

Chapter 1700 Miscellaneous

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1701 Office Personnel Not To Express Opinion on Validity or Patentability of Patent

Every patent is presumed to be valid. 35 U.S.C. 282, first sentence. Public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

- (A) an examination of a reissue application of the patent,
- (B) a reexamination proceeding to reexamine the patent, or
- (C) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. Members of the patent examining corps are cautioned to be especially wary of any inquiry from any person outside the USPTO, including an employee of another U.S. Government agency, the answer to which might indicate that a particular patent should not have issued. No USPTO employee may pursue a bounty offered by a private sector source for identifying prior art. The acceptance of payments from outside sources

for prior art search activities may subject the employee to administrative disciplinary action.

When a field of search for an invention is requested, examiners should routinely inquire whether the invention has been patented in the United States. If the invention has been patented, no field of search should be suggested.

Employees of the USPTO, particularly patent examiners who examined an application which matured into a patent or a reissued patent or who conducted a reexamination proceeding, should not discuss or answer inquiries from any person outside the USPTO as to whether or not a certain reference or other particular evidence was considered during the examination or proceeding and whether or not a claim would have been allowed over that reference or other evidence had it been considered during the examination or proceeding. Likewise, *employees* are cautioned against answering any inquiry concerning any entry in the patent or reexamination file, including the extent of the field of search and any entry relating thereto. The record of the file of a patent or reexamination proceeding must speak for itself.

Practitioners can be of material assistance in this regard by refraining from making improper inquiries of members of the patent examining corps. Inquiries from members of the public relating to the matters discussed above must of necessity be refused and such refusal should not be considered discourteous or an expression of opinion as to validity or patentability.

1701.01 Office Personnel Not To Testify [R-2]

It is the policy of the United States Patent and Trademark Office (USPTO) that its employees, including patent examiners, will not appear as witnesses or give testimony in legal proceedings, except under the conditions specified in **>37 CFR Part 104, Subpart C<. Any employee who testifies contrary to this policy will be *dismissed or removed*. **

Whenever an employee of the USPTO, including a patent examiner, is asked to testify or receives a subpoena, the employee shall immediately notify the Office of the USPTO General Counsel. Inquiries requesting testimony shall be also referred immediately to the Office of the USPTO General Counsel.

Patent examiners and other USPTO employees performing or assisting in the performance of quasi-judicial functions, are forbidden to testify as experts or to express opinions as to the validity of any patent.

Any individual desiring the testimony of an employee of the USPTO, including the testimony of a patent examiner or other quasi-judicial employee, must comply with the provisions of 37 CFR Part 104, Subpart C.

A request by a third party to take deposition testimony of a patent examiner in a pending *ex parte* reexamination proceeding will generally be denied in view of the *ex parte* nature of the reexamination proceeding.

A request for testimony of an employee of the USPTO should be made to the Office of the USPTO General Counsel at least **10 working days** prior to the date of the expected testimony.

If an employee is authorized to testify, the employee will be limited to testifying about facts within the employee's personal knowledge. Employees are prohibited from giving expert or opinion testimony. *Fischer & Porter Co. v. Corning Glass Works*, 61 F.R.D. 321, 181 USPQ 329 (E.D. Pa. 1974). Likewise, employees are prohibited from answering hypothetical or speculative questions. *In re Mayewsky*, 162 USPQ 86, 89 (E.D. Va. 1969) (deposition of an examiner must be restricted to relevant matters of fact and must avoid any hypothetical or speculative questions or conclusions based thereon); *Shaffer Tool Works v. Joy Mfg. Co.*, 167 USPQ 170 (S.D. Tex. 1970) (deposition of examiner should be limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses, or conclusions of the examiner in acting upon a patent application). Employees will not be permitted to give testimony with respect to subject matter which is privileged. Several court decisions limit testimony with respect to quasi-judicial functions performed by employees. Those decisions include *United States v. Morgan*, 313 U.S. 409, 422 (1941) (improper to inquire into mental processes of quasi-judicial officer or to examine the manner and extent to which the officer considered an administrative record); *Western Electric Co. v. Piezo Technology, Inc.*, 860 F.2d 428, 8 USPQ2d 1853 (Fed. Cir. 1988) (patent examiner may not be compelled to answer questions which probe the examiner's techni-

cal knowledge of the subject matter of a patent); *McCulloch Gas Processing Co. v. Department of Energy*, 650 F.2d 1216, 1229 (Temp. Emer. Ct. App. 1981) (discovery of degree of expertise of individuals performing governmental functions not permitted); *In re Nilssen*, 851 F.2d 1401, 7 USPQ2d 1500 (Fed. Cir. 1988) (technical or scientific qualifications of examiners-in-chief are not legally relevant in appeal under 35 U.S.C. 134 since board members need not be skilled in the art to render obviousness decision); *Lange v. Commissioner*, 352 F. Supp. 166, 176 USPQ 162 (D.D.C. 1972) (technical qualifications of examiners-in-chief not relevant in 35 U.S.C. 145 action).

