



## MEMORANDUM

DATE: February 12, 2004

TO: Charles A. Pearson  
Director, Office of Petitions

and

Technology Center SPREs  
**Stephen G. Kunin**

FROM: Stephen G. Kunin  
Deputy Commissioner for  
Patent Examination Policy

SUBJECT: **Clarification of Terminal Disclaimer Practice In Addressing Untimely Petitions to Withdraw the Holding of Abandonment Under MPEP 711.03(c)**

MPEP 711.03(c) provides that any petition to withdraw the holding of abandonment that is not filed within two months of the mail date of a notice of abandonment is not timely filed as required by 37 CFR 1.181(f), and that the Office **may** require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment. This memorandum clarifies the conditions under which a terminal disclaimer may be required under this provision of MPEP 711.03(c).

This memorandum applies to any untimely petition to withdraw a holding of abandonment (*e.g.*, whether based upon non-receipt of an Office action, or loss or non-receipt of an applicant's reply by the Office). This memorandum, however, does not apply to petitions under 37 CFR 1.137 to revive an abandoned application.

### **Design Applications, Utility Applications Filed Before June 8, 1995, And Plant Applications Filed Before June 8, 1995**

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, a terminal disclaimer **should** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. The period to be disclaimed in this situation is the terminal part of the term of any patent granted on the application 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* MPEP 711.03(c). 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). *See id.* Form PTO/SB/62 is the appropriate terminal disclaimer to be used in this situation.

### **Utility and Plant Applications Filed On Or After June 8, 1995 But Before May 29, 2000**

In utility and plant applications filed on or after June 8, 1995, but before May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. However, the Office of Patent Legal Administration (OPLA) must be consulted in such situations if the holding of abandonment involves a period during: (1) appellate review by the Board of Patent Appeals and Interferences; (2) an interference proceeding under 35 U.S.C. § 135(a), including any suspension due to an interference proceeding; or (3) which the application was in a sealed condition or prosecution was suspended due to a secrecy order under 35 U.S.C. § 181. Specifically, in such a situation, contact either Kery Fries (703-308-0687) or Mark Polutta (703-308-8122), Legal Advisors, Office of Patent Legal Administration. This is because it is necessary to effect (if appropriate) a reduction of patent term extension under the “due diligence” provisions of 37 CFR 1.701(d)(2).

### **Utility and Plant Applications Filed On Or After May 29, 2000**

In utility and plant applications filed on or after May 29, 2000, a terminal disclaimer should **not** be required as a condition of granting an untimely petition to withdraw the holding of abandonment. This is because any patent term adjustment is automatically reduced under the provisions of 37 CFR 1.704(c)(4) in applications subject to the patent term adjustment provisions of the American Inventors Protection Act of 1999 if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment.