragraph 7.68 if an appeal has been taken.
2. If it is not known whether a notice of appeal has been filed and the full six month period has expired, do not use paragraphs 7.67, 7.67.01, 7.67.02 or 7.68; use instead the following: "If an appeal under 37 CFR 1.191 has not been properly filed, this application is abandoned."
3. One or more of the appropriate paragraphs 7.72 to 7.76 must directly follow this paragraph.

*¶ 7.72 Advisory After Final, Lacks Showing, Why Necessary and Not Earlier Presented*

There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

**Examiner Note:**

1. Paragraph 7.71 must precede this paragraph.
2. Do not use this paragraph as the sole reason for refusing entry of the amendment unless the situation is aggravated, in which case a full explanation is necessary.
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

*¶ 7.73 Advisory After Final, Raises New Issues*

The proposed amendment raises new issues that would require further consideration and/or search.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. The new issues including questions of new matter must be clearly identified following this form paragraph. (Examples are sufficient if the new issues are extensive.)
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

*¶ 7.75 Advisory After Final, Form for Appeal Not Improved*

The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.76 Advisory After Final, Additional Claims Presented*

The proposed amendment presents additional claims without canceling a corresponding number of finally rejected claims.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.78 Advisory After Final, Proposed New Claims Would Be Allowable*

Claim [1] as proposed would be allowable if submitted in a separately filed amendment canceling all non-allowed claims.

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.79 Advisory After Final, Affidavit, Exhibit, or Request for Reconsideration Considered*

The [1] has been entered and considered but does not overcome the rejection because [2].

**Examiner Note:**

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should be provided in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

*¶ 7.80 Advisory After Final, Affidavit or Exhibit Not Considered*

The [1] will not be considered because good and sufficient reasons why it was not earlier presented have not been shown. [2]

**Examiner Note:**

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should follow in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

**HAND DELIVERY OF PAPERS**

Any paper which relates to a pending application may be personally delivered to an examining group. However, the examining group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), application number, filing date, and a description of the paper being filed. If more than one paper is being filed for

the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the group date stamp. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the examining group via the Mail Center.

The examining group will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand-carried to the Customer Service window, Crystal Plaza Building 2, Room 1B01.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Customer Service window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

#### **EXPEDITED PROCEDURE FOR PROCESSING AMENDMENTS AND OTHER REPLIES AFTER FINAL REJECTION (37 CFR 1.116)**

In an effort to improve the timeliness of the processing of amendments and other replies under 37 CFR 1.116, and thereby provide better service to the public, an expedited processing procedure has been established which the public may utilize in filing amendments and other replies after final rejection under 37 CFR 1.116. In order for an applicant to take advantage of the expedited procedure the amendment or other reply under 37 CFR 1.116 will have to be marked as a "Reply under 37 CFR 1.116 — Expedited Procedure - Examining Group (Insert Examining Group Number)" on the upper right portion of the amendment or other reply and the envelope must be marked "Box AF" in the lower left hand corner. The markings preferably should be written in a bright color with a felt point marker. If the reply is mailed to the Office, the envelope should contain only replies under 37 CFR 1.116 and should be mailed to "Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231." Instead of mailing the envelope to "Box AF" as noted above, the reply may be hand-carried to the particular examining group or other area of the Office in which the application is pending and marked on the outside envelope "Reply Under 37 CFR 1.116 - Expedited Procedure-Examining Group (Insert Examining Group Number)."

Upon receipt by the Patent and Trademark Office from the U.S. Postal Service of an envelope appropriately

marked "Box AF," the envelope will be specially processed by the Mail Center and forwarded promptly to the examining group, via the Office of Finance if any fees have to be charged or otherwise processed. Upon receipt of the reply in the examining group it will be promptly processed by a designated technical support staff member and forwarded to the examiner, via the Supervisory Patent Examiner (SPE), for action. The SPE is responsible for ensuring that prompt action on the reply is taken by the examiner. If the examiner to which the application is assigned is not available and will not be available for an extended period, the SPE will ensure that action on the application is promptly taken to assure meeting the PTO goal described below. Once the examiner has completed his or her consideration of the reply, the examiner's action will be promptly typed and mailed by technical support staff personnel designated to expedite the processing of replies filed under this procedure. The examining group supervisory personnel, e.g., the Supervisory Patent Examiner, Supervisory Applications Examiner, and Group Director are responsible for ensuring that actions on replies filed under this procedure are promptly processed and mailed. The Patent and Trademark Office goal is to mail the examiner's action on the reply within 1 month from the date on which the amendment or reply is received by the Patent and Trademark Office.

Applicants are encouraged to utilize this expedited procedure in order to facilitate Patent and Trademark Office processing of replies under 37 CFR 1.116. If applicants do not utilize the procedure by appropriately marking the envelope and enclosed papers, the benefits expected to be achieved therefrom will not be attained. The procedure cannot be expected to result in achievement of the goal in applications in which the delay results from actions by the applicant, e.g., delayed interviews, applicant's desire to file a further reply, or a petition by applicant which requires a decision and delays action on the reply. In any application in which a reply under this procedure has been filed and no action by the examiner has been received within the time referred to herein, plus normal mailing time, a telephone call to the SPE of the relevant group art unit would be appropriate in order to permit the SPE to determine the cause for any delay. If the SPE is unavailable or if no satisfactory reply is received, the Group Director of the examining group should be contacted.

#### **714.14 Amendments After Allowance of All Claims**

Under the decision in *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm'r Pat. 1935), after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be

outstanding formal objections which preclude fully closing the prosecution.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See MPEP § 714.12 and § 714.13.

See MPEP § 714.20 for amendments entered in part.

See MPEP § 607 for additional fee requirements.

Use form paragraph 7.51 to issue an *Ex parte Quayle* action.

#### ¶ 7.51 *Quayle Action*

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

#### Examiner Note:

Explain the formal matters which must be corrected in bracket 1.

### 714.15 Amendment Received in Examining Group After Mailing of Notice of Allowance

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under 37 CFR 1.312. Its entry is a matter of grace. For discussion of amendments filed under 37 CFR 1.312, see MPEP § 714.16 to § 714.16(e).

If, however, the amendment is filed in the Office prior to the mailing out of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it has the same standing in the application as though the notice had not been mailed. Where the application has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under 37 CFR 1.312.

As above implied, the application will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the case is a matter of grace and not of right. *Ex parte Quayle*,

25 USPQ 74, 1935 C.D. 11, 453 O.G. 213 (Comm'r Pat. 1935).

### 714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-1]

37 CFR 1.312. *Amendments after allowance.*

(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment pursuant to this paragraph filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The amendment of an application by applicant after allowance falls within the guidelines of 37 CFR 1.312. Further, the amendment of an application broadly encompasses any change in the file record of the application. Accordingly, the following are examples of “amendments” by applicant after allowance which must comply with 37 CFR 1.312:

- (A) an amendment to the specification,
- (B) a change in the drawings,
- (C) an amendment to the claims,
- (D) a change in the inventorship,
- (E) the submission of prior art, etc.

Finally, it is pointed out that an amendment under 37 CFR 1.312 filed on or before the date the issue fee is paid must comply with paragraph (a) and that such an amendment filed after the date the issue fee is paid must comply with paragraph (b).

The Commissioner has delegated the approval of recommendations under 37 CFR 1.312(a) to the supervisory patent examiners.

With the exception of a supplemental oath or declaration submitted in a reissue, a supplemental oath or declaration is not treated as an amendment under 37 CFR 1.312. See MPEP § 603.01. A supplemental reissue oath or declaration is treated as an amendment under 37 CFR 1.312 because the correction of the patent which it provides is an amendment of the patent, even though no amendment is physically entered into the specification or claim(s). Thus, for a reissue oath or declaration submitted after allowance to be entered, the reissue applicant must comply with 37 CFR 1.312 in the manner set forth in this section.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He or she can, however, make examiner’s amendments (see MPEP § 1302.04) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the

correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the supervisory patent examiner for approval.

Amendments other than those which merely embody the correction of formal matters without changing the scope of the claims require approval by the supervisory patent examiner. The Group Director establishes group policy with respect to the treatment of amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent, namely, (A) that its disclosure be adequately clear, and (B) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under 37 CFR 1.312 cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (A) to be needed for proper disclosure or protection of the invention, and (B) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of 37 CFR 1.111(c) (MPEP § 714.02) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment under 37 CFR 1.312, as in ordinary amendments. See MPEP § 713.04 and § 713.10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.

#### **NOT TO BE USED FOR CONTINUED PROSECUTION**

37 CFR 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly

the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

- (A) an additional search is required;
- (B) more than a cursory review of the record is necessary; or
- (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.

Where claims added by amendment under 37 CFR 1.312 are all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

#### **AMENDMENTS FILED AFTER PAYMENT OF ISSUE FEE**

37 CFR 1.312(b) provides that amendments under 37 CFR 1.312 filed after the date the issue fee has been paid must include a petition and fee under 37 CFR 1.17(i) and a showing of good and sufficient reasons why such an amendment is necessary and was not earlier presented. Such petitions are decided by the Group Director. Form paragraph 13.10 should be used where no petition and/or fee has been filed.

>See MPEP § 1306.03 for practice after payment of the issue fee.<

#### *¶ 13.10 Rule 312 Amendment, Issue Fee Paid, No Petition/Fee*

Applicant's amendment of [1] was filed after the issue fee was paid. 37 CFR 1.312(b) requires a petition and the fee set forth in 37 CFR 1.17(i).

#### **Examiner Note:**

1. For Rule 312 amendments submitted after the issue fee has been paid and not complying with 37 CFR 1.312(b), use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the date of the amendment.

#### **714.16(a) Amendments Under 37 CFR 1.312, Copied Patent Claims**

See MPEP § 2305.04 for the procedure to be followed when an amendment is received after notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See MPEP § 714.19.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

### 714.16(b) Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR 1.633

Where an amendment filed with a motion under 37 CFR 1.633(c)(2) applies to an application in issue, the amendment is not entered unless and until the motion has been granted.

### 714.16(c) Amendments Under 37 CFR 1.312, Additional Claims

If the amendment under 37 CFR 1.312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the examiner unless accompanied by the full fee required. See MPEP § 607 and 35 U.S.C. 41.

### 714.16(d) Amendments Under 37 CFR 1.312, Handling [R-1]

#### AMENDMENTS AFFECTING THE DISCLOSURE OF THE SPECIFICATION, ADDING CLAIMS, OR CHANGING THE SCOPE OF ANY CLAIM

Amendments under 37 CFR 1.312 are sent by the Office of Initial Patent Examination (OIPE) to the Publishing Division which, in turn, forwards the proposed amendment, file, and drawing (if any) to the examining group which allowed the application. In the event that the class and subclass in which the application is classified has been transferred to another group after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other group and the Publishing Division notified. If the examiner who allowed the application is still employed in the Patent and Trademark Office but not in said other group, he or she may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration. The amendment is PROMPTLY considered by the examiner who indicates whether or not its entry is recommended by writing “Enter — 312,” “Do Not Enter” or “Enter In Part” thereon in red ink in the upper left corner.

If the amendment is favorably considered, it is entered and a Response to Rule 312 Communication (PTOL-271) is prepared. No “Entry Recommended under Rule 312” stamp is required on the amendment in view of the use of form PTOL-271. The primary examiner indicates his or her recommendation by stamping and signing his or her name on the PTOL-271. Form paragraph 7.85 may also be used to indicate entry.

#### ¶ 7.85 Amendment Under 37 CFR 1.312 Entered

The amendment filed on [1] under 37 CFR 1.312 has been entered.

#### Examiner Note:

1. Use this form both for amendments that do not affect the scope of the claims (may be signed by Primary Examiner) and for amendments being entered under 37 CFR 1.312 (requires signature of Supervisory Patent Examiner).
2. Entry of amendments filed after the Notice of Allowance not affecting the scope of the claims require the approval of a Primary Examiner and entry of amendments under 37 CFR 1.312(a) require approval by the Supervisory Patent Examiner on recommendation of the Primary Examiner. See MPEP § 714.16.
3. Amendments filed after payment of the issue fee require a petition and fee. These petitions are first decided by the Group Director.

If the examiner’s recommendation is completely adverse, a report giving the reasons for nonentry is typed on the Response to Rule 312 Communication form PTOL-271 and signed by the primary examiner.

Form Paragraph 7.87 may also be used to indicate non-entry.

#### ¶ 7.87 Amendment Under 37 CFR 1.312 Not Entered

The proposed amendment filed on [1] under 37 CFR 1.312 has not been entered. [2]

#### Examiner Note:

- The reasons for non-entry should be specified in bracket 2:
- the amendment was filed after payment of the issue fee without the required petition and fee, 37 CFR 1.312 --; or
  - the amendment was filed in a reissue application and was not accompanied by a supplemental reissue oath or declaration, 37 CFR 1.175(b) --.

In either case, whether the amendment is entered or not entered, the file, drawing, and unmailed notices are forwarded to the supervisory patent examiner for consideration, approval, and mailing.

For entry-in-part, see MPEP § 714.16(e).

The filling out of the appropriate form by the technical support staff does not signify that the amendment has been admitted; for, though actually entered it is not officially admitted unless and until approved by the supervisory patent examiner.

See MPEP § 607 and § 714.16(c) for additional fee requirements.

Petitions to the Commissioner relating to the refusal to enter an amendment under 37 CFR 1.312 and relating to entry of an amendment under 37 CFR 1.312 filed after payment of the issue fee are decided by the Group Director.

If the 37 CFR 1.312 amendment includes proposed drawing changes which are acceptable, the Office response should include form paragraph 6.48.

#### ¶ 6.48 Drawing Changes in 37 CFR 1.312 Amendment

Applicant is hereby given **ONE MONTH** from the >mailing< date of this letter or until the expiration of the period set in the “Notice of Allowance” (PTOL-85) or “Notice of Allowability” (PTOL-37 or PTO-37), whichever is longer, to file corrected drawings.

#### Examiner Note:

Use with the 37 CFR 1.312 amendment notice where there is a drawing correction proposal or request.

**AMENDMENTS WHICH EMBODY MERELY THE CORRECTION OF FORMAL MATTERS IN THE SPECIFICATION, FORMAL CHANGES IN A CLAIM WITHOUT CHANGING THE SCOPE THEREOF, OR THE CANCELLATION OF CLAIMS**

The examiner indicates approval of amendments concerning merely formal matters by writing “Enter Formal Matters Only” thereon. Such amendments do not require submission to the supervisory patent examiner prior to entry. See MPEP § 714.16. The Response to Rule 312 Communication form PTOL-271 is date stamped and mailed by the examining group. If such amendments are disapproved either in whole or in part, they require the signature of the supervisory patent examiner.

**714.16(e) Amendments Under 37 CFR 1.312, Entry in Part**

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under 37 CFR 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the application. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment.

The examiner should then submit a Response to Rule 312 Communication form PTOL-271 recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his reasons therefor. The claims entered should be indicated by number in this response. Applicant may also be notified by using form paragraph 7.86.

*¶ 7.86 Amendment Under 37 CFR 1.312 Entered in Part*

The amendment filed on [1] under 37 CFR 1.312 has been entered-in-part. [2]

**Examiner Note:**

When an amendment under 37 CFR 1.312 is proposed containing plural changes, some of which may be acceptable and some not, the acceptable changes should be entered. An indication of which changes have and have not been entered with appropriate explanation should follow in bracket 2.

Handling is similar to complete entry of a 37 CFR 1.312 amendment.

Entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See MPEP § 607 and § 714.16(c).

**714.17 Amendment Filed After the Period for Reply Has Expired**

When an application is not prosecuted within the period set for reply and thereafter an amendment is filed without a petition for extension of time and fee pursuant to 37 CFR 1.136(a), such amendment shall be endorsed on the file wrapper of the application, but not formally entered. The technical support staff shall immediately notify the applicant, by telephone and form letter PTOL-327, that the amendment was not filed within the time period and therefore cannot be entered and that the application is abandoned unless a petition for extension of time and the appropriate fee are timely filed. See MPEP § 711.02.

See MPEP § 710.02(e) for a discussion of the requirements of 37 CFR 1.136(a).

**714.18 Entry of Amendments**

Amendments are stamped with the date of their receipt in the examining group. It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the examining group (“Group Date” stamp) and the stamp bearing the date of receipt of the amendment by the Office (“Office Date” stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his or her amendment.

All amendments received in the technical support staff sections are processed and with the applications delivered to the supervisory patent examiner for his or her review and distribution to the examiners.

Every mail delivery should be carefully screened to remove all amendments replying to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all applications where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these applications pass over the supervisory patent examiner’s desk, he or she will be made aware of the need for any special treatment, if the situation so warrants. For example, the supervisory patent examiner will know whether or not the examiner in each case is on extended leave or otherwise incapable of moving the case within the required time periods (see MPEP § 714.13). In cases of this type, the applicant should receive an Office communication in sufficient time to adequately consider his or her next action if the case is not allowed. Consequently, technical support staff handling will continue to be special when these applications are returned by the examiners to the technical support staff.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is “up for action.” It is placed on the examiner’s desk, and he or she is responsible for its proper disposal. The examiner should immediately inspect the amendment as set forth in MPEP § 714.05. After inspection, if no immediate or special action is required, the application awaits examination in regular order.

### **714.19 List of Amendments, Entry Denied [R-1]**

The following types of amendments are ordinarily denied entry:

(A) An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in an application whose prosecution before the primary examiner has been closed, as where

(1) All claims have been allowed,

(2) All claims have been finally rejected (for exceptions see MPEP § 714.12, § 714.13, and § 714.20, item (D)),

(3) Some claims have been allowed and the remainder finally rejected. See MPEP § 714.12 to § 714.14.