In view of the discussion above, if an employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the USPTO, the employee will not be permitted to give testimony in response to questions that the Office determines are impermissible. Impermissible questions include, but are not limited to, questions directed to discovering the mental processes or expertise of a quasi-judicial official, such as:

- (A) Information about that employee's:
 - (1) Background;
 - (2) Expertise;
 - (3) Qualifications to examine or otherwise consider a particular patent or trademark application;
 - (4) Usual practice or whether the employee followed a procedure set out in any Office manual of practice (including the MPEP or TMEP) in a particular case;
 - (5) Consultation with another Office employee;
 - (6) Understanding of:
 - (a) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file;
 - (b) Prior art;
 - (c) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file;
 - (d) Any Office manual of practice;
 - (e) Office regulations;
 - (f) Patent, trademark, or other law; or
 - (g) The responsibilities of another Office employee;

(7) Reliance on particular facts or arguments;

(B) To inquire into the manner in and extent to which the employee considered or studied material in performing a quasi-judicial function; or

(C) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

Any request for testimony addressed or delivered to the Office of the USPTO General Counsel shall comply with 37 CFR 104.22(c). All requests must be in *writing*. The need for a subpoena may be obviated where the request complies with 37 CFR 104.22(c) if the party requesting the testimony further meets the following conditions:

(A) The party requesting the testimony identifies the civil action or other legal proceeding for which the testimony is being taken. The identification shall include the:

- (1) Style of the case;
- (2) Civil action number;
- (3) District in which the civil action is pending;
- (4) Judge assigned to the case; and
- (5) Name, address, and telephone number of counsel for all parties in the civil action.

(B) The party agrees not to ask questions seeking information which is precluded by 37 CFR 104.23;

(C) The party shall comply with applicable provisions of the Federal Rules of Civil Procedure, including Rule 30, and give 10 working days notice to the Office of the USPTO General Counsel prior to the date a deposition is desired. Fifteen working days notice is required for any deposition which is desired to be taken between November 15 and January 15;

(D) The party agrees to notice the deposition at a place convenient to the USPTO. The Conference Room in the Office of the USPTO General Counsel is deemed to be a place convenient to the Office; and

(E) The party agrees to supply a copy of the transcript of the deposition to the USPTO for its records.

Absent a written agreement meeting the conditions specified in paragraphs (A) through (E), a party must comply with the precise terms of 37 CFR 104.22(c) and the USPTO will not permit a deposition without issuance of a subpoena.

1702 Restrictions on Former Examiners

37 CFR 10.10. Restrictions on practice in patent cases.

(a) Only practitioners who are registered under § 10.6 or individuals given limited recognition under § 10.9 will be permitted to prosecute patent applications of others before the Office.

(b) No individual who has served in the patent examining corps of the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking,

(1) Not to prosecute or aid in any manner in the prosecution of any patent application pending in any patent examining group during his or her period of service therein and

(2) Not to prepare or prosecute or to assist in any manner in the preparation or prosecution of any patent application of another (i) assigned to such group for examination and (ii) filed within two years after the date he or she left such group, without written authorization of the Director. Associated and related classes in other patent examining groups may be required to be included in the undertaking or designated classes may be excluded from the undertaking. When an application for registration is made after resignation from the Office, the applicant will not be registered if he or she has prepared or prosecuted or assisted in the preparation or prosecution of any patent application as indicated in the paragraph. Knowingly preparing or prosecuting or providing assistance in the preparation or prosecution of any patent application contrary to the provisions of this paragraph shall constitute misconduct under § 10.23(c)(13) of this part.

(c) A practitioner who is an employee of the Office cannot prosecute or aid in any manner in the prosecution of any patent application before the Office.

(d) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

See also MPEP § 309.

1703 The Official Gazette [R-2]

The *Official Gazette of the United States Patent and Trademark Office (Official Gazette)* is published >electronically< every Tuesday in two sections, the *Official Gazette – Patents* and the *Official Gazette – Trademarks*. **

The *Official Gazette — Patents* reports the reexamination certificates, reissues, plant patents, utility patents, and design patents issued and statutory invention registrations (if any) published on that day. **>The *Official Gazette — Patents* (eOG:P) allows browsing through the issued patents for the week. The eOG:P can be browsed by classification or type of patent, for example, utility, design, and plant. Specific patents can be accessed by class/subclass or patentee name. Links are provided to the various pages of the eOG:P:

(A) *Browse by Class/Subclass* page to access patents by a specific classification;

(B) *Classification of Patents* page with links to patents by a range of classifications;

(C) *Browse Granted Patents* page to access a patent by patent number or link to patents by type;

(D) *Index of Patentees* page to browse by names of inventors and assignees in either a cumulative alphabetical index or individual indexes by type of patent. Each patentee listing contains a link to the patent;

(E) *Geographical Index of Inventors* to link to patents by the state or country of residence of the first listed inventor; and

(F) *Notices* page containing the text of important notices for the week.<

As to each patent, the following information is given:

- (A) Patent number;
- (B) Title of the invention;
- (C) Applicant's name;
- (D) Applicant's city and state of residence and, if unassigned, applicant's mailing address;
- (E) Assignee's name, city and state of residence, if assigned;
- (F) U.S. or PCT parent application data, if any;
- (G) Filing date;
- (H) Application number;
- (I) Foreign priority application data, if any;
- (J) International classification;
- (K) U.S. classification by class and subclass;
- (L) Number of claims;
- (M) Selected figure of the drawing, if any **;
- (N) A claim or claims; *
- (O) For reissue patents, the original patent number and issue date, and the original application number and filing date>; and
- (P) Patent Application Publication Number and Publication date, if any.<

The *Official Gazette – Trademarks* >is published electronically and< contains ** an illustration of each trademark published for opposition, an alphabetical list of registered trademarks, a classified list of registered trademarks, an index of registrants, a list of can-

celed trademark registrations, and a list of renewed trademark registrations.

