Doc Code: DIST
Document Description: Terminal Disclaimer

PTO/AIA/26JRA (09-26)
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TERMINAL DISCLAIMER (WITH JOINT RESEARCH AGREEMENT ENFORCEMENT PROVISION) TO OBVIATE A NONSTATUTORY DOUBLE PATENTING REJECTION OVER A REFERENCE PATENT

Application Number:	Docket Number (Optional):
First Named Inventor:	Filing Date:
Title of Invention:	

Note: The filing of a terminal disclaimer by itself **does not satisfy the requirement** to respond to an outstanding Office action. To respond to a non-final action, a reply under 37 CFR 1.111 is required. To respond to a final action, a reply under 37 CFR 1.113 is required.

For each reference patent listed below, the applicant,

_____

_____,

owner of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of the reference patent, as the term of the reference patent is presently shortened by any terminal disclaimer.

The applicant of the instant application waives the right to separately enforce the reference patent and any patent granted on the instant application. The applicant of the instant application hereby agrees that any patent granted on the instant application shall be enforceable only for and during such period that the reference patent and any patent granted on the instant application are not separately enforced. The waiver and this agreement run with any patent granted on the instant application and are binding upon the applicant of the instant application, its successors, or assigns.

In making the above disclaimer, the applicant does not disclaim the terminal part of the statutory term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the reference patent, "as the term of the reference patent is presently shortened by any terminal disclaimer," in the event that the reference patent later: expires for failure to pay a maintenance fee; is held unenforceable; is found invalid by a court of competent jurisdiction; is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321; has all claims canceled by a reexamination certificate; is reissued; or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Reference Patent Number

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I. Requirements to establish a joint research agreement (JRA) for each reference patent identified in this terminal disclaimer

A. Statement under 37 CFR 1.104(c)(4)(ii)(A) or 37 CFR 1.104(c)(5)(ii)(A) as applicable. Check either box 1 or 2.

The statement ("JRA statement") in accordance with 37 CFR 1.104(c)(4)(ii)(A) or 37 CFR 1.104(c)(5)(ii)(A)

1. ☐ was previously filed on_____.

2. ☐ is concurrently being submitted with this terminal disclaimer.

Note: For the requirements of the JRA statement, see either (1) 35 U.S.C. 102(c) and 37 CFR 1.104(c)(4)(ii)(A) if the instant application is subject to the First-Inventor-to-File provision of the AIA; or (2) pre-AIA 35 U.S.C. 103(c)(2) and 37 CFR 1.104(c)(5)(ii)(A) if the instant application is subject to 35 U.S.C. 102 in effect on March 15, 2013.

Example of a statement under 37 CFR 37 CFR 1.104(c)(4)(ii)(A):

The subject matter of U.S. Patent No. XX,XXX,XXX [***this is the reference identified in the terminal disclaimer***] was developed and the claimed invention of the instant application was made by or on behalf of one or more the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and 37 CFR 1.9(e), that was in effect on or before the effective filing date the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

Example of a statement under 37 CFR 37 CFR 1.104(c)(5)(ii)(A):

The subject matter of U.S. Patent No. XX,XXX,XXX [***this is the reference identified in the terminal disclaimer***] and the claimed invention of the instant application were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and 37 CFR 1.9(e), which was in effect on or before the date the claimed invention was made, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement.

B. Specification discloses parties to the JRA. See 37 CFR 1.104(c)(4)(ii)(B) or 37 CFR 1.104(c)(5)(ii)(B). Check either box 1, 2, or 3.

The specification of the instant application

1. ☐ as filed discloses the names of the parties to the JRA.

2. ☐ was previously amended on_____to disclose the names of the parties to the JRA.

3. ☐ is concurrently being amended to disclose the names of the parties to the JRA.

Note: A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be required if the amendment was filed after the date the issue fee was paid. See 37 CFR 1.71(g)(3).

C. Fee in 37 CFR 1.17(i)(1) for amendment under 37 CFR 1.71(g)(1) to name parties to the JRA. Check either box 1, 2, or 3.

1. ☐ The fee set forth in 37 CFR 1.17(i)(1) is not required because the specification as filed discloses the names of the parties to the JRA, and no untimely amendment under 37 CFR 1.71(g)(1) was filed to name different or additional parties to the JRA.

2. ☐ The fee set forth in 37 CFR 1.17(i)(1) as required by 37 CFR 1.71(g)(2) for an untimely amendment naming the parties to the JRA is concurrently being submitted with this terminal disclaimer or was paid on_____.

3. ☐ The fee set forth in 37 CFR 1.17(i)(1) is not required because the amendment naming the parties to the JRA was filed within one of the time periods set forth in 37 CFR 1.71(g)(2).

II. Whether each reference patent identified in this terminal disclaimer is prior art. Check either box 1 or 2.

Note: 37 CFR 1.321(d) requires that the reference that the nonstatutory double patenting is based upon is not commonly owned and was disqualified as prior art as set forth in either 37 CFR 1.104(c)(4)(ii) or (c)(5)(ii).

1. ☐ Each reference patent identified in this terminal disclaimer is not commonly owned and is prior art under: (1) 35 U.S.C. 102(a)(2) before any exception under 35 U.S.C. 102(b)(2)(C) is considered; or (2) pre-AIA 35 U.S.C. 102(e), (f), or (g) before any exception under pre-AIA 35 U.S.C. 103(c) is considered.

2. ☐ At least one reference patent identified in this terminal disclaimer is **NOT** prior art (before any exception is considered) under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e), (f), or (g). **A petition under 37 CFR 1.183 requesting waiver of the prior art requirement in 37 CFR 1.321(d) is concurrently being filed with this terminal disclaimer.**

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III. A disclaimer fee is required for each disclaimer filed.

☐ The disclaimer fee under 37 CFR 1.20(d) is included.

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IV. Authorization for this disclaimer - Check either box 1 or 2 below.

1. ☐ The undersigned is the applicant or is authorized to act on behalf of the applicant (e.g., where the applicant is a juristic entity).
2. ☐ The undersigned is an attorney or agent of record. Registration No. _____

I hereby acknowledge that any willful false statements made are punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

_____ _____
Signature Date

_____ _____
Typed or printed name Telephone number

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications.

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If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.