

Chapter 1000 Matters Decided by Various Patent and Trademark Office Officials

- 1001 Statutory Authority of Commissioner**
- 1001.01 Modes of Exercising Authority
- 1002 Petitions to the Commissioner**
- 1002.01 Procedure
- 1002.02 Delegation of Authority To Decide Petitions
- 1002.02(b) Petitions and Requests Decided in the Office of Petitions
- 1002.02(c) Petitions and Requests Decided by the Group Directors
- 1002.02(c)(1) Petitions Decided by the Group Director of Group 2200
- 1002.02(c)(2) Petitions Decided by the Group Director of Group 1800
- >1002.02(c)(3) Petitions Decided by the Group Director of Group 2900<
- 1002.02(d) Petitions and Matters Decided by Supervisory Examiners
- 1002.02(e) Petitions Decided by Primary Examiners
- 1002.02(f) Petitions and Matters Decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences
- 1002.02(g) Petitions Decided by the Administrative Patent Judges
- 1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks
- 1002.02(j) Petitions Decided by the Board of Patent Appeals and Interferences
- 1002.02(k) Petitions Decided by the Solicitor
- 1002.02(l) Request Decided by the Certificates of Correction Branch
- 1002.02(m) Petitions Decided by the Director of Enrollment and Discipline
- 1002.02(o) Petitions and Other Matters Decided by the Deputy Commissioner of Patents and Trademarks
- 1002.02(p) Petitions and Matters Decided by the PCT Legal Administrator
- 1002.02(q) Petitions Decided by the Director of Office of National Application Review
- 1003 Matters Submitted to Group Directors**
- 1004 Actions Which Require the Attention of a Primary Examiner**
- 1005 Exceptions to Partial Signatory Authority**

1001 Statutory Authority of Commissioner [R-2]

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 the 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.

(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.

(e) The members of the Trademark Trial and Appeal Board of the Patent and Trademark Office shall each be paid at a rate not to exceed the maximum rate of basic pay payable for GS-16 of the General Schedule under section 5332 of title 5.

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, including programs to recognize, identify, assess and forecast the technology of patented inventions and their utility to industry; and 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.

(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.

37 CFR 1.351 Amendments to rules will be published.

All amendments to the regulations in this part will be published in the *Official Gazette* and in the FEDERAL REGISTER.

37 CFR 1.352 Publication of notice of proposed amendments.

(a) Whenever required by law, ** notice of proposed amendments to the regulations in this part will be published in the *Official Gazette* and in the FEDERAL REGISTER. If not published with the notice, copies

1001.01

of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

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.

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

The various delegations to various Office officials are set forth in this Chapter.

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 Patent Appeals and Interferences 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. For petitions in interferences, see § 1.644.

(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 2 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 MPEP § 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 (37 CFR 1.181(f)). For example, if a petition to vacate a final rejection as premature is filed within 2 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.

37 CFR 1.181(f) provides that any petition under that rule which is not filed "within 2 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 3-month period for response. Under such circumstances, if applicant requests reconsideration, under 37 CFR 1.111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the 2-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 2-month period. The 2-month period is not extendible 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 as set forth in 37 CFR 1.17(h).

(2) Petitions to suspend action under 37 CFR 1.103, to withdraw an application from issue under 37 CFR 1.313, and for consideration of an amendment under 37 CFR 1.312 after payment of the issue fee, require a fee as set forth in 37 CFR 1.17(i)(1).

(3) Petitions for an extension of time under 37 CFR 1.136(a) require varying fees. See 37 CFR 1.17(a) – (d).

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 37 CFR 1.181(c) or for an informal memorandum, MPEP § 711.03(d).

Where a formal statement under 37 CFR 1.181(c) is made, a copy thereof is mailed to the petitioner by the examiner unless the examiner 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-1]

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 MPEP §§ 1002.02* (b), (f), (g), (j) and (o), **>a denial of a petition< may be viewed as a final agency decision for the purposes of court review where such review is proper.

>A dismissal of a petition, a denial of a petition without prejudice, and other interlocutory orders are not final agency decisions.<

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.