(B) Substitute specification that does not comply with 37 CFR 1.125. See MPEP § 608.01(q) and § 714.20.

(C) A patent claim suggested by the examiner and not presented within the time limit set or an extension thereof, unless entry is authorized by the Commissioner. See MPEP § 2305.03.

(D) While copied patent claims are generally admitted even though the case is under final rejection or on appeal, under certain conditions, the claims may be refused entry. See MPEP § 2307.03.

(E) An unsigned or improperly signed amendment or one signed by a suspended or excluded attorney or agent.

(F) An amendment filed in the Patent and Trademark Office after the expiration of the statutory period or set time period for reply and any extension thereof. See MPEP § 714.17.

(G) An amendment so worded that it cannot be entered with certain accuracy. See MPEP § 714.23.

(H) An amendment >filed after the filing date of an application< canceling all of the claims and presenting no substitute claim or claims. See MPEP § 711.01.

(I) An amendment in an application no longer within the examiner’s jurisdiction with certain exceptions in applications in issue, except on approval of the Commissioner. See MPEP § 714.16.

(J) Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of nonentry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims. See MPEP § 608.04 and § 706.03(o).

(K) An amendatory paper containing objectionable remarks that, in the opinion of the examiner, brings it within the condemnation of 37 CFR 1.3, will be submitted to the Group Director for return to applicant. See MPEP § 714.25 and MPEP § 1003. If the Group Director determines that the remarks are in violation of 37 CFR 1.3, he or she will return the paper.

(L) Amendments not in permanent ink. Amendments on so-called “easily erasable paper.” See MPEP § 714.07.

(M) An amendment presenting claims (total and independent) in excess of the number previously paid for and not accompanied by the full fee for the claims or an authorization to charge the fee to a deposit account.

(N) An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified as directed in MPEP § 714.03 and § 714.05. See MPEP § 821.03.

While amendments falling within any of the foregoing categories should not be entered by the examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

### **714.20 List of Amendments Entered in Part**

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for reply. Thus:

(A) An “amendment” presenting an unacceptable substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry in toto. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The application as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been entered.

See 37 CFR 1.125 and MPEP § 608.01(q) for information regarding the submission of a substitute specification.

Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A proper substitute specification will normally be accepted by the Office even if it has not been required by the examiner.

(B) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See MPEP § 714.16(e).

(C) In an application in which prosecution on the merits is closed, i.e., after the issuance of an *Ex Parte Quayle* action, where an amendment is presented curing the noted formal defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the amendment in such a case will be entered only as to the formal matter. Applicant has no right to have new claims considered or entered at this point in the prosecution.

(D) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted.

**NOTE.** The examiner writes “Enter” in ink and his or her initials in the left margin opposite the enterable portions.

### 714.21 Amendments Inadvertently Entered, No Legal Effect

If the technical support staff inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as “Not Officially Entered.”

If an amendatory paper is to be retained in the file, even though not entered, it should be given a paper number and listed on the file wrapper with the notation “Not Entered.” See 37 CFR 1.3 and MPEP § 714.25 for an example of a paper which may be returned.

### 714.22 Entry of Amendments, Directions for [R-1]

37 CFR 1.121. *Manner of making amendments.*

(a) *Amendments in nonprovisional applications, other than reissue applications:* Amendments in nonprovisional applications, excluding reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(1) *Specification other than the claims.* Except as provided in § 1.125, amendments to add matter to, or delete matter from, the specification, other than to the claims, may only be made as follows:

(i) Instructions for insertions: The precise point in the specification must be indicated where an insertion is to be made, and the matter to be inserted must be set forth.

(ii) Instructions for deletions: The precise point in the specification must be indicated where a deletion is to be made, and the matter to be deleted must be set forth or otherwise indicated.

(iii) Matter deleted by amendment can be reinstated only by a subsequent amendment presenting the previously deleted matter as a new insertion.

(2) *Claims.* Amendments to the claims may only be made as follows:

(i) Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and the precise point where the deletion or insertion is to be made, where the changes are limited to:

(A) Deletions and/or

(B) The addition of no more than five (5) words in any one claim; or

(ii) Claim cancellation or rewriting: A claim may be amended by directions to cancel the claim or by rewriting such claim with underlining below the matter added and brackets around the matter deleted. The rewriting of a claim in this form will be construed as directing the deletion of the previous version of that claim. If a previously rewritten claim is again rewritten, underlining and bracketing will be applied relative to the previous version of the claim, with the parenthetical expression “twice amended,” “three times amended,” etc., following the original claim number. The original claim number followed by that parenthetical expression must be used for the rewritten claim. No interlineations or deletions of any prior amendment may appear in the currently submitted version of the claim. A claim canceled by amendment (not deleted and rewritten) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

(3) *Drawings.*

(i) Amendments to the original application drawings are not permitted. Any change to the application drawings must be by way of a substitute sheet of drawings for each sheet changed submitted in compliance with § 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(4) [Reserved]

(5) The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(6) No amendment may introduce new matter into the disclosure of an application.

(b) *Amendments in reissue applications:* Amendments in reissue applications are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(1) *Specification other than the claims.* Amendments to the specification, other than to the claims, may only be made as follows:

(i) Amendments must be made by submission of the entire text of a newly added or rewritten paragraph(s) with markings pursuant to paragraph (b)(1)(iii) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph.

(ii) The precise point in the specification must be indicated where the paragraph to be amended is located.

(iii) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made.

(2) *Claims.* Amendments to the claims may only be made as follows:

(i)(A) The amendment must be made relative to the patent claims in accordance with paragraph (b)(6) of this section and must include the entire text of each claim which is being amended by the current amendment and of each claim being added by the current amendment with markings pursuant to paragraph (b)(2)(i)(C) of this section, except that a patent claim or added claim should be cancelled by a statement cancelling the patent claim or added claim without presentation of the text of the patent claim or added claim.

(B) Patent claims must not be renumbered and the numbering of any claims added to the patent must follow the number of the highest numbered patent claim.

(C) Underlining below the subject matter added to the patent and brackets around the subject matter deleted from the patent are to be used to mark the amendments being made. If a claim is amended pursuant to paragraph (b)(2)(i)(A) of this section, a parenthetical expression “amended,” “twice amended,” *etc.*, should follow the original claim number.

(ii) Each amendment submission must set forth the status (*i.e.*, pending or cancelled) as of the date of the amendment, of all patent claims and of all added claims.

(iii) Each amendment when originally submitted must be accompanied by an explanation of the support in the disclosure of the patent for the amendment along with any additional comments on page(s) separate from the page(s) containing the amendment.

(3) *Drawings.*

(i) Amendments to the original patent drawings are not permitted. Any change to the patent drawings must be by way of a new sheet of drawings with the amended figures identified as “amended” and with added figures identified as “new” for each sheet changed submitted in compliance with § 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

(4) The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(5) No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251. No amendment to the patent may introduce new matter or be made in an expired patent.

(6) All amendments must be made relative to the patent specification, including the claims, and drawings, which is in effect as of the date of filing of the reissue application.

(c) *Amendments in reexamination proceedings:* Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530(d).

The term “brackets” set forth in 37 CFR 1.121(a) means square brackets, thus: [ ]. It does not encompass and is to be distinguished from parentheses (). Any amendment using parentheses to indicate canceled matter in a claim rewritten under 37 CFR 1.121(a) may be held not fully responsive.

Where, by amendment under 37 CFR 1.121(a), a dependent claim is rewritten to be in independent form, the subject matter from the prior independent claim should be considered to be “added” matter and should be underlined.

Form paragraphs 6.33 and 6.34 may be used to inform applicants if the amendments are not in proper format.

¶ 6.33 *Amendment to the Claims, Addition of More Than 5 Words, 37 CFR 1.121*

The reply filed on [1] is not fully responsive to the prior Office action and the amendment to the claims has not been entered, because the amendment requests the addition of more than five words in at least one claim. See 37 CFR 1.121(a)(2)(i) below:

(i) Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and the precise point where the deletion or insertion is to be made, where the changes are limited to:

(A) Deletions and/or

(B) The addition of no more than five (5) words in any one claim; or

The amendment to the claims should be made in accordance with 37 CFR 1.121(a)(2)(ii) which states:

(ii) Claim cancellation or rewriting: A claim may be amended by directions to cancel the claim or by rewriting such claim with underlining below the matter added and brackets around the matter deleted. The rewriting of a claim in this form will be construed as directing the deletion of the previous version of that claim. If a previously rewritten claim is again rewritten, underlining and bracketing will be applied relative to the previous version of the claim, with the parenthetical expression “twice amended,” “three times amended,” *etc.*, following the original claim number. The original claim number followed by that parenthetical expression must be used for the rewritten claim. No interlineations or deletions of any prior amendment may appear in the currently submitted version of the claim. A claim canceled by amendment (not deleted and rewritten) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Since the above-mentioned reply appears to be *bona fide*, applicant is given TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)**

**Examiner Note:**

1. In bracket 1, insert the filing date of the reply.

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¶ 6.34 *Amendment of the Claims, Use of Brackets or Underlining Unclear*

Brackets or underlining are commonly used to indicate amendments or changes in the claims as provided in 37 CFR 1.121(a)(2)(ii) and are normally not intended to be printed in the published patent. In the reply filed [1], applicant has used [2] in such a manner that it is unclear to the examiner whether the [3] is intended to appear in the patent. The [4] is unclear because [5]. If underlining and/or bracketing is intended to appear in the claims in the published patent, such intention must be clearly indicated in applicant’s reply to this notice.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply an amendment in compliance with 37 CFR 1.121 and this notice in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)**.

**Examiner Note:**

1. See MPEP § 714.22 for the proper use of this form paragraph.
2. In brackets 2, 3 and 4, insert --underlining-- and/or --bracketing--.
3. In bracket 5, insert an explanation of why the underlining or bracketing is unclear.

4. When confronted by a proposed amendment to the claims which is unclear and the examiner cannot perform a meaningful and thorough search and examination of the claims, the examiner should attempt to seek clarification from the applicant. Before sending out an Office action or notice setting a new time period for reply, the examiner should first attempt to call the applicant to determine whether the applicant intends the underlining and/or bracketing to appear in the issued patent. The substance of the interview must be made of record. The above form paragraph restarting the time period should only be used in such cases where the examiner is unable to obtain clarification from the applicant by telephone.
5. This form paragraph should not be used in a reissue application or a reexamination proceeding.<

### 714.23 Entry of Amendments, Directions for, Defective

The directions for the entry of an amendment may be defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line. If it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining group and notation thereof, initialed in ink by the examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action the applicant should be informed of this alteration in the amendment and the entry of the amendment as thus amended. The applicant will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

### 714.24 Amendment of Amendments

When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.

However, where a relatively small amendment to a previous amendment can be made easily without causing the amendatory matter to be obscure or difficult to follow, such small amendment should be entered.

### 714.25 Discourtesy of Applicant or Attorney

*37 CFR 1.3. Business to be conducted with decorum and courtesy.*

Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other employees must be made in communications separate from other papers.

All papers received in the Patent and Trademark Office should be briefly reviewed by the technical support staff,

before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney or agent is discourteous in the remarks or arguments in his or her amendment, either the discourtesy should be entirely ignored or the paper submitted to the Group Director with a view toward it being returned. See MPEP § 1003. If the Group Director determines that the remarks are in violation of 37 CFR 1.3, the Group Director will return the paper.

### 715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131 [R-1]

*37 CFR 1.131. Affidavit or declaration of prior invention to overcome cited patent or publication*

(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.

(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996 in a WTO member country other than a NAFTA country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

37 CFR 1.131(a) has been amended to implement the relevant provisions of Public Law 103-182, 107 Stat. 2057 (1993) (North American Free Trade Agreement Act) and Public Law 103-465, 108 Stat. 4809 (1994) (Uruguay Round Agreements Act), respectively. Under 37 CFR 1.131(a) as amended, which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a

date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act (URAA). Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

Any printed publication dated prior to an applicant's or patent owner's effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application or patent under reexamination.

Such a rejection may be overcome, in certain instances noted below, by filing of an affidavit or declaration under 37 CFR 1.131, known as "swearing back" of the reference.

It should be kept in mind that it is the rejection that is withdrawn and not the reference.

#### **SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS CAN BE USED**

Affidavits or declarations under 37 CFR 1.131 may be used:

(A) Where the date of the foreign patent or that of the publication is less than 1 year prior to applicant's or patent owner's effective filing date.

(B) Where the reference, a U.S. Patent, with a patent date less than 1 year prior to applicant's effective filing date, shows but does not claim the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention."

#### **SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE**

An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations:

(A) Where the reference publication date is more than 1 year back of applicant's or patent owner's effective filing date. Such a reference is a "statutory bar" under 35 U.S.C. 102(b).

(B) Where the reference U.S. patent claims the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention" and MPEP § 2306. Where the reference patent and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer

and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

(C) Where the reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than 12 months prior to the filing date of the domestic application. See 35 U.S.C. 102(d).

(D) Where the effective filing date of applicant's or patent owner's parent application or an International Convention proved filing date is prior to the effective date of the reference, an affidavit or declaration under 37 CFR 1.131 is unnecessary because the reference is not used. See MPEP § 201.11 to § 201.15.

(E) Where the reference is a prior U.S. patent to the same entity, claiming the same invention. The question involved is one of "double patenting."

(F) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending. The question is one of dedication to the public. Note however, *In re Gibbs*, 437 F.2d 486, 168 USPQ 578 (CCPA 1971) which substantially did away with the doctrine of dedication.

(G) Where applicant has clearly admitted on the record that subject matter relied on in the reference is prior art. In this case, that subject matter may be used as a basis for rejecting his or her claims and may not be overcome by an affidavit or declaration under 37 CFR 1.131. *In re Hellsund*, 474 F.2d 1307, 177 USPQ 170 (CCPA 1973); *In re Garfinkel*, 437 F.2d 1000, 168 USPQ 659 (CCPA 1971); *In re Blout*, 333 F.2d 928, 142 USPQ 173 (CCPA 1964); *In re Lopresti*, 333 F.2d 932, 142 USPQ 177 (CCPA 1964).

(H) Where the subject matter relied upon is prior art under 35 U.S.C. 102(f).

(I) Where the subject matter relied on in the reference is prior art under 35 U.S.C. 102(g). 37 CFR 1.131 is designed to permit an applicant to overcome rejections under 35 U.S.C. 102(a) and (e) based on patents and publications which are not statutory bars, but which have publication dates, or in the case of U.S. patents, effective filing dates, prior to the effective filing date of the application but subsequent to the applicant's actual date of invention. However, when the subject matter relied on is also available under 35 U.S.C. 102(g), a 37 CFR 1.131 affidavit or declaration cannot be used to overcome it. *In re Bass*, 474 F.2d 1276, 177 USPQ 178 (CCPA 1973). This is because subject matter which is available under 35 U.S.C. 102(g) by definition must have been made before the applicant made his invention. References under 35 U.S.C. 102(a) and (e), by contrast, merely establish a presumption that their subject matter was made before applicant's invention date. It is this

presumption which may be rebutted by evidence submitted under 37 CFR 1.131.

(J) Where the subject matter corresponding to a lost count in an interference is either prior art under 35 U.S.C. 102(g) or barred to applicant by the doctrine of interference estoppel. *In re Bandel*, 348 F.2d 563, 146 USPQ 389 (CCPA 1965); *In re Kroekel*, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986). See also *In re Deckler*, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992) (Under the principles of *res judicata* and *collateral estoppel*, applicant was not entitled to claims that were patentably indistinguishable from the claim lost in interference even though the subject matter of the lost count was not available for use in an obviousness rejection under 35 U.S.C. 103). But see *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989) (A losing party to an interference, on showing that the invention now claimed is not “substantially the same” as that of the lost count, may employ the procedures of 37 CFR 1.131 to antedate the filing date of an interfering application). On the matter of when a “lost count” in an interference constitutes prior art under 35 U.S.C. 102(g), see *In re McKellin*, 529 F.2d 1342, 188 USPQ 428 (CCPA 1976) (A count is not prior art under 35 U.S.C. 102(g) as to the loser of an interference where the count was lost based on the winner’s foreign priority date). Similarly, where one party in an interference wins a count by establishing a date of invention in a NAFTA or WTO member country (see 35 U.S.C. 104), the subject matter of that count is unpatentable to the other party by the doctrine of interference estoppel, even though it is not available as statutory prior art under 35 U.S.C. 102(g). See MPEP § 2138.01 and § 2138.02.

## REFERENCE DATE TO BE OVERCOME

The date to be overcome under 37 CFR 1.131 is the effective date of the reference (i.e., the date on which the reference is available as prior art).

### A. U.S. Patents

See MPEP § 2136 through § 2136.03 for a detailed discussion of the effective date of a U.S. patent as a reference.

