PTO/SB/26aJRA (09-26)
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TERMINAL DISCLAIMER (WITH JOINT RESEARCH AGREEMENT ENFORCEMENT PROVISION) IN A PATENT OR PROCEEDING IN VIEW OF A REFERENCE PATENT

Application/Control Number:	Filing Date:	Patent Number:
First Named Inventor:	Docket Number (Optional):	
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 patentee,

_____

_____,

owner of _____ percent interest in the instant patent hereby disclaims, except as provided below, the terminal part of the statutory term of the instant patent 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 patentee waives the right to separately enforce the instant patent and the reference patent. The patentee agrees that the instant patent shall be enforceable only for and during such period that the instant patent and the reference patent are not separately enforced. The waiver and this agreement run with the instant patent and are binding upon the patentee, its successors, or assigns.

In making the above disclaimer, the patentee does not disclaim the terminal part of the statutory term of the instant patent 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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A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0031. Public burden for this form is estimated to average 15 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **If filing this completed form by mail, send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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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 patent 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 patent 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 patent 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 of 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 patent 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 patent

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 is required to amend the specification of an issued patent to name the parties to the JRA. 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 fee for this disclaimer is set forth in 37 CFR 1.20(d) and is being paid in the following manner:

- ☐ payment by the USPTO patent electronic filing system.
- ☐ the Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. _____.
- ☐ payment by credit card. Form PTO-2038 is attached.
- ☐ a check in the amount of the fee is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on form PTO-2038.

IV. Check either box 1, 2, or 3 below regarding ownership, if appropriate.

1. ☐ The current ownership was previously established by the filing of a statement under 37 CFR 3.73.
2. ☐ The instant patent was issued from an application filed on or after September 16, 2012, and the current patent owner was the applicant under 37 CFR 1.46.
3. ☐ A statement under 37 CFR 3.73 is attached herewith. Form PTO/SB/96 or PTO/AIA/96, as appropriate, may be used.

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

1. ☐ The undersigned is the patentee or is authorized to act on behalf of the patentee (e.g., where the patentee 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.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013), www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf.

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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.