

From: Assistant Deputy Comm (ADCs)
Sent: Thursday, October 19, 2017 10:11 AM
Subject: Reminder Concerning Terminal Disclaimers

This email is being sent to all Directors, SPEs, Examiners, and OPESS Employees in the Technology Centers

The purpose of this email is to remind Patents Employees how terminal disclaimers are processed by the Office, and what an approval of a terminal disclaimer means in relation to any outstanding nonstatutory double patenting rejection(s) of record. A terminal disclaimer should not be considered effective to overcome the nonstatutory double patenting rejection(s) of record until (1) the terminal disclaimer has been approved by the Patent Legal Research Center (PLRC), and (2) the examiner has ensured that the correct target application(s) or (patent) is identified in the terminal disclaimer.

First, a terminal disclaimer must be reviewed and approved by the PLRC. The PLRC's review of a terminal disclaimer, however, is limited to compliance with 37 CFR 1.321, and an approval is not an indication that the terminal disclaimer identifies the target application or patent that was the basis for the nonstatutory double patenting rejection. A record of the approval may be found in the Image File Wrapper (IFW) either as a DISQ or DISQ.E.File with an indication of "approved."

Second, once the terminal disclaimer has been approved, the examiner must determine whether the correct target application or patent is identified in the terminal disclaimer before the nonstatutory double patenting rejection can be withdrawn in view of the terminal disclaimer. After any terminal disclaimer has been reviewed by the PLRC, the examiner must inform the applicant of its status in the next office action and may use the form paragraphs in MPEP 1490. If the terminal disclaimer identifies the wrong target application or patent, then a replacement terminal disclaimer would be required. Once a correct replacement terminal disclaimer is received, the next Office action should make it clear that "the second terminal disclaimer replaces the first terminal disclaimer, and the first terminal disclaimer is thus void." See MPEP 1490, Section VI. C.

Please note that terminal disclaimers are reviewed in date order (i.e., the date the terminal disclaimer is filed). If expedited review of a terminal disclaimer is needed, please contact your supervisor so that he or she may request expedited review.