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit or declaration is the date of amendment. *In re Willien*, 74 F.2d 550, 24 USPQ 210 (CCPA 1935). The effective date of a domestic patent when used as a reference is not the foreign filing date to which the application for patent may have been entitled under 35 U.S.C. 119(a) during examination. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Therefore, the date to be overcome under 37 CFR 1.131 is the effective U.S. filing date, not the foreign priority date. \*\*

>When a U.S. patent reference is entitled to a priority date based on an earlier filed international application (PCT) under 35 U.S.C. 120, \*\* >its effective filing date as a reference under 35 U.S.C. 102(e) is the U.S. filing date and not the international filing date<. Further, note that the effective date of a patent issued on an application entitled to priority under 35 U.S.C. 119(e) to a provisional application filed under 35 U.S.C. 111(b) is the filing date of the provisional application, except for a patent granted on an international application in which applicant has fulfilled the requirements of paragraphs (1), (2) and (4) of 35 U.S.C. 371(c). Where a U.S. national stage application filed under 35 U.S.C. 371 becomes a U.S. patent, its effective date as a prior art reference is the date on which the requirements of paragraphs (1), (2) and (4) of 35 U.S.C. 371(c) were fulfilled.

### B. Foreign Patents

See MPEP § 2126 through § 2127 regarding date of availability of foreign patents as prior art.

### C. Printed Publications

A printed publication, including a published foreign patent application, is effective as of its publication date, not its date of receipt by the publisher. For additional information regarding effective dates of printed publications, see MPEP § 2128 through § 2128.02.

## FORM PARAGRAPHS

Form paragraphs 7.57-7.64 may be used to respond to 37 CFR 1.131 affidavits.

### ¶ 7.57 Affidavit or Declaration Under 37 CFR 1.131: Ineffective-Heading

The [1] filed on [2] under 37 CFR 1.131 has been considered but is ineffective to overcome the [3] reference.

#### Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. This paragraph must be followed by one or more of paragraphs 7.58 to 7.63 or a paragraph setting forth proper basis for the insufficiency, such as failure to establish acts performed in this country, or that the scope of the declaration or affidavit is not commensurate with the scope of the claim(s).

### ¶ 7.58 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Claiming Same Invention

The [1] reference is a U.S. patent that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the patent is claiming the same patentable invention, see MPEP § 2306. If the patent and this application are not commonly owned, the patent can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the patent and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

**Examiner Note:**

1. If used to respond to the submission of an affidavit under 37 CFR 1.131, this paragraph must be preceded by paragraph 7.57.
2. This paragraph may be used without paragraph 7.57 when an affidavit has not yet been filed, and the examiner desires to notify applicant that the submission of an affidavit under 37 CFR 1.131 would be inappropriate.

*¶ 7.59 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Reduction to Practice Before Reference Date*

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the [1] reference. [2]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.57.
2. An explanation of the lack of showing of the alleged reduction to practice must be provided in bracket 2.

*¶ 7.60 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Reference Is a Statutory Bar*

The [1] reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

**Examiner Note:**

This paragraph must be preceded by paragraph 7.57.

*¶ 7.61 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Conception*

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the [1] reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). [2]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.57.
2. An explanation of the deficiency in the showing of conception must be presented in bracket 2.
3. If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this paragraph should be followed by paragraph 7.62 and/or 7.63. If either diligence or a reduction to practice is established, a statement to that effect should follow this paragraph.

*¶ 7.62 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Diligence Lacking*

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the [1] reference to either a constructive reduction to practice or an actual reduction to practice. [2]

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.57.
2. If the affidavit additionally fails to establish conception, this paragraph must also be preceded by paragraph 7.61. If the affidavit establishes conception, a statement to that effect should be added to this paragraph.
3. If the affidavit additionally fails to establish an alleged reduction to practice prior to the application filing date, this paragraph must be followed by paragraph 7.63. If such an alleged reduction to practice is established, a statement to that effect should be added to this paragraph.
4. An explanation of the reasons for a holding of non-diligence must be provided in bracket 2.

5. See MPEP § 715.07(a), *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947), which indicates that diligence is not required after reduction to practice.

*¶ 7.63 Affidavit or Declaration Under 37 CFR 1.131: Ineffective, Insufficient Evidence of Actual Reduction to Practice*

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the [1] reference. [2].

**Examiner Note:**

1. This paragraph must be preceded by paragraph 7.57.
2. If the alleged reduction to practice is prior to the effective date of the reference, do not use this paragraph. See paragraph 7.59.
3. If the affidavit additionally fails to establish either conception or diligence, paragraphs 7.61 and/or 7.62 should precede this paragraph. If either conception or diligence is established, a statement to that effect should be included after this paragraph.
4. An explanation of the lack of showing of the alleged reduction to practice must be given in bracket 2.

*¶ 7.64 Affidavit or Declaration Under 37 CFR 1.131: Effective To Overcome Reference*

The [1] filed on [2] under 37 CFR 1.131 is sufficient to overcome the [3] reference.

**Examiner Note:**

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the name of the reference.

## 715.01 37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits

The purpose of a 37 CFR 1.131 affidavit or declaration is to overcome a prior art rejection by proving invention of the claimed subject matter by applicant prior to the effective date of the reference relied upon in the rejection.

In some situations, an applicant may, alternatively, be able to overcome prior art rejections relying on references which are available as prior art under 35 U.S.C. 102(a) or (e) by proving that the subject matter relied upon in the reference was applicant's own invention.

Similarly, where the reference relied upon in a 35 U.S.C. 103 rejection qualifies as prior art only under 35 U.S.C. 102(f) or (g), applicant may be able to overcome this rejection by proving that the subject matter relied upon and the claimed invention were commonly owned or subject to common assignment at the time the later invention was made. In such situations, an affidavit or declaration under 37 CFR 1.132, rather than 37 CFR 1.131, would be appropriate. See MPEP § 715.01(a) through § 715.01(c) for specific situations where these issues may arise.

### 715.01(a) Reference Is a Joint Patent to Applicant and Another

When subject matter, disclosed but not claimed in a patent issued jointly to S and another, is claimed in a later

application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent was the invention of the applicant. Disclaimer by the other patentee should not be required but, if submitted, may be accepted by the examiner.

Although affidavits or declarations submitted for the purpose of establishing that the reference discloses applicant's invention are properly filed under 37 CFR 1.132, rather than 37 CFR 1.131, such affidavits submitted improperly under 37 CFR 1.131 will be considered as though they were filed under 37 CFR 1.132 to traverse a ground of rejection. *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

### **715.01(b) Reference and Application Have Common Assignee [R-1]**

The mere fact that the reference patent which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131, in the absence of a showing under 37 CFR 1.132 that the patentee derived the subject matter relied on from the applicant (MPEP § 716.10). The common assignee does not obtain any rights in this regard by virtue of common ownership which he would not have in the absence of common ownership. *In re Friblette*, 412 F.2d 269, 162 USPQ 163 (CCPA 1969); *Pierce v. Watson*, 275 F.2d 890, 124 USPQ 356 (D.C. Cir. 1960); *In re Beck*, 155 F.2d 398, 69 USPQ 520 (CCPA 1946). Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 >, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103< using the reference patent, a showing that the invention was commonly owned at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. >See MPEP § 706.02(1) and § 706.02(1)(1).<

### **715.01(c) Reference Is Publication of Applicant's Own Invention**

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under

37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. *Ex parte Lemieux*, 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); *Ex parte Powell*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

### **COAUTHORSHIP**

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

### **DERIVATION**

When the unclaimed subject matter of a patent or other publication is applicant's own invention, a rejection on that patent or publication may be removed by submission of evidence establishing the fact that the patentee or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent or publication is based. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

### **715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims**

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) (Where applicant claims an alloy comprising both nitrogen and molybdenum, an affidavit showing applicant made an alloy comprising nitrogen but not molybdenum is not sufficient under 37 CFR 1.131 to overcome a rejection under 35 U.S.C. 103 based on the combined teachings of one reference disclosing an alloy comprising nitrogen but

not molybdenum and a second reference disclosing an alloy comprising molybdenum but not nitrogen). Note, however, where the differences between the claimed invention and the disclosure of the reference(s) are so small as to render the claims obvious over the reference(s), an affidavit or declaration under 37 CFR 1.131 is required to show no more than the reference shows. *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). In other words, where the examiner, in rejecting a claim under 35 U.S.C. 103, has treated a claim limitation as being an obvious feature or modification of the disclosure of the reference(s) relied upon, without citation of a reference which teaches such feature or modification, a 37 CFR 1.131 affidavit or declaration may be sufficient to overcome the rejection even if it does not show such feature or modification.

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s). Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art. However, the affidavit or declaration showing must still establish possession of the invention (i.e., the basic inventive concept) and not just of what one reference (in a combination of applied references) happens to show, if that reference does not itself teach the basic inventive concept. *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974) (Claimed invention was use of electrostatic forces to adhere dry starch particles to a wet paper web on the Fourdrinier wire of a paper-making machine. 37 CFR 1.131 affidavit established use of electrostatic forces to adhere starch particles to wet blotting paper moved over a fluidized bed of starch particles prior to the applied reference date. Affidavit was sufficient in view of prior art reference showing that deposition of dry coatings directly on wet webs on the Fourdrinier wire of a paper-making machine was well known in the art prior to the date of the applied reference. The affidavit established

possession of the basic invention, i.e., use of electrostatic forces to adhere starch to wet paper.).

### **SWEARING BEHIND ONE OF A PLURALITY OF COMBINED REFERENCES**

Applicant may overcome a 35 U.S.C 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date. However, as discussed above, applicant's 37 CFR 1.131 affidavit must show possession of either the whole invention as claimed or something falling within the claim(s) prior to the effective date of the reference being antedated; it is not enough merely to show possession of what the reference happens to show if the reference does not teach the basic inventive concept.

Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A. However, the 37 CFR 1.131 affidavit or declaration must still establish possession of the claimed invention, not just what Reference A shows, if Reference A does not teach the basic inventive concept.

### **GENERAL RULE AS TO GENERIC CLAIMS**

A reference applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference (assuming, of course, that the reference is not a statutory bar or a patent claiming the same invention). See *Ex parte Biesecker*, 144 USPQ 129 (Bd. App. 1964). See, also, *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968) (distinguishing chemical species of genus compounds from embodiments of a single invention). See, however, MPEP § 715.03 for practice relative to cases in unpredictable arts.

### **715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question**

Where generic claims have been rejected on a reference which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn, subject to the rules set forth below, unless the applicant is able to establish that he or she was in possession of the

generic invention prior to the effective date of the reference. In other words, the affidavit or declaration under 37 CFR 1.131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

## REFERENCE DISCLOSES SPECIES

### A. *Species Claim*

Where the claim under rejection recites a species and the reference discloses the claimed species, the rejection can be overcome under 37 CFR 1.131 directly by showing prior completion of the claimed species or indirectly by a showing of prior completion of a different species coupled with a showing that the claimed species would have been an obvious modification of the species completed by applicant. See *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).

### B. *Genus Claim*

The principle is well established that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a “generic claim.” *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960).

Where the only pertinent disclosure in the reference is a single species of the claimed genus, the applicant can overcome the rejection directly under 37 CFR 1.131 by showing prior possession of the species disclosed in the reference. On the other hand, a reference which discloses several species of a claimed genus can be overcome directly under 37 CFR 1.131 only by a showing that the applicant completed, prior to the date of the reference, all of the species shown in the reference. *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957).

Proof of prior completion of a species different from the reference species will be sufficient to overcome a reference indirectly under 37 CFR 1.131 if the reference species would have been obvious in view of the species shown to have been made by the applicant. *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re Hostettler*, 356 F.2d 562, 148 USPQ 514 (CCPA 1966). Alternatively, if the applicant cannot show possession of the reference species in this manner, the applicant may be able to antedate the reference indirectly by, for example, showing prior completion of one or more species which put him or her in possession of the claimed genus prior to the reference date. The test is whether the species completed by applicant prior to the reference date provided an adequate basis for inferring that the invention has generic applicability. *In re Plumb*, 470 F.2d 1403, 176 USPQ 323 (CCPA 1973); *In re*

*Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1966); *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA 1957).

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference. *In re Schaub*, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).

### C. *Species Versus Embodiments*

References which disclose one or more embodiments of a single claimed invention, as opposed to species of a claimed genus, can be overcome by filing a 37 CFR 1.131 affidavit showing prior completion of a single embodiment of the invention, whether it is the same or a different embodiment from that disclosed in the reference. See *In re Fong*, 288 F.2d 932, 129 USPQ 264 (CCPA 1961) (Where applicant discloses and claims a washing solution comprising a detergent and polyvinylpyrrolidone (PVP), with no criticality alleged as to the particular detergent used, the PVP being used as a soil-suspending agent to prevent the redeposition of the soil removed, the invention was viewed as the use of PVP as a soil-suspending agent in washing with a detergent. The disclosure in the reference of the use of PVP with two detergents, both of which differed from that shown in applicant’s 37 CFR 1.131 affidavit, was considered a disclosure of different embodiments of a single invention, rather than species of a claimed genus); *In re Defano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968).

## REFERENCE DISCLOSES CLAIMED GENUS

In general, where the reference discloses the claimed genus, a showing of completion of a single species within the genus is sufficient to antedate the reference under 37 CFR 1.131. *Ex parte Biasecker*, 144 USPQ 129 (Bd. App. 1964).

In cases where predictability is in question, on the other hand, a showing of prior completion of one or a few species within the disclosed genus is generally not sufficient to overcome the reference. *In re Shokal*, 242 F.2d 771, 113 USPQ 283 (CCPA 1957). The test is whether the species completed by applicant prior to the reference date provided an adequate basis for inferring that the invention has generic applicability. *In re Mantell*, 454 F.2d 1398, 172 USPQ 530 (CCPA 1973); *In re Rainer*, 390 F.2d 771, 156 USPQ 334 (CCPA 1968); *In re DeFano*, 392 F.2d 280, 157 USPQ 192 (CCPA 1968); *In re Clarke*, 356 F.2d 987, 148 USPQ 665 (CCPA 1965). In the case of a small genus such as the halogens, which consists of four species, a reduction to practice of three, or perhaps even two, species

might show possession of the generic invention, while in the case of a genus comprising hundreds of species, reduction to practice of a considerably larger number of species would be necessary. *In re Shokal, supra*.

It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species he or she actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference. *In re Schaub*, 537 F. 509, 190 USPQ 324 (CCPA 1976).

### **715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations**

#### **WHO MAY MAKE AFFIDAVIT OR DECLARATION**

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims on a cited patent or publication must be made by the inventor or inventors of the subject matter of the rejected claim(s) or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

### **FORMAL REQUIREMENTS OF AFFIDAVITS AND DECLARATIONS**

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits.

37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

### **715.05 Patent Claiming Same Invention [R-1]**

When the reference in question is a noncommonly owned >U.S.< patent claiming the same invention as applicant and its issue date is less than 1 year prior to the \*\* >presentation of claims to that invention in< the application being examined, applicant's remedy, if any, must be by way of 37 CFR 1.608 instead of 37 CFR 1.131. \*\* If the patent is claiming the same invention as the application and its issue date is less than 1 year prior to the \*\* >presentation of claims to that invention in< the application, this fact should be noted in the Office action. The reference patent can then be overcome only by way of interference. See MPEP §§ 2306- 2308. If the patent is claiming the same invention as the application and its issue date is 1 year or more prior to the \*\* >presentation of claims to that invention in< the application, a rejection of the claims of the application under 35 U.S.C. 135(b) should be made. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) (The court holding that application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.).

Form paragraph 23.14 may be used when making a rejection under 35 U.S.C. 135(b).

#### *¶ 23.14 Claims Not Copied Within One Year*

Claim [1] rejected under 35 U.S.C. 135(b) as not being made prior to one year from the date on which U.S. Patent No. [2] was granted. >See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.<

Where the reference patent and the application or patent under reexamination are commonly owned, and the

inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims. *In re Clark*, 457 F.2d 1004, 173 USPQ 359 (CCPA 1972); *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Wagenhorst*, 62 F.2d 831, 16 USPQ 126 (CCPA 1933).

If the application (or patent under reexamination) and the domestic patent contain claims which are identical, or which are not patentably distinct, then the application and patent are claiming the “same patentable invention,” defined by 37 CFR 1.601(n) as follows:

Invention “A” is the *same patentable invention* as an invention “B” when invention “A” is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention “B” assuming invention “B” is prior art with respect to invention “A.”

As provided in 37 CFR 1.601(i), an interference may be declared whenever an examiner is of the opinion that an application and a patent contain claims for the “same patentable invention.” An applicant who is claiming an invention which is identical to, or obvious in view of, the invention as claimed in a domestic patent cannot employ an affidavit under 37 CFR 1.131 as a means for avoiding an interference with the patent. To allow an applicant to do so would result in the issuance of two patents to the same invention.

Since 37 CFR 1.131 defines “same patentable invention” in the same way as the interference rules (37 CFR 1.601(n)), the PTO cannot prevent an applicant from overcoming a reference by a 37 CFR 1.131 affidavit or declaration on the grounds that the reference domestic patent claims applicant’s invention and, at the same time, deny applicant an interference on the grounds that the claims of the application and those of the reference patent are not for substantially the same invention. See *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979). Where, in denying an applicant’s motion in interference to substitute a broader count, it is held that the limitation to be deleted was material for the opponent patentee, this constitutes a holding that the proposed count is for an invention which is not the “same patentable invention” claimed by the patentee. Therefore, the applicant may file an affidavit or declaration under 37 CFR 1.131 to overcome a prior art rejection based

on the patent. *Adler v. Kluver*, 159 USPQ 511 (Bd. Pat. Int. 1968).

Form paragraph 7.58 (reproduced in MPEP § 715) may be used to note such a situation in the Office action.

## 715.07 Facts and Documentary Evidence

### GENERAL REQUIREMENTS

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

- (A) attached sketches;
- (B) attached blueprints;
- (C) attached photographs;
- (D) attached reproductions of notebook entries;
- (E) an accompanying model;
- (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989);
- (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm’r Pat. 1905);
- (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception.