**The information in the *Official Gazette* pertaining to each issued patent and each trademark registration can be obtained from the Patent Grants Database and the U.S. Trademark Electronic Search System (TESS) respectively, both also available on the USPTO web site.

>Regular and special notices of the United States Patent and Trademark Office are published in the *Official Gazette Notices*, both as part of the *Official Gazette – Patents* (eOG:P) and as a separate publication. The notices that are included in this publication include notices of patent and trademark suits, disclaimers filed, Certificates of Correction issued, lists of applications and patents available for license or sale, notices of 37 CFR 1.47 applications, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, registration of attorneys and agents, reprimands, suspensions, and exclusions of registered attorneys and agents, and notices to parties not reached by mail. The *Official Gazette Notices* are available on the United States Patent and Trademark Office web site (www.uspto.gov).< Paper copies of the *Official Gazette* ** *Notices* are available from the Government Printing Office. Orders >for the *Official Gazette Notices*< should be addressed and subscriptions should be made payable to the Superintendent of Documents, Government Printing Office, Washington, D.C. 20402.

1704 Application Records and Reports [R-2]

The PALM (Patent Application Locating and Monitoring) System is the automated data management system used by the United States Patent and Trademark Office (USPTO) for the retrieval and/or online updating of the computer record of each patent application. The PALM System also maintains examiner time, activity, docket, and technical support staff backlog records.

Information retrieval from PALM is by means of ** the PALM intranet. **>Transactions are< entered via bar code readers>, by keyed entries, or by making an appropriate choice in a drop down menu<. Among other items, classification, examiner docket, attorney,

inventor, and prosecution history data as well as the location of each application can be retrieved and updated online with PALM.

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I. < DOCKET REPORTS

The recording of changes to examiner dockets is accomplished by PALM simultaneously with the recording of incoming and outgoing communications, transfers of applications to and from dockets, and other types of updating of the application record. The status of each examiner's docket can be determined by means of ** the PALM intranet and is supplemented by periodic printed reports. Docket reports that are generated by PALM include the individual examiner new, special, and amended docket which lists applications in priority order; the individual examiner rejected application docket; the individual examiner new application profile, which lists the totals of new applications in each docket, sorted by month of filing; and various summaries of the above reports at the art unit, Technology Center (TC), and corps levels.

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II. < BIWEEKLY TIME AND ACTIVITY REPORTS

All reporting of examiner time and activity is on a biweekly basis. Each examiner's examining and non-examining time, as listed on the examiner's Biweekly Time Worksheet, PTO-690E, is entered into PALM for use in the computation of productivity data. The biweekly reports produced include the individual Biweekly Examiner Time and Activity Report which lists, by application number, all applications for which actions have been counted during the biweekly period. The type of action counted for each application is also indicated on the report. This report also includes examiner time data, an action summary, and cumulative summaries to date for the current quarter and fiscal year. Various summary reports at the Art Unit, TC, and Corps levels are also produced.

1705 Examiner Docket, Time, and Activity Recordation [R-2]

Actions prepared by examiners are submitted to their respective legal instrument examiners for processing in accordance with the procedures set forth below.

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I. < PROCEDURES FOR REPORTING AN EXAMINER'S ACTION

(A) The examiner completes an Examiner's Case Action Worksheet, Form PTO-1472, which identifies the type of action prepared. The worksheet is attached to the application >if the application is maintained in a paper file, or placed in an Action folder with the Office action if the application is an Image File Wrapper (IFW) application< for processing by the legal instrument examiner;

(B) The legal instrument examiner checks the worksheet to verify that the examiner provided all necessary information relating to that action;

(C) The legal instrument examiner enters the type of action and the count date thereof on the Contents flap of the file wrapper >if the application is maintained in a paper file, or has the action added to the IFW (see IFW Manual)<; and

(D) The legal instrument examiner enters the examiner's action for the application directly into PALM **.

Each examiner's action that is counted and reported to the PALM system will be listed by application number on the Biweekly Examiner Time and Activity Report. The examiner should check his/her Biweekly Examiner Time and Activity Report to verify that all applications worked on for the biweekly report period are properly listed.

Examples of examiner's actions that are reported to PALM by the legal instrument examiner, but are not listed on the Biweekly Examiner Time and Activity Report, include examiner's amendments, actions in reexamination proceedings, interview summaries, transfers of applications, and supplemental Office actions and miscellaneous Office letters which do not set a period for reply.

