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[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.945 Response to Office action by patent owner in *inter partes* reexamination.**

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.947 Comments by third party requester to patent owner's response in *inter partes* reexamination.**

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.948 Limitations on submission of prior art by third party requester following the order for *inter partes* reexamination.**

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a

comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

(b) [Reserved].

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination.**

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.951 Options after Office action closing prosecution in *inter partes* reexamination.**

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.





**§ 1.981 Reopening after a final decision of the Board of Patent Appeals and Interferences.**

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the *inter partes* reexamination proceeding will not be reopened or reconsidered by the primary examiner except under the provisions of § 41.77 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

**APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT IN INTER PARTES REEXAMINATION**

**§ 1.983 Appeal to the United States Court of Appeals for the Federal Circuit in inter partes reexamination.**

(a) The patent owner or third party requester in an inter partes reexamination proceeding who is a party to an appeal to the Board of Patent Appeals and Interferences and who is dissatisfied with the decision of the Board of Patent Appeals and Interferences may, subject to § 1.979(e), appeal to the U.S. Court of Appeals for the Federal Circuit and may be a party to any appeal thereto taken from a reexamination decision of the Board of Patent Appeals and Interferences.

(b) The appellant must take the following steps in such an appeal:

(1) In the U.S. Patent and Trademark Office, timely file a written notice of appeal directed to the Director in accordance with §§ 1.302 and 1.304;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice of appeal and pay the fee, as provided for in the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice of appeal on every other party in the reexamination proceeding in the manner provided in § 1.248.

(c) If the patent owner has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the third party requester may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(d) If the third party requester has filed a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, the patent owner may cross appeal to the U.S. Court of Appeals for the Federal Circuit if also dissatisfied with the decision of the Board of Patent Appeals and Interferences.

(e) A party electing to participate in an appellant's appeal must, within fourteen days of service of the appellant's notice of appeal under paragraph (b) of this section, or notice of cross appeal under paragraphs (c) or (d) of this section, take the following steps:

(1) In the U.S. Patent and Trademark Office, timely file a written notice directed to the Director electing to participate in the appellant's appeal to the U.S. Court of Appeals for the Federal Circuit by mail to, or hand service on, the General Counsel as provided in § 104.2;

(2) In the U.S. Court of Appeals for the Federal Circuit, file a copy of the notice electing to participate in accordance with the rules of the U.S. Court of Appeals for the Federal Circuit; and

(3) Serve a copy of the notice electing to participate on every other party in the reexamination proceeding in the manner provided in § 1.248.

(f) Notwithstanding any provision of the rules, in any reexamination proceeding commenced prior to November 2, 2002, the third party requester is precluded from appealing and cross appealing any decision of the Board of Patent Appeals and Interferences to the U.S. Court of Appeals for the Federal Circuit, and the third party requester is precluded from participating in any appeal taken by the patent owner to the U.S. Court of Appeals for the Federal Circuit.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 70996, Dec. 22, 2003, effective Jan. 21, 2004]

CONCURRENT PROCEEDINGS INVOLVING  
SAME PATENT IN *INTER PARTES*  
REEXAMINATION

**§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.**

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.**

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

**§ 1.989 Merger of concurrent reexamination proceedings.**

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination

will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.991 Merger of concurrent reissue application and *inter partes* reexamination proceeding.**

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be terminated by the grant of the reissued patent.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**§ 1.993 Suspension of concurrent interference and *inter partes* reexamination proceeding.**

If a patent in the process of *inter partes* reexamination is or becomes involved in an interference, the

Director may suspend the *inter partes* reexamination or the interference. The Director will not consider a request to suspend an interference unless a motion under § 41.121(a)(3) of this title to suspend the interference has been presented to, and denied by, an administrative patent judge and the request is filed within ten (10) days of a decision by an administrative patent judge denying the motion for suspension or such other time as the administrative patent judge may set.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

**§ 1.995 Third party requester’s participation rights preserved in merged proceeding.**

When a third party requester is involved in one or more proceedings, including an *inter partes* reexamination proceeding, the merger of such proceedings will be accomplished so as to preserve the third party requester’s right to participate to the extent specifically provided for in these regulations. In merged proceedings involving different requesters, any paper filed by one party in the merged proceeding shall be served on all other parties of the merged proceeding.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

**REEXAMINATION CERTIFICATE IN *INTER PARTES* REEXAMINATION**

**§ 1.997 Issuance of *inter partes* reexamination certificate.**

(a) Upon the conclusion of an *inter partes* reexamination proceeding, the Director will issue a certificate in accordance with 35 U.S.C. 316 setting forth the results of the *inter partes* reexamination proceeding and the content of the patent following the *inter partes* reexamination proceeding.

(b) A certificate will be issued in each patent in which an *inter partes* reexamination proceeding has been ordered under § 1.931. Any statutory disclaimer filed by the patent owner will be made part of the certificate.

(c) The certificate will be sent to the patent owner at the address as provided for in § 1.33(c). A copy of the certificate will also be sent to the third party requester of the *inter partes* reexamination proceeding.

(d) If a certificate has been issued which cancels all of the claims of the patent, no further Office proceedings will be conducted with that patent or any reissue applications or any reexamination requests relating thereto.

(e) If the *inter partes* reexamination proceeding is terminated by the grant of a reissued patent as provided in § 1.991, the reissued patent will constitute the reexamination certificate required by this section and 35 U.S.C. 316.

(f) A notice of the issuance of each certificate under this section will be published in the *Official Gazette*.

[Added, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

**PART 3 — ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE**

Sec.

3.1 Definitions.

**DOCUMENTS ELIGIBLE FOR RECORDING**

- 3.11 Documents which will be recorded.
- 3.16 Assignability of trademarks prior to filing an allegation of use.

**REQUIREMENTS FOR RECORDING**

- 3.21 Identification of patents and patent applications.
- 3.24 Requirements for documents and cover sheets relating to patents and patent applications.
- 3.25 Recording requirements for trademark applications and registrations.
- 3.26 English language requirement.
- 3.27 Mailing address for submitting documents to be recorded.
- 3.28 Requests for recording.



## COVER SHEET REQUIREMENTS

- 3.31 Cover sheet content.
- 3.34 Correction of cover sheet errors.

## FEES

- 3.41 Recording fees.

## DATE AND EFFECT OF RECORDING

- 3.51 Recording date.
- 3.54 Effect of recording.
- 3.56 Conditional assignments.
- 3.58 Governmental registers.

## DOMESTIC REPRESENTATIVE

- 3.61 Domestic representative.

## ACTION TAKEN BY ASSIGNEE

- 3.71 Prosecution by assignee.
- 3.73 Establishing right of assignee to take action.

## ISSUANCE TO ASSIGNEE

- 3.81 Issue of patent to assignee.
- 3.85 Issue of registration to assignee.

**§ 3.1 Definitions.**

For purposes of this part, the following definitions shall apply:

*Application* means a national application for patent, an international patent application that designates the United States of America, or an application to register a trademark under section 1 or 44 of the Trademark Act, 15 U.S.C. 1051 or 15 U.S.C. 1126, unless otherwise indicated.

*Assignment* means a transfer by a party of all or part of its right, title and interest in a patent, patent application, registered mark or a mark for which an application to register has been filed.

*Document* means a document which a party requests to be recorded in the Office pursuant to §

3.11 and which affects some interest in an application, patent, or registration.

*Office* means the United States Patent and Trademark Office.

*Recorded document* means a document which has been recorded in the Office pursuant to § 3.11.

*Registration* means a trademark registration issued by the Office.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

## DOCUMENTS ELIGIBLE FOR RECORDING

**§ 3.11 Documents which will be recorded.**

(a) Assignments of applications, patents, and registrations, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, will be recorded in the Office. Other documents, accompanied by completed cover sheets as specified in §§ 3.28 and 3.31, affecting title to applications, patents, or registrations, will be recorded as provided in this part or at the discretion of the Director.

(b) Executive Order 9424 of February 18, 1944 (9 FR 1959, 3 CFR 1943-1948 Comp., p. 303) requires the several departments and other executive agencies of the Government, including Government-owned or Government-controlled corporations, to forward promptly to the Director for recording all licenses, assignments, or other interests of the Government in or under patents or patent applications. Assignments and other documents affecting title to patents or patent applications and documents not affecting title to patents or patent applications required by Executive Order 9424 to be filed will be recorded as provided in this part.

(c) A joint research agreement or an excerpt of a joint research agreement will also be recorded as provided in this part.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (c) added, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004; para. (c) revised, 70 FR 54259, Sept. 14, 2005, effective Sept. 14, 2005]

**§ 3.16 Assignability of trademarks prior to filing an allegation of use.**

Before an allegation of use under either 15 U.S.C. 1051(c) or 15 U.S.C. 1051(d) is filed, an applicant may only assign an application to register a mark under 15 U.S.C. 1051(b) to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

## REQUIREMENTS FOR RECORDING

**§ 3.21 Identification of patents and patent applications.**

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, *e.g.*, 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (*e.g.*, PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by the name of each inventor and the title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under § 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by the name of each inventor and the title of the invention so that there can be no mistake as to the provisional application intended.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

**§ 3.24 Requirements for documents and cover sheets relating to patents and patent applications.**

(a) *For electronic submissions:* Either a copy of the original document or an extract of the original document may be submitted for recording. All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), the document must be legible and a 2.5 cm (one-inch) margin must be present on all sides.

(b) *For paper or facsimile submissions:* Either a copy of the original document or an extract of the original document must be submitted for recording. Only one side of each page may be used. The paper size must be either 21.6 by 27.9 cm (8 1/2 inches by 11 inches) or 21.0 by 29.7 cm (DIN size A4), and in either case, a 2.5 cm (one-inch) margin must be present on all sides. For paper submissions, the paper used should be flexible, strong white, non-shiny, and durable. The Office will not return recorded documents, so original documents must not be submitted for recording.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; heading revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

**§ 3.25 Recording requirements for trademark applications and registrations.**

(a) *Documents affecting title.* To record documents affecting title to a trademark application or registration, a legible cover sheet (*see* § 3.31) and one of the following must be submitted:

- (1) A copy of the original document;
- (2) A copy of an extract from the document evidencing the effect on title; or
- (3) A statement signed by both the party conveying the interest and the party receiving the interest explaining how the conveyance affects title.

(b) *Name changes.* Only a legible cover sheet is required (*See* § 3.31).

(c) *All documents.* (1) *For electronic submissions:* All documents must be submitted as digitized images in Tagged Image File Format (TIFF) or

another form as prescribed by the Director. When printed to a paper size of either 21.6 by 27.9 cm (8 1/2 by 11 inches) or 21.0 by 29.7 cm (DIN size A4), a 2.5 cm (one-inch) margin must be present on all sides.

(2) *For paper or facsimile submissions:* All documents should be submitted on white and non-shiny paper that is either 8 1/2 by 11 inches (21.6 by 27.9 cm) or DIN size A4 (21.0 by 29.7 cm) with a one-inch (2.5 cm) margin on all sides in either case. Only one side of each page may be used. The Office will not return recorded documents, so original documents should not be submitted for recording.

[Added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

### § 3.26 English language requirement.

The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 3.27 Mailing address for submitting documents to be recorded.

Documents and cover sheets submitted by mail for recordation should be addressed to Mail Stop Assignment Recordation Services, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, unless they are filed together with new applications.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

### § 3.28 Requests for recording.

Each document submitted to the Office for recording must include at least one cover sheet as specified in § 3.31 referring either to those patent applications and patents, or to those trademark applications and registrations, against which the document is to be recorded. If a document to be recorded includes inter-

ests in, or transactions involving, both patents and trademarks, separate patent and trademark cover sheets should be submitted. Only one set of documents and cover sheets to be recorded should be filed. If a document to be recorded is not accompanied by a completed cover sheet, the document and the incomplete cover sheet will be returned pursuant to § 3.51 for proper completion. The document and a completed cover sheet should be resubmitted.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999]

## COVER SHEET REQUIREMENTS

### § 3.31 Cover sheet content.

(a) Each patent or trademark cover sheet required by § 3.28 must contain:

- (1) The name of the party conveying the interest;
- (2) The name and address of the party receiving the interest;
- (3) A description of the interest conveyed or transaction to be recorded;
- (4) Identification of the interests involved:
  - (i) For trademark assignments and trademark name changes: Each trademark registration number and each trademark application number, if known, against which the Office is to record the document. If the trademark application number is not known, a copy of the application or a reproduction of the trademark must be submitted, along with an estimate of the date that the Office received the application; or

(ii) For any other document affecting title to a trademark or patent application, registration or patent: Each trademark or patent application number or each trademark registration number or patent against which the document is to be recorded, or an indication that the document is filed together with a patent application;

- (5) The name and address of the party to whom correspondence concerning the request to record the document should be mailed;
- (6) The date the document was executed;
- (7) The signature of the party submitting the document. For an assignment document or name

change filed electronically, the person who signs the cover sheet must either:

(i) Place a symbol comprised of letters, numbers, and/or punctuation marks between forward slash marks submission (*e.g.* /Thomas O'Malley III/) in the signature block on the electronic submission; or

(ii) Sign the cover sheet using some other form of electronic signature specified by the Director.