Exhibits and models must comply with the requirements of 37 CFR 1.91 to be entered into an application file. See also MPEP § 715.07(d).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm’r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

37 CFR 1.131(b) requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In *Ex parte Donovan*, 1890 C.D. 109, 52 O.G. 309 (Comm’r Pat. 1890) the court stated

If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others.

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and “notes.” An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”).

### ESTABLISHMENT OF DATES

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

### THREE WAYS TO SHOW PRIOR INVENTION

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO mem-

ber country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, “there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.” *In re Asahi America Inc.*, 94-1249 (Fed. Cir. 1995) (Citing *Newkirk v. Lulegian*, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and *Sachs v. Wadsworth*, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs,

coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

The facts to be established under 37 CFR 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his remedy is by appeal from the continued rejection.

See MPEP § 2138.04 through § 2138.06 for a detailed discussion of the concepts of conception, reasonable diligence, and reduction to practice.

For the most part, the terms “conception,” “reasonable diligence,” and “reduction to practice” have the same meanings under 37 CFR 1.131 as they have in interference proceedings. However, in *In re Eickmeyer*, 602 F.2d 974, 202 USPQ 655 (CCPA 1979), the court stated:

The purpose of filing a [37 CFR 1.]131 affidavit is not to demonstrate prior invention, per se, but merely to antedate the effective date of a reference. See *In re Moore*, 58 CCPA 1340, 444 F.2d 572, 170 USPQ 260 (1971). Although the test for sufficiency of an affidavit under Rule 131(b) parallels that for determining priority of invention in an interference under 35 U.S.C. 102(g), it does not necessarily follow that Rule 131 practice is controlled by interference law. To the contrary, “[t]he parallel to interference practice found in Rule 131(b) should be recognized as one of convenience rather than necessity.” *Id.* at 1353, 444 F.2d at 580, 170 USPQ at 267. Thus, “the ‘conception’ and ‘reduction to practice’ which must be established under the rule need not be the same as what is required in the ‘interference’ sense of those terms.” *Id.*; accord, *In re Borkowski*, 505 F.2d 713, 718-19, 184 USPQ 29, 33 (CCPA 1974).

One difference is that in interference practice a reduction to practice requires a proof that a utility was known, whereas under 37 CFR 1.131 practice, proof of a utility must be shown only if the reference discloses a utility. *In re Wilkinson*, 304 F.2d 673, 134 USPQ 171 (CCPA 1962); *In re Moore*, 444 F.2d 572, 170 USPQ 260 (CCPA 1971). Where proof of utility is required, whether or not test results are required to establish the utility of the subject matter in question depends on the facts of each case. The ultimate issue is whether the evidence is such that one of ordinary skill in the art would be satisfied to a reasonable certainty that the subject matter necessary to antedate the reference possessed the alleged utility. *In re Blake*, 358 F.2d 750, 149 USPQ 217 (CCPA 1966). Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on his own affidavit or declaration if he so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).

Form paragraph 7.59 or 7.63 (both reproduced in MPEP § 715) may be used where insufficient evidence is included in a 37 CFR 1.131 affidavit.

### 715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the PTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The “lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon” is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

### 715.07(b) Interference Testimony Sometimes Used

In place of an affidavit or declaration the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of 37 CFR 1.131 affidavit or declaration.

The part of the testimony to form the basis of priority over the reference should be pointed out. *Ex parte Bowyer*, 1939 C.D. 5, 42 USPQ 526 (Comm'r Pat. 1939).

### **715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country**

*35 U.S.C. 104. Invention Made Abroad.*

In proceedings before the Patent and Trademark Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

The 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104.

Under 37 CFR 1.131(a), which provides for the establishment of a date of completion of the invention in a NAFTA or WTO member country, as well as in the United States, an applicant can establish a date of completion in a NAFTA member country on or after December 8, 1993, the effective date of section 331 of Public Law 103-182, the North American Free Trade Agreement Act, and can establish a date of completion in a WTO member country other than a NAFTA member country on or after January 1, 1996, the effective date of section 531 of Public Law 103-465, the Uruguay Round Agreements Act. Acts occurring prior to the effective dates of NAFTA or URAA may be relied upon to show completion of the invention; however, a date of completion of the invention may not be established under 37 CFR 1.131 before December 8, 1993 in a NAFTA country or before January 1, 1996 in a WTO country other than a NAFTA country.

### **715.07(d) Disposition of Exhibits**

Exhibits, such as those filed as part of an affidavit or declaration under 37 CFR 1.131, must comply with the requirements of 37 CFR 1.91 to be entered into an application file. Exhibits that do not comply with the requirements of 37 CFR 1.91 will be disposed of or returned to applicant at the discretion of the Office. See also MPEP § 608.03(a).

### **715.08 Passed Upon by Primary Examiner**

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition. Such petitions are answered by the Group Directors (MPEP § 1002.02(c)).

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

### **715.09 Seasonable Presentation**

Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

- (A) prior to a final rejection;
- (B) before appeal in an application not having a final rejection; or
- (C) after final rejection and submitted
  - (1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
  - (2) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
  - (3) under 37 CFR 1.129(a).

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his or her next succeeding action.

For affidavits or declarations under 37 CFR 1.131 filed after appeal, see 37 CFR 1.195 and MPEP § 1211.02.

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941). See MPEP § 715.08 regarding review of questions of propriety of 37 CFR 1.131 affidavits and declarations.

### **715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode**

Any affidavits or declarations submitted under 37 CFR 1.131 and the accompanying evidence must be reviewed carefully by the examiner in order to determine whether they show that the claimed invention was "in public use" or "on sale" in this country more than one year prior to the effective filing date of the application, which acts constitute

a statutory bar under 35 U.S.C. 102(b). Although the rejection based on the reference(s) sought to be antedated may actually be overcome by such an affidavit or declaration, the effect of the applicant's prior "public use" or "on sale" activities may not be overcome under 37 CFR 1.131. See MPEP § 2133.03 regarding rejections based on "public use" and "on sale" statutory bars.

Where the 37 CFR 1.131 evidence relies on an embodiment of the invention not disclosed in the application, the question of whether the application includes the "best mode" must be considered. However, a "best mode" rejection should not be made unless the record, taken as a whole, establishes by a preponderance of the evidence that applicant's specification has not set forth the best mode contemplated by the inventor of carrying out the invention. See MPEP § 2165 - § 2165.04 regarding the best mode requirement of the first paragraph of 35 U.S.C. 112.

## 716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

*37 CFR 1.132. Affidavits or declarations traversing grounds of rejection.*

When any claim of an application or a patent under reexamination is rejected on reference to a U.S. patent which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), on reference to a foreign patent, on reference to a printed publication, or on reference to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative, lacking in utility, frivolous, or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections. The enumeration of rejections in the rule is merely exemplary. All affidavits or declarations presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

Form paragraph 7.65 or 7.66 and any of form paragraphs 7.66.01 through 7.66.05, as appropriate, should be used to comment on a 37 CFR 1.132 affidavit or declaration.

*¶ 7.65 Affidavit or Declaration Under 37 CFR 1.132: Effective To Withdraw Rejection*

The [1] under 37 CFR 1.132 filed [2] is sufficient to overcome the rejection of claim [3] based upon [4].

### Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the affected claim or claims.
4. In bracket 4, indicate the rejection that has been overcome, including the statutory grounds, i.e.: insufficiency of disclosure under 35 U.S.C. 112, first paragraph; lack of utility under 35 U.S.C. 101; inoperativeness under 35 U.S.C. 101; a specific reference applied under 35 U.S.C. 103; etc. See MPEP § 716.

*¶ 7.66 Affidavit or Declaration Under 37 CFR 1.132: Insufficient*

The [1] under 37 CFR 1.132 filed [2] is insufficient to overcome the rejection of claim [3] based upon [4] as set forth in the last Office action because:

### Examiner Note:

1. In bracket 1, insert either --affidavit-- or --declaration--.
2. In bracket 2, insert the filing date of the affidavit or declaration.
3. In bracket 3, insert the claim or claims affected.
4. In bracket 4, indicate the rejection that has not been overcome, including the statutory grounds, i.e.: insufficiency of disclosure under 35 U.S.C. 112, first paragraph; lack of utility and/or inoperativeness under 35 U.S.C. 101; a specific reference applied under 35 U.S.C. 103; etc. See MPEP § 716.
5. Following this form paragraph, set forth the reasons for the insufficiency; e.g., categories include: --untimely--; --fails to set forth facts--; --facts presented are not germane to the rejection at issue--; --showing is not commensurate in scope with the claims--; etc. See MPEP § 716. Also include a detailed explanation of the reasons why the affidavit or declaration is insufficient. Any of form paragraphs 7.66.01 - 7.66.05 may be used, as appropriate.

*¶ 7.66.01 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Affiant Has Never Seen Invention Before*

It includes statements which amount to an affirmation that the affiant has never seen the claimed subject matter before. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

*¶ 7.66.02 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Invention Works as Intended*

It includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

*¶ 7.66.03 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Refers Only to Invention, Not to Claims*

It refers only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

### Examiner Note:

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.04 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: No Evidence of Long-Felt Need

It states that the claimed subject matter solved a problem that was long standing in the art. However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no showing that persons skilled in the art who were presumably working on the problem knew of the teachings of the above cited references and still were unable to solve the problem. See MPEP § 716.04.

**Examiner Note:**

1. This form paragraph must be preceded by form paragraph 7.66.
2. A full explanation must be provided, if appropriate.

¶ 7.66.05 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Conclusion

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

**Examiner Note:**

This form paragraph should be presented as a conclusion to your explanation of why the affidavit or declaration under 37 CFR 1.132 is insufficient, and it must be preceded by form paragraph 7.66.

## 716.01 Generally Applicable Criteria

The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:

(A) *Timeliness.*

Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, or
- (3) after final rejection and submitted
  - (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
  - (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
  - (iii) under 37 CFR 1.129(a).

(B) *Consideration of evidence.*

Evidence traversing rejections must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action. The extent of the commentary depends on the action taken by the examiner. Where an examiner holds that the evidence is sufficient to overcome the *prima facie* case, the comments should be consistent with the guidelines for statements of reasons for allowance.

See MPEP § 1302.14. Where the evidence is insufficient to overcome the rejection, the examiner must specifically explain why the evidence is insufficient. General statements such as “the declaration lacks technical validity” or “the evidence is not commensurate with the scope of the claims” without an explanation supporting such findings are insufficient.

## 716.01(a) Objective Evidence of Nonobviousness

### OBJECTIVE EVIDENCE MUST BE CONSIDERED WHENEVER PRESENT

Affidavits or declarations containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that “evidence rising out of the so-called ‘secondary considerations’ must always when present be considered en route to a determination of obviousness.” Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham v. John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Anderson’s-Black Rock Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976).

Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986). The lack of objective evidence of nonobviousness does not weigh in favor of obviousness. *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994). However, where a *prima facie* case of obviousness is established, the failure to provide rebuttal evidence is dispositive.

### 716.01(b) Nexus Requirement and Evidence of Nonobviousness

#### TO BE OF PROBATIVE VALUE, ANY SECONDARY EVIDENCE MUST BE RELATED TO THE CLAIMED INVENTION (NEXUS REQUIRED)

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966).

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). The term “nexus” designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988).

### 716.01(c) Probative Value of Objective Evidence

#### TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) (“It is well settled that unexpected results must be established by factual evidence.” “[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant’s heat shrinkable articles with those of the closest prior art, we conclude that appellant’s assertions of unexpected results constitute mere argu-

ment.”). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

#### ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF EVIDENCE

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.

See MPEP § 2145 generally for case law pertinent to the consideration of applicant’s rebuttal arguments.

#### OPINION EVIDENCE

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant’s or declarant’s opinion on the ultimate legal issue is not evidence in the case, “some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him.” 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert’s opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the *prima facie* case of obviousness); *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the “preliminary identification of a human  $\beta$ -NGF-like molecule” in the prior art, even if considered to be an expert opinion, was inadequate

to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Carroll*, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were “unexpected,” unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).

An affidavit of an applicant as to the advantages of his claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953).

#### **716.01(d) Weighing Objective Evidence**

#### **IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING *PRIMA FACIE* CASE**

When an applicant submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached, not against the conclusion itself. *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knock-down the *prima facie* case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989); *Richardson-Vicks, Inc., v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and pseudoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong *prima facie* case of obviousness). See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a detailed discussion of the proper roles of the examiner's *prima facie* case and applicant's rebuttal evidence in the final determination of obviousness.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.). See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988). See also MPEP § 716.01. See MPEP § 2144.08, paragraph II.B., for guidance in determining whether rebuttal evidence is sufficient to overcome a *prima facie* case of obviousness.

#### **716.02 Allegations of Unexpected Results**

Any differences between the claimed invention and the prior art may be expected to result in some differences in properties. The issue is whether the properties differ to such an extent that the difference is really unexpected. *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (differences in sedative and anticholinergic effects between prior art and claimed antidepressants were not unexpected). In *In re Waymouth*, 499 F.2d 1273, 1276, 182 USPQ 290, 293 (CCPA 1974), the court held that unexpected results for a claimed range as compared with the range disclosed in the prior art had been shown by a demonstration of “a marked improvement, over the results achieved under other ratios, as to be classified as a difference in kind, rather than one of degree.” Compare *In re Wagner*, 371 F.2d 877, 884, 152 USPQ 552, 560 (CCPA 1967) (differences in properties cannot be disregarded on the ground they are differences in degree rather than in kind); *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (“we generally consider a discussion of results in terms of ‘differences in degree’ as compared to ‘differences in kind’ . . . to have very little meaning in a relevant legal sense”).

## 716.02(a) Evidence Must Show Unexpected Results

### GREATER THAN EXPECTED RESULTS ARE EVIDENCE OF NONOBVIOUSNESS

“A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue.” *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). In *Corkill*, the claimed combination showed an additive result when a diminished result would have been expected. This result was persuasive of nonobviousness even though the result was equal to that of one component alone. Evidence of a greater than expected result may also be shown by demonstrating an effect which is greater than the sum of each of the effects taken separately (i.e., demonstrating “synergism”). *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). However, a greater than additive effect is not necessarily sufficient to overcome a *prima facie* case of obviousness because such an effect can either be expected or unexpected. Applicants must further show that the results were greater than those which would have been expected from the prior art to an unobvious extent, and that the results are of a significant, practical advantage. *Ex parte The NutraSweet Co.*, 19 USPQ2d 1586 (Bd. Pat. App. & Inter. 1991) (Evidence showing greater than additive sweetness resulting from the claimed mixture of saccharin and L-aspartyl-L-phenylalanine was not sufficient to outweigh the evidence of obviousness because the teachings of the prior art lead to a general expectation of greater than additive sweetening effects when using mixtures of synthetic sweeteners.).

### SUPERIORITY OF A PROPERTY SHARED WITH THE PRIOR ART IS EVIDENCE OF NONOBVIOUSNESS

Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. “Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.” No set number of examples of superiority is required. *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) (Evidence showing that the claimed herbicidal compound was more effective than the closest prior art compound in controlling quackgrass and yellow nutsedge weeds in corn and soybean crops was sufficient to overcome the rejection under 35 U.S.C. 103, even though the specification indicated the claimed compound was an average performer on crops other than corn and soybean.). See

also *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (unexpected superior therapeutic activity of claimed compound against anaerobic bacteria was sufficient to rebut *prima facie* obviousness even though there was no evidence that the compound was effective against all bacteria).

### PRESENCE OF AN UNEXPECTED PROPERTY IS EVIDENCE OF NONOBVIOUSNESS

Presence of a property not possessed by the prior art is evidence of nonobviousness. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); *Ex parte Thumm*, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing “‘regenerated cellulose consisting substantially entirely of skin’ ” whereas the prior art warned “‘this compound has ‘practically no effect.’ ”). The submission of evidence that a new product possesses unexpected properties does not necessarily require a conclusion that the claimed invention is nonobvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979). See the discussion of latent properties and additional advantages in MPEP § 2145.

### ABSENCE OF AN EXPECTED PROPERTY IS EVIDENCE OF NONOBVIOUSNESS

Absence of property which a claimed invention would have been expected to possess based on the teachings of the prior art is evidence of unobviousness. *Ex parte Mead Johnson & Co.* 227 USPQ 78 (Bd. Pat. App. & Inter. 1985) (Based on prior art disclosures, claimed compounds would have been expected to possess beta-andrenergic blocking activity; the fact that claimed compounds did not possess such activity was an unexpected result sufficient to establish unobviousness within the meaning of 35 U.S.C. 103.).

## 716.02(b) Burden on Applicant

### BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT

The evidence relied upon should establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); *Ex parte C*, 27 USPQ2d 1492 (Bd. Pat.

App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

#### **APPLICANTS HAVE BURDEN OF EXPLAINING PROFFERED DATA**

“[A]ppellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness.” *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

#### **DIRECT AND INDIRECT COMPARATIVE TESTS ARE PROBATIVE OF NONOBVIOUSNESS**

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP § 716.02(d) - § 716.02(e). See *In re Blondel*, 499 F.2d 1311, 1317, 182 USPQ 294, 298 (CCPA 1974) and *In re Fouche*, 439 F.2d 1237, 1241-42, 169 USPQ 429, 433 (CCPA 1971) for examples of cases where indirect comparative testing was found sufficient to rebut a *prima facie* case of obviousness.

