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1001 Statutory Authority of Commissioner [R-43]

35 U.S.C. 3. Officers and employees. (a) There shall be in the Patent and Trademark Office a Commissioner of Patents and Trademarks, a Deputy Commissioner, two Assistant Commissioners and not more than fifteen examiners-in-chief. The Deputy Commissioner, or in the event of a vacancy in that office, the Assistant Commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The

Commissioner of Patents and Trademarks, the Deputy Commissioner, and the Assistant Commissioners shall be appointed by the President, by and with the advice and consent of the Senate. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

(b) The Secretary of Commerce may vest in himself the functions of the Patent and Trademark Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

(c) The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 17 of the General Schedule of the Classification Act of 1949, as amended.

35 U.S.C. 6. Duties of Commissioner. The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

1001.01 Modes of Exercising Authority [R-43]

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of orders, notices and memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants, and by the designation of particular cases which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present chapter deals with the latter two items.

Rule 181, paragraph (g), states "The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions under this rule, with the exception of petitions under rule 183."

1002 Petitions to the Commissioner

[R-43]

Rule 181. Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of an issue fee (rule 317).

(e) Oral hearings will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within two months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions under this rule, with the exception of petitions under rule 183.

Rule 182. Questions not specifically provided for. All cases not specifically provided for in these rules will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

Rule 183. Suspension of rules. In an extraordinary situation, when justice requires, any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

Rule 184. Reconsideration of cases decided by former Commissioners. Cases which have been decided by one Commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

Petitions on appealable matters ordinarily are not entertained. See § 1201.

The mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings (rule 181(f)). For example, if a petition to vacate a final rejection as premature is filed within two months from the date of the final rejection, the period for response to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full response to the rejection *within the period for response*, the case is not abandoned.

Rule 181(f) now provides that any petition under that rule which is not filed "within two months from the action complained of" may be dismissed as untimely. Often, the "action complained of", for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a three months period for response. Under such circumstances, if applicant requests reconsideration, under rule 111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the two month period for filing the petition. The petition must be filed within this period even though the period for response to the rejection of the claims may extend beyond the two month period.

1002.01 Procedure [R-21]

Petitions, together with the respective application files, are sent to the Office of the Commissioner or other official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under rule 181(c) or for an informal memorandum.

Where a formal statement under rule 181(c) is made, a copy thereof is mailed to the petitioner by the examiner unless the latter is otherwise directed, and the file and petition, accompanied by the original copy of his statement, are returned to the official handling the petition. If an informal memorandum is requested, no copy thereof is mailed to the petitioner by the examiner. After the decision has been rendered, the decision is entered on the

"Contents" of the file wrapper which is then returned to the primary examiner, who will act in accordance with the decision.

1002.02 Delegation of Authority to Decide Petitions [R-43]

Petitions to the Commissioner are decided in accordance with the following delegation of authority.

In any case in which the authority to decide the petition has been delegated as indicated in §§ 1002.02(a)-(m), the decision may be viewed as a final agency decision for the purposes of court review where such review is proper.

The authority to decide certain types of petitions for suspension of rules of practice under rule 183 of the Rules of Practice in Patent Cases and rule 2.148 of the Trademark Rules of Practice has been delegated to the Assistant Commissioner for Patents and the Assistant Commissioner for Trademarks. The petitions falling within each of these delegations are set forth in the listings in §§ 1002.02 (a) and (i). Certain types of such petitions falling within the authority delegated to the Assistant Commissioner for Patents have been assigned by him to the Deputy Assistant Commissioner for Patents and this assignment is reflected in the listings in § 1002.02(b).

In accordance with rule 181(g) the authority to decide petitions to the Commissioner, not otherwise delegated, has been delegated to various Office officials. Generally, these officials will decide petitions as specified in the following sections for the effective operation of the Office. Also listed are certain petitions which are not, strictly speaking, to the Commissioner but have been committed by statute or rule to the designated officials. Not included herein are petitions under 37 C.F.R., Part 100, for reconsideration of Commissioner's decisions on patent rights of government employees, since authority to act on these petitions has been reserved to the Commissioner and has not been delegated.

Authority not herein delegated has been reserved to the Commissioner and may be delegated to appropriate officials on an ad hoc basis.

1002.02(a) Petitions Decided by the Assistant Commissioner for Patents [R-43]

1. Petitions related to public use proceedings. Rule 292.
2. Petitions to make a patent application special on the ground of:

- (a) prospective manufacture;
- (b) infringement; or
- (c) inability to interest capital. § 708.02.