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1002.02(b) Petitions and Requests Decided in the Office of Petitions [R-1]

All petitions decided by the >Special Program Law Office and the<Office of Petitions, and inquiries relating thereto, should be directed to "Petitions Information, Crystal Park One, Suite 520."

1. Petitions to revive an abandoned national>, nonprovisional or provisional< patent application, 37 CFR 1.137>, 1.139< (both unavoidable delay and unintentional *>delay<), MPEP § 711.03(c).

2. Petitions under 37 CFR 1.183 for waiver or suspension of rules **>not otherwise provided for<.

3. Petitions to invoke the supervisory authority of the Commissioner under 37 CFR 1.181 in matters ** not otherwise provided for.

4. Petitions to withdraw patent applications from issue after payment of the issue fee, 37 CFR 1.313(b), MPEP § 1308.

5. Petitions for acceptance of late priority papers in patent applications, 37 CFR 1.55, MPEP §§ 201.14 (a) and (c).

6. Petitions for deferment of issuance of patents, 37 CFR 1.314, MPEP § 1306.01.

7. Petitions for express abandonment of patent applications after payment of the issue fee, MPEP § 711.01.

8. Petitions to accept late payment of issue fees, 37 CFR 1.155 and 1.316, MPEP § 712.

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

MANUAL OF PATENT EXAMINING PROCEDURE

1002.02(c)

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

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

12. Petitions **>relating to public use proceedings, 37 CFR 1.292<.

13. Petitions **>to make a patent application special under 37 CFR 1.102 on the ground of: (a) prospective manufacture MPEP § 708.02, item I; (b) infringement MPEP § 708.02, item II<.

14. Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in proceedings before the Office of *>the Deputy Assistant Commissioner for Patent Policy and Projects<.

15. Petitions under 37 CFR 1.182 in matters not *>otherwise< provided for **.

16. Petitions **>to expunge papers from patent application files or patent files, 37 CFR 1.182<.

17. Requests by the examiner to the Board of Patent Appeals and Interferences for reconsideration of a decision, MPEP § 1214.04.

18. Petitions to review refusal to accept and record maintenance fee payment filed prior to the expiration of a patent, 37 CFR 1.377 >, MPEP § 2580< .

19. Petitions to accept delayed payment of maintenance fee in an expired patent **, 37 CFR 1.378, >MPEP § 2590<.

20. Petitions to issue patent in name of the assignee recorded after payment of the issue fee, 37 CFR 3.81(b).

21. Petitions to review decision of Group Director, 37 CFR 1.181.

22. Petitions to withdraw a holding of abandonment not otherwise delegated, 37 CFR 1.181.

23. Requests to order a Commissioner initiated re-examination proceeding, 37 CFR 1.520.

24. Petitions to revive an * >abandoned PCT national stage< application because of unavoidable delay, 37 CFR 1.137(a).

25. Petitions >relating< to ** international ** >applications filed under the Patent Cooperation Treaty not otherwise provided for<.

26. Petitions to revive a reexamination proceeding because of unavoidable delay, 35 U.S.C. 133.

>27. Petitions for access to patent applications under 37 CFR 1.14 with the exception of applications involved in or related to a proceeding before the Board of Patent

Appeals and Interferences, MPEP § 103, § 104, and § 1901.05.

28. Petitions relating to reexamination proceedings, under 37 CFR 1.182 and 1.183.

29. Petitions for acceptance of national applications without participation of one or more inventors under 37 CFR 1.47, MPEP § 409.03.

30. Matters involving deceased inventors in national applications, 37 CFR 1.42 and 1.44, MPEP § 409.01(a) and (b).

31. Petitions for correction of inventorship in national applications under 37 CFR 1.48(a) filed prior to issuance of filing receipt, MPEP § 201.1.

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

33. Petitions for extensions of time under 37 CFR 1.136(b) in cases pending in Application Processing Division.

34. Petitions relating to patent term extension, 37 CFR 1.710–1.785.

35. Petitions relating to the filing date of patent applications under 37 CFR 1.53, 1.60 and 1.62, MPEP § 506.

36. Petitions relating to filing and/or issuance of divisional reissue applications, 37 CFR 1.177, MPEP § 1451.

37. Petitions under 37 CFR 1.48(e) to delete the name of the person erroneously named as inventor in a provisional application.