The patentability of an intermediate may be established by unexpected properties of an end product “when one of ordinary skill in the art would reasonably ascribe to a claimed intermediate the ‘contributing cause’ for such an unexpectedly superior activity or property.” *In re Magerlein*, 602 F.2d 366, 373, 202 USPQ 473, 479 (CCPA 1979). “In order to establish that the claimed intermediate is a ‘contributing cause’ of the unexpectedly superior activity or property of an end product, an applicant must identify the cause of the unexpectedly superior activity or property (compared to the prior art) in the end product and establish a nexus for that cause between the intermediate and the end product.” *Id.* at 479.

#### **716.02(c) Weighing Evidence of Expected and Unexpected Results**

##### **EVIDENCE OF UNEXPECTED AND EXPECTED PROPERTIES MUST BE WEIGHED**

Evidence of unexpected results must be weighed against evidence supporting *prima facie* obviousness in making a final determination of the obviousness of the claimed invention. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (Claims directed to a method of effecting

analgesia without producing physical dependence by administering the levo isomer of a compound having a certain chemical structure were rejected as obvious over the prior art. Evidence that the compound was unexpectedly nonaddictive was sufficient to overcome the obviousness rejection. Although the compound also had the expected result of potent analgesia, there was evidence of record showing that the goal of research in this area was to produce an analgesic compound which was nonaddictive, enhancing the evidentiary value of the showing of nonaddictiveness as an indicia of nonobviousness.). See MPEP § 716.01(d) for guidance on weighing evidence submitted to traverse a rejection.

Where the unexpected properties of a claimed invention are not shown to have a significance equal to or greater than the expected properties, the evidence of unexpected properties may not be sufficient to rebut the evidence of obviousness. *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) (Claims were directed to a display/memory device which was *prima facie* obvious over the prior art. The court found that a higher memory margin and lower operating voltage would have been expected properties of the claimed device, and that a higher memory margin appears to be the most significant improvement for a memory device. Although applicant presented evidence of unexpected properties with regard to lower peak discharge current and higher luminous efficiency, these properties were not shown to have a significance equal to or greater than that of the expected higher memory margin and lower operating voltage. The court held the evidence of nonobviousness was not sufficient to rebut the evidence of obviousness.); *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (Evidence of improved feed efficiency in steers was not sufficient to rebut *prima facie* case of obviousness based on prior art which specifically taught the use of compound X537A to enhance weight gain in animals because the evidence did not show that a significant aspect of the claimed invention would have been unexpected.).

##### **EXPECTED BENEFICIAL RESULTS ARE EVIDENCE OF OBVIOUSNESS**

“Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof.” *In re Gershon*, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967) (resultant decrease of dental enamel solubility accomplished by adding an acidic buffering agent to a fluoride containing dentifrice was expected based on the teaching of the prior art); *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a process of sterilizing a polyolefinic composition which contains an antioxidant with high-energy radiation. Although evidence was

presented in appellant's specification showing that particular antioxidants are effective, the Board concluded that these beneficial results would have been expected because one of the references taught a claimed antioxidant is very efficient and provides better results compared with other prior art antioxidants.).

### **716.02(d) Unexpected Results Commensurate in Scope With Claimed Invention**

Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980) (Claims were directed to a process for removing corrosion at "elevated temperatures" using a certain ion exchange resin (with the exception of claim 8 which recited a temperature in excess of 100C). Appellant demonstrated unexpected results via comparative tests with the prior art ion exchange resin at 110C and 130C. The court affirmed the rejection of claims 1-7 and 9-10 because the term "elevated temperatures" encompassed temperatures as low as 60C where the prior art ion exchange resin was known to perform well. The rejection of claim 8, directed to a temperature in excess of 100C, was reversed.). See also *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983) (Claims were directed to certain catalysts containing an alkali metal. Evidence presented to rebut an obviousness rejection compared catalysts containing sodium with the prior art. The court held this evidence insufficient to rebut the *prima facie* case because experiments limited to sodium were not commensurate in scope with the claims.).

### **NONOBVIOUSNESS OF A GENUS OR CLAIMED RANGE MAY BE SUPPORTED BY DATA SHOWING UNEXPECTED RESULTS OF A SPECIES OR NARROWER RANGE UNDER CERTAIN CIRCUMSTANCES**

The nonobviousness of a broader claimed range can be supported by evidence based on unexpected results from testing a narrower range if one of ordinary skill in the art would be able to determine a trend in the exemplified data which would allow the artisan to reasonably extend the probative value thereof. *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979) (Claims directed to mixtures of an herbicide known as "FENAC" with a diphenyl ether herbicide in certain relative proportions were rejected as *prima facie* obvious. Applicant presented evidence alleging unex-

pected results testing three species of diphenyl ether herbicides over limited relative proportion ranges. The court held that the limited number of species exemplified did not provide an adequate basis for concluding that similar results would be obtained for the other diphenyl ether herbicides within the scope of the generic claims. Claims 6-8 recited a FENAC:diphenyl ether ratio of 1:1 to 4:1 for the three specific ethers tested. For two of the claimed ethers, unexpected results were demonstrated over a ratio of 16:1 to 2:1, and the effectiveness increased as the ratio approached the untested region of the claimed range. The court held these tests were commensurate in scope with the claims and supported the nonobviousness thereof. However, for a third ether, data was only provided over the range of 1:1 to 2:1 where the effectiveness decreased to the "expected level" as it approached the untested region. This evidence was not sufficient to overcome the obviousness rejection.); *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the *prima facie* case of obviousness because there was "no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition.").

### **DEMONSTRATING CRITICALITY OF A CLAIMED RANGE**

To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

### **716.02(e) Comparison With Closest Prior Art**

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the *claimed* invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." *In re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, *In re Finley*, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant,

explanation should be required. *In re Armstrong*, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

#### **THE CLAIMED INVENTION MAY BE COMPARED WITH PRIOR ART THAT IS CLOSER THAN THAT APPLIED BY THE EXAMINER**

Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over non-chlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the *prima facie* case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.).

#### **COMPARISONS WHEN THERE ARE TWO EQUALLY CLOSE PRIOR ART REFERENCES**

Showing unexpected results over one of two equally close prior art references will not rebut *prima facie* obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984) (Claimed compounds differed from the prior art either by the presence of a trifluoromethyl group instead of a chloride radical, or by the presence of an unsaturated ester group instead of a saturated ester group. Although applicant compared the claimed invention with the prior art compound containing a chloride radical, the court found this evidence insufficient to rebut the *prima facie* case of obviousness because the evidence did not show relative effectiveness over all compounds of the closest prior art. An applicant does not have to test all the compounds taught by each reference, “[h]owever, where an applicant tests less than all cited compounds, the test must be sufficient to permit a conclusion respecting the relative effectiveness of applicant’s claimed compounds and the compounds of the closest prior art.” *Id.* (quoting *In re Payne*, 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979)) (emphasis in original).).

#### **THE CLAIMED INVENTION MAY BE COMPARED WITH THE CLOSEST SUBJECT MATTER THAT EXISTS IN THE PRIOR ART**

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject

matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted *prima facie* case by comparing claimed invention with the most relevant prior art. Note that the majority held the Office failed to establish a *prima facie* case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 “would be requiring comparison of the results of the invention with the results of the invention.” 357 F.2d at 422, 148 USPQ at 714.).

#### **716.02(f) Advantages Disclosed or Inherent**

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) (Although the purported advantage of placement of a selective catalytic reduction catalyst in the bag retainer of an apparatus for controlling emissions was not disclosed in the specification, evidence and arguments rebutting the conclusion that such placement was a matter of “design choice” should have been considered as part of the totality of the record. “We have found no cases supporting the position that a patent applicant’s evidence or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution.” 66 F.3d at 299, 36 USPQ2d at 1095.). See also *In re Zenitz*, 333 F.2d 924, 928, 142 USPQ 158, 161 (CCPA 1964) (evidence that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from disclosed use as tranquilizer); *Ex parte Sasajima*, 212 USPQ 103, 104 - 05 (Bd. App. 1981) (evidence relating to initially undisclosed relative toxicity of claimed pharmaceutical compound must be considered).

The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical. *In re Saunders*, 444 F.2d 599, 607, 170 USPQ 213, 220 (CCPA 1971).

#### **716.02(g) Declaration or Affidavit Form**

“The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or

representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.” Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. *Ex parte Gray*, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989). Publications may, however, be evidence of the facts in issue and should be considered to the extent that they are probative.

### 716.03 Commercial Success

#### NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sale constitute commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

*In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness).

The term “nexus” designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

#### COMMERCIAL SUCCESS ABROAD IS RELEVANT

Commercial success abroad, as well as in the United States, is relevant in resolving the issue of nonobviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

### 716.03(a) Commercial Success Commensurate in Scope With Claimed Invention

#### EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff’d*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process “constructed according to the disclosure and claims of [the] patent application” or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

#### REQUIREMENTS WHEN CLAIMED INVENTION IS NOT COEXTENSIVE WITH COMMERCIAL PRODUCT OR PROCESS

If a particular range is claimed, applicant does not need to show commercial success at every point in the range. “Where, as here, the claims are directed to a combination of ranges and procedures not shown by the prior art, and where substantial commercial success is achieved at an apparently typical point within those ranges, and the affidavits definitely indicate that operation throughout the claimed ranges approximates that at the particular points involved in the commercial operation, we think the evidence as to commercial success is persuasive.” *In re Hollingsworth*, 253 F.2d 238, 240, 117 USPQ 182, 184 (CCPA 1958). See also *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (where the commercially successful product or process is

not coextensive with the claimed invention, applicant must show a legally sufficient relationship between the claimed feature and the commercial product or process).

### **716.03(b) Commercial Success Derived From Claimed Invention**

#### **COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION**

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.").

See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985)

(evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising hyperbole.).

#### **COMMERCIAL SUCCESS MUST FLOW FROM THE FUNCTIONS AND ADVANTAGES DISCLOSED OR INHERENT IN THE SPECIFICATION DESCRIPTION**

To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. Furthermore, the success of an embodiment within the claims may not be attributable to improvements or modifications made by others. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

#### **IN DESIGN CASES, ESTABLISHMENT OF NEXUS IS ESPECIALLY DIFFICULT**

Establishing a nexus between commercial success and the claimed invention is especially difficult in design cases. Evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition, improved performance, or some other factor. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984) (showing of commercial success was not accompanied by evidence attributing commercial success of Litton microwave oven to the design thereof).

#### **SALES FIGURES MUST BE ADEQUATELY DEFINED**

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the

product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

### 716.04 Long-Felt Need and Failure of Others

#### THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) (“Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware.”); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a “do-it-yourself” window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. “[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved”).

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

#### LONG-FELT NEED IS MEASURED FROM THE DATE A PROBLEM IS IDENTIFIED AND EFFORTS ARE MADE TO SOLVE IT

Long-felt need is analyzed as of the date the problem is identified and articulated, and there is evidence of efforts to solve that problem, not as of the date of the most pertinent prior art references. *Texas Instruments Inc. v. Int’l Trade*

*Comm’n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

#### OTHER FACTORS CONTRIBUTING TO THE PRESENCE OF A LONG-FELT NEED MUST BE CONSIDERED

The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

See also *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (presence of legislative regulations for controlling sulfur dioxide emissions did not militate against existence of long-felt need to reduce the sulfur content in the air); *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a bona fide licensing agreement entered into at arm's length).

### 716.05 Skepticism of Experts

“Expressions of disbelief by experts constitute strong evidence of nonobviousness.” *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966)) (The patented process converted all the sulfur compounds in a certain effluent gas stream to hydrogen sulfide, and thereafter treated the resulting effluent for removal of hydrogen sulfide. Before learning of the patented process, chemical experts, aware of earlier failed efforts to reduce the sulfur content of effluent gas streams, were of the opinion that reducing sulfur compounds to hydrogen sulfide would not adequately solve the problem.).

“The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention.” *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987) (testimony that the invention met with initial incredulity and skepticism of experts was sufficient to rebut the *prima facie* case of obviousness based on the prior art).

### 716.06 Copying

Another form of secondary evidence which may be presented by applicants during prosecution of an application, but which is more often presented during litigation, is evidence that competitors in the marketplace are copying the

invention instead of using the prior art. However, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentee's ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also *Vandenberg v. Dairy Equipment Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness) and *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1098-99, 227 USPQ 337, 348, 349 (Fed. Cir. 1985), *vacated on other grounds*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987) (evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after 10 years of effort and expense).

### 716.07 Inoperability of References

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability (*Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C.Cir. 1935)), examiners should not express any opinion on the operability of a patent. Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107

(CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

Where the affidavit or declaration presented asserts inoperability in features of the reference which are not relied upon, the reference is still effective as to other features which are operative. *In re Shepherd*, 172 F.2d 560, 80 USPQ 495 (CCPA 1949).

Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, the claims represented by applicant must distinguish from the alleged inoperative reference disclosure. *In re Crosby*, 157 F.2d 198, 71 USPQ 73 (CCPA 1946). See also *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (lack of diagrams, flow charts, and other details in the prior art references did not render them nonenabling in view of the fact that applicant's own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references).

If a patent teaches or suggests the claimed invention, an affidavit or declaration by patentee that he or she did not intend the disclosed invention to be used as claimed by applicant is immaterial. *In re Pio*, 217 F.2d 956, 104 USPQ 177 (CCPA 1954). Compare *In re Yale*, 434 F.2d 66, 168 USPQ 46 (CCPA 1970) (Correspondence from a co-author of a literature article confirming that the article misidentified a compound through a typographical error that would have been obvious to one of ordinary skill in the art was persuasive evidence that the erroneously typed compound was not put in the possession of the public.).

### 716.08 Utility and Operability of Applicant's Disclosure

See MPEP § 2107.01, for guidance on when it is proper to require evidence of utility or operativeness, and how to evaluate any evidence which is submitted to overcome a rejection under 35 U.S.C. 101 for lack of utility. See MPEP § 2107 - § 2107.02 generally for an overview of legal precedent relevant to the utility requirement of 35 U.S.C. 101.

### 716.09 Sufficiency of Disclosure

See MPEP § 2164 - § 2164.08(c) for guidance in determining whether the specification provides an enabling disclosure in compliance with 35 U.S.C. 112, first paragraph.

Once the examiner has established a *prima facie* case of lack of enablement, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). Evidence to supplement a specification which on its face appears deficient under 35 U.S.C. 112 must establish that the information which

must be read into the specification to make it complete would have been known to those of ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981) (copies of patent specifications which had been opened for inspection in Rhodesia, Panama, and Luxembourg prior to the U.S. filing date of the applicant were not sufficient to overcome a rejection for lack of enablement under 35 U.S.C. 112, first paragraph).

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944). But see *Glaser v. Strickland*, 220 USPQ 446 (Bd. Pat. Int. 1983) which reexamines the rationale on which *In re Oppenauer* was based in light of the Federal Rules of Evidence. The Board stated as a general proposition "Opinion testimony which merely purports to state that a claim or count, is 'disclosed' in an application involved in an interference . . . should not be given any weight. Opinion testimony which purports to state that a particular feature or limitation of a claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis."

### 716.10 Attribution [R-1]

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute a reference or part of a reference to the applicant. If successful, the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent. Disclaimer by the other patentee should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under subsection (f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under subsection (f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article or patent will be accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article or a patent may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re >Carreira<*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author or patentee of a first reference does not enable an applicant to step into the shoes of that author or patentee in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

### EXAMPLES

The following examples demonstrate the application of an attribution affidavit or declaration.

**Example 1**

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

**Example 2**

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

## **718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130**

*37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent as prior art.*

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent as prior art. The patent can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c), and

(2) An oath or declaration stating that the application or patent under reexamination and the patent are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

37 CFR 1.130(a) has been added to provide for those situations in which:

(A) the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b);

(B) the inventions defined by the claims in the application or patent under reexamination and by the claims in

the U.S. patent are not identical but are not patentably distinct; and

(C) the inventions are owned by the same party.

An applicant or owner of a patent under reexamination in this situation is prevented from using 37 CFR 1.131 to antedate a commonly owned U.S. patent due to the requirement in 37 CFR 1.131 that any U.S. patent to be antedated not claim the same patentable invention (as defined in 37 CFR 1.601(n)) as the application or patent under reexamination, and is prevented from proceeding in an interference due to the provision in 37 CFR 1.602(a) that an interference will not be declared or continued between an application and an unexpired patent owned by a single party.

As 37 CFR 1.130(a) was added for those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent are not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321(c) and 37 CFR 1.130(a)(2) requires an oath or declaration stating, *inter alia*, that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject matter before the actual date of invention of the subject matter of the reference U.S. patent claims. The oath or declaration may be signed by the inventor(s), the attorney of record, or assignee(s) of the entire interest.

The phrase “prior inventor under 35 U.S.C. 104” requires that the inventor named in the application or patent be the prior inventor within the meaning of 35 U.S.C. 104, in that an applicant or patent owner may not:

(A) establish a date of invention in a foreign country other than a NAFTA or WTO member country;

(B) establish a date of invention in a WTO member country other than a NAFTA country earlier than January 1, 1996; or

(C) establish a date of invention in a NAFTA country other than the U.S. earlier than December 8, 1993.

As the conflict between two pending applications can be avoided by filing a continuation-in-part application merging the conflicting inventions into a single application, 37 CFR 1.130 is limited to overcoming rejections under 35 U.S.C. 103 based on commonly owned U.S. patents.

37 CFR 1.130(b) provides that when an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially

created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(c). See MPEP § 804.02.

