



UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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MEMORANDUM - II

DATE: February 15, 2002

TO: Patent Examining Corps Directors
Stephen G. Kunin

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

SUBJECT: Treatment of (1) Replies filed by *Pro Se* Applicants without the Benefit of 37 CFR 1.8 or 1.10 and (2) After-Final Amendments that are Untimely due to Incoming Mail Delays

This memorandum sets forth the procedures for treating issues relating to delays in delivery of correspondence coming into the Office, including:

- I. Special procedures for *pro se* applicants who filed a reply (without a certificate of mailing or by "Express Mail" per 37 CFR 1.8 and 1.10, respectively) that should have been received between October 13, 2001 and January 2, 2002 but it was not timely due to USPS mail delays, including:
 - A. If the maximum extendable period for reply has not expired, remailing of an Office action (or notice) with a restarting of the time period for reply;
 - B. If the maximum extendable period for reply has expired, a streamlined procedure to revive an abandoned application on the grounds that the failure to reply was unavoidable under 37 CFR 1.137(a).
- II. Treatment of after-final replies that are untimely received due to the incoming USPS mail delays.

This memorandum also includes the following attachments:

- I. Template Notice of Untimely Reply and Remailing of Office Action
- II. Template Notice of Untimely Reply and Instructions to File a Petition to Revive
- III. Template Petition for Revival of an Application Abandoned Unavoidably under 37 CFR 1.137(a) Filed by a *Pro Se* Applicant(s)

I. Special Procedure for *Pro Se* Applicants

A. *Pro se Applicant's Reply Received within Maximum Extendable Period for Reply*

A reply cannot be treated as timely filed if it was received by the Office after expiration of a shortened statutory time period and was not accompanied by a certificate of mailing. In this situation, however, the Office may remail an Office action to restart the time period but only if the remailing occurs before expiration of the maximum extendable period for reply. For applicants prosecuting an application without assistance of a registered practitioner (i.e., *pro se* applicants), the Office will remail an Office action (and start a new period for reply) if the requirements set forth below are met.¹ The Group Director or his/her designee will make the determination of remailing an Office action.

Requirements for remailing an Office action to a pro se applicant where a reply is not timely received

1. Applicant(s) is not represented by a registered practitioner;
2. The reply was received late due to the mail delay between October 13, 2001 and January 2, 2002. For example, the date on the signature block of the reply is between October 6, 2001 and December 26, 2001;
3. The reply would have been timely received if the delivery was not delayed; and
 - a. The date on the signature block of the reply is more than one week prior to the expiration of the relevant period for reply set in the last Office action reply (i.e., the period for reply set in the last Office action or, if a petition for an extension of time and extension of time fee were filed, as extended by the petition for an extension of time). For example, if the 3-month period for reply to a non-final Office action ended on November 7, 2001, the date on the signature block of the reply is prior to November 1, 2001.
 - b. Acceptable alternative: Applicant submits a signed statement that the reply was mailed to the Office more than one week prior to the expiration of the relevant period for reply.
4. The remailing must occur prior to the expiration of the maximum extendable time period for reply to the last Office action.
 - a. Maximum extendable period for reply:
 - i. Rejection – six (6) months (the three month shortened statutory period set in the Office action plus a three month extension of time);

¹ The Office will remail an Office action whenever a *pro se*'s response meets the requirements of this memorandum. No petition will be required. If applicant does file a request to remail an Office action, the request will be treated as a petition under 37 CFR 1.181.

- ii. Restriction requirement and Notice of Noncompliance (37 CFR 1.121) - six (6) months (the one month shortened statutory period plus a five month extension of time);
 - iii. Notice to File Missing Parts, Notice of Omitted Items, and Notice to File Corrected Application Papers - seven (7) months (the two month period for reply plus a five month extension of time); and
 - iv. Notice of Allowance - three (3) months (an extension of time is not available).
- b. If the remailing cannot occur before the expiration of the maximum extendable period for reply, see section B.