(b) A cover sheet should not refer to both patents and trademarks, since any information, including information about pending patent applications, submitted with a request for recordation of a document against a trademark application or trademark registration will become public record upon recordation.

(c) Each patent cover sheet required by § 3.28 seeking to record a governmental interest as provided by § 3.11(b) must:

(1) Indicate that the document relates to a Government interest; and

(2) Indicate, if applicable, that the document to be recorded is not a document affecting title (see § 3.41(b)).

(d) Each trademark cover sheet required by § 3.28 seeking to record a document against a trademark application or registration should include, in addition to the serial number or registration number of the trademark, identification of the trademark or a description of the trademark, against which the Office is to record the document.

(e) Each patent or trademark cover sheet required by § 3.28 should contain the number of applications, patents or registrations identified in the cover sheet and the total fee.

(f) Each trademark cover sheet should include the citizenship of the party conveying the interest and the citizenship of the party receiving the interest. In addition, if the party receiving the interest is a partnership or joint venture, the cover sheet should set forth the names, legal entities, and national citizenship (or the state or country of organization) of all general partners or active members that compose the partnership or joint venture.

(g) The cover sheet required by § 3.28 seeking to record a joint research agreement or an excerpt of a joint research agreement as provided by § 3.11(c) must:

(1) Identify the document as a “joint research agreement” (in the space provided for the description

of the interest conveyed or transaction to be recorded if using an Office-provided form);

(2) Indicate the name of the owner of the application or patent (in the space provided for the name and address of the party receiving the interest if using an Office-provided form);

(3) Indicate the name of each other party to the joint research agreement party (in the space provided for the name of the party conveying the interest if using an Office-provided form); and

(4) Indicate the date the joint research agreement was executed.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (c) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(b) revised, paras. (d)-(e) added, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; para. (a)(7) deleted and para. (a)(8) redesignated as para. (a)(7), 67 FR 79520, Dec. 30, 2002, effective Dec. 30, 2002; paras. (a)(7) & (c)(1) revised and para. (f) added, 69 FR 29865, May 26, 2004, effective June 25, 2004; para (g) added, 70 FR 1818, Jan. 11, 2005, effective Dec. 10, 2004]

### § 3.34 Correction of cover sheet errors.

(a) An error in a cover sheet recorded pursuant to § 3.11 will be corrected only if:

(1) The error is apparent when the cover sheet is compared with the recorded document to which it pertains and

(2) A corrected cover sheet is filed for recordation.

(b) The corrected cover sheet must be accompanied by a copy of the document originally submitted for recording and by the recording fee as set forth in § 3.41.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (b) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

## FEES

### § 3.41 Recording fees.

(a) All requests to record documents must be accompanied by the appropriate fee. Except as provided in paragraph (b) of this section, a fee is required for each application, patent and registration against which the document is recorded as identified in the cover sheet. The recording fee is set in § 1.21(h) of

this chapter for patents and in § 2.6(b)(6) of this chapter for trademarks.

(b) No fee is required for each patent application and patent against which a document required by Executive Order 9424 is to be filed if:

(1) The document does not affect title and is so identified in the cover sheet (see § 3.31(c)(2)); and

(2) The document and cover sheet are either: Faxed or electronically submitted as prescribed by the Director, or mailed to the Office in compliance with § 3.27.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) amended, 63 FR 48081, Sept. 9, 1998, effective October 9, 1998; para. (a) corrected, 63 FR 52158, Sept. 10, 1998; para. (b)(2) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

## DATE AND EFFECT OF RECORDING

### § 3.51 Recording date.

The date of recording of a document is the date the document meeting the requirements for recording set forth in this part is filed in the Office. A document which does not comply with the identification requirements of § 3.21 will not be recorded. Documents not meeting the other requirements for recording, for example, a document submitted without a completed cover sheet or without the required fee, will be returned for correction to the sender where a correspondence address is available. The returned papers, stamped with the original date of receipt by the Office, will be accompanied by a letter which will indicate that if the returned papers are corrected and resubmitted to the Office within the time specified in the letter, the Office will consider the original date of filing of the papers as the date of recording of the document. The procedure set forth in § 1.8 or § 1.10 of this chapter may be used for resubmissions of returned papers to have the benefit of the date of deposit in the United States Postal Service. If the returned papers are not corrected and resubmitted within the specified period, the date of filing of the corrected papers will be considered to be the date of recording of the document. The specified period to resubmit the returned papers will not be extended.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 3.54 Effect of recording.

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

### § 3.56 Conditional assignments.

Assignments which are made conditional on the performance of certain acts or events, such as the payment of money or other condition subsequent, if recorded in the Office, are regarded as absolute assignments for Office purposes until cancelled with the written consent of all parties or by the decree of a court of competent jurisdiction. The Office does not determine whether such conditions have been fulfilled.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

### § 3.58 Governmental registers.

(a) The Office will maintain a Departmental Register to record governmental interests required to be recorded by Executive Order 9424. This Departmental Register will not be open to public inspection but will be available for examination and inspection by duly authorized representatives of the Government. Governmental interests recorded on the Departmental Register will be available for public inspection as provided in § 1.12.

(b) The Office will maintain a Secret Register to record governmental interests required to be recorded by Executive Order 9424. Any instrument to be recorded will be placed on this Secret Register at the request of the department or agency submitting the same. No information will be given concerning any instrument in such record or register, and no examination or inspection thereof or of the index

thereto will be permitted, except on the written authority of the head of the department or agency which submitted the instrument and requested secrecy, and the approval of such authority by the Director. No instrument or record other than the one specified may be examined, and the examination must take place in the presence of a designated official of the Patent and Trademark Office. When the department or agency which submitted an instrument no longer requires secrecy with respect to that instrument, it must be recorded anew in the Departmental Register.

[Added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

## DOMESTIC REPRESENTATIVE

### § 3.61 Domestic representative.

If the assignee of a patent, patent application, trademark application or trademark registration is not domiciled in the United States, the assignee may designate a domestic representative in a document filed in the United States Patent and Trademark Office. The designation should state the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the application, patent or registration or rights thereunder.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 67 FR 79520, Dec. 30, 2002, effective Dec. 30, 2002]

## ACTION TAKEN BY ASSIGNEE

### § 3.71 Prosecution by assignee.

(a) *Patents — conducting of prosecution.* One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or a reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.

(b) *Patents — assignee(s) who can prosecute.* The assignee(s) who may conduct either the prosecu-

tion of a national application for patent or a reexamination proceeding are:

(1) *A single assignee.* An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or

(2) *Partial assignee(s) together or with inventor(s).* All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined.

(c) *Patents — Becoming of record.* An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.

(d) *Trademarks.* The assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

### § 3.73 Establishing right of assignee to take action.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established

by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b)(1) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

## ISSUANCE TO ASSIGNEE

### § 3.81 Issue of patent to assignee.

(a) *With payment of the issue fee:* An application may issue in the name of the assignee consistent with the application's assignment where a request for such issuance is submitted with payment of the issue

fee, provided the assignment has been previously recorded in the Office. If the assignment has not been previously recorded, the request must state that the document has been filed for recordation as set forth in § 3.11.

(b) *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a)) and the processing fee set forth in § 1.17 (i) of this chapter.

(c) *Partial assignees.* (1) If one or more assignee, together with one or more inventor, holds the entire right, title, and interest in the application, the patent may issue in the names of the assignee and the inventor.

(2) If multiple assignees hold the entire right, title, and interest to the exclusion of all the inventors, the patent may issue in the names of the multiple assignees.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992; amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

### § 3.85 Issue of registration to assignee.

The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

[Added, 57 FR 29634, July 6, 1992, effective Sept. 4, 1992]

## PART 4 — COMPLAINTS REGARDING INVENTION PROMOTERS

Sec.

- 4.1 Complaints Regarding Invention Promoters.
- 4.2 Definitions.
- 4.3 Submitting Complaints
- 4.4 Invention Promoter Reply.
- 4.5 Notice by Publication.
- 4.6 Attorneys and Agents

### § 4.1 Complaints Regarding Invention Promoters.

These regulations govern the Patent and Trademark Office's (Office) responsibilities under the Inventors' Rights Act of 1999, which can be found in the U.S. Code at 35 U.S.C. 297. The Act requires the Office to provide a forum for the publication of complaints concerning invention promoters. The Office will not conduct any independent investigation of the invention promoter. Although the Act provides additional civil remedies for persons injured by invention promoters, those remedies must be pursued by the injured party without the involvement of the Office.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

### § 4.2 Definitions.

(a) *Invention Promoter* means any person, firm, partnership, corporation, or other entity who offers to perform or performs invention promotion services for, or on behalf of, a customer, and who holds itself out through advertising in any mass media as providing such services, but does not include—

- (1) Any department or agency of the Federal Government or of a State or local government;
- (2) Any nonprofit, charitable, scientific, or educational organization qualified under applicable State law or described under section 170(b)(1)(A) of the Internal Revenue Code of 1986;
- (3) Any person or entity involved in the evaluation to determine commercial potential of, or offering to license or sell, a utility patent or a previously filed nonprovisional utility patent application;
- (4) Any party participating in a transaction involving the sale of the stock or assets of a business; or

(5) Any party who directly engages in the business of retail sales of products or the distribution of products.

(b) *Customer* means any individual who enters into a contract with an invention promoter for invention promotion services.

(c) *Contract for Invention Promotion Services* means a contract by which an invention promoter undertakes invention promotion services for a customer.

(d) *Invention Promotion Services* means the procurement or attempted procurement for a customer of a firm, corporation, or other entity to develop and market products or services that include the invention of the customer.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

### § 4.3 Submitting Complaints.

(a) A person may submit a complaint concerning an invention promoter with the Office. A person submitting a complaint should understand that the complaint may be forwarded to the invention promoter and may become publicly available. The Office will not accept any complaint that requests that it be kept confidential.

(b) A complaint must be clearly marked, or otherwise identified, as a complaint under these rules. The complaint must include:

- (1) The name and address of the complainant;
- (2) The name and address of the invention promoter;
- (3) The name of the customer;
- (4) The invention promotion services offered or performed by the invention promoter;
- (5) The name of the mass media in which the invention promoter advertised providing such services;
- (6) An explanation of the relationship between the customer and the invention promoter, and
- (7) A signature of the complainant.

(c) The complaint should fairly summarize the action of the invention promoter about which the person complains. Additionally, the complaint should include names and addresses of persons believed to be associated with the invention promoter. Complaints, and any replies, must be addressed to: Mail Stop 24,



Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(d) Complaints that do not provide the information requested in paragraphs (b) and (c) of this section will be returned. If complainant's address is not provided, the complaint will be destroyed.

(e) No originals of documents should be included with the complaint.

(f) A complaint can be withdrawn by the complainant or the named customer at any time prior to its publication.

[Para. (c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

#### § 4.4 **Invention Promoter Reply.**

(a) If a submission appears to meet the requirements of a complaint, the invention promoter named in the complaint will be notified of the complaint and given 30 days to respond. The invention promoter's response will be made available to the public along with the complaint. If the invention promoter fails to reply within the 30-day time period set by the Office, the complaint will be made available to the public. Replies sent after the complaint is made available to the public will also be published.

(b) A response must be clearly marked, or otherwise identified, as a response by an invention promoter. The response must contain:

(1) The name and address of the invention promoter;

(2) A reference to a complaint forwarded to the invention promoter or a complaint previously published;

(3) The name of the individual signing the response; and

(4) The title or authority of the individual signing the response.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

#### § 4.5 **Notice by Publication.**

If the copy of the complaint that is mailed to the invention promoter is returned undelivered, then the Office will publish a Notice of Complaint Received in

the *Official Gazette*, the Federal Register, or on the Office's Internet home page. The invention promoter will be given 30 days from such notice to submit a reply to the complaint. If the Office does not receive a reply from the invention promoter within 30 days, the complaint alone will become publicly available.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000]

#### § 4.6 **Attorneys and Agents.**

Complaints against registered patent attorneys and agents will not be treated under this section, unless a complaint fairly demonstrates that invention promotion services are involved. Persons having complaints about registered patent attorneys or agents should contact the Office of Enrollment and Discipline at Mail Stop OED, Director of the United States Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450, and the attorney discipline section of the attorney's state licensing bar if an attorney is involved.

[Added, 65 FR 3127, Jan. 20, 2000, effective Jan. 28, 2000; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

### **PART 5 — SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES**

#### **SECRECY**

- Sec.
- 5.1 Applications and correspondence involving national security.
  - 5.2 Secrecy order.
  - 5.3 Prosecution of application under secrecy orders; withholding patent.
  - 5.4 Petition for rescission of secrecy order.
  - 5.5 Permit to disclose or modification of secrecy order.
  - 5.6 [Reserved]
  - 5.7 [Reserved]
  - 5.8 [Reserved]

### LICENSES FOR FOREIGN EXPORTING AND FILING

- 5.11 License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.
- 5.12 Petition for license.
- 5.13 Petition for license; no corresponding application.
- 5.14 Petition for license; corresponding U.S. application.
- 5.15 Scope of license.
- 5.16 [Reserved]
- 5.17 [Reserved]
- 5.18 Arms, ammunition, and implements of war.
- 5.19 Export of technical data.
- 5.20 Export of technical data relating to sensitive nuclear technology.
- 5.25 Petition for retroactive license.

