

Chapter 1100 Statutory Invention Registration (SIR)

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1101 Request for Statutory Invention Registration (SIR) [R-1]

35 U.S.C. 157. Statutory invention registration.

(a) Notwithstanding any other provision of this title, the Commissioner is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant —

- (1) meets the requirements of section 112 of this title;
- (2) has complied with the requirements for printing; as set forth in regulations of the Commissioner;
- (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Commissioner; and
- (4) pays application, publication, and other processing fees established by the Commissioner.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Commissioner shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The Secretary of Commerce shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the uses of such procedures.

37 CFR 1.293. Statutory invention registration.

(a) An applicant for an original patent may request, at any time during the pendency of applicant's pending complete application, that the specification and drawings be published as a statutory invention registration. Any such request must be signed by (1) the applicant and any assignee of record or (2) an attorney or agent of record in the application.

(b) Any request for publication of a statutory invention registration must include the following parts:

(1) A waiver of the applicant's right to receive a patent on the invention claimed effective upon the date of publication of the statutory invention registration;

(2) The required fee for filing a request for publication of a statutory invention registration as provided for in § 1.17(n) or (o);

(3) A statement that in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112; and

(4) A statement that, in the opinion of the requester, the application to which the request is directed complies with the formal requirements of this part for printing as a patent.

(c) A waiver filed with a request for a statutory invention registration will be effective, upon publication of the statutory invention registration, to waive the inventor's right to receive a patent on the invention claimed in the statutory invention registration, in any application for an original patent which is pending on, or filed after, the date of publication of the statutory invention registration. A waiver filed with a request for a statutory invention registration will not affect the rights of any other inventor even if the subject matter of the statutory invention registration and an application of another inventor are commonly owned. A waiver filed with a request for a statutory invention registration will not affect any rights in a patent to the inventor which issued prior to the date of publication of the statutory invention registration unless a reissue application is filed seeking to enlarge the scope of the claims of the patent. See also § 1.106(e).

A request for a statutory invention registration (SIR) may be filed at the time of filing * >a nonprovisional< application for patent, or may be filed later during pendency of * >a nonprovisional< application. The fee required (37 CFR 1.17(n) or (o)) depends on when the request is filed. The application to be published as a SIR must be complete as set forth in 37 CFR 1.51(a)>(1)< including a specification with a claim or claims, an oath or declaration, and drawings when necessary. Applicants should use the format set forth in form PTO/SB/94, Request for Statutory Registration. >A provisional application cannot include a request for a SIR.<

Requests for statutory invention registrations, including those submitted in utility, plant, and design applications, are handled in Examining Group 2200. Accordingly, incoming new applications which include a request for a SIR will be processed like other new applications in the Application Processing Division and then forwarded to Group 2200. Group 2200 may be assisted by other examining groups when the subject matter of the application makes it necessary or desirable. For example, Group 1800 may handle issues under 35 U.S.C. 112 in applications involving biotechnology.

Applications which are already assigned to examining groups other than Group 2200 and which receive a request for a SIR (or any other indication that they are to be published as a SIR) should be forwarded with a brief explanation to Group 2200 via the clerical staff of the examining group to which the application is assigned. The

MANUAL OF PATENT EXAMINING PROCEDURE

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forwarding group should first determine whether an Office action has been mailed in the application and issue proper SIR disposal credit to the examiner who prepared any such action where appropriate. Group 2200 R examiners will determine whether the request for a SIR

is proper. Non-Group 2200 examiners should make no comment to the applicant regarding what effect the filing of a request for a SIR may have had on any outstanding rejection.