38. Petitions under 37 CFR 1.181 to review a determination of the length of the patent term extension under 37 CFR 1.701.

39. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b)(1) to a provisional application under 37 CFR 1.53(b)(2) where the nonprovisional application is before the Office of Petitions or the Special Program Law Office.<

1002.02(c) Petitions and Requests Decided by the Group Directors [R–2]

1. Petitions to make patent applications special under 37 CFR 1.102, MPEP § 708.02:

(a) on the ground of applicant's age or state of health, MPEP § 708.02, items III & IV;

(b) a continuation—in—part of an earlier application;

(c) under the Environmental Quality Program, MPEP § 708.02 , item V;

(d) under the Energy Program, MPEP § 708.02, item VI.

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

(f) under the Special Examining Procedure for certain new applications—accelerated examination, MPEP § 708.02, item VIII.

(g) superconductivity, MPEP § 708.02, item IX.

(h) inventions relating to HIV/AIDS and cancer, MPEP § 708.02, item X.

(i) for reasons not otherwise provided for.

2. Petitions or requests to reopen prosecution of patent applications after decision by the Board of Patent Appeals and Interferences under 37 CFR 1.198, where no court action has been filed, MPEP § 1214.04, third paragraph and § 1214.07.

3. Petitions from a final decision of examiner requiring restriction in patent applications. 37 CFR 1.144, MPEP § 818.03(c) or holding lack of unity of invention in an international application.

4. Petitions invoking the supervisory authority of the Commissioner under 37 CFR 1.181 involving any *ex parte* action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.181) and not otherwise provided for, as for example:

(a) prematurity of final rejection, MPEP § 706.07(c);

(b) refusal to enter an amendment, 37 CFR 1.127, MPEP § 714.19;

(c) holding of abandonment, MPEP § 711.03(c);

(d) requirement to cancel “new matter” from specification, MPEP § 608.04(c);

(e) relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 (MPEP § 715.08) 1.132 (MPEP § 716) and 1.608, MPEP § 2308 – § 2308.03;

(f) refusal to initiate an interference under 37 CFR 1.601(i), MPEP § 2306;

(g) refusal to enter an amendment under 37 CFR 1.312, MPEP § 714.16(d);

>(h) resetting period of response, MPEP § 710.06.<

5. Petitions under 37 CFR 1.113 relating to objections or requirements made by the examiners.

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

7. Requests for extensions of a set shortened statutory period under 37 CFR 1.136(b). MPEP § 710.02(e).

8. Petitions under 37 CFR 1.193(a) relating to the form of the appeal.

9. Petitions concerning appealed patent applications before transfer of jurisdiction to the Board of Patent Appeals and Interferences (e.g., extension of time under 37 CFR 1.136(b) for filing an appeal brief). MPEP § 1206.

10. Request by applicant for a second or subsequent suspension of action in patent applications under 37 CFR 1.103. MPEP § 709.

11. Petitions from refusal to issue a Certificate of Correction for a patent not involved in an interference (37 CFR 1.181, MPEP § 1480 – § 1485).

12. Petitions to reinstate appeals dismissed in the group.

13. Petitions from the denial of a request for reexamination, 37 CFR 1.515, MPEP § 2248.

14. Petitions for consideration of an amendment under 37 CFR 1.312(b) filed after payment of issue fee, MPEP § 714.16.

15. Petitions for withdrawal of attorney from application pending in examining groups, 37 CFR 1.36.

16. Requests for extension of time in reexamination proceedings, 37 CFR 1.550(c).

17. Petition for second or subsequent change of inventorship in an application under 37 CFR 1.48. See MPEP § 201.03.

18. Petitions under 37 CFR 1.84 to accept photographs or color drawings in patent applications.

19. Petitions under 37 CFR 1.129(b)(2) traversing a restriction requirement made in an application which is subject to the transitional restriction provisions.

20. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b)(1) to a provisional application under 37 CFR 1.53(b)(2) where the nonprovisional application is before the Examining Group.