3. Petitions under rule 183 for suspension of rules relating to patent examining not otherwise covered.

4. Petitions to expunge papers from patent application files or patent files.

5. Petitions to strike patent applications, except where the petition to strike an application involves or arises out of interference proceedings. Rule 56.

1002.02(b) Petitions Decided by the Deputy Assistant Commissioner for Patents [R-43]

1. Petitions to revive an abandoned patent application. Rule 137, § 711.03(c).

2. Petitions under rule 183 for suspension of rules relating to the examining of patent applications.

3. Petitions to invoke the supervisory authority of the Commissioner in matters within the responsibility of the Patent Examining Operation.

4. Petitions to withdraw patent applications from issue. Rule 313, § 1308.

5. Petitions for acceptance of late priority papers in patent applications. Rule 55, §§ 201.14(a) and (c).

6. Petitions for deferment of issuance of patents.

7. Petitions for express abandonment of patent applications after Notice of Allowance.

8. Petitions to accept late payment of issue fees. Rule 316, § 712.

9. Petitions to accept late payment of additional issue fees. Rule 317, § 712.

10. Petitions relating to disclaimers in patents and patent applications under rule 321.

11. Petitions relating to assignments and issuance of patents. § 1308.

12. Petitions to invoke the supervisory authority of the Commissioner in matters concerning the Office of Administration.

13. Petitions under rule 183 for suspension of rules in patent matters administered by the Office of Administration.

1002.02(c) Petitions and Requests Decided by the Group Directors [R-43]

1. Petitions to make patent applications special: § 708.02
 - (a) on the ground of applicant's age or state of health;

- (b) a division, continuation or continuation-in-part of an earlier application;
- (c) under the Environmental Quality Program;
- (d) under the Special Examining Procedure for certain new applications—accelerated examination.

2. Petitions to reopen prosecution of patent applications after decision by the Board of Appeals, where no court action has been filed. § 1214.07.

3. Petitions from a final decision of examiner requiring restriction in patent applications. Rule 144, § 818.03(c).

4. Petitions invoking the supervisory authority of the Commissioner involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal, as for example:

- (a) prematureness of final rejection, § 706.07 (c);
- (b) refusal to enter an amendment, rule 127, § 714.19;
- (c) holding of abandonment, §§ 711.03 (c) and (d);
- (d) requirement to cancel "new matter" from specification, § 608.04(c);
- (e) petitions relative to formal sufficiency and propriety of affidavits under rules 131, 132, and 204;
- (f) petitions to institute an interference under rule 205.
- (g) petitions relating to refusal to enter an amendment under rule 312.

5. Petitions under rule 212 for concurrent ex parte and inter partes prosecution of patent applications. § 1103.

6. Petitions for return of original oaths of patent applications. § 604.04(a).

7. Requests for second or subsequent extensions of a set shortened statutory period under rule 136(b). § 710.02(e).

8. Requests for interviews with the examiner after a patent application has been sent to issue. § 713.10.

9. Requests for a defensive publication (denial). § 711.06.

10. Petitions concerning appealed patent applications before transfer of jurisdiction to the Board of Appeals (e.g., second or subsequent extension of time for filing an appeal brief). § 1206.

11. Petitions for a second or subsequent suspension of action in patent applications under rule 103. § 709.

12. Petitions for license to file patent applications in foreign countries (limited to the group director of Group 220).

13. Petitions to reinstate appeals dismissed by the group appeals clerk.

1002.02(d) Requests Decided by the Supervisory Primary Examiners [R-32]

Requests for defensive publication (approval). § 711.06.

1002.02(e) Requests Decided by the Examining Group Appeal Clerks [R-32]

First request for a one-month extension of time to file the appeal brief or reply brief in appeals to the Board of Appeals. § 1206.

1002.02(f) Petitions Decided by the Chairman of the Board of Patent Interferences [R-43]

1. Petitions in patent interferences from an action by a primary examiner or from an interlocutory action by the patent interference examiner.

