

## Untimely Filing of Petitions under 37 CFR 1.181(a) to Withdraw Holdings of Abandonment

**Summary:** The United States Patent and Trademark Office (USPTO) receives petitions under 37 CFR 1.181(a) to withdraw holdings of abandonment (based on non-receipt of an Office action, or upon non-receipt or loss of a reply by the applicant). Some of these petitions are filed years after the application is held abandoned, causing extensive prosecution delays. To prevent these delays from inappropriately extending the term of any patent issued from the application, the USPTO is clarifying its position concerning the treatment of petitions to withdraw holdings of abandonment that are not timely filed because the applicant failed to exercise reasonable diligence in monitoring the status of the application. The USPTO strongly encourages practitioners and applicants to use the USPTO's Patent Application Information and Retrieval (PAIR) system (private side) to monitor the status of the patent applications that they are prosecuting.

The Manual of Patent Examining Procedure (MPEP) will be revised for consistency with this notice in due course.

### **Treatment of Untimely Petitions to Withdraw Holding of Abandonment:**

#### ***Utility and Plant Applications Filed on or after May 29, 2000***

The term of a patent issuing from a utility or plant application filed on or after June 8, 1995 ends on the date that is twenty years from the filing date of the application, or the earliest filing date for which a benefit is claimed under 35 U.S.C. § 120, 121, or 365(c). Utility and plant applications filed on or after May 29, 2000, however, are eligible for patent term adjustment under the American Inventors Protection Act of 1999 (AIPA). Therefore, if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, any patent term adjustment will be reduced under the provisions of 37 CFR 1.704(c)(4). If applicant does not receive the notice of abandonment, any patent term adjustment may be reduced under the provisions of 37 CFR 1.704(a) by a period equal to the period of time during which the applicant "failed to engage in reasonable efforts to conclude prosecution" (processing or examination) of the application, in which case any period of adjustment shall be reduced by the number of days, if any, beginning on the day after the date that is twelve months from the date of applicant's filing or submission of correspondence with the USPTO for which further action by the USPTO can reasonably be expected and ending on the filing date of a grantable petition to withdraw the holding of abandonment.

#### ***Utility and Plant Applications Filed on or after June 8, 1995 but before May 29, 2000***

As discussed above, the term of a patent issuing from a utility or plant application filed on or after June 8, 1995 ends on the date that is twenty years from the filing date of the application, or the earliest filing date for which a benefit is claimed under 35 U.S.C.

§ 120, 121, or 365(c). Utility and plant applications filed on or after June 8, 1995, but before May 29, 2000, however, are eligible for patent term extension under the Uruguay Round Agreements Act (URAA). The URAA provides for patent term extension only if issuance of the patent was delayed due to: (1) an interference proceeding; (2) imposition of a secrecy order; or (3) successful appellate review. See 35 U.S.C. § 154(b) (1994). Unless an application is held abandoned during one of these three periods, the untimely filing of a petition to withdraw a holding of abandonment will not operate to extend the term of the patent because the USPTO has no authority to grant patent term extension under the URAA for other administrative delays. If a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment during a period of appellate review, any patent term extension accrued under 37 CFR 1.701(a)(3) (extension due to successful appellate review) may be reduced under the “due diligence” provisions of 37 CFR 1.701(d)(2).

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

#### **(A) Applicant Receives Notice of Abandonment**

In any utility or plant application filed before June 8, 1995, and in any design application, if applicant receives a notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within two months of the mail date of the notice of abandonment will **not** (absent extraordinary circumstances) be treated on its merits **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted on the application, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. § 120, 121, or 365(c), equivalent to the period between:

- (1) the date that is two months after the mail date of the notice of abandonment; and
- (2) the filing date of a grantable petition to withdraw the holding of abandonment.

*See* MPEP 711.03(c). Form PTO/SB/62 is the appropriate terminal disclaimer to be used.

#### **(B) Applicant Does Not Receive Notice of Abandonment**

In any utility or plant application filed before June 8, 1995, and in any design application, if applicant never receives the notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within twelve months from the date of applicant’s filing (or date of submission, if the correspondence was never received by the USPTO) of correspondence with the USPTO for which further action by the USPTO can reasonably be expected, will **not** (absent extraordinary circumstances) be treated on its merits **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted thereon, or of any patent granted on any utility or plant

application that claims the benefit of the filing date of the application under 35 U.S.C. § 120, 121, or 365(c), equivalent to the period between:

- (1) the date that is twelve months from the date of applicant's filing or submission of correspondence with the USPTO, for which further action by the USPTO can reasonably be expected; and
- (2) the filing date of a grantable petition to withdraw the holding of abandonment.