21. Petitions to withdraw patent applications from issue before payment of the issue fee, 37 CFR 1.313(a).

The examining groups should use Form Paragraph >10.01 to notify applicant that the application is withdrawn from issue where the issue fee has not been paid and should use Form Paragraph < 10.02 when preparing a paper to request withdrawal of an application from issue after payment of the issue fee.

MANUAL OF PATENT EXAMINING PROCEDURE

1002.02(c)(1)

>¶ 10.01 Withdrawal From Issue, Fee Not Paid

In re Application of [1] :
Appl. No.: [2] : WITHDRAWAL FROM ISSUE
Filed: [3] : 37 CFR 1.313
For: [4] :

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

Patent and Trademark Office records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

[5]
Director,
Patent Examining Group [6]

[7]

EXAMINER NOTE:

- 1. This letter should be printed on PTO letterhead and signed by the Group Director.
2. Do NOT use this form letter if the issue fee has been paid. Use form paragraph 10.02 if the issue fee has been paid.
3. In bracket 7, insert the correspondence address of record.<

¶ 10.02 Withdrawal From Issue, Fee Has Been Paid

Date: [1]
From: Director, Group [2]
To: Issue Control Officer
Via: Office of Petitions
Applicant: [3]
Issue Fee Paid Date: [4]
Application No.: [5]
Filed: [6]
Date sent to issue: [7]
Title: [8]

It is requested that the above-identified application be withdrawn from issue for the following purpose: [9].

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 [10].

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 [11].

Office of Petitions

The following procedure must be followed when the Group Director decides to withdraw an application from issue before payment of the issue fee:

- i. The CRT Screen on PALM is used to determine if the issue fee has been paid.
ii. If the issue fee has been paid, a memo to the Office of Petitions is required. (See Form Paragraph 10.02, MPEP § 1002.02(b).)
iii. If the issue fee has not been paid, and the deadline for payment has not expired, the Group Director must mail a "Withdrawal from Issue" letter to the applicant to effectuate the withdrawal from issue. A copy of the "Withdrawal from Issue" letter should be sent to the Publishing Division. After a "Withdrawal from Issue" letter is mailed by the examining group, the examining group must:

- a. Cross out the batch number on the face of the file;
b. Cross out the date mailed for the "Notice of Allowance" on the face of the file wrapper and write or stamp "WITHDRAWN";
c. Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action); and
d. Forward the file to the examiner for prompt action.

The processing will be done in the Examining Group without the need to send the application to Publishing Division.

1002.02(c)(1) Petitions Decided by the Group Director of Group 2200

In addition to the items delegated to all Group Directors under MPEP § 1002.02(c), authority to decide the following is delegated to the Group Director of Group 2200:

- 1. All petitions filed under 35 U.S.C. 267, to extend the time for taking action in United States-owned applications wherein the invention is important to the armament or defense of the United States.
2. All petitions under 37 CFR 1.103(c), to suspend action in United States-owned applications wherein the publication of the invention might be detrimental to the public safety or defense.

Any petitions filed under 35 U.S.C. 267 and/or 37 CFR 1.103(c) in any area of the Office must be

forwarded to the Director of Group 2200 for decision thereon.

3. Petitions under 37 CFR 5.12(a) for foreign license to file patent applications in foreign countries, MPEP § 140.

4. Petitions for rescission of secrecy order, 37 CFR 5.4, MPEP § 120.

5. Petition to permit disclosure of subject matter under a secrecy order, 37 CFR 5.5(b), MPEP § 120.

6. Petition for modification of secrecy order, 37 CFR 5.5(c), MPEP § 120.

7. Petition for retroactive foreign filing license, 37 CFR 5.25, MPEP § 140.

8. Petitions relating to refusal of request for publication of a Statutory Invention Registration, 37 CFR 1.295.

9. Petitions relating to request for withdrawal of request for publication of a Statutory Invention Registration, 37 CFR 1.296.

10. Petitions relating to DOE property rights statements under 42 U.S.C. 2182.

11. Petitions relating to NASA property rights statements under 42 U.S.C. 2457.

12. Petitions relating to foreign filing licenses under 35 U.S.C. 184.

13. Petitions concerning review of security or government interest matters not otherwise provided for.

14. Petitions relating to any application under a secrecy order pursuant to 35 U.S.C. 181, including petitions to expunge subject matter from the application to overcome the secrecy order.