## 719 File Wrapper

The folder in which the Patent and Trademark Office maintains the application papers is referred to as a file wrapper.

### 719.01 Papers in File Wrapper

Papers that do not become a permanent part of the record should not be entered on the “Contents” of the file wrapper. All papers legally entered on the “Contents” of the file wrapper are given a paper number. No paper legally entered on the “Contents” should ever be withdrawn or returned to applicant, especially a part of the original disclosure of the application, without special authority of the Commissioner. However, 37 CFR 1.59 provides that certain documents may be returned to applicant if they were unintentionally submitted or contain proprietary information which has not been made public and is not important to a decision of patentability. See MPEP § 724. Certain oaths executed abroad may be returned but a copy is retained in the file. See MPEP § 604.04(a).

#### 719.01(a) Arrangement of Papers in File Wrapper

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order, that is, the communication with the latest Mail Center “Office Date” is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the drawing print is always kept on top for the convenience of the examiner.

Where amendments are submitted in duplicate, the copy is destroyed except where the duplicate is received within the time period for reply and the original is late. In this latter situation both copies are placed in the file. The “original” (ribbon copy) is entered with reference made to the copy.

At allowance, only those papers required by the printer are placed in the left side (center section) of the file wrapper.

#### 719.01(b) Prints [R-1]

The prints of the drawing are fastened inside the file wrapper by the Office of Initial Patent Examination.

The white paper prints are always kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the \*\* >application number of the corresponding application.< Note MPEP § 608.02(m).

### 719.02 Data Entered on File Wrapper

See also MPEP § 707.10 and § 719.01.

It is sometimes necessary to return an application to the Office of Initial Patent Examination (OIPE) for correction of the file wrapper label, or, for 09/series applications, to forward the application to the technical support staff of the examining group for correction to the PALM bib-data sheet placed in the file wrapper. If the examiner notices an error in any of the data originally entered on the file wrapper or on the PALM bib-data sheet, he or she should return the application to OIPE for correction or, for 09/series applications, have the technical support staff of his or her examining group enter the correction on the PALM database and print a new PALM bib-data sheet, which will then be placed in the file wrapper.

Instances where correction is necessary include:

(A) Correction of inventorship such as changes in the order of the names or a change in the name of an inventor, granted by petition, and additions or deletions of inventors under 37 CFR 1.48. See MPEP § 605.04(g).

(B) Correction of the filing date.

(C) Correction concerning prior U.S. applications which have application number errors. See MPEP § 202.02.

(D) Correction of a claim for priority under 35 U.S.C. 120, 121, or 365(c). See MPEP § 201.11 and § 1302.09.

Any application that must be sent to OIPE for correction of the file wrapper label should be accompanied by an Office of Initial Patent Examination Data Base Routing Slip with an explanation of the correction to be made.

All other corrections are performed in the examining group. For example, changes to the title, power of attorney, and correspondence address may be made with red ink.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Division.

Except as otherwise indicated, all of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the technical support staff of the group, the original entry being canceled but not erased.

#### 719.02(b) Name or Residence of Inventor or Title Changed

The distinction between “residence” and Post Office address should not be lost sight of. See MPEP § 605.02 and § 605.03.

MPEP § 605.04(c) explains the procedure to be followed when applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

### 719.03 Classification During Examination [R-1]

When a new application is received in an examining group, the classification of the application and the initials or name of the examiner who will examine it or other assigned docket designation are noted in pencil \*\* in the designated spaces on the file wrapper. These notations should be kept current.

### 719.04 Index of Claims

Constant reference is made to the “Index of Claims” found in the inside of the file wrapper of all applications. It should be kept up to date so as to be a reliable index of all claims standing in a case, and of the amendment in which the claims are to be found.

The preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented.

Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under 37 CFR 1.121(a), the original claim number should not be stricken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e., “Amend. 1”; if the claim is rewritten a second time, “Amend. 1” should be changed by striking out “1” and inserting “2” above it.

As any claim is canceled, a line in red ink should be drawn through its number.

A space is provided for completion by the examiner to indicate the date and type of each Office action together with the resulting status of each claim. A list of codes for identifying each type of Office action appears below the Index. At the time of allowance, the examiner places the final patent claim numbers in the column marked “Final.”

### 719.05 Field of Search [R-1]

\*\* >In the first action on the merits of an application, the examiner shall make an initial endorsement in black ink, in the space provided on the right outside panel of the file wrapper, of the classes and subclasses of domestic and foreign patents, abstract collections, and publications in which the search for prior art was made. Other information collections and sources in which the search for prior art was made must also be identified by the examiner. The examiner must also indicate the date(s) on which the search was conducted. In subsequent actions, where the search is brought up to date and/or where a further search is made, the examiner must endorse and initial on the file wrapper that the search has been updated and/or identify the additional field of search. Any search updates should include all of the databases and the search queries and classifications employed in the original search. See MPEP § 904.< Great care should be taken so as to clearly indicate the places searched and the date(s) on which the search was conducted.

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation. These procedures will also facilitate the printing of certain search data on patents.

Under the procedures, searches are separated into two categories and listed, as appropriate, in either the “SEARCHED” box or “SEARCHED NOTES” box on the file wrapper.

#### I. “SEARCHED” BOX ENTRIES

Search entries made here, except those for search updates (see item I(C) below), will be printed under “Field of Search” on the patent front page. Therefore, the following searches will be recorded in the “SEARCHED” box by the examiner along with the date and the examiner’s initials, according to the following guidelines:

(A) *A complete search of a subclass*, including all United States and foreign patent documents, whether filed by U.S. or IPC classification, and other publications placed therein.

The complete classification (class and subclass) should be recorded.

#### Examples

424/270, 272, 273

224/42.1 F

414/DIG. 4

D3/32 R  
A61K 9/22  
A61K 31/56 - A61K 31/585

(B) A *limited search of a subclass*, for example, a search that is restricted to an identifiable portion of the patent documents placed therein. If, however, only the publications in a subclass are searched, such an entry is to be made under “SEARCH NOTES” rather than under “SEARCHED.” (See item II(D) below.)

The class and subclass, followed by the information defining the portion of the subclass searched, in parenthesis, should be recorded.

#### Examples

414/1 (U.S. only)  
238/6 (1954 to date)

(C) An *update of a search previously made*. This search entry will be recorded in a manner to indicate clearly which of the previously recorded searches have been updated, followed by the expression “(updated).” Search update entries, although recorded in the “SEARCHED” box, will not be printed.

#### Examples

424/270 (updated)  
414/DIG. 4 (updated)  
Above (updated)

When a search made in a parent application is updated during the examination of a continuing application, those searches updated, followed by “(updated from parent S.N. ....)” will be recorded. If the parent application has been patented, the patent number “Pat. N. ....” instead of application number in the above phrase will be recorded. The examiner should recopy the entire search updated from the parent on the file wrapper of the continuing application to the extent pertinent to the continuing application.

#### Examples

273/29 BC (updated from  
343/114.5 parent S.N. 08/495,123)  
116/DIG.47 (updated from  
D7/73, 74 parent Pat. N. 4,998,999)

## II. “SEARCH NOTES” BOX ENTRIES

Entries made in the “SEARCH NOTES” box are of equal importance to those placed in the “SEARCHED” box; however, these entries are not to be printed on any resulting patent. They are intended to complete the application file record of areas and/or documents considered by the examiner in his or her search. The examiner should

record the following searches in this box and in the manner indicated, with each search dated and initialled:

(A) A *cursory search*, or scanning, of a U.S. subclass or IPC subclass/group/subgroup, i.e., a search usually made to determine if the documents classified there are relevant. Record the classification, followed by “(cursory).”

#### Examples

250/13 (cursory)  
A61K 9/44 (cursory)

(B) A *consultation* with other examiners to determine if relevant search fields exist in their areas of expertise.

If the subclass is not searched, record the class and subclass discussed, followed by “(consulted).” This entry may also include the name of the examiner consulted and the art unit.

#### Examples

24/ fasteners (consulted)  
24/ fasteners (consulted J. Doe A.U. 3501)  
24/201 R-230 AV (consulted)

(C) A *search of a publication* not located within the classified patent file, e.g., a library search, a text book search, a Chemical Abstracts search, etc. Record according to the following for each type of literature search:

(1) *Abstracting publications*, such as Chemical Abstracts, record name of publications, list terms consulted in index, and indicate period covered.

#### Examples

*Chem. Abs*, Palladium hydride Jan.-June 1975  
*Eng. Index*, Data Conversion Analog to Digital 1975

(2) *Periodicals* — list by title and period or volumes covered, as appropriate.

#### Examples

*Popular Mechanics*, June-Dec. 1974  
*Lubrication Engineering*, vols. 20-24

(3) *Books* — list by title and author, edition or date, as appropriate.

#### Example

*Introduction to Hydraulic Fluids*, Roger E. Hatton, 1962

(4) *Other types of literature* not specifically mentioned herein (i.e., catalogs, manufacturer's literature, private collections, etc.).

Record data as necessary to provide unique identification of material searched.

#### Example

*Sears Roebuck* catalog, Spring-Summer, 1973.

Where a book or specific issue of a periodical is cited by the examiner, it is not necessary to list the specific book or periodical in the "SEARCH NOTES" box.

A cursory or browsing search through a number of materials that are not found to be of significant relevance may be indicated in a collective manner, e.g., "Browsed STIC shelves under QA 76.5" or "Browsed text books in STIC relating to .....". More detailed reviews or searches through books and periodicals or any search of terms in abstracting publications should be specifically recorded, however.

(5) *Computer Search in Scientific and Technical Information Center (STIC)* — An online computerized literature searching service which uses key terms and index terms to locate relevant publications in many large bibliographic data bases is available in the STIC. Members of the STIC staff are assigned to assist examiners in selecting key terms and to conduct a search. To record a computer search conducted by STIC, see instructions in II(F) below.

(D) A search of only the *publications in a subclass*.

Record class and subclass followed by "(publications only)."

#### Examples

43/56 (publications only)

99/DIG. 15 (publications only)

(E) *A review of art cited in a parent application* or an original patent, as required for all continuation and continuation-in-part applications, divisional applications, reissue applications and reexamination proceedings, or a review of art cited in related applications.

Record the application number of a parent application that is still pending or abandoned, followed by "refs. checked" or "refs. ck'ed." If for any reason not all of the references have been checked because they are not available or clearly not relevant, such exceptions should be noted.

#### Examples

S. N. 495,123 refs. checked

S. N. 490,000 refs. checked

S. N. 480,111 refs. checked except for Greek patent to Kam

S. N.410,113 refs. not checked since the file was not available

Record the patent number of a parent or related application that is now patented or of an original patent now being reissued with "refs. checked" or "refs. ck'ed."

#### Examples

Pat. 3,900,000 refs. checked

Pat. 3,911,111 refs. ck'ed

(F) *In each action involving a search of a computer accessed text or chemical structure or sequence database*, the examiner shall endorse, in the SEARCH NOTES box on the file wrapper flap, the name of the database service, the date when the search was made or was brought up to date and the examiner's initials. All entries shall be made in BLACK INK. Computer database searches including text, chemical structure, or sequences shall be documented in the SEARCH NOTES box on the file wrapper by providing the following minimum information:

- (1) The search logic or chemical structure or sequence used as a query;
- (2) The name of the file or files searched and the database service;
- (3) Date of the search; and
- (4) The examiner's initials.

Three ways in which this minimum documentation can be provided are:

(1) supplying, and as necessary annotating, the computer search printout resulting from a computer assisted search (see examples 1 and 2 and "Printouts" below), or

(2) recording the required information on the Search Request Form PTO-1590, or

(3) recording the required information in the SEARCH NOTES box.

For methods (1) and (2), the name of the database service and the expressions "(see form)" or "(see printout)" should be recorded in the SEARCH NOTES box as appropriate with the date and the examiner's initials.

#### Printouts

Most of the database services accessed in application searches provide a command to display or print the search history which includes most, if not all, of the minimum required information for documenting database searches. Table 1 below lists the history command for each database service and which of the required minimum documentation elements are missing when the history command is entered. The missing elements may be documented by writing them on the printout of the search history or by supplying further portions of the search transcript which do include the missing elements. In some instances, depending on the database service, the log off command will supply the missing data element. A printout of the history command and log out response containing the required data elements is acceptable as full documentation of a search. \*\* >For example, this is the case with the STN and Questel; the name of the database service is not provided by entering the history command and must be supplied by the inclusion of the log off command. Another example is with WEST. Neither the Freeform Search page nor the Show S Numbers page prints

the date of the search, therefore, the date of the WEST search must be documented in writing.<

If there are several search statements in the history, the statement or statements of which the results were reviewed

should be indicated by circling them in BLACK INK. The form or printout page(s) with the required data elements should be hole punched and placed in the application file on the right hand flap of the file wrapper.

TABLE 1

*History Commands and Missing Elements  
by Database Service*

Data-base Service	His-tory Com-mand	Name of Data-base Service	Search Logic	Name of File Search ed	Date of Search
*	**	*	*	*	*
Dialog	ds**	no	yes	miss-ing <sup>1</sup>	miss-ing***
STN*	d his full	no *****	yes	yes	yes
Orbit	his**	no *****	yes	miss-ing <sup>2</sup>	miss-ing**
Ques-tel	hi**	no *****	yes	yes	miss-ing***
Mead	r**	no	yes	yes	yes
IG Suite	none	yes ***	yes ****	yes	yes
> EAST	Details grid <sup>3</sup>	no <sup>5</sup>	yes	yes	yes
WEST	Free Form Search page <sup>4</sup>  Show S Numbers page	yes	yes	yes	miss-ing <sup>6</sup> <

\* In a structure search in STN, in addition to “d his full”, the structure should be printed out while in the Registry File. The command string for this is “d L# que stat,” where L# is the number of the answer set of a full file structure search.

**	Need to enter history command for each file searched before changing file or logging off.
***	Information provided as part of search result file for each request.
****	Search query sequence provided as part of search result file for each request.
*****	Displayed by log off command.
1	Name and number of file provided at file entry; number only of file given when leaving the file; number only of last file accessed given at log off.
2	Name of the file given at file entry and when leaving the file; name of last file accessed given at log off.
> <sup>3</sup>	Print details grid for Active folder to document current search; print Details grid for Saved folder to document saved search.
4	Print Freeform Search page to document current search; print Show S Numbers page to document saved search.
5	Shown on printed EAST cover page.
6	Must be written in BLACK INK.<

**Explanation of Table Terminology**

History Command - Generally, a display of what the user has asked the search software to do. Will display the search logic entered by the user. Some histories are limited to display of the searches done only in the current file while others deliver a complete record of what file or files were accessed and all searches done since sign on. Dialog, Ques-tel, Orbit, and Mead are services limited to display of the searches done only in the current file.

Name of Database Service - Most services do not display this information as part of the search transcript. None of the services in the table >, except WEST,< list that information as part of the history command. However, Orbit, Ques-tel, and STN supply the name of the database service during log off.

Search Logic - Generally, a display of the search commands executed by the search software. For a structure or sequence search, this can be a printout of the structure or sequence used to query the system.

Name of File Searched - This is the name of the collection of data accessed. In some services, the file name is

only displayed when the file is selected and not in response to the history display command \*>< Dialog and Orbit are two such services. \*\* For example, Dialog \* supplies >only< the file number with the log off command. The file number alone is not adequate documentation of a search. The name of the file is required.

Date of Search - >WEST,< Dialog, Orbit, and Questel do not display the date of search as part of the history command. \*\* >Dialog, Orbit, and Questel< supply the date of search during log off >; the date of search for WEST must be written on the search report<.

Nucleotide and peptide sequence searches will be fully documented by a printout of the search query sequence and the beginning of the search result file. Each query sequence should be clearly related to the appropriate search result, if necessary, by appropriate annotation.

#### ***Other Databases***

For other types of publicly accessible computer accessed databases (e.g., CD-ROM databases, specialized databases, etc.), record data as necessary to provide unique identification of material searched and sufficient information as to

the search query or request so that the search can be updated. The record should also document the location of the database and its form (CD-ROM, etc.)

#### **Example: Citing a biotech CD-ROM database**

Entrez: Sequences, National Center for Biotechnology Information, Version 7.19.91b (CD-ROM, Group 1800) Searched HIV and vaccine; neighbored Galloway article dated 6/5/91 on April 1, 1990.

#### **Example: Citing a nonbiotech CD-ROM database**

Computer Select, (November, 1991), Ziff Davis Communications Co., (CD-ROM, STIC), Searched Unix and emulation on December 1, 1991.

### **III. INFORMATION NOT RECORDED ON THE FILE WRAPPER**

For an indication of consideration or nonconsideration of prior art citations submitted by applicant in Information Disclosure Statements (37 CFR 1.97 and 1.98), see MPEP § 609.

\*\*

U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

**SEARCH REQUEST FORM**

Requestor's Name: \_\_\_\_\_ Serial Number: \_\_\_\_\_

Date: \_\_\_\_\_ Phone: \_\_\_\_\_ Art Unit: \_\_\_\_\_

**Search Topic:**

Please write a detailed statement of search topic. Describe specifically as possible the subject matter to be searched. Define any terms that may have a special meaning. Give examples or relevant citations, authors, keywords, etc., if known. For sequences, please attach a copy of the sequence. You may include a copy of the broadest and/or most relevant claim(s).

