

Change in Procedure for Handling Nonprovisional Applications Having Omitted Items

Summary:

The U.S. Patent and Trademark Office (Office) is revising its procedure for handling nonprovisional applications having omitted items (*e.g.*, missing pages or figures or missing or unreadable compact discs). Under the revised procedure, applicants must reply to a notice regarding omitted items in a nonprovisional application within the time period set by the notice in order to avoid abandonment. This time period is extendable under 37 CFR 1.136. Applicants will continue to have the following three options: (1) petition for the date of deposit by filing a petition under 37 CFR 1.53(e), asserting that the omitted item was in fact deposited in the Office, along with evidence of such deposit (*e.g.*, a date-stamped itemized postcard receipt) and the petition fee; (2) petition for a later filing date by filing the omitted item, along with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such item, a petition under 37 CFR 1.182 and the petition fee requesting the date of such submission as the application filing date; and (3) accept the application as deposited and filing an appropriate amendment to the application (*e.g.*, a substitute specification). Under the revised procedure, applicants who wish to accept the nonprovisional application as deposited (the third option) will be required to file an appropriate amendment (*e.g.*, a substitute specification) within the extendable time period to avoid abandonment of the application. Applicants will no longer be able to accept the nonprovisional application as deposited by failing to file a reply to the notice within the set time period.

Because the amendment correcting the application is not required by any particular time under the former procedure, the Office often receives such amendments after the application has been published and examination of the application has begun. Requiring correction in reply to a notice regarding omitted items will ensure that the nonprovisional application is complete and ready for examination before the application is forwarded to the Technology Center, and thus, the examination will be more efficient and effective. Any issues related to any omitted items will be resolved before the application is taken up for action, rather than after an Office action on the merits. This change will also improve the quality of the patent application publications and the efficiency of the publication process. The Office is not changing its procedure for handling provisional applications having omitted items.

Background:

Upon receiving a nonprovisional application filed under 35 U.S.C. 111(a), the Office of Initial Patent Examination (OIPE) reviews application papers to determine whether the application is complete. If the application is filed (1) without all of the pages of the specification, (2) without all of the drawing figures referred to in the specification, or (3) with missing or unreadable compact discs or a missing or unreadable file on a compact disc (and the duplicate copy), but is otherwise entitled to a filing date, OIPE will mail a notice (*e.g.*, a "Notice of Omitted Item(s) in a Nonprovisional Application") indicating that the application papers have been accorded a filing

date, but are lacking some page(s) of the specification or some of the figures of drawings described in the specification, or the compact discs are missing or unreadable or contain a missing or unreadable file.

Under the previous procedure, the OIPE notice provided applicant with three options: (1) petition for the date of deposit by filing a petition under 37 CFR 1.53(e), asserting that the omitted item was in fact deposited in the Office, along with evidence of such deposit and the petition fee; (2) petition for a later filing date by filing the omitted item, along with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such item, a petition under 37 CFR 1.182 and the petition fee requesting the date of such submission as the application filing date; and (3) accept the application as deposited. The notice also indicated that if applicant fails to file a petition pursuant to the first two options, the option of accepting the application as deposited is constructively elected. Even though applicant was required to file an amendment to correct the application when the option of accepting the application as deposited is constructively elected, no time period was set in which applicant had to submit such an amendment. Many times, the amendment for correcting the application was received by the Office after the publication process or the examination had been started.

Revised Procedure:

Under the revised procedure, applicants must reply to the OIPE notice within the time period set by the notice. This time period is extendable under 37 CFR 1.136. Applicants will continue to have the first two options (a petition for the date of deposit and a petition for a later filing date), but applicants who wish to accept the application as deposited will be required to file an appropriate amendment (*e.g.*, a substitute specification) within the time period to avoid abandonment of the application. Applicants will no longer have the option to accept the application as deposited by failing to file a reply to the OIPE notice within the set time period.

The OIPE notice will set forth the following options:

- (1) Petition for the date of deposit by filing a petition under 37 CFR 1.53(e), asserting that the omitted item was in fact deposited in the Office, along with evidence of such deposit (*e.g.*, a date-stamped itemized postcard receipt) and the petition fee;
- (2) Petition for a later filing date by filing the omitted item, along with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such item, a petition under 37 CFR 1.182 and the petition fee, requesting the date of such submission as the application filing date; or
- (3) Accept the application as deposited by filing an appropriate amendment (*e.g.*, a substitute specification).