Request for Statutory Invention Registration

Application Number _____, or attached hereto

Filed: _____

Titled: _____

Applicant(s): _____

A. In the above identified patent application, I hereby:

1. Request and authorize the Commissioner of Patents and Trademarks to publish the above identified regularly filed patent application as a Statutory Invention Registration. (35 U.S.C. 157)
2. Waive the right to receive a United States patent on the same invention claimed in the above identified patent application. These rights, which are waived, include those specified in 35 U.S.C. 183 and 271 through 289 as well as all attributes specified for patents in any other provisions of law other than title 35, United States Code. The waiver includes, but is not limited to, the remedies under 19 U.S.C. 1337 and 1337a, 22 U.S.C. 2356 and 28 U.S.C. 1498. (35 U.S.C. 157(c))
3. Understand that the above waiver will be effective pursuant to 37 CFR 1.293 upon publication of the Statutory Invention Registration to waive the inventor's right to receive a United States patent on the invention claimed in the Statutory Invention Registration. (37 CFR 1.293(b)(1))
4. State that, in my opinion, the disclosure and claims of the above identified patent application meet the requirements of 35 U.S.C. 112. (37 CFR 1.293(b)(3))
5. State that, in my opinion, the above identified patent application complies with the requirements for printing as set forth in the Rules of Practice for Patent Cases, 37 CFR Part 1. (37 CFR 1.293(b)(4))
6. Enclose the fee set forth in 37 CFR 1.17(n) or (o) for requesting publication of a Statutory Invention Registration:

- A first Office Action has not been mailed in the above application, 37 CFR 1.17(n) \$ _____*
- A first Office Action has been mailed in the above application, 37 CFR 1.17(o) \$ _____
Request fee \$ _____

MINUS BASIC FILING FEE, IF PREVIOUSLY PAID

Basic filing fee for utility patent application set forth in 37 CFR 1.16(a)
 or
 Basic filing fee for design patent application set forth in 37 CFR 1.16(f)
 or
 Basic filing fee for plant patent application set forth in 37 CFR 1.16(g) Minus basic filing fee \$ _____
 Amount due \$ _____

- Amount enclosed by check or money order _____
- Please charge Deposit Account No. _____ the amount of \$ _____
- If payment of any additional fee is required for publication of the Statutory Invention Registration, charge such amount to Deposit Account No. _____

B. For printing of the Statutory Invention Registration front page, if desired, list below the name(s) of not more than 3 registered patent attorneys and agents OR alternatively, the name of a firm having as a member a registered patent attorney or agent. If no name is listed below, no name will be printed on the Statutory Invention Registration.

C. Name of assignee, if any, for printing on the Statutory Invention Registration _____
 Address (City and State or Country) _____
 State of incorporation, if assignee is a corporation _____

* Where this request is submitted at the time the application is filed, the filing fee is included in the fee.

Signature(s) (37 CFR 1.293(a)) _____
 attorney or agent of record applicant(s) and any assignee

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1103 Examination of a SIR [R-1]

37 CFR 1.294. Examination of request for publication of a statutory invention registration and patent application to which the request is directed.

(a) Any request for a statutory invention registration will be examined to determine if the requirements of § 1.293 have been met. The application to which the request is directed will be examined to determine (1) if the subject matter of the application is appropriate for publication, (2) if the requirements for publication are met, and (3) if the requirements of 35 U.S.C. 112 and § 1.293 of this part are met.

(b) Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the requirements of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for response established pursuant to this section are subject to the extension of time provisions of § 1.136. After response by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

(c) If the examination pursuant to this section results in approval of the request for a statutory invention registration the applicant will be notified of the intent to publish a statutory invention registration.

A Group 2200 examiner will determine whether the application in which a request for a statutory invention registration has been filed is a pending >nonprovisional< application. If the application was abandoned at the time the request was filed, has been patented, or has been allowed and the issue fee paid, the examiner should return the SIR request to the requester accompanied by a Return of Statutory Invention Registration Request to Requester notice (form PTOL-442).

If the application is pending, the examiner should ascertain whether an Office action with a rejection under 35 U.S.C. 112 has been issued and not responded to. If so, and if there remains any time to respond to the rejection, the examiner should send the applicant a courtesy notice requiring a timely response. If no time for response remains, the application is abandoned and the examiner should inform the applicant of this fact.