### GENERAL

- 5.31 [Reserved]
- 5.32 Reserved]
- 5.33 [Reserved]

### SECREC Y

#### § 5.1 Applications and correspondence involving national security.

(a) All correspondence in connection with this part, including petitions, should be addressed to: Mail Stop L&R, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(b) Application as used in this part includes provisional applications filed under 35 U.S.C. 111(b) (§ 1.9(a)(2) of this chapter), nonprovisional applications filed under 35 U.S.C. 111(a) or entering the national stage from an international application after compliance with 35 U.S.C. 371 (§ 1.9(a)(3)), or international applications filed under the Patent Cooperation Treaty prior to entering the national stage of processing (§ 1.9(b)).

(c) Patent applications and documents relating thereto that are national security classified (see § 1.9(i) of this chapter) and contain authorized national security markings (*e.g.*, “Confidential,” “Secret” or “Top Secret”) are accepted by the Office. National security classified documents filed in the Office must be either hand-carried to Licensing and Review or

mailed to the Office in compliance with paragraph (a) of this section.

(d) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2(a). If a national security classified patent application is filed without a notification pursuant to § 5.2(a), the Office will set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application. If evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency is submitted by the applicant within the time period set by the Office, but the application has not been declassified or placed under a secrecy order pursuant to § 5.2(a), the Office will again set a time period within which either the application must be declassified, or the application must be placed under a secrecy order pursuant to § 5.2(a), or the applicant must submit evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2(a) from the relevant department or agency in order to prevent abandonment of the application.

(e) An application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter if publication or disclosure of the application would be detrimental to national security. An application under national security review will not be published at least until six months from its filing date or three months from the date the application was referred to a defense agency, whichever is later. A national security classified patent application will not be published under § 1.211 of this chapter or allowed under § 1.311 of this chapter until the application is declassified and any secrecy order under § 5.2(a) has been rescinded.

(f) Applications on inventions made outside the United States and on inventions in which a U.S. Government defense agency has a property interest will not be made available to defense agencies.

[43 FR 20470, May 11, 1978; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (e) revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29,

2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a) revised, 69 FR 29865, May 26, 2004, effective June 25, 2004]

### § 5.2 Secrecy order.

(a) When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner for Patents.

(b) Any request for compensation as provided in 35 U.S.C. 183 must not be made to the Patent and Trademark Office, but directly to the department or agency which caused the secrecy order to be issued.

(c) An application disclosing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section also falls within the scope of such secrecy order. Any such application that is pending before the Office must be promptly brought to the attention of Licensing and Review, unless such application is itself under a secrecy order pursuant to paragraph (a) of this section. Any subsequently filed application containing any significant part of the subject matter of an application under a secrecy order pursuant to paragraph (a) of this section must either be hand-carried to Licensing and Review or mailed to the Office in compliance with § 5.1(a).

[24 FR 10381, Dec. 22, 1959; para. (b) revised, paras. (c) and (d) removed, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) added, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

### § 5.3 Prosecution of application under secrecy orders; withholding patent.

Unless specifically ordered otherwise, action on the application by the Office and prosecution by the applicant will proceed during the time an application is under secrecy order to the point indicated in this section:

(a) National applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commis-

sioner for Patents will not be set for hearing until the secrecy order is removed.

(b) An interference will not be declared involving a national application under secrecy order. An applicant whose application is under secrecy order may suggest an interference (§ 41.202(a) of this title), but the Office will not act on the request while the application remains under a secrecy order.

(c) When the national application is found to be in condition for allowance except for the secrecy order the applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under § 1.311 of this chapter) does not require reply by the applicant and places the national application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent and Trademark Office will issue a notice of allowance under § 1.311 of this chapter, or take such other action as may then be warranted.

(d) International applications under secrecy order will not be mailed, delivered, or otherwise transmitted to the international authorities or the applicant. International applications under secrecy order will be processed up to the point where, if it were not for the secrecy order, record and search copies would be transmitted to the international authorities or the applicant.

[43 FR 20470, May 11, 1978; amended 43 FR 28479, June 30, 1978; para. (b) amended 53 FR 23736, June 23, 1988, effective Sept. 12, 1988; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

### § 5.4 Petition for rescission of secrecy order.

(a) A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate.

(b) The petition must recite any and all facts that purport to render the order ineffectual or futile if this is the basis of the petition. When prior publications or patents are alleged the petition must give complete data as to such publications or patents and should be accompanied by copies thereof.

(c) The petition must identify any contract between the Government and any of the principals under which the subject matter of the application or any significant part thereof was developed or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

(d) Appeal to the Secretary of Commerce, as provided by 35 U.S.C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within sixty days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued, will be notified of the time and place of hearing.

[24 FR 10381, Dec. 22, 1959; paras. (a) and (d) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

### § 5.5 Permit to disclose or modification of secrecy order.

(a) Consent to disclosure, or to the filing of an application abroad, as provided in 35 U.S.C. 182, shall be made by a “permit” or “modification” of the secrecy order.

(b) Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed disclosure is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate.

(c) In a petition for modification of a secrecy order to permit filing abroad, all countries in which it is proposed to file must be made known, as well as all attorneys, agents and others to whom the material will be consigned prior to being lodged in the foreign patent office. The petition should include a statement vouching for the loyalty and integrity of the proposed disclosees and where their clearance status in this or the foreign country is known all details should be given.

(d) Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common

subject matter in other applications under secrecy order so long as the subject matter is not taken out of context in a manner disclosing material beyond the modification granted in the first application.

(e) Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.

[24 FR 10381, Dec. 22, 1959; paras. (b) and (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.6 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.7 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.8 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

## LICENSES FOR FOREIGN EXPORTING AND FILING

### § 5.11 License for filing in a foreign country an application on an invention made in the United States or for transmitting international application.

(a) A license from the Commissioner for Patents under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign patent office or any foreign patent agency or any international agency other than the United States Receiving Office, if the invention was made in the United States and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed, or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner for Patents referred to in paragraph (a) would also authorize the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign patent application without separately complying with the regulations contained in 22 CFR parts 121 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR part 779 (Regulations of the Office of Export Administration, International Trade Administration, Department of Commerce) and 10 CFR part 810 (Foreign Atomic Energy Programs of the Department of Energy).

(c) Where technical data in the form of a patent application, or in any form, is being exported for purposes related to the preparation, filing or possible filing and prosecution of a foreign patent application, without the license from the Commissioner for Patents referred to in paragraphs (a) or (b) of this section, or on an invention not made in the United States, the export regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 768-799 (Export Administration Regulations of the Department of Commerce) and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy) must be complied with unless a license is not required because a United States application was on file at the time of export for at least six months without a secrecy order under § 5.2 being placed thereon. The term “exported” means export as it is defined in 22 CFR part 120, 15 CFR part 779 and activities covered by 10 CFR part 810.

(d) If a secrecy order has been issued under § 5.2, an application cannot be exported to, or filed in, a foreign country (including an international agency in a foreign country), except in accordance with § 5.5.

(e) No license pursuant to paragraph (a) of this section is required:

(1) If the invention was not made in the United States, or

(2) If the corresponding United States application is not subject to a secrecy order under § 5.2, and was filed at least six months prior to the date on which the application is filed in a foreign country, or

(3) For subsequent modifications, amendments and supplements containing additional subject matter to, or divisions of, a foreign patent application if:

(i) A license is not, or was not, required under paragraph (e)(2) of this section for the foreign patent application;

(ii) The corresponding United States application was not required to be made available for inspection under 35 U.S.C. 181; and

(iii) Such modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181.

(f) A license pursuant to paragraph (a) of this section can be revoked at any time upon written notification by the Patent and Trademark Office. An authorization to file a foreign patent application resulting from the passage of six months from the date of filing of a United States patent application may be revoked by the imposition of a secrecy order.

[49 FR 13461, Apr. 4, 1984; paras. (a) and (e), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; paras. (b), (c), and (e)(3) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)-(c) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

### § 5.12 Petition for license.

(a) Filing of an application for patent for inventions made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

(b) A petition for license must include the fee set forth in § 1.17(g) of this chapter, the petitioner’s address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner. The petition should be presented in letter form.

[48 FR 2714, Jan. 20, 1983; amended 49 FR 13462, Apr. 4, 1984; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

### § 5.13 Petition for license; no corresponding application.

If no corresponding national or international application has been filed in the United States, the petition for license under § 5.12(b) must also be accompanied by a legible copy of the material upon which a license is desired. This copy will be retained as a measure of the license granted.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.14 Petition for license; corresponding U.S. application.

(a) When there is a corresponding United States application on file, a petition for license under § 5.12(b) must also identify this application by application number, filing date, inventor, and title, but a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application.

(b) Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign or international application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

(c) Where the application to be filed or exported abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed in the foreign country or international application which is to be transmitted to a foreign international or national agency for filing in the Receiving Office, must be furnished with the petition. If however, all new matter in the foreign or international application to be filed is readily identifiable, the new matter may be submitted in detail and the

remainder by reference to the pertinent United States application or applications.

[43 FR 20471, May 11, 1978; 49 FR 13462, Apr. 4, 1984; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.15 Scope of license.

(a) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign patent application, if such changes to the application do not alter the general nature of the invention in a manner which would require the United States application to have been made available for inspection under 35 U.S.C. 181. Grant of this license authorizing the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency when the subject matter of the foreign or international application corresponds to that of the domestic application. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with international agencies;

(2) To make amendments, modifications, and supplements, including divisions, changes or supporting matter consisting of the illustration, exemplification, comparison, or explanation of subject matter disclosed in the application; and

(3) To take any action in the prosecution of the foreign or international application provided that the adding of subject matter or taking of any action under paragraphs (a)(1) or (2) of this section does not change the general nature of the invention disclosed in the application in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 by including technical data pertaining to:

(i) Defense services or articles designated in the United States Munitions List applicable at the time of foreign filing, the unlicensed exportation of which is prohibited pursuant to the Arms Export

Control Act, as amended, and 22 CFR parts 121 through 130; or

(ii) Restricted Data, sensitive nuclear technology or technology useful in the production or utilization of special nuclear material or atomic energy, dissemination of which is subject to restrictions of the Atomic Energy Act of 1954, as amended, and the Nuclear Non-Proliferation Act of 1978, as implemented by the regulations for Unclassified Activities in Foreign Atomic Energy Programs, 10 CFR part 810, in effect at the time of foreign filing.

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export and filing of an application in a foreign country or the transmitting of an international application to any foreign patent agency or international patent agency. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign and international patent agencies and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign or international application, provided subject matter additional to that covered by the license is not involved.

(c) A license granted under § 5.12(b) pursuant to § 5.13 or § 5.14 shall have the scope indicated in paragraph (a) of this section, if it is so specified in the license. A petition, accompanied by the required fee (§ 1.17(g) of this chapter), may also be filed to change a license having the scope indicated in paragraph (b) of this section to a license having the scope indicated in paragraph (a) of this section. No such petition will be granted if the copy of the material filed pursuant to § 5.13 or any corresponding United States application was required to be made available for inspection under 35 U.S.C. 181. The change in the scope of a license will be effective as of the date of the grant of the petition.

(d) In those cases in which no license is required to file the foreign application or transmit the international application, no license is required to file papers in connection with the prosecution of the foreign or international application not involving the disclosure of additional subject matter.

(e) Any paper filed abroad or transmitted to an international patent agency following the filing of a foreign or international application which changes the general nature of the subject matter disclosed at the time of filing in a manner which would require such application to have been made available for inspection under 35 U.S.C. 181 or which involves the disclosure of subject matter listed in paragraphs (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign or international application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with an international patent agency which involves the disclosure of additional subject matter must be licensed in the same manner as a foreign or international application.

(f) Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided:

(1) Subject matter which changes the general nature of the subject matter disclosed at the time of filing or which involves subject matter listed in paragraphs (a)(3) (i) or (ii) of this section is not introduced and,

(2) In the case where at least one of the licenses was obtained under § 5.12(b), additional subject matter is not introduced.

(g) A license does not apply to acts done before the license was granted. See § 5.25 for petitions for retroactive licenses.

[49 FR 13462, Apr. 4, 1984; paras. (a) - (c), (e) and (f), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; paras. (a)-(c) and (e) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

#### § 5.16 [Reserved]

[Removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

#### § 5.17 [Reserved]

[49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 5.18 Arms, ammunition, and implements of war.**

(a) The exportation of technical data relating to arms, ammunition, and implements of war generally is subject to the International Traffic in Arms Regulations of the Department of State (22 CFR parts 120 through 130); the articles designated as arms, ammunitions, and implements of war are enumerated in the U.S. Munitions List (22 CFR part 121). However, if a patent applicant complies with regulations issued by the Commissioner for Patents under 35 U.S.C. 184, no separate approval from the Department of State is required unless the applicant seeks to export technical data exceeding that used to support a patent application in a foreign country. This exemption from Department of State regulations is applicable regardless of whether a license from the Commissioner for Patents is required by the provisions of §§ 5.11 and 5.12 (22 CFR part 125).