The reply must be at least a *bona fide* attempt to provide a complete reply (i.e., substantially responsive to the rejections, objections, or requirements in the Office action). If the Office action is a final rejection, the Office will not remail the final rejection unless the reply is: (1) an after-final amendment placing the application in condition for allowance, or (2) a notice of appeal. An untimely reply will be treated in accordance with MPEP 714.17 if the Office is not remailing the prior Office action.

Once the Group Director, or his/her designee, decides to remail an Office action, the Office will mail to the *pro se* applicant the following: (1) the Notice of Untimely Reply and Remailing of Office Action (a template notice is provided in Attachment I), (2) a copy of the prior Office action (or notice), and (3) a form SB-92 to encourage applicant to file any subsequent correspondence with a certificate of mailing or transmission per 37 CFR 1.8. The untimely reply will be placed in the application file wrapper, but will not be formally entered, unless applicant, in response to the remailed Office action, requests that the previously unentered reply be entered and considered.

Procedure for processing the remailing an Office action

1. If a request for the Office action to be remailed has been filed, it should be entered as a petition under 37 CFR 1.181 using PALM code 699.
2. A notice should be prepared by the Group Director, or his/her designee, to notify applicant of whether the request has been granted. See Attachment I.
3. The notice of remailing should be entered in PALM as a decision using PALM code 699 if a request has been filed.
4. The prior action should be copied and entered into the file and PALM as a new Office action setting the same time period as the last Office action with a new mail date using PALM code 1568.
5. The notice and a copy of the prior Office action must be mailed to applicant, and the Technology Center should fax a courtesy copy to the applicant if possible.

The period for reply will be restarted on the new mail date of the Office action. When remailing an Office action (or notice), the Technology Centers **will not** change the mail date of the original Office action (or notice). Instead, the Technology Centers will follow the procedure above.

Untimely replies filed by applicants that are represented by a registered practitioner

An Office action should not be remailed if the untimely reply is filed by an applicant represented by a registered practitioner because the registered practitioner should have filed the reply in accordance with 37 CFR 1.8 or 1.10, and therefore the mail delay would not have caused the reply to be untimely. The untimely reply will be treated in accordance with MPEP 714.17. If the reply is filed without the appropriate petition for extension of time and fee pursuant to 37 CFR 1.136(a), the reply will be endorsed on the application file wrapper, but not formally entered. The technical support staff will immediately notify the applicant, by telephone and letter, that the reply was not filed within the set time period and therefore cannot be entered and that the application will be abandoned unless the appropriate petition for extension of time and fee are timely filed.

B. No Remailing of an Office Action After Expiration of the Maximum Extendable Period for Reply

Where remailing of an Office action is not possible because the maximum extendable period for reply has expired, the application should be held to be abandoned. The Office will, however, provide a streamlined procedure to assist *pro se* applicants to revive an abandoned application on the grounds that the failure to reply was unavoidable under 37 CFR 1.137(a) if the following requirements are met:

1. Applicant(s) is not represented by a registered practitioner;
2. The reply was received late due to the USPS mail delay between October 13, 2001 and January 2, 2002. For example, the date on the signature block of the reply is between October 6, 2001 and December 26, 2001;
3. The reply would have been timely received if the delivery was not delayed; and

The date on the signature block of the reply is more than one week prior to the expiration of the shortened statutory period set in the prior Office action. For example, if the 3-month period for reply to a non-final Office action ended on November 7, 2001, the date on the signature block of the reply is prior to November 1, 2001.

The reply must be at least a *bona fide* attempt to provide a complete reply (i.e., substantially responsive to the rejections, objections, or requirements in the prior Office action). If the prior Office action is a final rejection, the Office will not provide the streamlined procedure for reviving the application unless the after-final amendment places the application in condition for allowance.

If all of the requirements above are met, the Office will mail to the *pro se* applicant the following: (1) a Notice of Untimely Reply and Instructions for Filing a Petition to Revive an Abandoned Application for *Pro Se* Applicants (provided in Attachment II), (2) the form for filing a Petition for Revival under 37 CFR 1.137(a) (provided in Attachment III), (3) a notice of abandonment, if it has not been mailed, and (4) a form SB-92 to encourage applicant to file any subsequent correspondence with a certificate of mailing or transmission.