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FORM PTO-1472
(Rev. 4-2002)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

EXAMINER'S CASE ACTION WORKSHEET

Application No. _____	Legal Instrument Examiner _____
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CHECK TYPE OF ACTION

DATE OF COUNT

<input type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ <small>(Approval for Disposal)</small>	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ <small>(initial)</small>
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal <small>(use only after FAOM)</small>	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter <small>(With Shortened Statutory Period Set)</small>	<input type="checkbox"/> Notice of Non-Responsive Amendment <small>(With One Month Time Period set)</small>	<input type="checkbox"/> Miscellaneous Office Letter <small>(No Response Period Set)</small>
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action <small>(excluding Examiner's Answer)</small>	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ <small>(initial)</small>
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other Specify: _____

Examiner's Name: _____

AU: _____

II. < COUNTING OF FIRST ACTION ON THE MERITS (FAOM) >

Office actions on the merits consist of rejections (final and non-final), *Ex parte Quayle* actions, and allowances.

The first time an examiner performs one of the above merit actions, he/she receives credit for a First Action on the Merits (FAOM) on the production reports.

A second/subsequent but FAOM usually occurs when the first action is a restriction/election action and the second action is an action on the merits. The examiner indicates the type of second action on the Examiner's Case Action Worksheet, and the PALM system will automatically determine if it is a FAOM. If the second action is a FAOM, the action will be listed and credited on the Biweekly Examiner Time and Activity Report as a Second/Subsequent FAOM.

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III. < COUNTING OF DISPOSALS

An examiner receives a "disposal" count for the following actions:

- (A) Allowance;
- (B) Abandonment;
- (C) Examiner's Answer;
- (D) International Preliminary Examination Report;
- (E) Statutory Invention Registration (SIR) disposal (only after a FAOM; see MPEP § 1101); and
- (F) Interference wherein the application would be in condition for allowance but for the interference.

These same items constitute the "disposals" for performance evaluation of examining art units and TCs. However, disposals at the Office level consist only of allowances and abandonments.

For either an allowance or an abandonment after an Examiner's Answer or decision by a court or the Board of Patent Appeals and Interferences, no disposal credit is received, though these actions are indicated on the Biweekly Examiner Time and Activity Report.

IV. < CORRECTION INFORMATION

(A) If any information is either missing from or incorrect on the Biweekly Examiner Time and Activity Report, the examiner should promptly notify the legal instrument examiner by providing all the pertinent information necessary to make the changes to the PALM system (e.g., examining hours, application number, type of action, etc.).

(B) The legal instrument examiner will report the necessary changes and corrections directly into PALM. These changes will be listed on the next Biweekly Examiner Time and Activity Report.

(C) If any information is missing from the last Biweekly Examiner Time and Activity Report of a quarter (except at the end of a fiscal year) or is incorrect, the examiner should promptly notify the legal instrument examiner and his/her supervisory patent examiner (SPE). The legal instrument examiner will make the appropriate changes directly into the PALM system. The changes will be listed on the next Biweekly Examiner Time and Activity Report. However, these changes will not be reflected in the last Quarter's Report; the examiner's SPE may manually make an adjustment to the records to show these changes.

(D) In order to ensure that all PALM reports are correct at the end of the fiscal year (rating period), a special correction cycle is provided on the PALM system. If any information is missing from or is incorrect on the last Biweekly Examiner Time and Activity Report, the examiner should immediately notify the legal instrument examiner and his/her SPE. These changes will be reflected in the examiner's final biweekly report for the entire fiscal year.

1706 Disclosure Documents [R-2]

A service provided by the United States Patent and Trademark Office (USPTO) is the acceptance and preservation for two years of "Disclosure Documents" as evidence of the date of conception of an invention. >However, inventors are strongly encouraged to file a provisional patent application instead of a Disclosure Document. A provisional application for patent is a U.S. national application for patent filed in the USPTO under 35 U.S.C. 111(b). It allows filing without a formal patent claim, oath or declaration, or any

information disclosure (prior art) statement. It provides the means to establish an early effective filing date in a non-provisional patent application filed under 35 U.S.C. 111(a). It also allows the term "Patent Pending" to be applied to products for which a patent application has been filed. A provisional application has a pendency lasting 12 months from the date the provisional application is filed. The 12-month pendency period cannot be extended. Unlike a Disclosure Document, the benefit of the filing date of the provisional application may be relied upon pursuant to 35 U.S.C. 119(e) in a corresponding non-provisional application or for foreign priority purposes when filing a patent application on the invention in other countries. See MPEP § 201.04(b) and § 601.01(b).

I. < THE PROGRAM

A paper disclosing an invention (called a Disclosure Document) and signed by the inventor or inventors may be forwarded to the USPTO by the inventor (or by any one of the inventors when there are joint inventors), by the owner of the invention, or by the attorney or agent of the inventor(s) or owner. The Disclosure Document will be retained for two years, and then be destroyed unless it is referred to in a separate letter in a related patent application filed within those two years.

THE DISCLOSURE DOCUMENT IS NOT A PATENT APPLICATION, AND THE DATE OF ITS RECEIPT IN THE USPTO WILL NOT BECOME THE EFFECTIVE FILING DATE OF ANY PATENT APPLICATION SUBSEQUENTLY FILED. THESE DOCUMENTS WILL BE KEPT IN CONFIDENCE BY THE USPTO.

This program does not diminish the value of the conventional, witnessed, permanently bound, and page-numbered laboratory notebook or notarized records as evidence of conception of an invention.