(b) When a patent application containing subject matter on the Munitions List (22 CFR part 121) is subject to a secrecy order under § 5.2 and a petition is made under § 5.5 for a modification of the secrecy order to permit filing abroad, a separate request to the Department of State for authority to export classified information is not required (22 CFR part 125).

[35 FR 6430., Apr. 22, 1970; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

**§ 5.19 Export of technical data.**

(a) Under regulations (15 CFR 770.10(j)) established by the Department of Commerce, a license is not required in any case to file a patent application or part thereof in a foreign country if the foreign filing is in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office.

(b) An export license is not required for data contained in a patent application prepared wholly from foreign-origin technical data where such application is being sent to the foreign inventor to be executed and returned to the United States for subsequent filing in the U.S. Patent and Trademark Office (15 CFR 779A.3(e)).

[45 FR 72654, Nov. 3, 1980; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 5.20 Export of technical data relating to sensitive nuclear technology.**

Under regulations (10 CFR 810.7) established by the United States Department of Energy, an application filed in accordance with the regulations (§§ 5.11 through 5.25) of the Patent and Trademark Office and eligible for foreign filing under 35 U.S.C. 184, is considered to be information available to the public in published form and a generally authorized activity for the purposes of the Department of Energy regulations.

[49 FR 13463, Apr. 4, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

**§ 5.25 Petition for retroactive license.**

(a) A petition for retroactive license under 35 U.S.C. 184 shall be presented in accordance with § 5.13 or § 5.14(a), and shall include:

(1) A listing of each of the foreign countries in which the unlicensed patent application material was filed,

(2) The dates on which the material was filed in each country,

(3) A verified statement (oath or declaration) containing:

(i) An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,

(ii) A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and

(iii) An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and

(4) The required fee (§ 1.17(g) of this chapter).

(b) The explanation in paragraph (a) of this section must include a showing of facts rather than a mere allegation of action through error and without deceptive intent. The showing of facts as to the nature of the error should include statements by those persons having personal knowledge of the acts regarding



filing in a foreign country and should be accompanied by copies of any necessary supporting documents such as letters of transmittal or instructions for filing. The acts which are alleged to constitute error without deceptive intent should cover the period leading up to and including each of the proscribed foreign filings.

(c) If a petition for a retroactive license is denied, a time period of not less than thirty days shall be set, during which the petition may be renewed. Failure to renew the petition within the set time period will result in a final denial of the petition. A final denial of a petition stands unless a petition is filed under § 1.181 within two months of the date of the denial. If the petition for a retroactive license is denied with respect to the invention of a pending application and no petition under § 1.181 has been filed, a final rejection of the application under 35 U.S.C. 185 will be made.

[49 FR 13463, Apr. 4, 1984; para. (a), 56 FR 1924, Jan. 18, 1991, effective Feb. 19, 1991; para. (c) removed, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a)(4) revised, para. (b) redesignated as para. (c) and para. (b)

added, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

## GENERAL

### § 5.31 [Reserved]

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.32 [Reserved]

[24 FR 10381, Dec. 22, 1959; Redesignated at 49 FR 13463, Apr. 4, 1984; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

### § 5.33 [Reserved]

[49 FR 13463, Apr. 4, 1984; amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; removed and reserved, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

MANUAL OF PATENT EXAMINING PROCEDURE

**Index I – RULES RELATING TO PATENTS****A**

- Abandoned applications:
- Abandonment by failure to reply . . . . . 1.135
  - Abandonment during interference . . . . . 41.127
  - Abandonment for failure to pay issue fee . . . . . 1.316
  - Express abandonment . . . . . 1.138
  - Processing and retention fee . . . . . 1.21(1)
  - Referred to in issued patents . . . . . 1.14
  - Revival of . . . . . 1.137
  - When open to public inspection . . . . . 1.14
- Abandonment of application. (See Abandoned applications.)
- Abstract of the disclosure . . . . . 1.72, 1.77, 1.163
- Access to pending applications (limited) . . . . . 1.14
- Action by applicant . . . . . 1.111 - 1.138
- Addresses for correspondence with the
- United States Patent and Trademark Office . . . . . 1.1
  - Board of Patent Appeals and Interferences . 1.1(a)(1), 41.10
  - Deposit account replenishment . . . . . 1.25(c)(3), 1.25(c)(4)
  - Director of the United States Patent and Trademark Office . . . . . 1.1(a)
  - FOIA Officer . . . . . 102.1(b), 102.4(a)
  - Generally . . . . . 1.1(a)
  - Licensing and Review . . . . . 5.1(a)
  - Office of the General Counsel . . . . . 1.1(a)(3), 102.10(b), 102.29(b)
  - Office of the Solicitor . . . . . 1.1(a)(3),
- Mail Stops
- Mail Stop 4 . . . . . 150.6
  - Mail Stop 8 . . . . . 1.1(a)(3)
  - Mail Stop 24 . . . . . 4.3(c)
  - Mail Stop Assignment Recordation Services . . . . . 1.1(a)(4), 3.27
  - Mail Stop CPA . . . . . 1.53(d)(9)
  - Mail Stop Document Services . . . . . 1.1(a)(4)
  - Mail Stop *Ex parte* Reexam . . . . . 1.1(c)(1)
  - Mail Stop *Inter partes* Reexam . . . . . 1.1(c)(2)
  - Mail Stop Interference . . . . . 41.10(b)
  - Mail Stop M Correspondence . . . . . 1.1(d)(2)
  - Mail Stop OED . . . . . 4.6
  - Mail Stop Patent Ext . . . . . 1.1(e)
  - Mail Stop PCT . . . 1.1(b), 1.417, 1.434(a), 1.480(b)
- Maintenance fee payments . . . . . 1.1(d)(1)
- Patent correspondence . . . . . 1.1(a)(1)
- Privacy Officer . . . . . 102.23(a), 102.24(a)
- Trademark correspondence . . . . . 2.190
- Adjustment of patent term. (see Patent term adjustment due to examination delay.)
- Administrator, executor, or other legal representative may make  
application and receive patent. . . . . 1.42, 1.43, 1.64
- Admission to practice. (See Attorneys and agents.)
- Affidavit (See also Oath in patent application):
- After appeal . . . . . 41.33
  - As evidence in a contested case . . . . . 41.154
  - To disqualify commonly owned patent or published application as prior art . . . . . 1.130
  - Traversing rejections or objections . . . . . 1.132
- Agents. (See Attorneys and agents.)
- Allowance and issue of patent:
- Amendment after allowance . . . . . 1.312
  - Application abandoned for nonpayment of issue fee . . . . . 1.316
  - Deferral of issuance . . . . . 1.314
  - Delayed payment of issue fee . . . . . 1.137
  - Delivery of patent . . . . . 1.315
  - Failure to pay issue fee . . . . . 1.137(c), 1.316
  - Issuance of patent . . . . . 1.314
  - Notice of allowance . . . . . 1.311
  - Patent to issue upon payment of issue fee 1.311, 1.314
  - Patent to lapse if issue fee is not paid in full . . . 1.317
  - Reasons for . . . . . 1.104
  - Withdrawal from issue . . . . . 1.313
- Allowed claims, rejection of by Board of Patent Appeals and Interferences . . . . . 41.50(b)
- Amendment:
- Adding or substituting claims . . . . . 1.121
  - After appeal . . . . . 41.33, 41.63
  - After decision on appeal, based on new rejection of Board of Patent Appeals and Interferences . . . . . 41.50(b)(1)
  - After final action . . . . . 1.116
  - After final action (transitional procedures) . . . . 1.129
  - After notice of allowance . . . . . 1.312
  - Copying claim of another application for interference . . . . . 41.202
  - Copying claim of issued patent . . . . . 41.202
  - Deletions and insertions . . . . . 1.121
  - Drawings . . . . . 1.121
  - Manner of making . . . . . 1.121
  - Not covered by original oath . . . . . 1.67
  - Numbering of claims . . . . . 1.126
  - Of amendments . . . . . 1.121
  - Of claims . . . . . 1.121
  - Of disclosure . . . . . 1.121
  - Of drawing . . . . . 1.121
  - Of specification . . . . . 1.121
  - Paper and writing . . . . . 1.52
  - Petition from refusal to admit . . . . . 1.127

Preliminary . . . . .	1.115	Correspondence address . . . . .	1.33
Proposed during interference . . . . .	41.121	Daytime telephone number . . . . .	1.33
Provisional application . . . . .	1.53(c)	Deceased or insane inventor . . . . .	1.42, 1.43
Reexamination proceedings . . . . .	1.121(j), 1.530, 1.941	Executor or administrator . . . . .	1.42
Reissue . . . . .	1.121(i), 1.173	In a continued prosecution application . . . . .	1.53(b)(1), 1.53(d)(4)
Requisites of . . . . .	1.33, 1.111, 1.116, 1.121, 1.125	In an international application . . . . .	1.421-1.425
Right to amend . . . . .	1.111, 1.116, 1.127	Informed of application number . . . . .	1.54
Signature to . . . . .	1.33	Inventorship in a provisional application . . . . .	1.41(a)(2)
Substitute specification . . . . .	1.125	Mailing address and residence of inventors may be provided in oath/declaration or in application data sheet . . . . .	1.63, 1.76
Time for . . . . .	1.134	May be represented by an attorney or agent . . . . .	1.31
To applications in interference . . . . .	41.121	Person making oath or declaration . . . . .	1.64
To correct inaccuracies . . . . .	1.121	Personal attendance unnecessary . . . . .	1.2
To correspond to original drawing or specifica- tion . . . . .	1.121	Required to conduct business with decorum and courtesy . . . . .	1.3
To reissues . . . . .	1.173	Required to report assistance received . . . . .	1.4
To save from abandonment . . . . .	1.135	Who may apply for a patent . . . . .	1.41-1.48
Amino acid sequences. (See Nucleotide and/or amino acid sequences.)		Application Data sheet . . . . .	1.76
Appeals:		Application for patent (See also Abandoned applications, Claims, Drawing, Examination of applications, Provisional applications, Publication of application, Published application, Reissues, Specification):	
Civil Actions under 35 U.S.C. 145, 146, 306 . . . . .	1.303, 1.304	Access to . . . . .	1.14
To the Board of Patent Appeals and Interferences . . . . .	41.30-41.54	Acknowledgment of filing . . . . .	1.54
Affidavits after appeal . . . . .	41.33	Alteration after execution . . . . .	1.52
Brief . . . . .	41.37	Alteration before execution . . . . .	1.52
Decision/Action by Board . . . . .	41.50	Application number and filing date . . . . .	1.54
Return of jurisdiction to examiner . . . . .	1.197(a)	Arrangement . . . . .	1.77
Termination of proceedings . . . . .	1.197(b)	Compact disc submissions (see Electronic documents)	
Examiner's answer . . . . .	41.39	Confidentiality of applications . . . . .	1.14
Fees . . . . .	41.20	Continuation or division, reexecution not required . . . . .	1.63
Hearing of . . . . .	41.47	Continued prosecution application . . . . .	1.53(d)
<i>Inter partes</i> reexamination . . . . .	41.61	Filed by facsimile . . . . .	1.6, 1.8
New grounds of rejection . . . . .	41.39(a)(2), 41.50(b)	Copies of, furnished to applicants . . . . .	1.59
Notice of appeal . . . . .	41.31	Cross-references to related applications . . . . .	1.78
Public inspection or publication of decisions . . . . .	1.14	Deceased or insane inventor . . . . .	1.42, 1.43
Rehearing . . . . .	41.50(b)(2), 41.52	Declaration . . . . .	1.68
Reopening after final Board decision . . . . .	1.198	Duty of disclosure . . . . .	1.56
Reply brief . . . . .	41.41	Examined only when complete . . . . .	1.53
Sanctions . . . . .	41.128	Filed by other than inventor . . . . .	1.42, 1.43, 1.47, 1.64, 1.421(b)
What may be appealed . . . . .	41.31	Filing date . . . . .	1.53
Who may appeal . . . . .	41.31	Filing requirements . . . . .	1.53
To Court of Appeals for the Federal Circuit:		Foreign language oath or declaration . . . . .	1.69
Fee provided by rules of court . . . . .	1.301	Formulas and tables . . . . .	1.58
From Board of Patent Appeals and Interfer- ences . . . . .	1.301	General requisites . . . . .	1.51
Notice and reasons of appeal . . . . .	1.302	Identification required in letters concerning . . . . .	1.5
Time for filing notice of appeal . . . . .	1.302, 1.304		
Applicant for patent:			
Actual inventor or inventors to make application for patent . . . . .	1.41, 1.45		
Assignee . . . . .	1.47(b)		
Change of (see Correction of inventorship)			

