

Changes to Pre-Examination Notices

I. Summary

The United States Patent and Trademark Office (USPTO) reviews new nonprovisional applications filed under 35 U.S.C. § 111(a) and national stage applications submitted under 35 U.S.C. § 371 to ensure that each application is complete and in condition for examination. The USPTO also reviews provisional applications filed under 35 U.S.C. § 111(b) to ensure that each provisional application is complete. Applicants are notified of any deficiencies or informalities in new applications through various types of pre-examination notices. Pre-examination notices that require the submission of missing items or correction of the application papers set a time period for reply during which all the requirements must be satisfied.

The USPTO has received feedback from applicants that pre-examination notices are not always easy to understand and has received requests to modify the notices for clarity. In response to that feedback, the USPTO undertook an effort to revise the pre-examination notices. The notices have now been revised to more clearly set forth the required items and/or the corrections needed to complete the application and place it in condition for examination.

Applicants are advised that some changes have also been made to the notices to create consistency between the practices for nonprovisional applications filed under 35 U.S.C. § 111(a) and national stage applications under 35 U.S.C. § 371. As a result, the title of the Notification of Defective Response in national stage applications under 35 U.S.C. § 371 has been changed to “Notification of Defective Reply” and the time period for reply thereto has also changed. Applicants should carefully review any pre-examination notices received over the coming months to ensure that any replies in response to such notices are proper and filed in a timely manner.

II. Detailed Information

The USPTO has made changes to clarify pre-examination notices issued by the Office of Patent Application Processing (OPAP) (including notices from the United States Designated/Elected Office (DO/EO/US) for national stage applications under 35 U.S.C. § 371). The changes will result in notices that are better tailored to each situation by eliminating unnecessary generic text that is not applicable, by identifying specific items and corrections that are required, and by providing further information on how to comply with each requirement.

The following discussion includes examples of the changes that were made to the notices.

Notice of Incomplete Reply: The Notice of Incomplete Reply will now specify the extensions of time that remain available in the particular application and provide the last date on which a reply can be timely filed. In addition, the Notice of Incomplete Reply will now clearly state that the time period continues to run from the previous notice. Previously, where the only outstanding requirement was an extension of time, the Notice of Incomplete Reply listed all extensions of

time permitted under the rules without regard to the time period running in the particular application. In addition, in most cases, the Notice of Incomplete Reply referred to the two month time period set forth in the previous notice without expressly stating that the time period continues to run from the previous notice. Some applicants misunderstood this language on the Notice of Incomplete Reply as providing a new two month time period to reply. These changes to the Notice of Incomplete Reply will make it easier for applicants to understand the extensions of time that remain available in the particular application and that the time period continues to run from the mailing date of the previous notice.

Notice Regarding Power of Attorney: The Notice Regarding Power of Attorney will now clearly indicate the specific reason why the power of attorney cannot be accepted. For example, when a power of attorney is submitted with a request to change the applicant but the request to change the applicant cannot be granted because the statement under 37 CFR 3.73(c) is non-compliant, the notice will specifically indicate the reason why the power of attorney cannot be accepted. Previously, the notice only stated that the power of attorney was not signed by the applicant, rather than pointing out that the reason for rejecting the power of attorney was related to an improper request to change the applicant. This change in the Notice Regarding Power of Attorney will clarify what the applicant must submit in order for a change in power of attorney to be accepted.

Notification of Defective Reply: While undertaking this effort to improve the notices issued during the pre-examination process, the USPTO has discovered some inconsistencies between the practices for nonprovisional applications filed under 35 U.S.C. § 111(a) and national stage applications under 35 U.S.C. § 371 and has made changes to these notices for consistency. Previously, when applicant's response to a Notification of Missing Requirements was not complete in a national stage application under 35 U.S.C. § 371, the USPTO would issue a Notification of Defective Response giving applicant an alternative time period for reply of one month from the date of the Notification of Defective Response or the time remaining in the Notification of Missing Requirements, whichever was longer, in order to complete a reply to the Notification of Missing Requirements. In most instances, the USPTO revised its practice of issuing actions or notices that set an alternative time period of one month or the time remaining in a previous action or notice, whichever was longer, several years ago. Therefore, the title of the Notification of Defective Response is being changed to "Notification of Defective Reply" and the additional one month time period is being eliminated in order to create consistency with the practice in applications filed under 35 U.S.C. § 111(a) and to reduce any confusion that may arise from an alternative time period for reply.

Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures: A number of clarifying changes have also been made to the Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. For example, the notice will now provide more detail regarding sequence listing requirements and how to correct any deficiencies. As a reminder, applications containing disclosures of nucleotide and/or amino acid sequences are reviewed in OPAP for compliance with sequence listing requirements and are

retained in OPAP until any noncompliant sequence listing that renders an application unsuitable for examination is corrected. OPAP will mail to applicant a Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures listing the requirements that have not been met and setting a two month time period within which to comply with the sequence rules (37 CFR 1.821 -1.825). Failure to comply with these requirements will result in abandonment of the application under 37 CFR 1.821(g). Extensions of time may be obtained under the provisions of 37 CFR 1.136. See the Manual of Patent Examining Procedure (MPEP) Section 2421.03.

III. Reminders

Use the Correct Document Descriptions for Correspondence Filed Electronically: Applicants are reminded that using the correct document description is important since it will result in a message to the appropriate area of the USPTO to process the reply. Failure to use the correct document description may result in no message being sent to anyone in the USPTO that a reply has been filed. Applicants are advised that replies to most notices sent by OPAP (e.g., Notice to File Missing Parts, Notice of Omitted Items, Notice of Incomplete Application, or Notification of Missing Requirements) submitted electronically via the USPTO's electronic filing system (EFS-Web) should be identified using the document description "Applicant Response to Pre-Exam Formalities Notice." Replies to notices regarding sequence listing requirements only (e.g., Notice to Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures) should be identified using the document description "Response to Pre-Exam Sequence Notice." In addition, it is noted that use of the document description "Application Data Sheet" by itself does not result in a message being sent to anyone in the USPTO that a reply has been filed and needs to be processed. Thus, a corrected ADS must be filed with an appropriate request to take some action, such as a request for corrected filing receipt using the document description "Request for Corrected Filing Receipt," a request under 37 CFR 1.48 using the document description "Request under Rule 48 correcting inventorship," or a request under 37 CFR 1.46(c) using the document description "Request under 37 CFR 1.46(c) to correct, update or change the applicant." An indexing guide for document descriptions is available at <https://www.uspto.gov/patents-application-process/applying-online/efs-web-guidance-and-resources>.

All Correspondence Must Be Properly Signed: When submitting correspondence in an existing application, applicants are reminded that a properly signed reply or request is required. For example, where only fees are required, applicant must submit a properly signed reply with the payment of the fees. All correspondence filed in an application must be signed in accordance with 37 CFR 1.33(b).

A Substitute Specification is Required for Certain Amendments: Applicants are reminded that if a reply to a notice sent by OPAP necessitates changes to the specification (excluding the claims or abstract), then the notice will require applicant to submit an amendment **in the form of a substitute specification** in compliance with 37 CFR 1.121(b)(3) and 37 CFR 1.125. Such an amendment to the specification **cannot** be made by way of replacement paragraph or replacement section under 37 CFR 1.121(b)(1) or (b)(2). The only format for an amendment to

the specification useable for pre-grant publication purposes is a substitute specification. See MPEP Section 714.01(e).

IV. Contact Information

Questions regarding a pre-exam notice received in an application filed under 35 U.S.C. § 111 should be directed to the Application Assistance Unit at (571) 272-4000. Questions regarding a pre-examination notice received in a national stage application under 35 U.S.C. § 371 should be directed to the person listed on the notice or, alternatively, the PCT Help Desk at (571) 272-4300.

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Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office