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II. < CONTENT OF DISCLOSURE

The benefits afforded by the Disclosure Document will depend directly upon the adequacy of the disclosure. It is strongly recommended that the document contain a clear and complete explanation of the manner and process of making and using the invention in

sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention. When the nature of the invention permits, a drawing or sketch should be included. The use or utility of the invention should be described, especially in chemical inventions. Where the invention is directed to a design, the appearance presented by the object should be described.

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III. < PREPARATION OF THE DOCUMENT

A standard format for the Disclosure Document is required to facilitate the USPTO's electronic data capture and storage. The Disclosure Document (including drawings or sketches) must be on white letter-size (8 1/2 by 11-inch) or A4 (21.0 by 29.7 cm) paper, written on one side only, with each page numbered. Text and drawings must be sufficiently dark to permit reproduction with commonly used office copying machines. Oversized papers, even if foldable to the above dimensions, will not be accepted. Attachments such as videotapes and working models will not be accepted and will be returned.

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IV. < OTHER ENCLOSURES

The Disclosure Document must be accompanied by a separate cover letter signed by the inventor stating that he or she is the inventor and requesting that the material be received under the Disclosure Document Program. The inventor's request may take the following form:

The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years.

A Disclosure Document Deposit Request form (PTO/SB/95) can also be used as a cover letter. This form is available at the USPTO's Internet site or by calling the USPTO General Information Services Division (see MPEP § 1730).

A notice with an identifying number and date of receipt in the USPTO will be mailed to the customer, indicating that the Disclosure Document may be relied upon only as evidence of conception and that a

patent application should be diligently filed if patent protection is desired. The USPTO prefers that applicants send two copies of the cover letter or Disclosure Document Deposit Request form and one copy of the Disclosure Document, along with a self-addressed stamped envelope. The second copy of the cover letter or form will be returned with the notice. It is not necessary to submit more than one copy of the document in order for it to be accepted under the Disclosure Document Program.

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V. < DISPOSITION

The Disclosure Document will be preserved by the USPTO for two years after its receipt. It will then be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-year period. The separate letter filed in the related patent application must identify not only the patent application, but also the Disclosure Document by its title, number, and date of receipt in the USPTO. Acknowledgment of such letters will be made in the next official communication or in a separate letter from the USPTO.

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VI. < ACKNOWLEDGMENT

When a paper referring to a Disclosure Document is filed in a patent application within 2 years after the filing of a Disclosure Document, the examining Technology Center (TC) technical support staff member will prepare either (1) a memorandum indicating that a reference to Disclosure Document No. -- has been made in Patent Application No. --, or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the Customer Contact Team of the Office of Initial Patent Examination (OIPE).

Upon receipt, the Customer Service Branch of the OIPE prepares a retention label (PTO-150) and attaches it to the Disclosure Document, and indicates such on the forwarded memo or copy, and returns the memo or copy to the TC. The returned memo or copy is stapled to the inside left flap of the file wrapper >if the application is maintained in a paper file, or added to the Image File Wrapper (IFW) if the application is

an IFW application,< so that the examiner's attention is directed to it when the next Office action is prepared. If prosecution before the examiner has been concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the examining TC technical support staff member.

After the acknowledging letter is mailed, the paper number of the acknowledgment is noted in the application file. The returned memo or copy is ** retained with the original paper referring to the Disclosure Document in the file wrapper.

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VII. < FEE

A fee of \$10, as set forth in 37 CFR 1.21(c), in the form of a check or money order made payable to “* Commissioner for Patents” must accompany the Disclosure Document when it is submitted to the USPTO. Documents not accompanied by the full fee will be returned. Mail the Disclosure Document along with the fee to:

**>Mail Stop DD
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450<

Applicants can request a copy of their Disclosure Document as filed in the USPTO if they are the original submitters of the document. The request must be made in writing and accompanied by a fee for \$25.

Fees are subject to change annually. To confirm current fees, contact the General Information Services Division or visit the USPTO's Internet site (see MPEP § 1730).

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VIII. < NOTICE TO INVENTORS

The two-year retention period is not a “grace period” during which the inventor can wait to file his or her patent application without possible loss of benefits. >As explained above, it may be advisable to file a provisional application instead of a Disclosure Document.< It must be recognized that, in order to establish priority of invention, an affidavit or testimony referring to a Disclosure Document must usually also

establish diligence in completing the invention or in filing the patent application after the filing of the Disclosure Document.

Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a U.S. patent on it. See 35 U.S.C. 102(b). Foreign patent laws in this regard may be much more restrictive than U.S. laws.

The USPTO advises inventors who are not familiar with the requirements of U.S. patent law and procedures to consult an attorney or agent registered to practice before the USPTO. A list of *Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office* can be found at the USPTO's Internet site. See MPEP § 1730 for additional sources of this list.

As a service to USPTO's customers, the three Partnership Patent and Trademark Depository Libraries (PTDLs) listed below have been authorized to act as USPTO's "agent" in accepting documents under the Disclosure Document Program. This service provides customers with a completed transaction on-site, eliminating the wait for USPTO notification of acceptance. The documents are stamped with an identifying number and date at the time of receipt by the PTDL. Original documents are sent to the USPTO for processing and retention.