- Incomplete papers not filed for examination . . . . 1.53
- Interlineations, etc., to be indicated . . . . . 1.52
- Involving national security . . . . . 5.1
- Language, paper, writing, margin . . . . . 1.52
- Later filing of oath and filing fee. . . . . 1.53
- Missing pages when application filed . . . . . 1.53(e)
- Must be made by actual inventor, with excep-  
tions . . . . . 1.41, 1.46, 1.47
- Naming of inventors:
- Application data sheet . . . . . 1.76(b)(1)
- In a continued prosecution application . . 1.53(d)(4)
- In a provisional application . 1.41(a)(2), 1.51(c)(1),  
    1.53(c)(1)
- In an international application . . . . . 1.421
- National stage . . . . . 1.497
- Inconsistencies between application data  
    sheet and oath or declaration . . . . . 1.76(d)
- Joint inventors . . . . . 1.45
- Oath/declaration. . . . . 1.63(a)(2)
- Non-English language . . . . . 1.52
- Nonpublication request . . . . . 1.213
- Numbering of claims . . . . . 1.126
- Numbering of paragraphs . . . . . 1.52, 1.125
- Original disclosure not expunged . . . . . 1.59(a)(2)
- Parts filed separately . . . . . 1.54
- Parts of application desirably filed together . . . . 1.54
- Parts of complete application . . . . . 1.51
- Processing fees . . . . . 1.17
- Provisional application . . . . . 1.9, 1.51, 1.53
- Publication of . . . . . 1.211, 1.219
- Published . . . . . 1.9, 1.215
- Relating to atomic energy . . . . . 1.14
- Reservation for future application not permit-  
ted . . . . . 1.79
- Retention fee . . . . . 1.53(f)
- Secrecy order . . . . . 5.1-5.5
- Status information . . . . . 1.14
- Tables and formulas . . . . . 1.58
- To contain but one invention unless connected. 1.141
- To whom made . . . . . 1.51
- Two or more by same party with conflicting  
claims. . . . . 1.78
- Application number. . . . . 1.5(a), 1.53, 1.54
- Arbitration award filing . . . . . 1.335
- Arbitration in a contested case before the Board . 41.126
- Assignee:
- Correspondence held with assignee(s) of  
    entire interest . . . . . 3.71, 3.73
- Establishing ownership . . . . . 3.73(b)
- May conduct prosecution of application . . . 3.71, 3.73
- May make application on behalf of  
    inventor(s) . . . . . 1.47(b)
- May take action in Board proceeding . . . . . 41.9
- Must consent to application for reissue of  
    patent . . . . . 1.171, 1.172
- Partial assignee(s) . . . . . 1.46, 3.71, 3.73, 3.81
- Assignments and recording:
- Abstracts of title, fee for . . . . . 1.19(b)(5)
- Conditional assignments . . . . . 3.56
- Cover sheet required . . . . . 3.28, 3.31
- Corrections . . . . . 3.34
- Date of receipt is date of record . . . . . 3.51
- Definitions . . . . . 1.332
- Effect of recording . . . . . 3.54
- Fees . . . . . 1.21(h)
- Formal requirements . . . . . 3.21-3.28
- If recorded before payment of issue fee,  
    patent may issue to assignee. . . . . 3.81
- Joint research agreements . . . . . 3.11(c), 3.31(g)
- Mailing address for submitting  
    documents. . . . . 1.1(a)(4), 3.27
- Must be recorded in Patent and  
    Trademark Office to issue patent to assignee. . . 3.81
- Must identify patent or application. . . . . 3.21
- Orders for copies of . . . . . 1.12
- Patent may issue to assignee. . . . . 3.81
- Recording of assignments . . . . . 3.11
- Records open to public inspection . . . . . 1.12
- Requirements for recording . . . . . 3.21-3.41
- What will be accepted for recording. . . . . 3.11
- Atomic energy applications reported to Depart-  
ment of Energy . . . . . 1.14
- Attorneys and agents:
- Acting in representative capacity . . . . . 1.33, 1.34
- Assignment will not operate as a revocation  
    of power . . . . . 1.36
- Certificate of good standing . . . . . 1.21(a)
- Complaints . . . . . 4.6
- Fee on admission . . . . . 1.21(a)
- Office cannot aid in selection of . . . . . 1.31
- Personal interviews with examiners . . . . . 1.133
- Power of attorney . . . . . 1.32
- Power to inspect . . . . . 1.14
- Representative capacity . . . . . 1.33, 1.34
- Required to conduct business with  
    decorum and courtesy. . . . . 1.3
- Revocation of power. . . . . 1.36(a)
- Signature and certificate of attorney. . . . . 1.4, 10.18
- Withdrawal of . . . . . 1.36(b), 41.5
- Authorization of agents. (See Attorneys  
and agents.)
- Award in arbitration . . . . . 1.335

**B**

Balance in deposit account . . . . . 1.25  
 Basic filing fee. . . . . 1.16  
 Benefit of earlier application. . . . . 1.78  
 Bill in equity. (See Civil action.)  
 Biological material. (See Deposit of biological material.)  
 Board of Patent Appeals and Interferences. (See Appeal to Board of Patent Appeals and Interferences.)  
 Briefs:  
     In petitions to Director. . . . . 1.181  
     On appeal to Board . . . . . 41.37  
 Business to be conducted with decorum and courtesy . . . . . 1.3  
 Business to be transacted in writing . . . . . 1.2

**C**

Certificate of correction. . . . . 1.322, 1.323  
     Fees . . . . . 1.20  
     Mistakes not corrected. . . . . 1.325  
 Certificate of mailing (First Class) or transmission . . 1.8  
 Certification effect of presentation  
     to Office . . . . . 1.4(d), 10.18  
 Certified copies of records, papers, etc.. . . . . 1.4(f), 1.13  
     Fee for certification . . . . . 1.19(b)  
 Chemical and mathematical formulae and tables . . . 1.58  
 Citation of prior art in patented file. . . . . 1.501  
 Citation of references. . . . . 1.104  
 Civil action . . . . . 1.303, 1.304  
 Claims (See also Examination of applications):  
     Amendment of . . . . . 1.121  
     Commence on separate sheet or electronic page . . . . . 1.52(b), 1.75(h)  
     Conflicting, same applicant or owner . . . . . 1.78  
     Date of invention of. . . . . 1.110  
     Dependent . . . . . 1.75  
     Design patent . . . . . 1.153  
     May be in dependent form. . . . . 1.75  
     More than one permitted . . . . . 1.75  
     Multiple dependent . . . . . 1.75  
     Must conform to invention and specification . . . 1.75  
     Notice of rejection of. . . . . 1.104  
     Numbering of. . . . . 1.126  
     Part of complete application . . . . . 1.51  
     Plant patent. . . . . 1.164  
     Rejection of . . . . . 1.104  
     Required. . . . . 1.75  
     Separate from other parts of application . . . . 1.75(h)  
     Twice rejected before appeal . . . . . 41.31  
 Color drawing . . . . . 1.6(d)(4), 1.84(a)(2)

Commissioner of Patents and Trademarks (See Director of the USPTO.)  
 Common ownership, statement by assignee may be required. . . . . 1.78(c)  
 Compact disc submissions. (See Electronic documents.)  
 Complaints against examiners, how presented. . . . . 1.3  
 Complaints regarding invention promoters (See Invention promoters.)  
 Composition of matter, specimens of ingredients may be required. . . . . 1.93  
 Computer program listing appendix . . . . . 1.96  
 Concurrent office proceedings . . . . . 1.565  
 Conflicting claims, same applicant or owner in two or more applications. . . . . 1.78  
 Contested cases before the Board of Patent Appeals and Interferences. . . . . 41.100-41.208  
 Continued examination, request for . . . . . 1.114  
     Fee. . . . . 1.17  
     Suspension of action after . . . . . 1.103  
 Continued prosecution application. . . . . 1.53(d)  
     Suspension of action in . . . . . 1.103  
 Continuing application for invention disclosed and claimed in prior application . . . . . 1.53, 1.63  
 Control number, display of. . . . . 1.419  
 Copies of patents, published applications, records, etc. . . . . 1.11, 1.12, 1.13  
 Copies of records, fees . . . . . 1.19(b), 1.59  
 Copyright notice in specification . . . . . 1.71(d)  
 Copyright notice on drawings . . . . . 1.84(s)  
 Correction, certificate of. . . . . 1.322, 1.323  
 Correction of inventorship:  
     In a nonprovisional application . . . . . 1.48  
         Before filing oath/declaration . . . 1.41(a)(1), 1.76(c)  
         By filing oath/declaration . . . . . 1.76(d)(3)  
         When filing a continuation or divisional application . . . . . 1.63(d)  
         When filing a continued prosecution application . . . . . 1.53(d)(4)  
     In a provisional application . . . . . 1.48  
         By filing a cover sheet . . . . . 1.48(f)(2)  
         Without filing a cover sheet . . . . . 1.41(a)(2)  
     In a reexamination proceeding . . . . . 1.530  
     In an international application . . . . . 1.472  
         When entering the national stage . . . . . 1.497  
     In an issued patent . . . . . 1.324  
     In other than a reissue application . . . . . 1.48  
 Inconsistencies between application data sheet and oath or declaration . . . . . 1.76(d)  
 Motion to correct inventorship in an interference . . . . . 41.121(a)(2)  
 Supplemental application data sheet(s) . . . . . 1.76(c)

- Correspondence:
- Address:
    - Change of correspondence address . . . . . 1.33(a)
    - Established by the office if more than one is specified . . . . . 1.33(a)
    - Of the U.S. Patent and Trademark Office . . . . . 1.1
  - Business with the Office to be transacted by . . . . . 1.2
  - Discourteous communications not entered . . . . . 1.3
  - Double, with different parties in interest not allowed . . . . . 1.33
  - Duplicate copies disposed of . . . . . 1.4
  - Facsimile transmission . . . . . 1.6(d)
  - Held with attorney or agent . . . . . 1.33
  - Identification of application or patent in letter relating to . . . . . 1.5
  - Involving national security . . . . . 5.1
  - May be held exclusively with assignee(s) of entire interest . . . . . 3.71
  - Nature of . . . . . 1.4
  - Patent owners in reexamination . . . . . 1.33(c)
  - Receipt of letters and papers . . . . . 1.6
  - Rules for conducting in general . . . . . 1.1-1.8
  - Separate letter for each subject or inquiry . . . . . 1.4
  - Signature requirements . . . . . 1.4(d)
  - When no attorney or agent . . . . . 1.33
  - With attorney or agent after power or authorization is filed . . . . . 1.33
- Court of Appeals for the Federal Circuit, appeal to. (See Appeal to Court of Appeals for the Federal Circuit.)
- Credit card payment . . . . . 1.23
- Cross-reference to related applications . . . . . 1.76-1.78
- Customer Number
- Defined . . . . . 1.32(a)(4)
  - Required to establish a Fee Address . . . . . 1.363(c)
- D**
- Date of invention of subject matter of individual claims . . . . . 1.110
- Day for taking any action or paying any fee falling on Saturday, Sunday, or Federal holiday . . . . . 1.7
- Death or insanity of inventor . . . . . 1.42, 1.43
- In an international application . . . . . 1.422, 1.423
- Decision by the Board of Patent Appeals and Interferences . . . . . 41.50
- Return of jurisdiction to examiner . . . . . 1.197(a)
  - Termination of proceedings . . . . . 1.197(b)
- Declaration (See also Oath in patent application):
- Foreign language . . . . . 1.69
  - In lieu of oath . . . . . 1.68
  - In patent application . . . . . 1.68
- Deferral of examination . . . . . 1.103
- Definitions:
- Assignment . . . . . 3.1
  - Customer Number . . . . . 1.32(a)(4)
  - Document . . . . . 3.1
  - Federal holiday within the District of Columbia . . . . . 1.9
  - National and international applications . . . . . 1.9
  - National security classified . . . . . 1.9
  - Nonprofit organization . . . . . 1.27
  - Person (for small entity purposes) . . . . . 1.27
  - Power of Attorney . . . . . 1.32(a)(1)
  - Principal . . . . . 1.32(a)(2)
  - Published application . . . . . 1.9
  - Recorded document . . . . . 3.1
  - Revocation . . . . . 1.32(a)(3)
  - Service of process . . . . . 15 CFR Part 15
  - Small business concern . . . . . 1.27
  - Small entity . . . . . 1.27
  - Terms under Patent Cooperation Treaty . . . . . 1.401
  - Testimony by employees . . . . . 15 CFR Part 15a
- Delivery of patent . . . . . 1.315
- Deposit accounts . . . . . 1.25
- Fees . . . . . 1.21(b)
- Deposit of biological material:
- Acceptable depository . . . . . 1.803
  - Biological material . . . . . 1.801
  - Examination procedures . . . . . 1.809
  - Furnishing of samples . . . . . 1.808
  - Need or opportunity to make a deposit . . . . . 1.802
  - Replacement or supplemental deposit . . . . . 1.805
  - Term of deposit . . . . . 1.806
  - Time of making original deposit . . . . . 1.804
  - Viability of deposit . . . . . 1.807
- Deposit of computer program listings . . . . . 1.52(e), 1.96
- Depositions (See also Testimony in contested cases before the Board):
- Certificate of officer to accompany . . . . . 41.157(e)
  - Original filed as exhibit . . . . . 41.157(e)
  - Person before whom taken . . . . . 41.157(e)
  - Transcripts of . . . . . 41.154(a), 41.157
- Description of invention. (See Specification.)
- Design Patent Applications:
- Arrangement of application elements . . . . . 1.154
  - Claim . . . . . 1.153
  - Drawing . . . . . 1.152
  - Expedited examination . . . . . 1.155
  - Filing fee . . . . . 1.16(b)
  - Issue fee . . . . . 1.18(b)

Oath . . . . . 1.153

Rules applicable . . . . . 1.151

Title, description and claim . . . . . 1.153

Determination of request for *ex parte* reexamination . . . . . 1.515

Director of the USPTO (See also Petition to the Director):

    Address of . . . . . 1.1

    Availability of decisions by . . . . . 1.14

    Initiates *ex parte* reexamination . . . . . 1.520

Disclaimer, statutory:

    Fee . . . . . 1.20(d)

    Requirements of . . . . . 1.321

    Terminal . . . . . 1.321

Disclosure, amendments to add new matter not permitted . . . . . 1.121

Disclosure document fee . . . . . 1.21(c)

Discovery in contested cases before the Board . . 41.150-41.158

Division. (See Restriction of application.)