This change in procedure is applicable to any application in which an OIPE notice addressing omitted items is issued which requires the applicant to reply by exercising one of the above three options.

Appropriate Amendment Including Substitute Specification:

If applicant wants to accept the application as deposited (without adding the subject matter that was in the omitted item), applicant is required to submit one or more of the following items without adding any new matter (see 35 U.S.C. 132(a)):

- (A) For a missing page of the specification, a substitute specification (including claims) that amends the specification to renumber the pages consecutively and cancels any incomplete sentences, in compliance with 37 CFR 1.121(b)(3) and 1.125;
- (B) For a missing figure of the drawings, replacement drawing sheets in compliance with 37 CFR 1.121(d) to renumber the drawing figures consecutively (if necessary), a substitute specification (excluding claims) that amends the specification to cancel any references to any omitted drawing(s) and corrects the references in the specification to the drawing figures to correspond with any relabeled drawing figures, in compliance with 37 CFR 1.121(b)(3) and 1.125;
- (C) For a missing page of the claim listing only, a replacement claim listing with the claims renumbered consecutively or, if amendment to the claims is also necessary, then a complete claim listing in compliance with 37 CFR 1.121(c);
- (D) For a missing or unreadable compact disc, a substitute specification (excluding the claims) deleting the reference to the compact disc and the files contained on the compact disc, in compliance with 37 CFR 1.121(b)(3) and 1.125; and
- (E) For a missing or unreadable file submitted on a compact disc, (a) a substitute specification (excluding the claims) deleting the reference to the missing or unreadable file, in compliance with 37 CFR 1.121(b)(3) and 1.125; and (b) a replacement transmittal letter listing all of the files, except the missing or unreadable file, in compliance with 37 CFR 1.52(e)(3)(ii).

Alternatively, if applicant wants to accept the application as deposited but wishes to add the subject matter in the omitted item by relying on an incorporation by reference under 37 CFR 1.57 or other portions of the original disclosure, applicant is required to submit one or more of the following items without adding any new matter (see 35 U.S.C. 132(a)):

- (A) For a missing page of the specification, a substitute specification (excluding claims) in compliance with 37 CFR 1.121(b)(3) and 1.125;
- (B) For a missing figure of the drawings, new and replacement drawing sheets in compliance with 37 CFR 1.121(d) to add the missing figure;

- (C) For a missing page of the claim listing, a complete claim listing in compliance with 37 CFR 1.121(c);
- (D) For a missing or unreadable compact disc, (a) a replacement compact disc and a duplicate copy of the compact disc, in compliance with 37 CFR 1.52(e); and (b) a statement that the replacement compact disc contains no new matter in compliance with 37 CFR 1.52(e)(4); and
- (E) For a missing or unreadable file submitted on a compact disc, (a) a replacement compact disc that contains all of the files listed in the specification including the missing or unreadable file and a duplicate copy of the compact disc, in compliance with 37 CFR 1.52(e); and (b) a statement that the replacement compact disc contains no new matter in compliance with 37 CFR 1.52(e)(4).

If applicant is relying on an incorporation by reference under 37 CFR 1.57 to add the omitted subject matter, then applicant must also comply with the requirements of 37 CFR 1.57.

In addition, since the Office is now requiring a reply to a Notice of Omitted Item(s) in a Nonprovisional Application, such a notice is now considered a notice or action by the Office making a rejection, objection, argument, or other request within the meaning of 35 U.S.C. 154(b)(2)(C)(ii) or 37 CFR 1.704(b). Therefore, if applicant fails to reply to such a notice within three months of the mailing date of the notice, applicant would be subject to a reduction of patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). As discussed previously, applicant must reply within the time period set in such notice (including any extensions under 37 CFR 1.136) to avoid abandonment of the application.

In order to ensure better quality of patent application publications and improve efficiency in the publication process, OIPE will also continue to require applicant to submit an appropriate amendment (e.g., substitute specification) if the application contains incomplete or illegible text or does not contain an abstract, by mailing other notices, such as a Notice to File Corrected Application Papers.

Appropriate sections of the *Manual of Patent Examining Procedure* (e.g., §§ 201.06(c), 201.17, 601.01(d) and 601.01(g)) will be revised accordingly in due course.

Questions regarding this notice may be directed to Eugenia Jones (by phone (571) 272-7727) or Joni Chang (by phone (571) 272-7720), Senior Legal Advisors, Office of Patent Legal Administration, or e-mailed to PatentPractice@uspto.gov.

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Patent Examination Policy