



UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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MEMORANDUM - I

DATE: February 15, 2002

TO: Patent Examining Corps Directors
Stephen G. Kunin

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

SUBJECT: **Resetting Period for Reply and Remailing Office Communications
when Outgoing Office Mail is Delayed**

This memorandum addresses Office relief procedures for mail delays involving outgoing Office correspondence mailed on or after October 13, 2001 and before January 2, 2002, including:

- (A) Petitions to reset a time period set in an Office action (or notice) where delivery to applicant(s) has been delayed; and
- (B) Requests to reemail an Office action (or notice) that has been mailed by the Office but not yet received by applicant(s).

The memorandum also includes four attachments:

- I: Template Decision for Granting Petition to Reset Period for Reply
- II: Template Decision for Granting Petition to Remail an Office action and Restart Period for Reply
- III: Template Decision for Granting Petition to Withdraw Holding of Abandonment
- IV: PALM Procedures for Resetting and Restarting Reply Period

In view of the recent delays in the USPS delivery of mail from the Office to applicants, many applicants are requesting the Office to reset the time period for reply so that the starting date is changed from the Office mail date to the date of actual receipt of the Office action (or notice). Many applicants are also requesting the Office to reemail actions (or notices) that they have not yet received even though the applicants know that they were mailed by the Office two or more weeks previously. These issues will be addressed in this memo. Memorandum II addresses 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.

I. Procedures to reset a time period for reply so that it starts on the date that applicant(s) actually received the Office action (or notice) instead of the Office’s mail date.

The Office’s procedure for treating a petition to reset a time period set in an action (or notice) because delivery of the action (or notice) has been delayed by the USPS is set forth in MPEP 710.06. These procedures were established to: (a) provide a complete public record of why a time period was reset; (b) insist on the prompt submission of such petitions; and (c) make it clear that applicant(s) should set forth adequate justification for requesting the resetting of the time period for reply, to avoid frivolous requests.

As the Office is aware that USPS delivery of correspondence to certain locations (e.g., the District of Columbia) has been delayed, **the evidence** to establish late receipt of an Office action (or notice) ordinarily required in MPEP 710.06 **need not be insisted upon** for the circumstances noted in this memorandum. For Office actions (or notices) that were mailed between October 13, 2001 and January 2, 2002, the Office should grant a petition to reset a time period for reply if the following requirements are met:

- A) **Separate Petition:** In order to provide a complete file history, a separate petition must be filed for each application for which a reset time period is requested;
- B) **Timeliness:** A written petition must be filed within two weeks of actual receipt of the action/notice;
- C) **Significant Delay:** More than a month of a two or three month time period set for reply must have elapsed, or more than two weeks of a month/30 day time period set for reply must have elapsed (e.g., a written restriction, or a notice of non-compliant amendment);
- D) **Evidence:** In general, because of the recent problem of USPS mail delays, the requisite evidence is considered met by the statement in (E) below;
- E) **Statement:** There must be a clear statement that the action/notice was received on the date indicated, and a request that the period for reply be reset as of the date of receipt; and
- F) **Signature:** The petition must be signed by applicant(s) or a registered practitioner.

See Attachment I for a template decision granting a petition to reset period for reply. A request to reset a time period for reply will be treated as a petition filed under 37 CFR 1.181 to reset a time period for reply. A petition fee is not required for a petition filed under 37 CFR 1.181. Each petition will be given a paper number, and entered into the file wrapper. In response to a proper petition by applicant(s), the Office must notify applicant(s) that the petition was granted and that the time period has been reset to begin on the receipt date specified by applicant(s). The original Office action (or notice) need not be mailed again. If the petition is not grantable because the requirements noted above are not met, the petition should be dismissed. The Office will notify applicant that the petition is dismissed and cite the reasons why. The notification/dismissal will be given a paper number and made of record in the application file.

The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address.

Advisory Actions: A petition to reset a time period for reply because an advisory action was delayed in delivery or mailed late because of the delay in delivery of the after final amendment should not be granted. See MPEP 714.13. In the circumstance where the advisory action relates to an after-final reply filed within two months of the final rejection and receipt of the advisory action was delayed, please contact an advisor in the Office of Patent Legal Administration at (703) 308-6906.

PALM Processing Procedures

When resetting the period for reply to an Office action, the Technology Centers **will not** change the date of mailing of the Office action. Instead, the Technology Centers will follow the procedure in Attachment IV, section I.

II. Procedures to re-mail, or fax, an Office action (or notice) that was previously mailed by the Office but has not yet been received by applicant(s).

Many applicants, aware of the delay in delivery of Office communications to certain locations, are checking on their pending applications via private PAIR, or otherwise, to see if an Office action (or notice) has been sent out. If an Office action has been mailed, and applicants have not yet received it, they are now requesting that the Office re-mail it or send them a facsimile copy of the communication. Before complying with the request, however, it is important to determine if applicant(s) (an inventor(s) or an attorney or agent of record) is requesting:

- (A) a courtesy copy of the Office communication (see subsection A below); or
- (B) a re-mailing of the Office communication with a restarting of the period for reply (see subsections B and C below).