After the Group 2200 examiner has ascertained that all outstanding rejections under 35 U.S.C. 112 have been responded to, the examiner should verify that the request for a SIR meets the requirements of 37 CFR 1.293. First, applicant should be notified of any defects

in the signature on the SIR request or of any inadequacy of the SIR fee. A 1-month time period should be set for applicant to correct the signature or fee before any further consideration of the SIR request is given. Form PTOL-444 may be used for this purpose. Next, applicant should be given 1 month to correct any other informalities in the SIR request under 37 CFR 1.293 and any informalities in the application under 37 CFR 1.294 using a Notice of Informal Statutory Invention Registration (SIR) Request, form PTOL-445. The examiner should also determine whether the application complies with 35 U.S.C. 112. If not, a rejection with a 3-month shortened statutory period for response should be made using a Notice of Noncompliance with 35 U.S.C. 112 of application having SIR Request, form PTOL-448. Both form PTOL-445 and form PTOL-448 can be mailed at the same time. If they are, applicant should be given a 3-month shortened statutory period to respond to both forms.

If applicant's response to form PTOL-445 does not correct the defects, the SIR request should be finally refused using a Notice of Final Refusal of Informal Statutory Invention Registration (SIR) Request, form PTOL-446. If applicant's response to the rejection set forth on form PTOL-448 does not bring the application into compliance with 35 U.S.C. 112, the rejection should be made final.

After the application complies with 37 CFR 1.293, 37 CFR 1.294, and 35 U.S.C. 112, the examiner should determine whether the application is involved in a pending interference. If so, applicant should be notified, using form PTOL-449, that no decision will be made on the SIR request until the interference proceedings are concluded.

If the applicant has lost priority of any claims due to a concluded interference, applicant should be given 1 month, using form PTOL-449, to cancel the lost claims (if a statutory invention registration is still desired with claims on which priority was not lost) or to request withdrawal of the request for statutory invention registration (if further prosecution as to patentability is desired). See MPEP § 1109. If none of the claims in the application was lost in interference, and if the application complies with 37 CFR 1.293, 37 CFR 1.294, and 35 U.S.C. 112, then the application is in condition to be prepared for publication. See MPEP § 1107.

An application under secrecy order will be withheld from publication during such period as the national interest requires, and the applicant should be informed of this fact by using a Notice of Statutory Invention Registration (SIR) Acceptance (Form D-11), form PTOL-452.

1105 Review of Final Refusal to Publish SIR

37 CFR 1.295. Review of decision finally refusing to publish a statutory invention registration.

(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the commissioner accompanied by the fee set forth in § 1.17(h) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 1.191. If the decision rejecting claims pursuant to 35 U.S.C.112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

An applicant who is dissatisfied with a final refusal to publish a SIR for reasons other than compliance with 35 U.S.C. 112 may obtain review by filing a petition as set forth in 37 CFR 1.295(a). The petition should be directed to the Group Director of Examining Group 2200.

An applicant who is dissatisfied with a decision finally rejecting claims under 35 U.S.C. 112 may obtain review by filing an appeal with the Board of Patent Appeals and Interferences as set forth in 37 CFR 1.295(b).

1107 Preparing a SIR for Publication [R-1]

In preparing * >a nonprovisional< application with a SIR request for publication, the examiner should fill out the face of the application file jacket in the same manner as in a non-SIR application. Additionally, the examiner should add the notation "OK for SIR" in the space provided for the primary examiner's signature. A form PTO-1547 is attached to the label area of the file jacket to indicate that the application is for a statutory invention registration. An issue classification slip (form PTO-270 or PTO-328) is filled out and attached inside the file jacket in the normal manner with the additional

notation of "SIR" added to the left side of the space allocated for the patent number. The index of claims inside the file jacket is filled out, with the notation " * " indicating the claims to be published in the SIR. If the application contains formal drawings, the final official classification of the application and the figure to be published in the *Official Gazette* are indicated as in non-SIR applications in the spaces provided by the Draftsman's stamp. Otherwise, a yellow tag (form PTO-1364) is attached to the file.

A Notice of Intent to Publish Statutory Invention Registration, form PTOL-451, is prepared and sent to the applicant. Requirements for formal drawings (allowing a 3-month shortened statutory period for response) and examiner's amendments may be attached to the Notice of Intent to Publish Statutory Invention Registration as needed. The application is then forwarded to Publication Division.