Document supply fees . . . . . 1.19

Drawing:

    Amendment of . . . . . 1.121

    Arrangement of views . . . . . 1.84(i)

    Arrows . . . . . 1.84(r)

    Character of lines . . . . . 1.84(l)

    Color . . . . . 1.6(d)(4), 1.84(a)(2), 1.165(b)

    Content of drawing . . . . . 1.83

    Copyright notice . . . . . 1.84(s)

    Correction . . . . . 1.84(w), 1.85(c), 1.121

    Cost of copies of . . . . . 1.19

    Design application . . . . . 1.152

    Figure for front page . . . . . 1.76, 1.84(j)

    Filed with application . . . . . 1.81

    Graphics . . . . . 1.84(d)

    Hatching and shading . . . . . 1.84(m)

    Holes . . . . . 1.84(x)

    Identification . . . . . 1.84(c)

    If of an improvement, must show connection with old structure . . . . . 1.83

    Informal drawings . . . . . 1.85

    Ink . . . . . 1.84(a)(1)

    Lead lines . . . . . 1.84(q)

    Legends . . . . . 1.84(o)

    Letters . . . . . 1.84(p)

    Location of names . . . . . 1.84(c)

    Mask work notice . . . . . 1.84(s)

    Must be described in and referred to specification . . . . . 1.74

    Must show every feature of the invention . . . . . 1.83

    No return or release . . . . . 1.85(b)

    Numbering of sheets . . . . . 1.84(t)

Numbering of views . . . . . 1.84(u)

Numbers . . . . . 1.84(p)

Original should be retained by applicant . . . . 1.81(a)

Paper . . . . . 1.84(e)

Part of application papers . . . . . 1.52

Photographs . . . . . 1.84(b)

Plant patent application . . . . . 1.81, 1.165

Reference characters . . . . . 1.74, 1.84(p)

Reissue . . . . . 1.173

Release not permitted . . . . . 1.85(b)

Required by law when necessary for understanding . . . . . 1.81

Scale . . . . . 1.84(k)

Security markings . . . . . 1.84(v)

Shading . . . . . 1.84(m)

Size of sheet and margins . . . . . 1.84(f),(g)

Standards for drawings . . . . . 1.84

Symbols . . . . . 1.84(n)

Views . . . . . 1.84(h)

    When necessary, part of complete application . . . 1.51

Duty of disclosure . . . . . 1.56, 1.555

    Patent term extension . . . . . 1.765

**E**

Election of species . . . . . 1.146

Electronic documents:

    Compact disc submissions:

        Amino acid sequences . . . . . 1.821, 1.823, 1.825

        Computer program listings . . . . . 1.96

        Incorporation by reference in specification . . . 1.52

        Nuclide acid sequences . . . . . 1.821, 1.823, 1.825

        Requirements . . . . . 1.52

        Submitted as part of permanent record . . . 1.52, 1.58, 1.96, 1.821, 1.823, 1.825

        Tables . . . . . 1.58

Employee testimony. (See Testimony by Office employees.)

Establishing small entity status . . . . . 1.27, 1.28

Evidence in contested cases before the Board . . . . . 41.154

*Ex parte* reexamination. (See Reexamination.)

Examination of applications:

    Advancement of examination . . . . . 1.102

    As to form . . . . . 1.104

    Citation of references . . . . . 1.104

    Completeness of examiner's action . . . . . 1.104

    Deferral of . . . . . 1.103

    Examiner's action . . . . . 1.104

    International-type search . . . . . 1.104

    Nature of examination . . . . . 1.104

    Reasons for allowance . . . . . 1.104

    Reconsideration after rejection if requested . . . 1.111





Mailing address . . . . . 150.6  
 Submission of requests . . . . . 150.3  
 Formulas and tables in patent applications. . . . . 1.58  
 Fraud practiced or attempted on Office . . . . . 1.56  
 Freedom of Information Act (FOIA) . . . . . Part 102  
     Appeals from initial determinations or  
         untimely delays . . . . . 102.10  
     Business information . . . . . 102.9  
     Correspondence address . . . . . 102.1, 102.4  
     Expedited processing . . . . . 102.6  
     Fees . . . . . 102.11  
     Public reference facilities . . . . . 102.2  
     Records . . . . . 102.3  
     Responses to requests . . . . . 102.7  
         Responsibility for responding . . . . . 102.5  
         Time limits . . . . . 102.6  
     Requirements for making requests . . . . . 102.4

**G**

*Gazette.* (See *Official Gazette.*)  
 General authorization to charge deposit account 1.25, 1.136  
 General information and correspondence . . . . . 1.1-1.8  
 Government acquisition of foreign patent rights. Part 501  
 Government employee invention . . . . . Part 501  
 Government interest in patent, recording of . 3.11, 3.31,  
     3.41, 3.58  
 Governmental registers . . . . . 3.58  
 Guardian of insane person may apply for patent. . . . 1.43

**H**

Hearings:  
     Before the Board of Patents Appeals and Inter-  
         ferences . . . . . 41.47  
     Fee for appeal hearing . . . . . 41.20  
 Holiday, time for action expiring on . . . . . 1.6, 1.7

**I**

Identification of application, patent or registration . . . 1.5  
 Inconsistencies between application data sheet  
     and oath or declaration . . . . . 1.76(d)  
 Incorporation by reference. . . . . 1.57  
 Information disclosure statement:  
     At time of filing application. . . . . 1.51  
     Content of . . . . . 1.98  
     Not permitted in provisional applications . . . . . 1.51  
     Reexamination . . . . . 1.555, 1.902  
     Suspension of action to provide time for  
         consideration of an IDS in a CPA . . . . . 1.103(b)  
     Third party submission of . . . . . 1.99  
     To comply with duty of disclosure . . . . . 1.97  
 Information, Public . . . . . Part 102

Insane inventor, application by guardian of . . . . . 1.43  
*Inter partes* reexamination. (See Reexamination.)  
 Interferences:  
     Abandonment of the contest . . . . . 41.127  
     Access to applications. . . . . 1.11(e)  
     Addition of patent or application. . . . . 41.203  
     Amendment during . . . . . 41.121  
     Appeal to the Court of Appeals for the Federal  
         Circuit. . . . . 1.301, 1.302  
     Applicant requests . . . . . 41.202  
     Arbitration. . . . . 41.126  
     Burden of proof. . . . . 41.207  
     Civil action . . . . . 1.303  
     Common interests in the invention . . . . . 41.206  
     Concession of priority. . . . . 41.127  
     Copying claims from patent . . . . . 41.121, 41.202  
     Declaration of interference . . . . . 41.203  
     Definitions . . . . . 41.201  
     Disclaimer to avoid interference. . . . . 41.127  
     Discovery . . . . . 41.150  
     Extension of time . . . . . 41.4  
     In what cases declared . . . . . 41.203  
     Junior party fails to overcome filing date of  
         senior party. . . . . 41.204  
     Jurisdiction over involved files. . . . . 41.103  
     Manner of service of papers . . . . . 41.106  
     Motions . . . . . 41.121  
     Notice to file civil action . . . . . 1.303  
     Notice of declaration. . . . . 41.203  
     Petitions . . . . . 41.3  
     Presumption as to order of invention . . . . . 41.207  
     Priority Statement . . . . . 41.204  
     Prosecution by owner of entire interest . . . . . 41.9  
     Records of, when open to public . . . . . 1.11(e)  
     Requests by applicants . . . . . 41.202  
     Review of decision by civil action . . . . . 1.303  
     Same party . . . . . 41.206  
     Sanctions . . . . . 41.128  
     Secrecy order cases. . . . . 5.3(b)  
     Service of papers. . . . . 41.106  
     Statutory disclaimer by patentee during . . . . . 41.127  
     Suggestion of claims for interference . . . . . 41.202  
     Suspension of other proceedings . . . . . 41.103  
     Time period for completion . . . . . 41.200  
     Translation of document in foreign language . . 41.154  
 International application. (See Patent Cooperation  
     Treaty.)  
 International Preliminary Examining Authority. . . . 1.416  
 Interview summary . . . . . 1.133  
 Interviews with examiner . . . . . 1.133, 1.560  
 Invention promoters:  
     Complaints regarding . . . . . 4.1-4.6

Publication of . . . . . 4.1, 4.3, 4.5  
 Reply to . . . . . 4.4  
 Submission of . . . . . 4.3  
 Withdrawal of . . . . . 4.3  
 Definition . . . . . 4.2  
 Reply to complaint . . . . . 4.4  
 Inventor (See also Applicant for patent, Application for patent):  
   Death or insanity of inventor . . . . . 1.42, 1.43  
     In an international application . . . . . 1.422, 1.423  
   Refuses to sign application . . . . . 1.47  
   To make application . . . . . 1.41, 1.45  
   Unavailable . . . . . 1.47  
 Inventor's certificate priority benefit . . . . . 1.55  
 Inventorship and date of invention of the subject matter of individual claims . . . . . 1.110  
 Issue fee . . . . . 1.18  
 Issue of patent. (See Allowance and issue of patent.)

**J**

Joinder of inventions in one application . . . . . 1.141  
 Joint inventors . . . . . 1.45, 1.47, 1.324  
 Joint patent to inventor and assignee . . . . . 1.46, 3.81  
 Jurisdiction:  
   After decision by Board of Patent Appeals and Interferences . . . . . 1.197, 1.198  
   After notice of allowance . . . . . 1.312  
   Over involved files . . . . . 41.103

**L**

Lapsed patents . . . . . 1.317  
 Legal representative of deceased or incapacitated inventor . . . . . 1.42-1.43, 1.64  
 Legibility of papers . . . . . 1.52  
 Letters to the Office. (See Correspondence.)  
 Library service fee . . . . . 1.19(c)  
 License and assignment of government interest in patent . . . . . 3.11, 3.31, 3.41  
 License for foreign filing . . . . . 5.11-5.15  
 List of U.S. patents classified in a subclass, cost of . . . . . 1.19(d)  
 Local delivery box rental . . . . . 1.21(d)  
 Lost files . . . . . 1.251

**M**

Mail Stops  
   Mail Stop 4 . . . . . 150.6  
   Mail Stop 8 . . . . . 1.1(a)(3)  
   Mail Stop 24 . . . . . 4.3(c)  
   Mail Stop Assignment Recordation Services . . . . . 1.1(a)(4), 3.27

Mail Stop Document Services . . . . . 1.1(a)(4)  
 Mail Stop *Ex parte* Reexam . . . . . 1.1(c)(1)  
 Mail Stop *Inter partes* Reexam . . . . . 1.1(c)(2)  
 Mail Stop Interference . . . . . 41.10(b)  
 Mail Stop L&R . . . . . 5.1  
 Mail Stop M Correspondence . . . . . 1.1(d)(2)  
 Mail Stop OED . . . . . 4.6  
 Mail Stop Patent Ext . . . . . 1.1(e)  
 Mail Stop PCT . . . . . 1.1(b), 1.417, 1.434(a), 1.480(b)  
 Maintenance fees . . . . . 1.20  
   Acceptance of delayed payment of . . . . . 1.378  
   Address for payments . . . . . 1.1(d)(1)  
   Address for correspondence (at PTO) . . . . . 1.1(d)(2)  
   Address for correspondence (applicant's) . . . . . 1.363  
   Review of decision refusing to accept . . . . . 1.377  
   Submission of . . . . . 1.366  
   Time for payment of . . . . . 1.362  
 Mask work notice in specification . . . . . 1.71(d)  
 Mask work notice on drawing . . . . . 1.84(s)  
 Mask work protection, foreign . . . . . Part 150  
 Microorganisms. (See Deposit of biological material.)  
 Minimum balance in deposit accounts . . . . . 1.25  
 Missing pages when application filed . . . . . 1.53(e)  
 Mistake in patent, certificate thereof issued . . . . . 1.322, 1.323  
 Models and exhibits:  
   Copies of . . . . . 1.95  
   Disposal without notice unless return arrangements made . . . . . 1.94  
   If on examination model found necessary request therefor will be made . . . . . 1.91  
   In contested cases . . . . . 41.154  
   May be required . . . . . 1.91  
   Model not generally admitted in application or patent . . . . . 1.91  
   Not to be taken from the Office except in custody of sworn employee . . . . . 1.95  
   Return of . . . . . 1.94  
   Working model may be required . . . . . 1.91  
 Money. (See Fees and payment of money.)  
 Motions in interferences . . . . . 41.121  
   To take testimony in foreign country . . . . . 41.156(b)