Form PTO/SB/62 is again the appropriate terminal disclaimer to be used.

### ***Provisional Applications, Reissue Applications and Reexamination Proceedings***

Provisional patent applications are not provided for in this notice because these applications become abandoned within one year of filing. Reissue patent applications and reexamination proceedings not provided for in this notice because delays in filing a petition will not operate to extend the term of the patent.

### ***Petitions to Revive under 37 CFR 1.137 (a) and (b)***

A petition under 37 CFR 1.137 submitted in either a utility or a plant patent application filed before June 8, 1995, or submitted in a design application, is subject to the terminal disclaimer requirement of 37 CFR 1.137(d).

### **Proof of Non-Receipt of Office Action, or Proof of Filing or Submission of Reply, is Also Required**

If the petition is based upon non-receipt of an Office action, the petition must be accompanied by a convincing showing that establishes non-receipt of the action. *See* MPEP 711.03(c), subsection II. If the petition is based upon the timely filing (and subsequent loss) of a reply to the Office action, the petition must be accompanied by a convincing showing that establishes the timely filing of the reply. *See* MPEP 503. If the petition is based upon the timely submission under 37 CFR 1.8 or 1.10 of a reply to the Office action (which was not received or was lost by the USPTO), the petition must be accompanied by a convincing showing that establishes the timely submission of the reply under 37 CFR 1.8 or 1.10. *See* MPEP 512 and 513.

### **Private PAIR Should Be Used by Practitioners and Applicants to Monitor Status of Pending Applications**

To avoid a reduction of patent term extension or adjustment, or to avoid being required to file a terminal disclaimer, as a result of the untimely filing of a petition to withdraw a holding of abandonment, the USPTO strongly encourages practitioners and applicants to exercise due diligence in monitoring the status of the patent applications that they are prosecuting. MPEP 203.08 provides, in part, that:

Amended applications are expected to be taken up by the examiner and an action completed within two months of the date the examiner receives the application. Accordingly, a status inquiry is not in order after reply by the

attorney until 5 or 6 months have elapsed with no response from the Office.

Obviously, a status inquiry is in order once six months have elapsed with no response from the USPTO.

The USPTO makes the status of patent applications available within the private side of the PAIR system. Private PAIR (<http://www.pair.uspto.gov>) provides customers with direct secure access to their own patent application status information, as well as to general patent and patent application information that is publicly available. Private PAIR also permits access to the electronic images of all documents that are part of the official record of the patent application, and that are stored with the USPTO's Image File Wrapper (IFW). For example, after the USPTO mails a rejection (either final or non-final), or notice of allowance, the electronic image of the Office action would be viewable 24 hours a day, seven days a week via the USPTO's IFW system. Use of the automated system will reduce the effort needed to monitor the status of applications under examination. The USPTO strongly urges practitioners (and applicants not represented by a practitioner) who do not already have access to the USPTO's private PAIR, and the USPTO's IFW system, to do the following:

1. Obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate,
2. Obtain a USPTO customer number,
3. Associate all of their pending and new patent application filings with their customer number,
4. Install no-cost software (supplied by the USPTO) required to access the USPTO's Private PAIR, and
5. Make appropriate arrangements for Internet access.

The full instructions for obtaining a PKI digital certificate are available at the USPTO's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To obtain a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form.

A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

Since practitioners and *pro se* applicants can monitor the status of their applications using the USPTO's PAIR and IFW systems, the failure to receive a notice of abandonment (or any other USPTO notification) will not excuse an unreasonable delay in filing a petition to withdraw the holding of abandonment.

### **Who to Contact for Further Information**

Technical information on the operation of the USPTO's IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Questions concerning the operation of the USPTO's PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Legal inquiries relating to the terminal disclaimer requirement should be directed to Cynthia L. Nessler, Legal Advisor, Office of Patent Legal Administration, by telephone at (703) 305-0271, and by e-mail at [patentpractice@uspto.gov](mailto:patentpractice@uspto.gov).

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/s/  
Stephen G. Kunin  
Deputy Commissioner for  
Patent Examination Policy