1109 Withdrawal of SIR Request [R-1]

37 CFR 1.296. Withdrawal of request for publication of statutory invention registration.

A request for a statutory invention registration which has been filed may be withdrawn prior to the date of the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).

If a request to withdraw a SIR is filed in * >a nonprovisional< application which contains a SIR request before a Notice of Intent to Publish Statutory Invention Registration has been mailed, the Group 2200 examiner should ascertain whether any outstanding rejection under 35 U.S.C. 112 is present in the application. If so, the examiner should require a timely response to the rejection using a Response to Request to Withdraw Request for a Statutory Invention Registration, form PTOL-450. After a timely reply to the rejection is received, the request to withdraw the SIR request will ordinarily be granted and the application forwarded for further examination to whichever examining group would ordinarily examine the art area in which the application is classifiable.

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Any request to withdraw a SIR filed after the mailing date of the Notice of Intent to Publish Statutory Invention Registration must be in the form of a petition pursuant to 37 CFR 1.183 accompanied by the fee set forth in 37 CFR 1.17(h). The Director of Group 2200 will inform the applicant of the decision on the petition via a form PTOL-450 or Response to Petition under 37 CFR 1.295(a), form PTOL-447.

Note that an original SIR application can be abandoned in favor of a continuing application for a patent, claiming the filing date of the earlier filed application, by filing an express abandonment of the original application and a timely request or petition to withdraw the request for a SIR prior to publication of the SIR.

1111 SIR Publication and Effect [R-1]

37 CFR 1.297. Publication of statutory invention registration.

(a) If the request for a statutory invention registration is approved, the statutory invention registration will be published. The statutory invention registration will be mailed to the requester at the correspondence address as provided for in § 1.33(a). A notice of the publication of each statutory invention registration will be published in the Official Gazette.

(b) Each statutory invention registration published will include a statement relating to the attributes of a statutory invention registration. The statement will read as follows:

A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforceable attributes of a patent. No article or advertisement or the like may use the term patent, or any term suggestive of a patent, when referring to a statutory invention registration. For more specific information on the rights associated with a statutory invention registration see 35 U.S.C. 157.

Published SIR's are sequentially numbered in a separate "H" series, starting with number "H1".

In accordance with 35 U.S.C. 157(c), a published SIR will be treated the same as a U.S. patent for all defensive purposes, usable as a reference as of its filing date in the same manner as a patent. A SIR is a "constructive reduction to practice" under 35 U.S.C. 102(g) and "prior art" under all applicable sections of 35 U.S.C. 102 including section 102(e). SIR's are classi-

fied cross-referenced, and placed in the search files, disseminated to foreign patent offices, stored in Patent and Trademark Office computer tapes, made available in commercial data bases, and announced in the Official Gazette.

The waiver of patent rights to the subject matter claimed in a statutory invention registration takes effect on publication (37 CFR 1.293(c)) and may affect the patentability of claims in related applications without SIR requests, such as divisional or other continuing applications, since the waiver of patent rights is effective for all inventions claimed in the SIR and would effectively waive the right of the inventor to obtain a patent on the invention claimed in the same application or in any other application not issued before the publication date of the SIR. If an application containing generic claims is published as a SIR, the waiver in that application applies to any other related applications to the extent that the same invention claimed in the SIR is claimed in the other application. Examiners should apply standards similar to those applied in making "same invention" double patenting determinations to determine whether a waiver by an inventor to claims in a SIR precludes patenting by the same inventor to subject matter in any related application. If the same subject matter is claimed in an application and in a published statutory invention registration naming a common inventor, the claims in the application should be rejected as being precluded by the waiver in the statutory invention registration. See 37 CFR 1.106(e). A rejection as being precluded by a waiver in a SIR cannot be overcome by a terminal disclaimer.

Examiners should note that the holder of a SIR will not be able to file a reissue application to recapture the rights, including the right to exclude others from making, using, * selling>, offering to sell, or importing< the invention, that were waived by the initial publication of the SIR.