**>Texas Intellectual Property Partnership (TIP2)

Texas A&M University Libraries

Sterling C. Evans Library Annex

College Station, TX 77843-5000

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Great Lakes Patent and Trademark Center at the Detroit Public Library (GLPTC)

5201 Woodward Avenue (second level)

Detroit, MI 48202

313-833-3379 or 800-547-0619

Fax: 313-833-6481

South Central Intellectual Property Partnership at Rice University (SCIPPR)
Fondren Library - MS220
6100 South Main Street
Houston, TX 77521-1892
713-285-5196
Fax: 713-737-6341

To locate a Patent and Trademark Depository Library (PTDL) near you, consult the complete listing of PTDLs found in every issue of the *Official Gazette*, call the USPTO General Information Services Division, or access the USPTO's Internet site (see MPEP § 1730). The nationwide network of PTDLs has collections of patents and patent-related reference materials available to the public, including automated access to USPTO data bases. Contact the PTDL prior to your visit to learn about its collections, services, and hours.

1711 U.S.-Philippines Search Exchange

The United States-Philippines search exchange program involves patent applications filed in the United States which are subsequently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program operates as follows:

The applicant files his or her application in the United States Patent and Trademark Office (USPTO) which will process the application in the normal manner and examine the application in the usual time sequence.

If the applicant should later file a corresponding application in the Philippines Patent Office, he or she may elect to use the special filing procedure. Under this special filing procedure, applicant files his or her application in the Philippines accompanied by a notice of election to participate in the special procedure, which notice of election contains a certification that the description (excluding references to related applications), claims, and drawings are identical to those of the corresponding application originally filed in the United States. The earlier filed application must be fully identified, and, in applications without a claim of priority, a certified copy of the earlier filed U.S. application must be submitted to the Philippines

Patent Office. In addition, applicant must also agree that all amendments to his or her U.S. application will also be made with respect to his or her application filed in the Philippines.

In the USPTO, applicant will regularly file two copies of each amendment. One copy must be marked "Copy for Philippines Patent Office." Upon termination of prosecution, the USPTO shall remove all copies so marked from the U.S. file and promptly forward the same to the Philippines Patent Office.

Election forms for participation in this special program must be signed in duplicate and simultaneously accompany the application to be filed in the Philippines.

Upon receipt of properly filed notice of election, the Philippines Patent Office will notify the USPTO of the election by forwarding one copy of the election forms to the USPTO. The Philippines Patent Office will defer action on the Philippines application pending receipt of information as to the disposition of the application by the USPTO. If no such information is received by the Philippines Office within a reasonable amount of time from the date of filing in the Philippines, the Philippines Office may, either on its own initiative, or at applicant's request, inquire as to the status of the U.S. application and, if desired, proceed with its own independent examination.

Upon disposal of the application by the USPTO, appropriate information will be sent to the Philippines Patent Office which will include all necessary identifying data, whether allowed or abandoned, notice of allowance, copies of documents cited during examination, a copy of the last office action and, when necessary, any earlier actions which may be included by reference in the last action. The Philippines Office will then make its own complete office action based upon the claims as amended with USPTO, performing whatever checks desired and searching for copending interfering applications. Alternatively, the Philippines may request applicant to show cause why the results of the U.S. examination should not be accepted in the Philippines. All avenues of appeal will remain open to the applicant.

Where copending applications are cited and applied during examination in the USPTO full examination will not be forwarded to the Philippines Patent Office, and the fact that a U.S. copending application was

cited would be noted as a matter of information, since such references are inapplicable in the Philippines.

Where the application originates in the Philippines Patent Office and is subsequently filed in the USPTO, a similar procedure as outlined above, consonant with U.S. law, will be followed.

It is believed that this program will facilitate the handling of U.S. origin applications filed in the Republic of the Philippines resulting in a savings in time and expense of prosecution to U.S. applicants.

1720 Dissemination of Court and Board of Patent Appeals and Interferences Decisions [R-2]

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I. < COURT DECISIONS

The Office of the Solicitor forwards to the Office of the * Commissioner for Patents copies of all recent court decisions in patent cases where a precedential opinion is issued. The Office of the * Commissioner for Patents will routinely **>forward< these opinions to TC Directors, the Patent Academy, and the Director of the Office of Patent Quality * >Assurance<.

TC Directors, in turn, are to make copies available to supervisors and other individuals as the TC Director determines to be appropriate. TC Directors are encouraged to discuss the contents of the opinions in their staff meetings, particularly where such meetings are being held to reinforce examination quality.

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II. < BOARD OF PATENT APPEALS AND INTERFERENCES DECISIONS

A decision rendered by the Board of Patent Appeals and Interferences (Board) is returned to the examiner through the TC Director and the examiner's supervisor. The examiner takes action consistent with the decision rendered by the Board unless rehearing of the Board decision will be requested (MPEP § 1214.04). The TC Director may circulate and discuss the decision among some or all of the supervisors in the TC, and the supervisors, in turn, may circulate the decision among the examiners in their art units, depending on the subject matter or issues in the decisions.

1721 Treatment of Court and Board of Patent Appeals and Interferences Decisions Affecting Patent and Trademark Office Policy and Practice [R-2]

In the event the Board of Patent Appeals and Interferences (Board) or court decision is one that significantly adds to the body of law by, for example, addressing a new legal or procedural issue, or providing a new interpretation of a prior decision, such a decision may result in an internal United States Patent and Trademark Office (USPTO) memorandum pointing out the significance of the decision to the examination process.