**STAFF USE ONLY**

Date completed: \_\_\_\_\_  
 Searcher: \_\_\_\_\_  
 Terminal time: \_\_\_\_\_  
 Elapsed time: \_\_\_\_\_  
 CPU time: \_\_\_\_\_  
 Total time: \_\_\_\_\_  
 Number of Searches: \_\_\_\_\_  
 Number of Databases: \_\_\_\_\_

**Search Site**  
 \_\_\_\_\_ STIC  
 \_\_\_\_\_ CM-1  
 \_\_\_\_\_ Pre-S  
**Type of Search**  
 \_\_\_\_\_ N.A. Sequence  
 \_\_\_\_\_ A.A. Sequence  
 \_\_\_\_\_ Structure  
 \_\_\_\_\_ Bibliographic

**Vendors**  
 \_\_\_\_\_ IG  
 \_\_\_\_\_ STN  
 \_\_\_\_\_ Dialog  
 \_\_\_\_\_ APS  
 \_\_\_\_\_ Geninfo  
 \_\_\_\_\_ SDC  
 \_\_\_\_\_ DARC/Questel  
 \_\_\_\_\_ Other

PTO-1590 (9-90)

SEARCHED			
Class	Sub.	Date	Exmr.
D7	78, 74 (Updated from Present Patent No. 4,000,000)	8-21-91	RKL
424	270	} 8-21-91	RKL
D3	32R		
414	1 (U.S. only)		
424	270 (updated)	} 11-26-91	AAM
100	99		
Above	(updated) <b>IPC</b>	4-22-92	F3
A61K	9/22	} 4-22-92	F3
A61K	31/56		
A61k	31/585		

INTERFERENCE SEARCHED			
Class	Sub.	Date	Exmr.

SEARCH NOTES		
	Date	Exmr.
S. N. 495,125 refs. Ck'd 250/13 (cursory) 24/ separable fasteners (consulted Globe, All 351)	} 8-21-91	RKL
<u>Chem. Abs.</u> , Palladium hydride, Jan. - June 1990		
<u>Popular Mechanics</u> June - Dec. 1990	11-26-91	AAM
<u>Introduction to Hydraulic Fluids</u> Roger E. Hatton, 1962		
45/36 (Publications only)		
A61K 9/44 (cursory)		
APS    USPAT 3    laser and agric? Dialog (See form)		
STN    (See printout)		
Entries: Sequences NC8I Y7-19-91 b (CD ROM GB 130) Searched HIV & vaccine, neighbored Galloway article dated 6/5/91		

## 719.06 Foreign Filing Dates

See MPEP § 201.14(c), § 202.03 and § 201.14(d).

## 719.07 Related Applications

The file wrapper or the PALM bib-data sheet (for 09/series applications) should identify earlier filed related applications.

See MPEP § 202.02 and § 202.03.

## 720 Public Use Proceedings [R-1]

37 CFR 1.292. *Public use proceedings.*

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 through 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:

- (1) The petition is accompanied by the fee set forth in § 1.17(j);
- (2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and
- (3) The petition is submitted prior to the mailing of a notice of allowance under § 1.311.

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a preliminary motion under § 1.633(a).

Public use proceedings are provided for in 37 CFR 1.292. The institution of public use proceedings is discretionary with the Commissioner. This section is intended to provide guidance when a question concerning public use proceedings arises.

Any member of the public other than the applicant, including private persons, corporate entities, and government agencies, may file a petition under 37 CFR 1.292. A petition may be filed by an attorney or other representative on behalf of an unnamed principal since 37 CFR 1.292 does not require that the principal be identified. A petition and fee (37 CFR 1.17(j)) are required to initiate consideration of whether to institute a public use proceeding. The petitioner ordinarily has information concerning a pending application which claims, in whole or in part, subject matter that the petitioner alleges was in “public use” or “on sale” in this country more than one year prior to the effective United States filing date of the pending application (see 35 U.S.C. 119 and 120). He or she thus asserts that a

statutory bar (35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103) exists which prohibits the patenting of the subject matter of the application.

When public use petitions and accompanying papers are submitted they, or a notice in lieu thereof, will be entered in the application file if the petition is:

(A) accompanied by the fee set forth in 37 CFR 1.17(j);

(B) served on the applicant in accordance with 37 CFR 1.248, or filed with the Office in duplicate in the event service is not possible; and

(C) submitted prior to the mailing of a notice of allowance under 37 CFR 1.311.

Duplicate copies should be submitted only when, after diligent effort, it has not been possible for petitioner to serve a copy of the petition on the applicant, or his or her attorney or agent in accordance with 37 CFR 1.248 in which case the Special Program Law Office of the Office of the Deputy Assistant Commissioner for Patent Policy and Projects will attempt to get the duplicate copy to the applicant, or his or her attorney or agent.

Notice of a petition for a public use proceeding will be entered in the file in lieu of the petition itself when the petition and the accompanying papers are too bulky to accompany the file. Any public use papers not physically entered in the file will be publicly available whenever the application file wrapper is available.

There are two types of public use proceedings: *ex parte* and *inter partes*. It is important to understand the difference. In the *ex parte* situation, the petitioner is not entitled, as a matter of right, to inspect the pending application. Thus, he or she stands in no better position than any other member of the public regarding access to the pending application. In the *inter partes* situation, the pending application is a reissue application. In the *inter partes* situation, the petitioner is privy to the contents of the pending application (37 CFR 1.612). Thus, as pointed out below, the petitioner in the *inter partes* situation participates in the public use proceedings to a greater degree than in the *ex parte* situation. A petitioner who was once involved in a terminated interference with a pending application is no longer privy to the application contents and will accordingly be treated as an *ex parte* petitioner. It should be noted that petitions filed on and after February 11, 1985 will not be allowed in accordance with 37 CFR 1.292(c) unless the petition arises out of an interference declared prior to February 11, 1985 or the interference was declared after February 11, 1985 but arose from an interference declared prior to that date.

Since February 11, 1985, a petition for institution of public use proceedings cannot be filed by a party to an interference as to an application involved in the interference. Public use issues can only be raised by a preliminary motion under 37 CFR 1.633(a). However, if the issue of public use arises out of an interference declared prior to February 11, 1985, the petition may be filed by a party to the interference as to an application involved in the interference.

There may be cases where a public use petition has been filed in an application which has been restricted or is subject to a proper restriction requirement. If the petition alleges that subject matter covering both elected claims and nonelected claims is a statutory bar, only that part of the petition drawn to subject matter of the elected claims will be considered. However, if a public use proceeding is ultimately instituted, it will not necessarily be limited to the subject matter of the elected claims but may include the nonelected subject matter. Any evidence adduced on the nonelected subject matter may be used in any subsequently-filed application claiming subject matter without the requirement of a new fee (37 CFR 1.17(j)). The petitioner will not be heard regarding the appropriateness of any restriction requirement.

A petition under 37 CFR 1.292 must be submitted in writing, must specifically identify the application to which the petition is directed by application number or serial number and filing date, and should include a listing of all affidavits or declarations and exhibits relied on. The petition must contain a sufficient description of the subject matter that the petitioner alleges was in “public use” or “on sale,” including any necessary photographs, drawings, diagrams, exits, or flowcharts, to enable the examiner to compare the claimed subject matter to the subject matter alleged to have been in “public use” or “on sale.” In addition, the petition and any accompanying papers must either (A) reflect that a copy of the same has been served upon the applicant or upon the applicant’s attorney or agent of record; or (B) be filed with the Office in duplicate in the event service is not possible.

It is important that any petition in a pending application specifically identify the application to which the petition is directed with the identification being as complete as possible. The following information, if known, should be placed on the petition:

- (A) Name of Applicant(s).
- (B) Application number.
- (C) Filing date of application.
- (D) Title of invention.
- (E) Group art unit number.
- (F) Name of examiner to whom the application is assigned.

(G) Current status and location of application.

(H) The word “ATTENTION:” followed by the area of the Office to which the petition is directed as set forth below.

In addition, to the above information, the petition itself should be clearly identified as a “PETITION UNDER 37 CFR 1.292.” If the petition is accompanied by exhibits or other attachments, these should also contain identifying information thereon in order to prevent them from becoming inadvertently separated and lost.

Any petition under 37 CFR 1.292 can be submitted by mail to the Assistant Commissioner for Patents, Washington, D.C. 20231, and should be directed to the attention of the director of the particular examining group in which the application is pending. If the petitioner is unable to specifically identify the application to which the petition is directed, but, nevertheless, believes such an application to be pending, the petition should be directed to the attention of the Special Program Law Office of the Office of the Deputy Assistant Commissioner for Patent Policy and Projects or to “Box DAC,” along with as much identifying data for the application as possible.

Where a petition is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the petition should be marked with the words “REISSUE LITIGATION.” The notations preferably should be written in a bright color with a felt point marker. Any “REISSUE LITIGATION” petition mailed to the Office should be so marked and mailed to “\*\*>Box DAC<.” However, in view of the urgent nature of most “REISSUE LITIGATION” petitions, petitioners may wish to hand-carry the petition to the appropriate area in order to ensure prompt receipt and to avoid any unnecessary delays. In litigation-type cases, all responses should be hand-carried to the appropriate area in the Office.

Every effort should be made by a petitioner to effect service of the petition upon the attorney or agent of record or upon the applicant if no attorney or agent is of record. Of course, the copy served upon applicant or upon applicant’s attorney or agent should be a complete copy including a copy of each photograph, drawing, diagram, exhibit, flowchart, or other document relied on. The petition filed in the Office should reflect, by an appropriate “Certificate of Service,” that service has been made as provided in 37 CFR 1.248. Only in those instances where service is not possible should the petition be filed in duplicate in order that the Office can attempt service. In addition, all other papers filed by the petitioner relating to the petition or subsequent public use proceeding must be served in accordance with 37 CFR 1.248.

## 720.01 Preliminary Handling

A petition filed under 37 CFR 1.292 should be forwarded to the Special Program Law Office of the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. A member of the Special Program Law Office's staff will ascertain whether the formal requirements of 37 CFR 1.292 have been fulfilled. In particular, the petition will be reviewed to see whether the petition has been filed prior to the mailing of a notice of allowance under 37 CFR 1.311, if the alleged use or sale occurred in this country more than 1 year before the effective filing date of the application, whether the petition contains affidavits or declarations and exhibits to establish the facts alleged, whether the papers have been filed in duplicate, or one copy has been served on applicant and whether the required fee has been tendered. The application file is ordered and its status ascertained so that appropriate action may be taken.

A petition under 37 CFR 1.292 must be "submitted prior to the mailing of a notice of allowance under 37 CFR 1.311." As a practical matter, any petition should be submitted as soon as possible after the petitioner becomes aware of the existence of the application to which the petition is to be directed. By submitting a petition early in the examination process, i.e., before the Office acts on the application if possible, the petitioner ensures that the petition will receive maximum consideration and will be of the most benefit to the Office in its examination of the application.

Since a petition under 37 CFR 1.292 cannot be considered subsequent to issuance of the application as a patent or abandonment of the application, the petition will not be considered if the application is not pending when the petition and application are provided to the member of the Special Program Law Office's staff (i.e., that the application was pending at the time the petition was filed would be immaterial to its ultimate consideration). A petition submitted prior to the mailing of a notice of allowance under 37 CFR 1.311, but not provided to the member of the Special Program Law Office's staff with the application file prior to issuance or abandonment of the application, will be entered in the application file, but will be dismissed as moot. A petition filed after final rejection will be considered if the application is still pending when the petition and application are provided to the member of the Special Program Law Office's staff. However, prosecution will not ordinarily be reopened after final rejection if the subject matter alleged in the petition to have been in "public use" or "on sale" is merely cumulative of the prior art cited in the final rejection. If a petition is filed after the mailing of a notice of allowance under 37 CFR 1.311, it will be dismissed as untimely.

A petition with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the petition cannot be filed within the 2-month period provided by 37 CFR 1.176, the petition can be submitted at a later time, but petitioner must be aware that reissue applications are "special" and a later filed petition may be received after action by the examiner. Any request by a petitioner in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette* will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17(h). The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate examining group. Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

If the petition is a "REISSUE LITIGATION" petition, it is particularly important that it be filed early if petitioner wishes it considered prior to the first Office action on the application. Petitioners should be aware that the Office will entertain petitions under 37 CFR 1.183, when accompanied by the petition fee set forth in 37 CFR 1.17(h), to waive the 2-month delay period of 37 CFR 1.176 in appropriate circumstances. Accordingly, petitioners in reissue applications cannot automatically assume that the full 2-month delay period of 37 CFR 1.176 will always be available.

In those *ex parte* situations where a petitioner cannot identify the pending application by application number, the petition papers will be forwarded to the appropriate Group Director for an identification search. Once the application file(s) is located, it should be forwarded to the Special Program Law Office.

If the petition filed in the Office does not indicate service on applicant or applicant's attorney or agent, and is not filed in duplicate, then the Office will undertake to determine whether or not service has been made by contacting applicant or applicant's attorney or agent by telephone or in writing to ascertain if service has been made. If service has not been made and no duplicate has been filed, then the Office may request petitioner to file such a duplicate before the petition is referred to the examiner. Alternatively, if the petition involves only a few pages, the Office may, in its sole discretion, elect to reproduce the petition rather than delay referring it to the examiner. If duplicate petition

papers are mailed to applicant or applicant's attorney or agent by the Office, the application file should reflect that fact, either by a letter transmitting the petition or, if no transmittal letter is used, simply by an appropriate notation in the "Contents" section of the application file wrapper.

If the petition is not submitted prior to the mailing of a notice of allowance under 37 CFR 1.311, it should not be entered in the application file. The applicant should be notified that the petition is untimely and that it is not being entered in the application file. The handling of the petition will vary depending on the particular following situation.

(A) *Service Of Copy Included*

Where the petition includes an indication of service of copy on the applicant, the original petition should be discarded.

(B) *Service Of Copy Not Included*

Where the petition does not include an indication of service and a duplicate copy of the petition is or is not present, the duplicate copy (if present) should be discarded and the original petition should be sent to the applicant along with the notification of nonentry.

## 720.02 Examiner Determination of *Prima Facie* Showing

Once the Special Program Law Office staff member has determined that the petition meets the formal requirements of 37 CFR 1.292, and the application's status warrants consideration of the petition, he or she will prepare a letter for the Patent Legal Administrator, forwarding the petition and the application file to the examiner for determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition. Any other papers that have been filed by the parties involved, such as a reply by the applicant or additional submissions by the petitioner, will also be forwarded to the examiner. Whether additional papers are accepted is within the discretion of the Special Program Law Office's staff member. However, protracted paper filing is discouraged since the parties should endeavor to present their best case as to the *prima facie* showing at the earliest possible time. No oral hearings or interviews will be granted at this stage, and the examiner is cautioned not to answer any inquiries by the petitioner or applicant.

A *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103. See MPEP § 2133.03 *et seq.*

To make this determination, the examiner must identify exactly *what* was in public use or on sale, whether it was in

use or on sale in this country more than 1 year before the effective filing date, and whether the pending claims "read" on or are obvious over what has been shown to be in public use or on sale. On this last point, the examiner should compare all pending claims with the matter alleged to have been in use or on sale, not just the claims identified by petitioner.

In situations where the petition alleges only that the claims are obvious over subject matter asserted to be in public use or on sale, the petition should include prior art or other information on which it relies and explain how the prior art or other information in combination with the subject matter asserted to be in public use or on sale renders the claims obvious. The examiner is not expected to make a search of the prior art in evaluating the petition. If, however, the examiner determines that a *prima facie* case of anticipation under 35 U.S.C. 102(b) has not been established but, at the time of evaluating the petition, the examiner is aware of prior art or other information which, in his or her opinion, renders the claims obvious over the subject matter asserted to be in public use or on sale the examiner may determine that a *prima facie* case is made out, even if the petition alleged only that the claims were anticipated under 35 U.S.C. 102(b).

After having made his/her determination, the examiner will forward a memorandum to the Patent Legal Administrator, stating his or her findings and his or her decision as to whether a *prima facie* case has been established. The findings should include a summary of the alleged facts, a comparison of at least one claim with the device alleged to be in public use or on sale, and any other pertinent facts which will aid the Patent Legal Administrator in conducting the preliminary hearing. The report should be prepared in triplicate and addressed to the Patent Legal Administrator.

## 720.03 Preliminary Hearing

Where the examiner concludes that a *prima facie* showing has not been established, both the petitioner and the applicant are so notified by the Office of the Deputy Assistant Commissioner for Patent Policy and Projects and the application proceedings are resumed without giving the parties an opportunity to be heard on the correctness of the examiner's decision. Where the examiner concludes that a *prima facie* case has been established, the Commissioner may hold a preliminary hearing. In such case, the parties will be notified by letter of the examiner's conclusion and of the time and date of the hearing. In *ex partecases*, whether or not the examiner has concluded that a *prima facie* showing has been established, no copy of the examiner's memorandum to the Patent Legal Administrator will be forwarded to the petitioner. However, in such cases

where the petition covers restrictable subject matter and it is evident that petitioner is not aware of a restriction requirement which has been or may be made, petitioner will be informed that the examiner's conclusion is limited to elected subject matter. While not so specifically captioned, the notification of this hearing amounts to an order to show cause why a public use proceeding should not be held. No new evidence is to be introduced or discussed at this hearing. The format of the hearing is established by the member of the Special Program Law Office staff, and the Patent Legal Administrator presides. The examiner may attend as an observer only.

Where the hearing is held in the *ex parte* situation, great care will be taken to avoid discussion of any matters of the application file which are not already of knowledge to petitioner. Of course, applicant may of his or her own action or consent notify the petitioner of the nature of his or her claims or other related matters.