A. If Courtesy Copy is Requested

If applicant does not request that the Office action be re-mailed (or the period for reply be reset) and instead requests a courtesy copy, it is appropriate to send a facsimile copy of the Office communication to a facsimile number specified by an applicant(s) or by an attorney or agent of record. If someone other than an applicant(s) or an attorney or agent of record calls requesting a courtesy copy, the Office should offer to send a courtesy copy to the applicant(s) or the attorney or agent of record at a facsimile number specified in a paper in the application file wrapper signed by the applicant(s) or an attorney or agent of record. If there is no such fax number specified in the file wrapper, the applicant(s) or the attorney or agent of record should fax in a signed request for a duplicate paper, and the request should be entered into the application file wrapper. An interview summary should also be mailed to document when the courtesy copy was faxed.

B. If Remailing with Restarting of Reply Period is Requested Within the Maximum Extendable Period for Reply

If applicant(s) requests that the Office action (or notice) be remailed with a new time period and either the original period for reply has not expired or an extension of time is still available, the request will be treated as a petition under 37 CFR 1.181. The petition should be decided by the Office that mailed the Office action (or notice). The petition should be granted if the following requirements are met:

A) **Statement:** There must be a clear statement that the Office communication was not received;

B) **Evidence:**

- i. A copy of the docket record where the non-received Office action (or notice) would have been entered had it been received and docketed is ordinarily required to be attached and referenced in practitioner's statement.
- ii. Acceptable alternative: If a practitioner states that a significant amount of correspondence mailed by the Office between October 13, 2001 and January 2, 2002 has not been received, and provides the requisite statement in (A) above, then the evidence set forth in (B)(i) above would not be needed.
- iii. Alternative for Pro se applicant(s): If a *pro se* applicant(s) states that the Office action (or notice) has not been received at the correspondence address of record, and the Office action (or notice) was mailed by Office between October 13, 2001 and January 2, 2002, then the evidence set forth in (B)(i) above would not be needed.

C) **Signature:** The petition must be signed by applicant(s) or a registered practitioner.

A separate petition must be filed for each application for which remailing of the action (or notice) and a restarted time period are requested. Each petition will be entered into the file wrapper as well as a decision notifying applicant(s) of the action by the Office. See Attachment II for a template decision granting petition to remail an Office action with a new period for reply. The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address. When an Office action is remailed, the entire Office action must be remailed. For example, when a Notice of Allowance is remailed, a copy of the notice of allowability and attachments including interview summary form and examiner's amendment must also be remailed with the notice of allowance.

When remailing an Office action (or notice), the Technology Centers **will not** change the date of mailing of the original Office action (or notice). Instead, the Technology Centers will follow the procedure in Attachment IV, section II. A courtesy copy of the Office action (or notice) may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record.

Advisory Actions: A petition for remailing of an advisory action with restarting of a reply should be dismissed because the period for reply is set forth in the final Office action, and not in the advisory action. The delay in receipt of an advisory action does not necessitate the restarting

of the reply period set in the final Office action. A courtesy copy of the advisory action may be provided. In the circumstance where the advisory action relates to an after-final reply filed within two months of the final rejection and receipt of the advisory action was delayed, please contact an advisor in the Office of Patent Legal Administration at (703) 308-6906.

C. If Remailing with Restarting of Reply Period is Requested, and the Maximum Extendable Period for Reply has Expired (i.e., the application is abandoned):

If the maximum extendable period for reply has expired and a reply was not timely filed, the application is abandoned. The request for remailing and restarting of the reply period will be treated as a petition to withdraw the holding of abandonment because the Office communication was not received by the applicant. If the holding of abandonment is reflected in the record by a Notice of Abandonment, then the request should be treated by the Office that mailed the Notice of Abandonment. Otherwise, if a Notice of Abandonment has not been mailed, the Office that mailed the correspondence (e.g., the Notice of Allowance) should treat the request. The applicant(s) may, alternatively, file a petition to withdraw the holding of abandonment as provided in MPEP 711.03(c)(II), subsection (II), page 700-140, left-hand column (August 2001). If the Office correspondence, that applicant(s) has not received which led to abandonment, was mailed between October 13, 2001 and January 2, 2002, then applicant(s) should submit a clear statement that the Office communication was not received, and may submit a statement as set forth in (B)ii or (B)iii of section II B above, instead of filing the required evidence. Thus, in such situation, the applicant(s) will not be required to file a copy of the docket record or a copy of any other evidence where the correspondence would have been recorded. For example: if a *pro se* applicant(s) states that the Office action (or notice) has not been received at the correspondence address of record, and the Office action (or notice) was mailed by Office between October 13, 2001 and January 2, 2002, further the evidence would not be needed and such statement made by a *pro se* applicant is sufficient. See Attachment III for a template decision granting a petition to withdraw holding of abandonment. The decision may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record, but it must also be mailed to the correspondence address.

When remailing an Office action (or notice) after granting such a petition to withdraw the holding of abandonment, the Technology Centers **will not** change the date of mailing of the original Office action (or notice). Instead, the Technology Centers will follow the procedure in Attachment IV, section III. A courtesy copy of the Office action (or notice) may be faxed to a facsimile number specified by the applicant(s) or attorney/agent of record.

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

Attachments:

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