When any examiner or supervisor in the Patent Examining Corps concludes that a recent decision of the Board or a court affects existing USPTO policy or practice, he or she should bring the matter to the attention of his/her TC Director through normal chain-of-command procedures.

When the TC Director believes that guidance to the Corps is warranted as a result of a decision, the TC Director should consult with the Deputy Commissioner for Patent Examination Policy and provide a draft of the guidance that is recommended as appropriate under the circumstances. The Deputy * Commissioner for Patent Examination Policy will then consult appropriate Office officials, as necessary, to formulate a recommendation to the * Commissioner for Patents on the policy implications of the opinion.

It may be necessary for the *>Director<, General Counsel, Solicitor, Chief Administrative Patent Judge, *>Commissioner< for Patents, Deputy *>Commissioner< for Patent Examination Policy, Deputy *>Commissioner< for *>Patent Operations< and TC Director making the recommendation to meet to review and discuss the policy ramifications of the **>opinion and recommended guidance to enable< the *>Director< to decide how the USPTO will proceed.

Communication of the decision on the policy implications of the court or Board decision will normally take place by either notice in the *Official Gazette* and/or via memorandum to USPTO personnel. Ultimately, the policy implications of the decision will be officially incorporated into the Manual of Patent Examining Procedure and Patent Academy curriculum

materials during the next update cycle for these reference materials.

1730 Information Sources [R-2]

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I. < IN GENERAL

General information about patents, trademarks, products and services offered by the United States Patent and Trademark Office (USPTO), and other related information is available by contacting the USPTO's General Information Services Division at:

800-PTO-9199 or 703-308-HELP
(FAX) 703-305-7786
(TDD) 703-305-7785

An automated message system is available 7 days a week, 24 hours a day providing informational responses to frequently asked questions and the ability to order certain documents. Customer service representatives are available to answer questions, send materials or connect customers with other offices of the USPTO from 8:30 a.m. - 8:00 p.m. EST/EDT, Monday-Friday excluding federal holidays.

For other technical patent information needs, the *>Inventors< Assistance Center can be reached through customer service representatives at the above numbers, Monday through Friday (except federal holidays) from 8:30 a.m. to 5:00 p.m. EST/EDT.

For questions or concerns relating to other technical trademark matters, the Trademark Assistance Center can be reached at 703-308-9000 or by facsimile at 703-308-7016.

General information brochures can also be obtained in person from the Patent Search Room located in Crystal Plaza 3, Room 1A03, 2021 South Clark Place, Arlington, VA 22202.

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II. < USPTO INTERNET SITE

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A. < General Information

The USPTO web site (<http://www.uspto.gov> or <ftp.uspto.gov>) provides a wealth of information to all users. The USPTO web site offers links to news and

notices (such as announcements, press releases, *Official Gazette* Notices and *Federal Register* Notices), USPTO contacts and addresses, activities and education related pages (such as the PTDL and Independent Inventor programs and the Kids Pages), patent specific information (such as issued patents and published patent applications, general information pertaining to applying for a patent, electronic filing of patent applications, and reference materials such as the MPEP and examination guidelines), and trademark specific information (such as the Trademark Manual of Examining Procedure and the U.S. Trademark Electronic Search System (TESS)). In addition, the web site allows downloading of a variety of USPTO forms (including PCT forms), ordering copies of patents and trademarks, accessing a list of all current fees, paying patent maintenance fees, replenishing deposit accounts, accessing various legal materials, linking to related web sites, etc.

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B. < Patent Related Databases

The USPTO web site offers two patent database collections which provide the public with flexible and powerful search capabilities. The Patent Grants Database provides access to the full-text of all U.S. patents issued since 1976, and to the full-page images of all U.S. patents issued since 1790. The Patent Applications Database provides both full-text and full-page images of all U.S. patent applications published since March 15, 2001.

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C. < Patent Electronic Business Center

The Patent Electronic Business Center (EBC) allows USPTO customers to retrieve data, check the status of pending actions, and submit information and applications. The tools currently available in the Patent EBC are Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS). >The hours of operation of the EBC are Monday to Friday 6 am - Midnight Eastern Standard time. The EBC can be reached by telephone at (866-217-9197) (toll-free), 703-305-3028, or 703-308-6845. The EBC may be reached by e-mail at ebc@uspto.gov.

PAIR (<http://pair.uspto.gov>) provides customers direct secure access to their own patent application * information >, and, if available, the Image File Wrapper (IFW) of the application (Private PAIR)<, as well as to general patent information publicly available >(Public PAIR). Private PAIR allows customers access to their own patent application when a Customer Number is associated with the correspondence address for the patent application and the customer is associated with the customer number. *Pro se* inventors and registered patent attorneys and patent agents can be associated with a Customer Number. See MPEP § 403 for Customer Number practice. Questions about IFW images viewed in PAIR should be directed to the Patent EBC. Public PAIR provides access to patent application information related to applications that have been published as patent application publications or issued as patents. For example, Public PAIR provides information on the patent term adjustment calculation, as well as the maintenance fee payment information for a patent<.