> 1002.02(c)(2) Petitions Decided by the Group Director of Group 1800 [R-1]

In addition to the items delegated to all Group Directors under MPEP § 1002.02(c), authority to decide the following is delegated to the Group Director of Group 1800:

1. Petition regarding sequence rules, 37 CFR 1.821-1.825.<

> 1002.02(c)(3) Petitions Decided by the Group Director of Group 2900 [R-2]

In addition to the items delegated to all Group Directors under MPEP § 1002.02(c), authority to decide the following petitions and requests filed in design applications is delegated to the Group Director of Group 2900:

1. Petitions to revive an abandoned national application, 37 CFR 1.137 (both unavoidable delay and unintentional delay), MPEP § 711.03(c).

2. Petitions to accept late payment of issue fees, 37 CFR 1.155, MPEP § 712.

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

4. Petitions for access to patent applications under 37 CFR 1.14 with the exception of applications involved in or related to a proceeding before the Board of Patent Appeals and Interferences, MPEP § 103, § 104, and § 1901.05.

5. Petitions for acceptance of national applications without participation of one or more inventors under 37 CFR 1.47, MPEP § 409.03.

6. Matters involving deceased inventors in national applications, 37 CFR 1.42 and 1.44, MPEP § 409.01 (a) and (b).

7. Petitions for correction of inventorship in national applications under 37 CFR 1.48(a) filed prior to issuance of filing receipt, MPEP § 201.03.

8. Petitions for extensions of time under 37 CFR 1.136(b) in cases pending in Application Processing Division.

9. Petitions relating to the filing date of patent applications under 37 CFR 1.53, 1.60 and 1.62, MPEP § 506.<

1002.02(d) Petitions and Matters Decided by Supervisory Examiners

1. Entry of amendments under 37 CFR 1.312 which embody more than merely the correction of formal matters without changing the scope of any claim, MPEP § 714.16, § 714.16(d).

2. 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, MPEP § 1208.01.

3. Requests for a Certificate of Correction submitted under 37 CFR 1.322 or 1.323 unless the error is clearly minor, clerical or typographical, in which case it is handled by the Certificate of Correction Branch.

4. Requests for a Certificate of Correction to correct a claim even if the request is submitted under 37 CFR 1.322.

1002.02(e)

5. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent that is not involved in an interference, MPEP § 1481.

6. Requests for interviews with the examiner after a patent application has been sent to issue (Notice of Allowability mailed), MPEP § 713.10, or after transfer of jurisdiction to the Board of Patent Appeals and Interferences.

7. Petitions to consider Information Disclosure Statement after final action or notice of allowance but before payment of the issue fee, 37 CFR 1.97(d).

8. 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 1.603 and MPEP § 2303.

9. Amendments presented after decision in an appeal by the Board of Patent Appeals and Interferences as to which the primary examiner recommends entry as placing the application in condition for allowance. See MPEP § 1214.07.

1002.02(e) Petitions Decided by Primary Examiners

Petitions under 37 CFR 1.48 for correction of inventorship in applications not otherwise provided for.

1002.02(f) Petitions and Matters Decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences [R-2]

The Chief Administrative Patent Judge is authorized to redelegate authority to decide any of these petitions or matters to the Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences.

1. Designation of members of the Board of Patent Appeals and Interferences to hear appeals and decide interferences, both initially and on request for reconsideration. 35 U.S.C. 7.

2. Designation of members of the Board of Patent Appeals and Interferences to conduct proceedings in an interference. 37 CFR 1.610(a).

3. Designation of members of the Board of Patent Appeals and Interferences to decide requests for reconsiderations. 37 CFR 1.640(c).