2. Petitions to accept late settlement papers in patent interferences under 35 U.S.C. 135(c).

3. Petitions for acceptance of priority papers in patent applications involved in an interference.

1002.02(g) Petitions Decided by the Patent Interference Examiners [R-32]

1. Petitions for access to patent applications related to an interference or having an interference background. § 103.

2. Petitions for access to unopened preliminary statements under rule 227(d).

1002.02(h) Petitions Decided by the Special Assistant to the Assistant Commissioner for Patents [R-43]

1. Petitions for filing date. § 506.

2. Petitions relating to filing and issuance of divisional reissue applications. Rule 177, § 1401.10(a).

1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks [R-43]

Petitions relating to Trademarks are covered in Chapter 1700 of the Trademark Manual of Examining Procedure.

1002.02(j) Petitions Decided by the Board of Appeals [R-48]

1. Petitions or requests for extension of time to file an amendment under 37 CFR 1.196(b), § 1214.01.

2. Petitions under 37 CFR 1.197(b) for a rehearing, or reconsideration or modification of a decision of the Board of Appeals. § 1214.03.

3. Petitions to make special patent applications within the jurisdiction of the Board of Appeals. § 708.02.

4. Petitions or requests for extensions of time to file a supplemental reply brief responding to a supplemental examiner's answer under 37 CFR 1.193(b). § 1208.01.

1002.02(k) Petitions Decided by the Solicitor [R-48]

1. Petitions for access to patent applications except applications involved in or related to an interference. §§ 103 and 104.

2. Petitions for access to agreements filed under 35 U.S.C. 135(c).

3. Petitions from refusal to issue certificates of correction. §§ 1402 to 1402.02.

4. Petitions for extension of time in court matters. 35 U.S.C. 142, 145, 146.

5. Petitions for withdrawal of attorney. 37 CFR 1.36. § 402.06.

6. Petitions for acceptance of patent applications under 37 CFR 1.47. § 409.03.

7. Petitions involving deceased inventors. §§ 409.01 (a) and (b).

8. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent. § 1402.01.

9. Petitions relating to ex parte questions in cases before the Court of Customs and Patent Appeals.

1002.02(l) Requests Decided by the Decisions and Certificates of Correction Unit [R-48]

Requests for certificates of correction under 37 CFR 1.322 or 1.323 except for denials on grounds requiring consideration by the Solicitor. §§ 1402 and 1402.01.

1002.02(m) Petitions Decided by the Chairman, Committee on Enrollment [R-32]

1. Petitions relating to registration under 37 CFR 1.341.

2. Petitions for special recognition under 37 CFR 1.342.

3. Petitions for exceptions to undertakings under 37 CFR 1.341 (g). § 1702.

4. Petitions for recognition in trademark cases under rule 2.12(c) of the Trademark Rules of Practice.

1002.02(n) Petitions Decided by the Clerk of the Board of Appeals [R-48]

The authority to decide certain petitions requesting an extension of time, upon a showing of sufficient cause, to appeal to the U.S. Court of Customs and Patent Appeals or commence a civil action under 37 C.F.R. § 1.304(a) as amended February 1, 1976, has been delegated to the Clerk of the Board of Appeals. This delegation is limited to Board of Appeals cases in which: (1) the petition is the first request for such an extension; (2) the time is not extended for more than one month; and (3) the petition is filed prior to expiration of the period that is being extended. The Chairman of the Board gives guidance on the general policy to be followed in deciding such petitions.

1003 Matters Submitted to Group Directors [R-43]

The following is a list of matters which require the approval of the appropriate group director, together with a reference to the section of this manual where such matters are more fully treated.

1. Applications filed without drawings where there is a doubt as to the need for drawings before granting a filing date. § 608.02.

2. Return of papers entered on the "Contents" of the file wrapper. See §§ 201.14(c) and 717.01.

3. Return of papers containing discourteous remarks. See § 714.25.

4. Certain rejections on double patenting of divisional (or parent) case when restriction or election of species has previously been required. § 804.04.

5. Request for patentability report. § 705.01 (e).

6. Letters to an applicant suggesting claims for purposes of interference, or the submission of Form PTO-850, where one or more claims of one application would differ from corresponding claims of another application. See 37 CFR 1.203 (a) and § 1101.01 (j).

7. Letters to an applicant of an allowed application informing him of a proposal to request withdrawal of said application from

issue for the purpose of rejecting a claim or claims as fully met by, or obviously unpatentable over a new reference. § 1308.01.

8. Second or subsequent attempts at conversion of an application (addition or removal of an inventor under 37 CFR 1.45, or simultaneous addition and removal of inventors. See § 201.03.

9. Entry of a patent claim copied outside the time limit set requires the approval of the appropriate group director. See § 1101.02(f).

10. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee. § 1101.02(f).