EFS allows customers to electronically file patent application documents securely via the Internet. EFS is a system for submitting new utility patent applications and pre-grant publication submissions in electronic publication-ready form. EFS includes software to help customers prepare submissions in eXtensible Markup Language (XML) format and to assemble the various parts of the application as an electronic submission package. EFS * allows the submission of Computer Readable Format (CRF) sequence listings >and electronic information disclosure statements< for pending * patent applications which were filed in paper form. >EFS can also be used to submit provisional applications as well as assignment documents for patent applications and patents.

III. < PCT

For questions and information concerning the Patent Cooperation Treaty (PCT), the PCT Help Desk is available to provide assistance and may be reached by telephone at (703) 305-3257 between the hours of 9:00 am and 4:30 pm (EST/EDT), Monday through Friday, or by facsimile at (703) 305-2919, 24 hours a day. In addition, helpful information is available through the internet at the >Office of< PCT Legal *>Administration< page of the USPTO web site and

at the World Intellectual Property Office web site (<http://www.wipo.org/>).

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IV. < USPTO SEARCH AND INFORMATION RESOURCE FACILITIES

The following USPTO search and information resource facilities are accessible to the public:

(A) Patent Search Room (Crystal Plaza 3, 1A03) at ****>(703) 308-0044<**

(Hours: Weekdays, 8:00 a.m. to 8:00 p.m., EST/EDT);

(B) ****Patent Assignment Search Room** (Crystal Plaza 3, ****>1A03**) at 703-308-0044<

(Hours: Weekdays, 8:30 a.m. to 5:00 p.m., EST/EDT); and

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(C) < Scientific and Technical Information Center

****>(1) Main Library** (Crystal Plaza 3/4, 2C08) at (703) 308-1076

(2) Biotech/Chemical Library (Remsen 1D58) at (571) 272-2520<

(Hours: Weekdays, 8:30 a.m. to 5:00 p.m., EST/EDT).

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V. < REGISTERED PRACTITIONERS

The USPTO cannot recommend any particular attorney or agent, or aid in the selection of an attorney or agent. A list of *Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office* may be purchased ****>on DVD-ROM<** from the USPTO's Office of Electronic Information Products and Services (703-306-2600). ***>The DVD-ROM<** is also available on the USPTO web site **>(http://www.uspto.gov)** from the "Products and Services Catalog"<.

To obtain a list of registered patent attorneys and agents for a particular area, customers may either ****** contact a customer service representative through the USPTO's General Information Services Division (see "In General" above), or acquire the information from the USPTO web site. The attorneys and agents list may be examined without charge at Patent and Trade-

mark Depository Libraries (PTDLs) and at many other libraries throughout the U.S. Many large cities also have associations of patent attorneys and agents which may be consulted.

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VI. < MISCELLANEOUS

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A. < *Recently Filed Applications*

For information and questions concerning recently filed patent applications and filing receipts, contact the Customer Service Center of the Office of Initial Patent Examination at (703) 308-1202 (hours: weekdays, 8:30 a.m. to 5:00 p.m., EST/EDT; the Customer Service Center hours for receipt of mail are weekdays, 8:30 a.m. to 12 midnight, EST/EDT).

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B. *Pre-Grant Publication*

For inquiries concerning projected pre-grant publication dates, contact the Pre-Grant Publication Division at (703) 605-4823.

C. < *Status Information*

For information on the status of a patent application, **>patent applicants who have access to PAIR should check PAIR. Alternatively, applicants may<** contact the File Information Unit at (703) 308-2733.

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D. *Correspondence*

For information pertaining to mail, facsimile, or hand-delivery of correspondence to the USPTO, see MPEP §§ 502 - 502.01.

E. < *Copies of Documents*

Inquiries regarding certified copies of documents, including patent applications-as-filed, patent related file wrappers, patent copies, and reproduced copies of individual replacement pages or previous revisions of the MPEP, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382. Orders for certified copies may be placed by facsimile

when paying by VISA®, MasterCard®, American Express®, Discover®, or USPTO Deposit Account at (703) 308-7048. Orders for uncertified copies of patents may be placed by phone at (703) 305-8716*,< by fax at (703) 305-8759>, or on the USPTO web site<. To order file histories for self-service copying, contact the File Information Unit at (703) 308-2733.

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F. < Maintenance Fees

Information regarding maintenance fees may be obtained **>from the Patent Application Information Retrieval (PAIR) system on the USPTO web site, or by contacting the Maintenance Fee Branch< at (703) 308-5068 **. Status requests can also be faxed to the **>Maintenance Fee Branch< at (703) 308-5077.

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G < Assignments

For questions pertaining to filing assignments or other documents affecting title, contact the Assign-

ment Division at (703) 308-9723. Documents may be submitted to the Assignment Division by facsimile at (703) 306-5995. See MPEP § 302.09 for additional information.

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H. < Petitions

For matters decided by the Office of Petitions, the appropriate USPTO personnel may be reached at (703) 305-9282 or by facsimile at **>(703) 872-9306<.

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I. < PatentIn

For information regarding orders for the PatentIn software program, call the Office of Electronic Information Products and Services at (703) 306-2600. For assistance using PatentIn, **>contact the Patent Electronic Business Center, see paragraph II.C., above<.



MANUAL OF PATENT EXAMINING PROCEDURE