4. Requests related to superintending the functions of the Board of Patent Appeals and Interferences, including:

a. Petitions under 37 CFR 1.644 in interferences declared on or after February 11, 1985 (commonly known as "new rule" interferences which are governed by 37 CFR 1.601 through 1.689).

b. Petitions under 37 CFR 1.244 (1984) in interferences declared prior to February 11, 1985 (commonly known as "old rule" interferences which are governed by 37 CFR 1.201 through 1.288 (1984)).

c. Petitions under 37 CFR 1.181, 1.182, and 1.183 from actions of the Board of Patent Appeals and Interferences or of personnel at the Board or Patent Appeals and Interferences.

d. Petitions under 35 U.S.C. 135(c) and 37 CFR 1.666(c) to permit the filing of an agreement or understanding during the six-month period subsequent to termination of an interference.

e. Petitions under 37 CFR 1.666(b) for access to copies of an interference agreement or understanding filed under 35 U.S.C. 135(c), MPEP § 2366.

f. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent involved in an "old rule" interference.

g. Petitions from a decision under 37 CFR 1.612(a) granting or denying access by a party to an interference to pending and abandoned patent applications, MPEP § 103.

h. Petitions for an extension of time to file a request for reconsideration of a decision of the Board of Patent Appeals and Interferences in an *ex parte* case.

i. Petitions from a decision under 37 CFR 1.615(b) authorizing or declining to authorize continued concurrent prosecution of an application involved in an interference proceeding.

j. Petitions from a decision under 37 CFR 1.613(d) declining to authorize a withdrawal of an attorney or agent from representing a party involved in an interference.

k. Petitions from a refusal to issue a certificate of correction for a patent that is involved in an "old rule" interference.

l. Petitions from a decision granting or denying a request for a certificate of correction under 37 CFR 1.322 and 1.323 * >for< a patent involved in a "new rule" interference.

m. Petitions seeking disqualification of an attorney or agent under 37 CFR 10.130(b) in an *inter partes* case pending before the Board of Patent Appeals and Interferences.

1002.02(g) Petitions Decided by the Administrative Patent Judges [R-2]

1. Petitions for access to unopened preliminary statements under 37 CFR 1.631.
2. Petitions under 37 CFR 1.615 for concurrent *ex parte* and *inter partes* prosecution of patent applications, MPEP § 2315.
3. Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in interference proceedings under 37 CFR 1.601 – 1.688 before the Board of Patent Appeals and Interferences, 37 CFR 1.613(d).
4. A request for a Certificate of Correction for a patent that is involved in an interference conducted under 37 CFR 1.601 – 1.688 * presented via a motion under 37 CFR 1.635.
5. Motions to correct errors in joining inventors in proceedings under 37 CFR 1.601 – 1.688, 37 CFR 1.634. See also MPEP § 1002.02(j).

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 Patent Appeals and Interferences

Requests under 37 CFR 1.197(b) for a reconsideration or modification of a decision of the Board of Patent Appeals and Interferences. MPEP § 1214.03.

1002.02(k) Petitions Decided by the Solicitor

1. Petitions for extension of time in court matters 35 U.S.C. 142, 145, 146.
2. Petitions relating to *ex parte* questions in cases before the Court of Appeals for the Federal Circuit.
3. Requests filed under the Freedom of Information Act.

1002.02(o)

The Office of the Solicitor is available to render legal advice to any deciding official in connection with any petition.

1002.02(l) Requests Decided by the Certificates of Correction Branch

1. Requests for Certificates of Correction under 37 CFR 1.322 or 1.323 except for denials on grounds requiring consideration by the Chief Administrative Patent Judge or the supervisory primary examiners otherwise provided for, MPEP § 1480 – § 1485.
2. Petitions to issue corrected patent, 37 CFR 1.322(b).

1002.02(m) Petitions Decided by the Director of Enrollment and Discipline

1. Petitions relating to registration.
2. Requests for limited recognition under 37 CFR 10.9.
3. Petitions for exceptions to undertakings under 37 CFR 10.10(b)(2), MPEP § 1702.
4. Petitions for regrading of registration examinations under 37 CFR 10.7(c).
5. Petitions for reinstatement under 37 CFR 10.160.
6. Petitions to suspend the rules under 37 CFR 10.170.

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. Decide petitions to the Commissioner in patent interference proceedings under 37 CFR 1.644.
2. Decide petitions to the Commissioner from actions taken by the Board of Patent Appeals and Interferences.
3. Decide petitions (under 37 CFR 1.304 or 37 CFR 2.145(d)) seeking to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action seeking judicial review of a decision of the Board of Patent Appeals and Interferences or the Trademark Trial and Appeal Board.