**N**

Name of Applicant or Inventor (see Applicant for patent, Application for patent, Inventor)  
 New matter inadmissible in application . . . . . 1.121  
 New matter inadmissible in reissue . . . . . 1.173  
 Non-English language specification fee . . . . . 1.17(i)  
 Nonprofit organization:  
   Definition . . . . . 1.27  
   Small entity status . . . . . 1.27

Notice:

- Of allowance of application . . . . . 1.311
- Of appeal to the Court of Appeals for the Federal Circuit . . . . . 1.301, 1.302
- Of arbitration award . . . . . 1.335
- Of defective *ex parte* reexamination request . 1.510(c)
- Of declaration of interference . . . . . 41.203
- Of oral hearings before the Board of Patent Appeals and Interferences . . . . . 41.47
- Of rejection of an application . . . . . 1.104
- Of taking testimony . . . . . 41.157(c)

Nucleotide and/or amino acid sequences:

- Amendments to . . . . . 1.825
- Disclosure in patent applications . . . . . 1.821
- Form and format for computer readable form . . 1.824
- Format for sequence data . . . . . 1.822
- Replacement of . . . . . 1.825
- Requirements . . . . . 1.823
- Submission on compact disc . . . . . 1.52, 1.821, 1.823
- Symbols . . . . . 1.822

**O**

Oath in patent application. (See also Declaration):

- Apostles . . . . . 1.66
- Before whom taken in foreign countries . . . . . 1.66
- Before whom taken in United States . . . . . 1.66
- By administrator or executor . . . . . 1.42, 1.63, 1.64
- By guardian of insane person . . . . . 1.43, 1.63, 1.64
- Certificate of Officer administering . . . . . 1.66
- Continuation-in-part . . . . . 1.63(e)
- Declaration . . . . . 1.68
- Foreign language . . . . . 1.69
- International application . . . . . 1.497
- Inventor's Certificate . . . . . 1.63
- Made by inventor . . . . . 1.41, 1.63
- Made by someone other than inventor . . . . . 1.64(b)
- Officers authorized to administer oaths . . . . . 1.66
- Part of complete application . . . . . 1.51
- Person making . . . . . 1.64
- Plant patent application . . . . . 1.162
- Requirements of . . . . . 1.63
- Ribboned to other papers . . . . . 1.66
- Sealed . . . . . 1.66
- Signature to . . . . . 1.63, 1.64, 1.67
- Supplemental . . . . . 1.67
- To acknowledge duty of disclosure . . . . . 1.63
- When taken abroad to seal all papers . . . . . 1.66

Oath or declaration in reissue application . . . . . 1.175

Oath or declaration

- Plant patent application . . . . . 1.162
- When international application enters national stage . . . . . 1.497
- Object of the invention . . . . . 1.73
- Office action time for reply . . . . . 1.134
- Office fees. (See Fees and payment of money.)
- Official action, based exclusively upon the written record . . . . . 1.2
- Official business, should be transacted in writing . . . . 1.2
- Official Gazette*:
  - Amendments to rules published in . . . . . 1.351
  - Announces request for reexamination . 1.11(c), 1.904
  - Notice of filing application to nonsigning inventor . . . . . 1.47
  - Notice of issuance of *ex parte* reexamination certificate . . . . . 1.570(f)
  - Notice of issuance of *inter partes* reexamination certificate . . . . . 1.997
- Oral statements . . . . . 1.2

**P**

- Payment of fees, Method . . . . . 1.23
- Paper, definition of . . . . . 1.9
- Papers (requirements to become part of Office permanent records) . . . . . 1.52
- Papers not received on Saturday, Sunday, or holidays . . . . . 1.6
- Patent application. (See Application for patent and Provisional patent applications.)
- Patent application publication. (See Published application.)
- Patent attorneys and agents. (See Attorneys and agents.)
- Patent Cooperation Treaty:
  - Access to international application files . . . 1.14(g)
  - Amendments and corrections during international processing . . . . . 1.471
  - Amendments during international preliminary examination . . . . . 1.485
  - Applicant for international application . . . . . 1.421
  - Changes in person, name or address, where filed . . . . . 1.421(f), 1.472
  - Conduct of international preliminary examination . . . . . 1.484
  - Copies of international application files . . . . 1.14(g)
  - Definition of terms . . . . . 1.401
  - Delays in meeting time limits . . . . . 1.468
  - Demand for international preliminary examination . . . . . 1.480
  - Designation of States . . . . . 1.432
  - Entry into national stage . . . . . 1.491, 1.495

- Examination at national stage . . . . . 1.496
- Fees:
- Authorization to charge fees under  
37 CFR 1.16 . . . . . 1.25(b)
  - Due on filing of international application. . 1.431(c)
  - Failure to pay results in withdrawal of  
application . . . . . 1.431(d), 1.432
  - Filing, processing and search fees . . . . . 1.445
  - International Filing Fee . . . . . 1.431(c), 1.445(b)
  - International preliminary  
examination . . . . . 1.481, 1.482
  - National stage. . . . . 1.25(b), 1.492
  - Refunds . . . . . 1.446
- Filing by other than inventor . . . . . 1.421(b)
- International application requirements . . . . . 1.431
- Abstract . . . . . 1.438
  - Claims . . . . . 1.436
  - Description . . . . . 1.435
  - Drawings . . . . . 1.437
  - Physical requirements . . . . . 1.433
  - Request. . . . . 1.434
- International Bureau . . . . . 1.415
- International Preliminary Examining  
Authority . . . . . 1.416
- Inventor deceased . . . . . 1.422
- Inventor insane or legally incapacitated . . . . . 1.423
- Inventors, joint. . . . . 1.421(b), 1.497
- National stage in the United States:
- Commencement . . . . . 1.491
  - Entry . . . . . 1.491, 1.495
  - Examination . . . . . 1.496
  - Fees . . . . . 1.25(b); 1.492
- Oath or declaration at national stage . . . . . 1.497
- Priority, claim for. . . . . 1.55, 1.451
- Record copy to International Bureau,  
transmittal procedures . . . . . 1.461
- Representation by attorney or agent . . . . . 1.455
- Time limits for processing applications. . 1.465, 1.468
- United States as:
- Designated or Elected Office . . . . . 1.414
  - International Searching Authority . . . . . 1.413
  - Receiving Office . . . . . 1.412
- Unity of invention:
- Before International Searching  
Authority . . . . . 1.475, 1.476
  - Before International Preliminary Examining  
Authority . . . . . 1.488
  - National stage. . . . . 1.475, 1.499
  - Protest to lack of. . . . . 1.477, 1.489
- Patent term adjustment due to examination  
delay . . . . . 1.702-1.705
- Application for . . . . . 1.705
  - Determination . . . . . 1.705
  - Grounds for . . . . . 1.702
  - Period of adjustment . . . . . 1.703
  - Reduction of period of adjustment . . . . . 1.704
- Patent term extension due to examination delay . . 1.701
- Patent term extension due to regulatory review  
period. (See Extension of patent term due to  
regulatory review period (35 U.S.C. 156).)
- Patents (See also Allowance and issue of patent):
- Available for license or sale, publication of  
notice . . . . . 1.21(i)
  - Certified copies of . . . . . 1.13
  - Correction of errors in . . . 1.171, 1.322, 1.323, 1.324
  - Delivery of . . . . . 1.315
  - Disclaimer. . . . . 1.321
  - Identification required in letters concerning. . . . . 1.5
  - Lapsed, for nonpayment of issue fee . . . . . 1.317
  - Obtainable by civil action. . . . . 1.303
  - Price of copies . . . . . 1.19
  - Records of, open to public . . . . . 1.11, 1.12
  - Reissuing of, when defective . . . . . 1.171-1.178
- Payment of fees . . . . . 1.23
- Personal attendance unnecessary . . . . . 1.2
- Petition for reissue . . . . . 1.171, 1.172
- Petition to the Director:
- Fees . . . . . 1.17
  - For delayed payment of issue fee . . . . . 1.137
  - For expungement of papers . . . . . 1.59
  - For extension of time . . . . . 1.136
  - For license for foreign filing. . . . . 5.12
  - For the revival of an abandoned application . . . 1.137
  - From formal objections or requirements 1.113, 1.181
  - From requirement for restriction . . . . . 1.129, 1.144
  - General requirements . . . . . 1.181
  - In interferences . . . . . 41.3
  - In reexamination . . . . . 1.181
  - If examiner refused the *ex parte* request. . . 1.515(c)
  - On refusal of examiner to admit amendment . . . 1.127
  - Questions not specifically provided for . . . . . 1.182
  - Suspension of rules. . . . . 1.183
  - Petition to accept an unintentionally  
delayed claim for domestic  
priority . . . . . 1.78(a)(3), 1.78(a)(6)
  - Petition to accept an unintentionally delayed  
claim for foreign priority . . . . . 1.55(c)
  - To exercise supervisory authority. . . . . 1.181
  - To make special . . . . . 1.102
  - Untimely unless filed within two months . . . . 1.181

Photographs . . . . .	1.84(b), 1.152	Privacy Act . . . . .	Part 102
Plant patent applications:		Denial of access to records . . . . .	102.25
Applicant . . . . .	1.162	Definitions . . . . .	102.22
Claim . . . . .	1.164	Disclosure of records . . . . .	102.25, 102.30
Declaration . . . . .	1.162	Exemptions . . . . .	102.33, 102.34
Description . . . . .	1.162	Fees . . . . .	102.31
Drawings . . . . .	1.165	Grant of access to records . . . . .	102.25
Examination . . . . .	1.167	Inquiries . . . . .	102.23
Fee for copies . . . . .	1.19	Medical records . . . . .	102.26
Filing fee . . . . .	1.16(c)	Penalties . . . . .	102.32
Issue fee . . . . .	1.18(c)	Requests for records . . . . .	102.24
Oath . . . . .	1.162	Requests for correction or amendment . . . . .	102.27
Rules applicable . . . . .	1.161	Appeal of initial adverse determination . . . . .	102.29
Specification and arrangement of application		Review of requests . . . . .	102.28
elements . . . . .	1.163	Processing and retention fee . . . . .	1.21(l), 1.53(f)
Specimens . . . . .	1.166	Proclamation as to protection of foreign mask	
Post issuance and reexamination fees . . . . .	1.20	works . . . . .	Part 150
Post Office receipt as filing date . . . . .	1.10	Protests to grants of patent . . . . .	1.291
Postal emergency or interruption . . . . .	1.10(g)-(i)	Provisional applications:	
Power of attorney. (See Attorneys or agents.)		Claiming the benefit of . . . . .	1.78
Power to inspect . . . . .	1.14(c)	Converting a nonprovisional to a provisional. . . . .	1.53(c)
Preliminary amendments . . . . .	1.115	Converting a provisional to a	
Preliminary Examining Authority, International . . . . .	1.416	nonprovisional . . . . .	1.53(c)
Preserved in confidence, applications . . . . .	1.12, 1.14	Cover sheet required by § 1.51(c)(1) may be a	
Exceptions (status, access or copies available) . . . . .	1.14	§ 1.76 application data sheet . . . . .	1.53(c)(1)
Prior art citation in patented files . . . . .	1.501	Filing date . . . . .	1.53(c)
Prior art statement:		Filing fee . . . . .	1.16(d)
Content of . . . . .	1.98	General requisites . . . . .	1.51(c)
To comply with duty of disclosure. . . . .	1.97	Later filing of fee and cover sheet . . . . .	1.53(g)
Prior invention, affidavit or declaration of to		Names of inventor(s) . . . . .	1.41(a)(2)
overcome rejection . . . . .	1.130, 1.131	Application data sheet . . . . .	1.53(c)(1), 1.76
Priority, right of, under treaty or law:		Correction of . . . . .	1.48
Domestic benefit claim:		Cover sheet . . . . .	1.51(c)(1), 1.53(c)(1)
Cross-reference to related		Joint inventors . . . . .	1.45
application(s) . . . . .	1.76-1.78	No right of priority . . . . .	1.53(c)
Filing fee must be paid in provisional appli-		No examination . . . . .	1.53(i)
cation . . . . .	1.78	Papers concerning, should identify provisional	
Indication of whether international applica-		application as such, by application number . . . . .	1.5(f)
tion was published in English . . . . .	1.78(a)(2)	Parts of complete provisional application. . . . .	1.51(c)
May be in first sentence of application or on		Processing fees . . . . .	1.17
application data sheet . . . . .	1.78	Revival of . . . . .	1.137
Petition to accept, unintentionally delayed . . . . .	1.78	When abandoned . . . . .	1.53(i)
Translation of non-English language		Provisional rights	
provisional application required . . . . .	1.78	Submission of international publication or	
Waived if not timely . . . . .	1.78	English translation thereof pursuant to 35	
Foreign priority claim:		U.S.C. 154(d)(4) . . . . .	1.417
Filed after issue fee has been paid . . . . .	1.55	Public Information . . . . .	Part 102
May be on application data sheet or in oath/		Public use proceedings . . . . .	1.292
declaration . . . . .	1.63(c)	Fee . . . . .	1.17(j)
Petition to accept, unintentionally delayed . . . . .	1.55	Publication of application . . . . .	1.211
Priority document . . . . .	1.55	Early publication . . . . .	1.219
Time for claiming . . . . .	1.55	Express abandonment to avoid publication . . . . .	1.138