11. Interferences between applications neither of which is in condition for allowance. § 1101.01(c).

12. Letters requesting jurisdiction of applications involved in interference. § 1101.01(o).

13. Letters to an applicant suggesting claims for purposes of interference, the adoption of which by the applicant would result in the withdrawal of an application from issue. § 1101.01(o).

14. Amendments presented after decision by the Board of Appeals as to which the primary examiner recommends entry as placing the application in condition for allowance. See § 1214.07.

15. New ground of rejection or objection or new reference cited in examiner's answer on appeal. Prior approval of the group director must be obtained before the answer is written and all copies of the answer must be stamped "approved" by the group director if it meets with his approval. See § 1208.01.

16. Examiner's answers containing a new interpretation of law. See § 1208.

17. Letters to an applicant indicating a defect in his appeal brief. § 1206.

18. Proposed interferences between applications whose effective filing dates differ by more than six months. See § 1101.01.

19. Withdrawal from appeal of an application remanded by the Board of Appeals. See § 1208.02.

The group director should also be consulted in situations such as the one spelled out in § 1208.01, where it must be decided whether to fully reopen the ex parte prosecution after appeal or to proceed by introducing a new ground of rejection in the examiner's answer. Such consultation would ordinarily be confined to questions of policy as to whether the best interests of the applicant as well as the Office would be served by reopening the prosecution or extending the term to reply to the answer.

All unusual questions of practice may be referred to the group directors.

1004 Actions Which Require the Attention of the Primary Examiner [R-48]

There are some questions which existing practice requires the primary examiner to be personally responsible for. The following actions fall in this category:

Third action on any case (§ 707.02(a)).

Action on a case pending 5 or more years (§ 707.02(a)).

Final rejection (§ 706.07).

Initiating an interference (§ 1101.01(c)).

First request for extension of time (§ 710.02(e)).

Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (§ 1111.05).

Decisions on interference motions under 37 CFR 1.231; also actions taken under 37 CFR 1.237 (§§ 1105.02 to 1105.05).

Rejection of a previously allowed claim (§ 706.04).

Proposed rejection of a copied patent claim. (If applicable to a patentee, see § 1101.02(f).)

Classification of allowed cases (§ 903.07).

Holding of abandonment for insufficient response (§ 711.03(a)).

Suspension of examiner's action (§ 709).

Treatment of newly filed application which obviously fails to comply with 35 U.S.C. 112 (§ 702.01).

Consideration of the advisability of a patentability report (§ 705.01).

An action making final a requirement for restriction between inventions recited in a Markush-type claim (§ 803).

Final requirements for restriction (§ 803.01).

Withdrawal of final rejection (§§ 706.07(d) and 706.07(e)).

All examiner's answers on appeal (§ 1208). Note also § 1208.01 where a new ground of rejection or objection is raised, or a new reference is cited, in the answer.

Decision on reissue oath or declaration. (§ 1401.08).

Decision on affidavits or declarations under 37 CFR 1.131 (rule 131) (§ 715.08) and under 37 CFR 1.132 (rule 132) (§ 716).

For a list of actions that are to be submitted to the group directors, see §§ 1002.02(c) and 1003.

1005 Partial Signatory Authority [R-39]

Examiners who are delegated partial signatory authority are expected to sign their own

actions with the exception of the following actions which require the signature of the primary examiner:

Allowances
Quayle actions
Final rejections (§ 706.07).
Actions on amendments submitted after final rejection (§ 714.12).
Examiners' answers on appeal (§ 1208).
Interference declarations or modifications (§§ 1102.01(a) and 1106).
Decisions on interference motions (§ 1105.06).
Actions suggesting claims for interference purposes (§ 1101.01(j)).
Actions involving copied patent claims (§ 1101.02(f)).
Actions reopening prosecution (§ 1214.07).

Requests for withdrawal from issue (§ 1308).
Rule 312 (37 CFR 1.312) amendments (§ 714.16). ←
Rejection of previously allowed claim (§ 706.04).
Final holding of abandonment for insufficient response (§ 711.03(a)).
Actions based on affidavit or declaration evidence (37 CFR 1.131 and 1.132 (§§ 715.08 and 716)). ←
Suspension of examiner's action (§ 709).
Reissue cases (decisions on reissue oath or declaration) (§ 1401.08)).
Requests for an extension of time (§ 710.02(e)).
Examiner's amendments (§ 1302.04).
Final restriction requirements (§ 803.01).