If the requirements are not met, the Office will process the abandonment of the application and mail a notice of abandonment. Applicant may revive the application in compliance with 37 CFR 1.137 as provided in MPEP 711.03(c). The streamlined procedure set forth above does not apply to applicants who are represented by patent practitioners. Patent practitioners who do not follow the procedures of a reasonably prudent person have a remedy in 37 CFR 1.137(b). See Krahn v. Commissioner, 15 USPQ2d 1823 (E.D. Va. 1990) and MPEP 711.03(c), page 700-150.

II. Treatment of after-final amendments that are untimely received due to the incoming mail delays

Many after-final amendments are not processed within the statutory period for reply because of USPS delays in the delivery of the amendments to the Office. Furthermore, some of the amendments are not considered by the examiners until after the expiration of the statutory period and applicants are not notified in time to avoid unnecessary appeals, filings of requests for continued examination (RCE), or abandonment of the application. Accordingly, applicants are encouraged to fax all after-final amendments to the appropriate technology center to avoid any mail delays.

After-final amendment received prior to the expiration of the statutory period (the six month maximum extendable period for reply)

Examiners should expeditiously consider after-final amendments and notify the applicants of the status of the application by calling and/or faxing a courtesy copy of any Office communications including: the advisory action, notice of allowability, and examiner's amendment, to the applicant or attorney/agent of record.

If the after-final amendment is received by the Office after two months from the mail date of the final Office action, the applicant will not get the benefit of a longer shortened statutory period (i.e., shortened statutory period will be considered to have expired on the date the Office mails the advisory action) even if the date on the certificate of mailing is within the two month period and the advisory action is not mailed until after the end of the three-month shortened statutory period. For the purposes of determining the amount of extension fee for any subsequent filings of after-final correspondence (e.g., an RCE or a notice of appeal), the last date of the three-month shortened statutory period set in the final Office action will be used.

After-final amendment received after the expiration of the maximum extendable period for reply

The Office will enter an after-final amendment that has been received after the expiration of the maximum extendable period for reply if: (1) such amendment places the application in condition for allowance, (2) the date on the certificate of mailing is within the shortened statutory period, or, if an extension of time was filed, within the extended period for reply, and (3) the amendment is filed with the appropriate petition for extension of time and fee. If an after-final amendment will place the application in condition for allowance except for the correction of formal matters which had not yet been required by the examiner, the Office will also enter such amendment filed within the maximum extendable period and the appropriate petition for extension of time and fee, and issue an *Ex parte Quayle* action. See MPEP 706.07(f). Otherwise, if the amendment does not

place the application in condition for allowance, the Office will process the abandonment of the application and mail a notice of abandonment to the applicant. Any after-final amendment that does not place the application in condition for allowance will not be entered. An examiner's amendment may not be made after expiration of the statutory period. See MPEP 706.07(f).

The Office will consider and enter any information disclosure statement (IDS) that has been received after the expiration of the statutory period if: (1) the IDS is filed in compliance with 37 CFR 1.97 and 1.98, and (2) the date on the certificate of mailing is within the statutory period. Similarly, a notice of appeal filed with the appeal fee, and an RCE filed with a submission and the requisite fee will be entered if (1) the date on the certificate of mailing is within the statutory period; and (2) an appropriate petition for extension of time and fee are enclosed.

Further Information or Assistance: Inquiries concerning this memorandum should be directed to the Office of Patent Legal Administration at (703) 308-6906 or e-mailed to Patent Practice.

Attachments:

- I. Template Notice of Untimely Reply and Remailing of an Office Action
- II. Template Notice of Untimely Reply and Instructions to File a Petition to Revive an Abandoned Application For *Pro Se* Applicants
- III. Template Petition for Revival of an Application Abandoned Unavoidably under 37 CFR 1.137(a) Filed by a *Pro Se* Applicant(s)

Note: when using a template decision for an application, please delete the attachment heading on the top.