1002.02(p)

4. Decide petitions under 37 CFR 10.2(c) from a final decision of the Director of Enrollment and Discipline.

5. Render final decisions in proceedings under 35 U.S.C. 32 in which the Director of Enrollment and Discipline seeks to exclude or suspend a practitioner from practice before the Patent and Trademark Office.

6. Render final decisions in proceedings under 35 U.S.C. 32 seeking to disqualify a practitioner and/or the practitioner's firm in all cases in the Patent and Trademark Office.

If a vacancy in the position of Deputy Commissioner for Patents and Trademarks, decisions on petitions in patent interference cases will be signed by the Commissioner of Patents and Trademarks.

Upon receipt of a petition and without waiting for any opposition, the entire interference file is to be forwarded to the Office of the Solicitor. The Solicitor is directed to promptly cause a review to be made of the petition and to prepare a draft decision for the Deputy Commissioner or Commissioner as may be appropriate. The Solicitor is authorized to take any interlocutory action, i.e., extending times for filing oppositions and seeking judicial review, obtaining agreement on facts from the parties, etc., as may be necessary to promptly dispose of the petition.

**>1002.02(p) Petitions and Matters Decided
by the PCT Legal Administrator
[R-1]**

1. Petitions to withdraw the Notice of Acceptance and/or filing receipt and indication of the steps necessary for completion of the national stage in a national application requesting treatment under 35 U.S.C. 371.

2. Petitions for withdrawal of attorney or agent of record in proceedings before PCT Operations and/or the Office of the PCT Legal Administrator, 37 CFR 1.36, MPEP § 402.06.

3. Petitions for access to an international application or a national application (i.e., a national stage application or a national application which is continuing from an international application) pending in PCT Operations and/or the Office of the PCT Legal Administrator.

4. Requests under 37 CFR 1.26 or 1.446 for refund of fees paid in an international application or in a national application (i.e., a national stage application or a national application which is continuing from an international

application) before PCT Operations and/or the Office of the PCT Legal Administrator.

5. Petitions under 37 CFR 1.182 to convert a national application which was filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a) or to convert a national application which was filed under 35 U.S.C. 111(a) to an application filed under 35 U.S.C. 371.

6. Petitions under 37 CFR 1.181 to withdraw the holding of abandonment where the holding was made in PCT Operations or in the PCT Legal Office.

7. Petitions under 37 CFR 1.181 to invoke the Supervisory authority of the Commissioner in circumstances arising in PCT Operations and/or the Office of the PCT Legal Administrator other than the circumstances set forth in paragraph 6, above.

8. Petitions under 37 CFR 1.137(b) to revive an application filed under the Patent Cooperation Treaty (PCT).

9. Petitions under 37 CFR 1.425 to accept the signature in an international application on behalf of an applicant.

10. Petitions under 37 CFR 1.47 or a submission under 37 CFR 1.42 or 1.44 to accept the signature in a national stage application on behalf of an applicant.

11. Petitions under 37 CFR 1.48 or a submission under 37 CFR 1.28 (change of inventorship and small entity status, respectively) in a national stage application prior to entry into the national stage.

12. Petitions under 37 CFR 1.182 or 1.183 filed in an international application relating to filing date matters, drawing problems, priority claim issues, Express Mail problems, Chapter II Demand problems, issues relating to obvious error and issues relating to withdrawal.

13. Petitions under 37 CFR 1.182 or 1.183 dealing with circumstances other than those set forth in paragraph 12, but relating to issues under the PCT.

14. Decisions withdrawing an examiner's office action in an application where the application is not in compliance with the PCT provisions of the Treaty, U.S. Law or the Regulations.

15. Petitions dealing with PCT related issues in an application filed under 35 U.S.C. 111(a) (such as applications where there is a potential claim for benefit under 35 U.S.C. 365).

16. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b)(1) to a provisional application under 37 CFR 1.53(b)(2) where the nonprovisional

application is before PCT Operations and/or the Office of the PCT Legal Administrator.

1002.02(q) Petitions Decided by the Director of Office of National Application Review [R-1]

1. Petitions under 37 CFR 1.48(d) to add the name of an inventor in a provisional application.

2. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b)(1) to a provisional application under 37 CFR 1.53(b)(2) where the nonprovisional application is before the Office of National Application Review or where the nonprovisional application is before the Office of Publications.<

1003 Matters Submitted to Group Directors

The following is a list of matters which are submitted to the appropriate Group Director, together with a reference to any section of this manual where such matters are more fully treated.

1. Requests for a Certificate of Correction in which the:

i. request raises a novel issue or about which there is some question.

ii. request is for a patent known to be in litigation.

iii. request deals with a legal matter (e.g., the insertion of foreign priority data or cross referencing to prior U.S. patent applications) unless the file reflects that the examiner has already ruled on the matter and that failure to print the material was clearly an Office error in which case it will be handled by the Certificate of Corrections Branch.

2. Return of papers entered on the "Contents" of the file wrapper. See MPEP § 201.14(c), § 604.04(a) and § 717.01.

3. Return of papers containing discourteous remarks. See MPEP § 714.19, item 11 and MPEP § 714.25.

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

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

6. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee, MPEP § 2307.02.

7. Interferences between applications neither of which is in condition for allowance, MPEP § 2303.

8. Letters requesting jurisdiction from Board of Patent Appeals and Interferences of applications involved in appeal or interference.

9. 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, MPEP § 2305.04.

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

11. Proposed interferences between applications whose effective filing dates differ by more than 6 months. See MPEP § 2303.

12. Withdrawal from appeal of an application remanded by the Board of Patent Appeals and Interferences. See MPEP § 1211.

13. Protests filed against issuance of a patent. See MPEP § 1901.06.

14. Letters suggesting claims to an application in issue for purposes of interference with a patent. See MPEP § 2305.04.

15. Requests by the examiner to the Board for reconsideration of a decision before forwarding to the Office of Petitions, MPEP § 1214.04.

16. Second or subsequent suspension of action in patent application under 37 CFR 1.103 on examiner's initiative. MPEP § 709.

17. Request by the examiner to withdraw an application from issue.

All unusual questions of practice may be referred to the Group Directors.

1004 Actions Which Require the Attention of a Primary Examiner

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

Final rejection (MPEP § 706.07).

Initiating an interference (MPEP § 2309).

Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (MPEP §2364.01).

Calling Administrative Patent Judge's attention to a discovered reference which makes a claim corresponding to a count unpatentable (37 CFR 1.641, MPEP § 2341).

1005

Rejection of a previously allowed claim (MPEP § 706.04).

Classification of allowed cases (MPEP § 903.07).

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

Suspension of examiner's action (MPEP § 709).

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

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

Final requirements for restriction (MPEP § 803.01).

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

All examiner's answers on appeal (MPEP § 1208). Note also MPEP § 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 (MPEP § 1414 - § 1414.05).

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

Decision as to acceptance of amendments, statements, and oaths or declarations filed under 37 CFR 1.48 (MPEP § 201.03).

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

1005 Exceptions to Partial Signatory Authority

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 (MPEP § 1302.13).

Quayle actions (MPEP § 714.14).

Final rejections (MPEP § 706.07).

Actions on amendments submitted after final rejection (MPEP § 714.12).

Examiners' answers on appeal (MPEP § 1208).

Interference declarations or modifications (MPEP § 2309).

Actions suggesting claims for interference purposes (MPEP § 2305).

Actions involving copied patent claims (MPEP § 2307).

Actions reopening prosecution (MPEP § 1214.07).

Requests for withdrawal from issue (MPEP § 1308). 37 CFR 1.312 amendments (MPEP § 714.16).

Rejection of previously allowed claim (MPEP § 706.04).

Final holding of abandonment for insufficient response (MPEP § 711.03(a)).

Actions based on affidavit or declaration evidence (37 CFR 1.131 and 1.132 (MPEP § 715.08 and § 716)).

Suspension of examiner's action (MPEP § 709).

Reissue cases (decisions on reissue oath or declaration) (MPEP § 1444).

Requests for an extension of time under 37 CFR 1.136(b) (MPEP § 710.02(e)).

Examiner's amendments (MPEP § 1302.04).

Final restriction requirements (MPEP § 803.01).

Reexamination proceedings (MPEP § 2236).