After the hearing is concluded, the Patent Legal Administrator will decide whether public use proceedings are to be initiated, and he/she will send appropriate notice to the parties.

## 720.04 Public Use Proceeding Testimony

When the Patent Legal Administrator decides to institute public use proceedings, the application is referred to the examiner who will conduct all further proceedings. The fact that the affidavits or declarations and exhibits presented with the petition for institution of the public use proceedings have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established. The statutory bar can only be established by testimony taken in accordance with normal rules of evidence, including the right of cross-examination. The affidavits or declarations are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them unless the affidavits or declarations are submitted as a part of the petitioner's testimony.

The procedure for taking testimony in a public use proceeding is similar to that for taking testimony in an interference. Normally, no representative of the Commissioner need be present at the taking of the testimony. Note that 37 CFR 1.672(a) limits noncompelled direct testimony to affidavits. See 37 CFR 1.601(b) for the meaning of affidavit.

The examiner will set a schedule of times for taking testimony and for filing the record and briefs on the basis of the following:

## SCHEDULE FOR TESTIMONY

(A) Testimony for petitioner to close . . . . .  
[specify a date, e.g., January 10, 1997, which is approximately 60 days after the letter]

(B) Time for the applicant to file objections to admissibility of petitioner's evidence to close . . . . .  
[specify a date which is approximately 20 days after date (A)]

(C) Time for the petitioner to file supplemental evidence to overcome objections to close 20 days from above date, i.e., . . . . .  
[specify a date which is exactly 20 days after date (B), unless the date is a Saturday, Sunday or federal holiday, in which case use the next business day]

(D) Time for the applicant to request cross-examination of the petitioner's affiants to close . . . . .  
[specify a date which is approximately 20 days after date (C)]

(E) Time for cross-examination of the petitioner's affiants to close . . . . .  
[specify a date which is approximately 30 days after date (D)]

(F) Rebuttal testimony by applicant to close . . . . .  
[specify a date which is approximately 20 days after date (E)]

## SCHEDULE FOR FILING AND SERVING COPIES OF RECORD AND BRIEFS

One copy of each of the petitioner's and the applicant's record and exhibits (see 37 CFR 1.653) is due . . . . .  
[specify a date which is approximately 30 days after date (F)]

Petitioner's brief is due . . . . .  
[specify a date which is approximately 30 days after previous date]

Applicant's brief is due . . . . .  
[specify a date which is approximately 20 days after previous date]

Applicant and petitioner may agree on a different schedule for testimony, records, and briefs, provided the last brief is due no later than the date set forth above and provided a copy of the new schedule is filed by either applicant or petitioner. No extension of time will be permitted under 37 CFR 1.136(a). Any petition to extend the time for filing the last brief must be filed under 37 CFR 1.136(b).

A certified transcript of a deposition must be filed in the Patent and Trademark Office within one month after the date of deposition. 37 CFR 1.678.

All papers in the public use proceeding shall be served in accordance with 37 CFR 1.248.

It is understood from the above scheduling of times that a given time period begins with the close of the previous

period, and that the completion of testimony or the filing of the record or a brief before the close of the corresponding period does not change its closing date. To avoid confusion, the examiner should indicate specific dates for the close of each period.

In *ex parte* cases and in *inter partes* cases where the pending application is a reissue, an oral hearing is ordinarily not held.

In all public use proceedings, whether the ultimate issue is anticipation under 35 U.S.C. 102(b) or obviousness over 35 U.S.C. 103, testimony will be limited to the issues of public use or on sale. No testimony will be received on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale.

### 720.05 Final Decision

The final decision of the examiner should be “analogous to that rendered by the [Board of Patent Appeals and Interferences] in an interference proceeding, analyzing the testimony” and stating conclusions. *In re Townsend*, 1913 C.D. 55, 188 O.G. 513 (Comm’r Pat. 1913). In reaching his or her decision, the examiner is not bound by the prior finding that a *prima facie* case has been established.

If the examiner concludes that a public use or sale bar exists, he or she will enter a rejection to that effect in the application file, predicating that rejection on the evidence considered and the findings and decision reached in the public use proceeding. Even if a rejection is not made, the examiner’s written action should reflect that the evidence of 35 U.S.C. 102(b) activity has in fact been considered. Likewise, if the examiner concludes that a *prima facie* case (A) has not been established, or (B) has been established and rebutted (MPEP § 2133.03(e) *et seq.*) then the examiner’s written action should so indicate. Strict adherence to this format should cause the rationale employed by the examiner in the written action to be self-evident. In this regard, the use of reasons for allowance pursuant to 37 CFR 1.104(e) may also be appropriate. See MPEP § 1302.14. In *ex parte* cases where the petitioner does not have access to the file, no copy of the examiner’s action is mailed to the petitioner by the Office.

There is no review from the final decision of the examiner in the public use proceedings. A petition under 37 CFR 1.181, requesting that the Commissioner exercise his or her supervisory authority and vacate the examiner’s decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm’r Pat. 1908). Once the application returns to its *ex parte* status, appellate review under 35 U.S.C. 134 and 141-145 may be had of any adverse decision rejecting

claim(s), as a result of the examiner’s decisions as to public use or sale.

### 724 Trade Secret, Proprietary, and Protective Order Materials

Situations arise in which it becomes necessary, or desirable, for parties to proceedings in the Patent and Trademark Office relating to pending patent applications or reexamination proceedings to submit to the Office trade secret, proprietary, and/or protective order materials. Such materials may include those which are subject to a protective or secrecy order issued by a court or by the International Trade Commission (ITC). While one submitting materials to the Office in relation to a pending patent application or reexamination proceeding must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes imposes. The Office is also cognizant of the sentiment expressed by the court in *In re Sarkar*, 575 F.2d 870, 872, 197 USPQ 788, 791 (CCPA 1978), which stated:

[T]hat wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.

Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
  - (i) Opposing an argument of unpatentability relied on by the Office, or
  - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring “material” information to the attention of the Office. It matters not whether the “material” information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if “material to patentability” as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

Somewhat the same problem faces a protestor under 37 CFR 1.291(a) who believes that trade secret, proprietary, or protective order material should be considered by the Office during the examination of an application.

In some circumstances, it may be possible to submit the information in such a manner that legitimate trade secrets, etc., will not be disclosed, e.g., by appropriate deletions of nonmaterial portions of the information. This should be done only where there will be no loss of information material to patentability under 37 CFR 1.56 or 1.555.

The provisions of this section do not relate to material appearing in the description of the patent application.

### **724.01 Completeness of the Patent File Wrapper**

It is the intent of the Office that the patent file wrapper be as complete as possible insofar as “material” information is concerned. The Office attempts to minimize the potential conflict between full disclosure of “material” information as required by 37 CFR 1.56 and protection of trade secret, proprietary, and protective order material to the extent possible.

The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material.

### **724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials**

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or

item must be clearly labeled as a “Trade Secret” document or item, a “Proprietary” document or item, or as an item or document “Subject To Protective Order.” It is essential that the terms “Confidential,” “Secret,” and “Restricted” or “Restricted Data” not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is “Subject to Protective Order” the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

A. “TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADE-MARK OFFICE EMPLOYEE.

In re Application of

Application No.

Filed:

For: (Title of Invention)

Group Art Unit:

Examiner:

ATTENTION: (Current Location of Application)”

B. “PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADE-MARK OFFICE EMPLOYEE.

In re Application of

Application No.

Filed:

For: (Title of Invention)

Examiner:

ATTENTION: (Current Location of Application)”

C. “MATERIAL SUBJECT TO PROTECTIVE ORDER — NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADEMARK OFFICE EMPLOYEE.

Tribunal Issuing Protective Order:

Civil Action or Other Identification No.:

Date of Order:

Current Status of Proceeding: (Pending, Stayed, etc.)

In re application of:

Application No.

Filed:

For: (Title of Invention)

Group Art Unit:

Examiner:

ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(i)) to expunge the information, if found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, may also accompany the envelope or container.

In order to ensure that such an envelope or container is not mishandled, either prior to reaching the Office, or in the Office, the envelope or container should preferably be hand-carried to the particular area to which it is directed and in which the application or reexamination is pending at that time. If the proceeding is then pending in an examining group, the envelope or container should be hand-carried to the office of the Director of the examining group. The Office personnel receiving the envelope or container should be informed that it contains such material. If the envelope or container cannot be hand-carried to the office, it can be mailed to the Patent and Trademark Office in the normal manner, but that method of submission is not as desirable as hand-carrying the envelope or container to the Office or area involved.

### **724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02**

The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/ or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR

1.131 or 1.132, they will be made of record in the file and will not be given any special status.

Insofar as protestors under 37 CFR 1.291(a) are concerned, submissions can be made in accordance with MPEP § 724.02 if protestor or petitioner has access to the application involved. In such cases, of course, the requirements for service must be followed. The Office cannot ensure that the party or parties served will maintain the information secret. If the party or parties served find it necessary or desirable to comment on material submitted under MPEP § 724 before it is, or without its being, found "material to patentability," such comments should either (A) not disclose the details of the material or (B) be submitted in a separate paper under MPEP § 724.02.

### **724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02**

The exact methods of treating and handling materials submitted under MPEP § 724.02 will differ slightly depending upon whether the materials are submitted in an original application subject to the requirements of 35 U.S.C. 122 or whether the submission is made in a reissue application or reexamination file open to the public under 37 CFR 1.11(b) or (d). In any event, Office personnel must not disclose such materials to the public without authorization. Upon receipt of the submission, the transmittal letter and the envelope or container will be date stamped and brought to the attention of the examiner or other Office employee responsible for evaluating the submission. The receipt of the transmittal letter and envelope or container will be noted on the "Contents" of the application or reexamination file. In addition, the face of the application or reexamination file will have the notation placed thereon to indicate that trade secret, proprietary, or protective order material has been filed. The location of the material will also be specified. The words "TRADE SECRET MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" on the face of the file are sufficient to indicate the presence of trade secret material. Similar notations will be made for either proprietary or protective order materials.

#### **724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122**

Any materials submitted under MPEP § 724.02 in an application covered by 35 U.S.C. 122 will be treated in the following manner:

(A) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all

of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(B) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, it will be cited in the next Office action, or other appropriate Office communication and will become a part of the file history, which upon issuance of the application as a patent would become available to the public.

(C) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the next Office action or other appropriate Office communication will so indicate without including the details of the submitted information.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, that information will be resealed in its envelope or container and retained pending the possible filing of a petition to expunge the information.

(E) Any petition to expunge the submitted information or any portion thereof under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

#### **724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)**

Any materials submitted under MPEP § 724.02 in a reissue application open to the public under 37 CFR 1.11(b) will be treated in the following manner:

(A) The submitted information will be maintained separate from the reissue application file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reissue application file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the next Office action or other appropriate Office communication will so indicate without including in the communication the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, that information will be resealed in its envelope or container and retained separate from the application file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked “Not Open To The Public” and Office personnel will not make such envelope or container available to any member of the public inspecting the reissue application file.

(G) Any petition to expunge a portion or all of the submitted information will be treated in accordance with MPEP § 724.05.

#### **724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)**

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, the next Office action or other appropriate Office communication will so indicate without including in the communication the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, that information will be resealed in its envelope or container and retained separate from the reexamination file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked “Not Open To The Public” and Office personnel will not make such envelope or container available to any member of the public inspecting the reexamination file.

(G) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

## **724.05 Petition To Expunge Information or Copy of Papers in Application File**

### **I. INFORMATION SUBMITTED UNDER MPEP § 724.02**

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02 will be entertained only if the petition fee (37 CFR 1.17(i)) is filed and the information has been found *not* to be important to a reasonable examiner in deciding on patentability. If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be directed to the examining group to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR 1.17(i) for a petition under 37 CFR 1.59.

Any such petition to expunge may accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the

date on which the patent or reexamination certificate issues. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is pending in the examining group and before it is transmitted to the Publishing Division. If, for any reason, a decision to expunge cannot be, or is not, made prior to the date on which the patent or reexamination certificate issues, any material then in the file will remain therein and be open to the public. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

### **II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION**

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(i) is included.

A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

**III. INFORMATION SUBMITTED IN INCORRECT APPLICATION**

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37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request return of the papers rather than transfer of the papers to the correct application file. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g., application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the papers to the correct application file for which they were intended without the need of a petition.

**IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE**

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions. The petition must explain why justice requires waiver of the rules to permit the requested material to be expunged. It should be noted that petitions to expunge information which is a part of the original disclosure, such as the specification and drawings, will ordinarily not be favorably entertained. The original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the PTO record of the originally filed application be changed, which may not be possible.

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(i) are filed, and further that petitioner has established to the satisfaction of the Commissioner that the return of the information is appropriate. Return of information that was originally submitted to the Office under MPEP § 724.02 is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the information is not important to a reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability). Return of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

Where the information to be expunged was not submitted pursuant to MPEP § 724.02 or as part of an Information Disclosure Statement, the petition should be sent to the Office of Petitions for decision.

If the application has not been allowed or abandoned or an *Ex parte Quayle* action has not been mailed, then the decision on the petition to expunge should be held in abeyance until the close of prosecution on the merits, at which time the petition will be decided. However, where it is clear that the information was submitted in the wrong application, then the decision on the petition should not be held in abeyance. See MPEP § 724.05, paragraph III. In a pending application that has not been allowed or in which an *Ex parte Quayle* action has not been mailed, the examiner may not have finally considered what is material to a decision of patentability of the claims. Petitioner may be notified that the decision on the petition under 37 CFR 1.59(b) to expunge information in an application will be held in abeyance and be decided upon the close of prosecution on the merits using form paragraph 7.204.

**724.06 Examiner Handling of Petitions to Expunge Information or Copy of Papers in Application File**

*37 CFR 1.59. Expungement of information or copy of papers in application file.*

(a)(1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) Information, other than what is excluded by paragraph (a)(2) of this section, may be requested to be expunged and returned to applicant upon petition under this paragraph and payment of the petition fee set forth in § 1.17(i). Any petition to expunge and return information from an application must establish to the satisfaction of the Commissioner that the return of the information is appropriate.

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

	Paper No. [1]
In re Application of [2]	:
Appl. No.: [3]	: RESPONSE TO PETITION
Filed: [4]	: UNDER 37 CFR 1.59
For: [5]	:

This is a response to the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The decision on the petition will be held in abeyance until prosecution on the merits is closed, at which time the petition will be decided.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states either: (A) that the information contains

trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to applicant.

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#### Examiner Note:

1. An examiner may only decide this petition if the information was submitted pursuant to MPEP § 724.02.
2. An examiner may not decide the petition if:
  - (a) the information is part of the original disclosure. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Although some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstances, a petition to expunge information other than that submitted as part of an Information Disclosure Statement should be sent to the Office of Petitions for decision; or
  - (b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).
3. This decision is printed with the PTO letterhead.
4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.
5. Mail with PTO-90C cover sheet.<

When an application has been allowed, an *Ex parte* Quayle action has been mailed, or an application is abandoned, a petition to expunge should be treated by a primary examiner and the examiner should consider whether the information in question is material. Form paragraph 7.205 should be used to grant a petition to expunge, whereas form paragraphs 7.206 - 7.213 should be used to dismiss such a petition.

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

Paper No. [1]

In re Application of [2] :  
 Appl. No.: [3] : DECISION ON PETITION  
 Filed: [4] : UNDER 37 CFR 1.59  
 For: [5] :

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states that either (A) that the information con-

tains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(i) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

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

The expunged material is returned herewith.

Enclosure: [9]

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#### Examiner Note:

1. An examiner may only decide this petition if the information was submitted pursuant to MPEP § 724.02. Furthermore, a petition to expunge may not be granted unless the application has been allowed or is abandoned, or an Ex Parte Quayle action has been mailed.
2. An examiner may not decide the petition if:
  - (a) the information is part of the original disclosure. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. However, some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or
  - (b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).
3. This decision is printed with the PTO letterhead.
4. In brackets 7 and 9, clearly identify the expunged document. For example, refer to the author and title of the document.
5. Mail with PTO-90C cover sheet.<

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

Paper No. [1]

In re Application of [2] :  
 Appl. No.: [3] : DECISION ON PETITION  
 Filed: [4] : UNDER 37 CFR 1.59  
 For: [5] :

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record.

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

The petition is deficient because:

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#### Examiner Note:

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

entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the PTO letterhead.

4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.

5. This form paragraph must be followed with one or more of form paragraphs 7.207, 7.208, and 7.209.<

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

the petition was not accompanied by the required fee under 37 CFR1.17(i).

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

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

**Examiner Note:**

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

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

the information has been made public. [1]

**Examiner Note:**

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

*¶ 7.210 Petition to Expunge, Conclusion, No Commitment to Retain Information*

the petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the period of any patent with regard to which such information is submitted.

*¶ 7.211 Petition to Expunge, Conclusion, No Clear Statement That Information is Trade Secret, Proprietary, and/or Subject to Protective Order, or that Submission Was Unintentional*

the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted. [1]

**Examiner Note:**

In bracket 1, indicate whether any such statement was provided and, if so, explain why such statement is not clear.

*¶ 7.212 Petition to Expunge, Conclusion, No Clear Identification of Information to be Expunged*

the petition does not clearly identify the information requested to be expunged. [1]

**Examiner Note:**

In bracket 1, explain why the identification of the information requested to be expunged is not clear.

*¶ 7.213 Petition to Expunge, Conclusion, No Statement That Petition Is Submitted By, or on Behalf of, Party in Interest Who Originally Submitted the Information*

the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.

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MANUAL OF PATENT EXAMINING PROCEDURE