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1001 Statutory Authority of Commissioner

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 examiners-in-chief appointed under section 7 of this title. 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 Commissioners 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.

(d) The Commissioner of Patents and Trademarks shall be an Assistant Secretary of Commerce and shall receive compensation at the rate prescribed by law for Assistant Secretaries of Commerce.

35 U.S.C. 6. *Duties of Commissioner.* (a) 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; shall have the authority to carry on studies, programs or exchanges of items or services regarding domestic and international patent and trademark law or the administration of the Patent and Trademark Office; and shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secre-

tary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

(b) The Commissioner, under the direction of the Secretary of Commerce, may, in coordination with the Department of State, carry on programs and studies cooperatively with foreign patent offices and international intergovernmental organizations, or may authorize such programs and studies to be carried on, in connection with the performance of duties stated in subsection (a) of this section.

(c) The Commissioner, under the direction of the Secretary of Commerce, may, with the concurrence of the Secretary of State, transfer funds appropriated to the Patent and Trademark Office, not to exceed \$100,000 in any year, to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and related matters. These special payments may be in addition to any other payments or contributions to the international organization and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the Government of the United States.

1001.01 Modes of Exercising Authority

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.

Section 1.181, paragraph (g), states "The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

1002 Petitions to the Commissioner

37 CFR 1.181. *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 (§ 1.111) 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) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(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.

37 CFR 1.182. Questions not specifically provided for. All cases not specifically provided for in the regulations of this part 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. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.183. Suspension of rules. In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.184. 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 (§ 1.181(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.

Section 1.181(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 month period for response. Under such circumstances, if applicant requests reconsideration, under § 1.111(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. The two month period is not extendable under 37 CFR 1.136(a) since the time is within the discretion of the Commissioner.

Form Paragraph 7.99 may be used where an insufficient fee was filed with a petition.

7.99 Petition Dismissed, Proper Fee Not Submitted

Applicant's petition under 37 CFR [1] filed [2] is DISMISSED because the proper petition fee of [3] required under 37 CFR 1.17 has not been submitted.

Examiner Note:

(1) Petitions under 37 CFR 1.48 for correcting inventorship require a fee of \$120.

(2) Petitions to suspend action under 37 CFR 1.103, to withdraw an application from issue under 37 CFR 1.313, and for considera-

tion of an amendment under 37 CFR 1.312 after payment of the issue fee, require a fee of \$60.

(3) Petitions for an extension of time under 37 CFR 1.136(a) require varying fees.

1002.01 Procedure

Petitions, together with the respective application files, are sent to the official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under § 1.181(c) or for an informal memorandum.

Where a formal statement under § 1.181(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

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)-(o), 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 37 CFR 1.183 of the Rules of Practice in Patent Cases and § 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), (i) and (o). Certain types of such petitions have been assigned to the Deputy Assistant Commissioner for Patents and this assignment is reflected in the listings in § 1002.02(b).

In accordance with 37 CFR 1.181(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.

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

1. Petitions relating to public use proceedings, 37 CFR 1.292.

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 37 CFR 1.183 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. 37 CFR 1.56.

1002.02(b) Petitions Decided by the Deputy Assistant Commissioner for Patents

1. Petitions to revive an abandoned patent application. 37 CFR 1.137, § 711.03(c).

2. Petitions under 37 CFR 1.183 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. 37 CFR 1.313, § 1308.

The examining groups should use Form Paragraph 10.01 or 10.02 when preparing a paper to withdraw an application from issue.

10.01 Withdrawal From Issue, Fee Not Paid

Date: [1]

From: [2]

To: Issue Control Officer, Patent Issue Division

Via: Office of the Director, Group [3]

Subject: Withdrawal from issue

Applicant: [4]

Date Sent to Issue: [8]

Serial No.: [5]

Notice of Allowance Mailed: [9]

Filed: [6]

For: [7]

It is requested that the above-identified application be withdrawn from issue for the following purpose: [10]

The issue fee has not been paid. It is directed that this application be withdrawn from issue under 37 CFR 1.313 and returned to the jurisdiction of examining Group [11]

The Examiner is authorized and directed to take prompt appropriate action on this case including notifying applicant of the new status of this application.

Request approved.

Director, Group [12]

10.02 Withdrawal From Issue, Fee Has Been Paid

Date: [1]

From: [2]

To: Issue Control Officer, Patent Issue Division

Via: Office of the Director, Group [3]; Office of the Deputy Assistant Commissioner for Patents

Subject: Withdrawal from Issue

Applicant: [4]

Issue Fee Paid Date: [8]

Serial No.: [5]

Notice of Allowance Mailed: [9]

Filed: [6]

Date Sent to Issue: [10]

For: [7]

It is requested that the above-identified application be withdrawn from issue for the following purpose: [11]

The issue fee has been paid. It is directed that this application be withdrawn from issue under 37 CFR 1.313 and returned to the jurisdiction of examining Group [12]

The Examiner is authorized and directed to take prompt appropriate action on this case including notifying applicant of the new status of this application. Return this application promptly to the Office of the Director of Group [13].

Request approved.

Director, Group [14]

Office of the Deputy Assistant Commissioner for Patents

5. Petitions for acceptance of late priority papers in patent applications. 37 CFR 1.55, §§ 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. 37 CFR 1.316, § 712.

9. Petitions to accept late payment of additional issue fee, 37 CFR 1.317, § 712.

10. Petitions relating to disclaimers in patents and patent applications under 37 CFR 1.321.

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 37 CFR 1.183 for suspension of rules in patent matters administered by the Office of Administration.

14. Petitions under 37 CFR 1.113 for entry of late papers in a reexamination proceeding, see § 2268.

1002.02(c) Petitions and Requests Decided by the Group Directors

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.

(e) under the Energy Program, § 708.02, VI.

(f) because the application involves safety of research in the field of Recombinant DNA, § 708.02, VII.

2. Petitions or requests to reopen prosecution of patent applications after decision by the Board of Appeals, where no court action has been filed. §§ 1214.04, third paragraph and 1214.07.

3. Petitions from a final decision of examiner requiring restriction in patent applications. 37 CFR 1.144, § 818.03(c).

4. Petitions invoking the supervisory authority of the Commissioner involving any ex parte action or re-

requirement in a patent application by the examiner which is not subject to appeal, as for example:

- (a) prematurity of final rejection, § 706.07(c);
 - (b) refusal to enter an amendment, 37 CFR 1.127, § 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 37 CFR §§ 1.131, 1.132 and 1.204;
 - (f) petitions to institute an interference under 37 CFR 1.205;
 - (g) petitions relating to refusal to enter an amendment under 37 CFR 1.312.
5. Petitions under 37 CFR 1.212 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 37 CFR 1.136(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 under 37 CFR 1.136(b) for filing an appeal brief). § 1206.
 11. A second or subsequent suspension of action in patent applications under 37 CFR 1.103. § 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.
 14. Petitions from the denial of a request for reexamination.
 15. Petitions to enter amendment under 37 CFR 1.312 filed after payment of issue fee, § 714.16.

1002.02(d) Matters Decided by the Supervisory Primary Examiners

1. Requests for defensive publication (approval). § 711.06.
2. Entry of amendments under 37 CFR 1.312, §§ 714.16, 714.16(d).
3. Approval of any new ground of rejection made after the filing of an appeal brief. This requirement extends to new grounds of rejection made either in an examiner's answer or in an Office action reopening prosecution. Evidence of the approval should appear on applicant's copy of the Office action or answer as well as the record copy.

1002.02(f) Petitions Decided by the Chairman of the Board of Patent Interferences

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

Petitions for access to unopened preliminary statements under 37 CFR 1.227(d).

1002.02(h) Petitions Decided by the Special Assistant to the Assistant Commissioner for Patents

1. Petitions for filing date. § 506.
2. Petitions relating to filing and issuance of divisional reissue applications. 37 CFR 1.177. § 1401.10(a).

1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks

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

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

1. Petitions for access to patent applications including 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. §§ 1480-1485.
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.

9. Petitions relating to *ex parte* questions in cases before the Court of Appeals for the Federal Circuit.

1002.02(l) Requests Decided by the Decisions and Certificates of Correction Unit

Requests for certificates of correction under 37 CFR 1.322 or 1.323 except for denials on grounds requiring consideration by the Solicitor. §§ 1480-1485.

1002.02(m) Petitions Decided by the Chairman, Committee on Enrollment

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 § 2.12(c) of the Trademark Rules of Practice.

1002.02(n) Petitions Decided by the Clerk of the Board of Appeals

The authority to decide certain petitions requesting an extension of time pursuant to § 1.136(b), upon a showing of sufficient cause, to appeal to the U.S. Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR § 1.304(a) has been delegated to the Clerk of the Board of Appeals. This delegation is limited to Board of Appeals cases in which the provisions of § 1.136(a) are not applicable. The Chairman of the Board gives guidance on the general policy to be followed in deciding such petitions.

1002.02(o) Petitions and Other Matters Decided by the Deputy Commissioner of Patents and Trademarks

The authority to take the following actions has been delegated to the Deputy Commissioner of Patents and Trademarks.

1. Review other government agencies' invention rights determinations under 37 CFR 100.6(c)(3).

2. Decide appeals under 37 CFR 100.7 from invention rights determinations of other government agencies.

3. Decide petitions to the Commissioner in patent interference proceedings.

4. Rule on petitions for extensions of time under 37 CFR 1.304 and § 1.136(b) for filing a notice of appeal to the CAFC or for commencing a civil action after a decision by the Board of Patent Interferences or the Board of Appeals.

5. Rule on requests in trademark cases for extensions of time under 37 CFR 2.145(d) for filing a notice of appeal to the CAFC or for commencing a civil action.

1003 Matters Submitted to Group Directors

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 §§ 714.19, item 11 and 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 or her 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 under 37 CFR 1.48. 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. Letters to an applicant indicating a defect in his or her appeal brief. § 1206.

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

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

18. Protests filed against issuance of a patent. See § 1309.02 and § 1901.06.

19. Letters requesting the application be withdrawn from issue for purposes of interference with a patent. See § 1101.02(g).

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 con-