Fee	1.18
Nonpublication request	1.213
Publication of redacted copy	1.217
Republication	1.221
Voluntary publication	1.221
Published application	
Access to	1.11, 1.14
Certified copies of	1.13
Contents	1.215
Definition	1.9
Records of, open to public	1.11, 1.12
Republication of	1.221
Third party submission in	1.99

**R**

Reasons for allowance	1.104
Reconsideration of Office action	1.112
Reconstruction of lost files	1.251
Recording of assignments. (See Assignments and recording.)	
Records of the Patent and Trademark Office	1.11-1.15
Reexamination:	
Announcement in O.G.	1.11(c)
Correction of inventorship	1.530
Correspondence address	1.33(c)
<i>Ex parte</i> proceedings:	
Amendments, manner of making	1.121(j), 1.530
Appeal to Board	41.31
Appeal to C.A.F.C.	1.301
Civil action under 35 U.S.C. 145	1.303
Concurrent with interference, reissue, other reexamination, litigation, or office proceeding(s)	1.565
Conduct of	1.550
Duty of disclosure in	1.555
Examiner's determination to grant or refuse request for	1.515
Extensions of time in	1.550(c)
Initiated by the Director	1.520
Interviews in	1.560
Issuance of certificate at conclusion of	1.570
Order for reexamination by examiner	1.525
Patent owner's statement	1.530, 1.540
Processing of prior art citations during	1.502
Reply to patent owner's statement to third party requester	1.535, 1.540
Request for	1.510
Scope of	1.552
Service of papers	1.248
Examiner's action	1.104
Fee	1.20(c)
Fees may be charged to deposit account	1.25
Identification in letter	1.5(d)
<i>Inter partes</i> proceedings	1.902-1.997
Amendments, manner of making	1.121(j), 1.530, 1.941
Appeal to Board	41.61
Appeal to C.A.F.C.	1.983
Civil action under 35 U.S.C. 145 not available	1.303(d)
Concurrent with interference, reissue, other reexamination, litigation, or office proceeding(s)	1.565, 1.985
Conduct of	1.937
Duty of disclosure in	1.555, 1.923
Examiner's determination to grant or refuse request for	1.923-1.927
Extensions of time in	1.956
Filing date of request for	1.919
Issuance of certificate at conclusion of	1.997
Merged with concurrent reexamination proceedings	1.989
Merged with reissue application	1.991
Notice of, in the <i>Official Gazette</i>	1.904
Persons eligible to file request for	1.903
Processing of prior art citations during	1.902
Scope of	1.906
Service of papers	1.248, 1.903
Submission of papers by the public	1.905
Subsequent requests for	1.907
Suspension due to concurrent interference	1.993
Suspension due to litigation	1.987
Information Disclosure Statements	1.98, 1.555
Open to public	1.11(d)
Reconsideration before final action	1.112
Refund of fee	1.26
Reply to action	1.111
Revival of terminated proceeding	1.137
Reference characters in drawings	1.74, 1.84(p)
References cited on examination	1.104
Refund of money paid by mistake	1.26
International applications	1.446
Later establishment of small entity status	1.28
Time period for requesting	1.26
Register of Government interest in patents	3.58
Rehearing:	
On appeal to Board	41.52
Request for, time for appeal after action on	1.304
Reissues:	
Amendments	1.173
Applicants, assignees	1.172
Application for reissue	1.171
Application made and sworn to by inventor, if living	1.172

Continuing duty of applicant . . . . . 1.178  
 Declaration . . . . . 1.175  
 Drawings . . . . . 1.173  
 Examination of reissue . . . . . 1.176  
 Filed during *ex parte* reexamination . . . . . 1.565  
 Filed during *inter partes* reexamination . . . . . 1.985  
 Filing fee . . . . . 1.16  
 Filing of announcement in *Official Gazette* . . . . . 1.11  
 Grounds for and requirements . . . . . 1.171-1.178  
 Issue fee . . . . . 1.18(a)  
 Multiple applications for reissue of a  
     single patent . . . . . 1.177  
 Oath . . . . . 1.175  
 Open to public . . . . . 1.11  
 Original patent surrendered . . . . . 1.178  
 Restriction . . . . . 1.176  
 Specification . . . . . 1.173  
 Take precedence in order of examination . . . . . 1.176  
 To contain no new matter . . . . . 1.173  
 What must accompany application . . . . . 1.171, 1.172  
 Rejection:  
     After two rejections appeal may be taken  
         from examiner to Board . . . . . 41.31  
     Applicant will be notified of rejection  
         with reasons and references . . . . . 1.104  
     Based on commonly owned prior art,  
         how overcome . . . . . 1.130  
     Examiner may rely on admissions by applicant  
         or patent owner, or facts within examiner's  
         knowledge . . . . . 1.104  
     Final . . . . . 1.113  
     Formal objections . . . . . 1.104  
     On account of invention shown by others but  
         not claimed, how overcome . . . . . 1.131  
     References will be cited . . . . . 1.104  
     Requisites of notice of . . . . . 1.104  
 Reply brief . . . . . 41.41  
 Reply to Office action:  
     Abandonment for failure to . . . . . 1.135  
     By applicant or patent owner . . . . . 1.111  
     Substantially complete . . . . . 1.135  
     Supplemental . . . . . 1.111  
     Time for . . . . . 1.134  
 Representative capacity . . . . . 1.34(a)  
 Request for continued examination . . . . . 1.114  
     Fee . . . . . 1.17  
     Suspension of action after . . . . . 1.103  
 Request for reconsideration . . . . . 1.112  
 Request for *ex parte* reexamination . . . . . 1.510  
 Request for *inter partes* reexamination . . . . . 1.913-1.927  
 Requirement for submission of information . . . . . 1.105

Reservation clauses not permitted . . . . . 1.79  
 Restriction of application . . . . . 1.141-1.146, 1.176  
     Claims to nonelected invention withdrawn . . . . . 1.142  
     Constructive election . . . . . 1.145  
     Petition from requirements for . . . . . 1.129, 1.144  
     Provisional election . . . . . 1.143  
     Reconsideration of requirement . . . . . 1.143  
     Requirement for . . . . . 1.142  
     Subsequent presentation of claims for different  
         invention . . . . . 1.145  
 Retention fee . . . . . 1.21(l), 1.53(f)  
 Return of correspondence . . . . . 1.5(a)  
 Revival of abandoned application, terminated  
     reexamination proceeding, or lapsed patent . . . . . 1.137  
     Unavoidable abandonment fee . . . . . 1.17(l)  
     Unintentional abandonment fee . . . . . 1.17(m)  
 Revocation of power of attorney or authorization  
     of agent . . . . . 1.36(a)  
 Rules of Practice:  
     Amendments to rules will be published . . . . . 1.351

**S**

Saturday, when last day falls on . . . . . 1.7  
 Secrecy order . . . . . 5.1-5.5  
 Sequences:  
     Amendments to sequence listing and computer  
         readable copy . . . . . 1.825  
     Disclosure requirements . . . . . 1.821, 1.823  
     Sequence data, symbols and format . . . . . 1.822  
     Submissions in computer readable form . . . . . 1.824  
     Submissions on compact disc in lieu of paper . . . . . 1.52,  
         1.821, 1.823  
 Serial number of application . . . . . 1.5  
 Service of notices:  
     In interference cases . . . . . 41.106  
     Of appeal to the U.S. Court of Appeals for the  
         Federal Circuit . . . . . 1.301  
 Service of papers . . . . . 1.248  
 Service of process . . . . . 15 CFR Part 15  
 Shortened period for reply . . . . . 1.134  
 Signature:  
     EFS character coded . . . . . 1.4(d)(3)  
     Handwritten . . . . . 1.4(d)(1)  
     Implicit certifications . . . . . 1.4(d), 10.18  
     S-signature . . . . . 1.4(d)(2)  
     To a written assertion of small entity status . . . . . 1.27(c)(2)  
     To amendments and other papers . . . . . 1.33(b)  
     To an application for extension of patent term . . . . . 1.730  
     To express abandonment . . . . . 1.138  
     To oath . . . . . 1.63  
     To reissue oath or declaration . . . . . 1.172  
     When copy is acceptable . . . . . 1.4



- Small business concern:  
 Definition . . . . . 1.27  
 Small entity status . . . . . 1.27
- Small entity:  
 Definition . . . . . 1.27  
 Errors in status excused . . . . . 1.28  
 Fraud on the office . . . . . 1.27  
 License to Federal agency . . . . . 1.27  
 Statement . . . . . 1.27  
 Statement in parent application . . . . . 1.27  
 Status establishment . . . . . 1.27, 1.28  
 Status update . . . . . 1.27, 1.28
- Solicitor's address . . . . . 1.1(a)(3), 1.302(c)
- Species of invention claimed . . . . . 1.141, 1.146
- Specification (See also Application for patent, Claims):  
 Abstract . . . . . 1.72  
 Amendments to . . . . . 1.121, 1.125  
 Arrangement of . . . . . 1.77, 1.154, 1.163  
 Best mode . . . . . 1.71  
 Claim . . . . . 1.75  
 Commence on separate sheet . . . . . 1.71(f)  
 Contents of . . . . . 1.71-1.75  
 Copyright notice . . . . . 1.71(d)  
 Cross-references to other applications . . . . . 1.78  
 Description of the invention . . . . . 1.71  
 If defective, reissue to correct . . . . . 1.171-1.178  
 Mask work notice . . . . . 1.71(d)  
 Must conclude with specific and distinct claim . . . . . 1.75  
 Must point out new improvements specifically . . . . . 1.71  
 Must refer by figures to drawings . . . . . 1.74  
 Must set forth the precise invention . . . . . 1.71  
 Object of the invention . . . . . 1.73  
 Order of arrangement in framing . . . . . 1.77  
 Paper, writing, margins . . . . . 1.52  
 Paragraph numbering . . . . . 1.52  
 Part of complete application . . . . . 1.51  
 Reference to drawings . . . . . 1.74  
 Requirements of . . . . . 1.71-1.75  
 Reservation clauses not permitted . . . . . 1.79  
 Separate from other parts of application . . . . . 1.71(f)  
 Substitute . . . . . 1.125  
 Summary of the invention . . . . . 1.73  
 Title of the invention . . . . . 1.72  
 To be rewritten, if necessary . . . . . 1.125
- Specimens. (See Models and exhibits.)
- Specimens of composition of matter to be furnished when required . . . . . 1.93
- Specimens of plants . . . . . 1.166
- Statement of status as small entity . . . . . 1.27
- Status information . . . . . 1.14
- Statutory disclaimer fee . . . . . 1.20(d)
- Statutory invention registrations . . . . . 1.293  
 Examination . . . . . 1.294  
 Publication of . . . . . 1.297  
 Review of decision finally refusing to publish . . . . . 1.295  
 Withdrawal of request for publication of . . . . . 1.296
- Submission of international publication or English translation thereof pursuant to 35 U.S.C. 154(d)(4) . . . . . 1.417
- Sufficient funds in deposit account . . . . . 1.25
- Suit in equity. (See Civil action.)
- Summary of invention . . . . . 1.73
- Sunday, when last day falls on . . . . . 1.7
- Supervisory authority, petition to  
 Director to exercise . . . . . 1.181
- Supplemental oath /declaration . . . . . 1.67
- Surcharge for oath or basic filing fee filed after filing date . . . . . 1.16(f), 1.53(f)
- Suspension of action . . . . . 1.103
- Suspension of rules . . . . . 1.183
- Symbols for drawings . . . . . 1.84(n)
- Symbols for nucleotide and/or amino acid sequence data . . . . . 1.822
- T**
- Tables in patent applications . . . . . 1.58
- Terminal disclaimer . . . . . 1.321
- Testimony by Office employees . . . . . 15 CFR Part 15a
- Testimony in contested cases before the Board . . . . . 41.156-41.158  
 Compelling testimony and production . . . . . 41.156  
 Expert testimony . . . . . 41.158  
 Taking testimony . . . . . 41.157
- Third party submission in published application . . . . . 1.99
- Time expiring on Saturday, Sunday, or holiday . . . . . 1.7
- Time for claiming benefit of prior (domestic) application . . . . . 1.78
- Time for claiming foreign priority . . . . . 1.55
- Time for filing preliminary amendment to ensure entry thereof . . . . . 1.115
- Time for payment of issue fee . . . . . 1.311
- Time for payment of publication fee . . . . . 1.311
- Time for reply by applicant . . . . . 1.134, 1.135, 1.136
- Time for reply to Office action . . . . . 1.134, 1.136
- Time for requesting a refund . . . . . 1.26
- Time, periods of . . . . . 1.7
- Timely filing of correspondence . . . . . 1.8, 1.10
- Title of invention . . . . . 1.72
- Title reports, fee for . . . . . 1.19(b)
- Transitional procedures . . . . . 1.129

**RULES INDEX**

**MANUAL OF PATENT EXAMINING PROCEDURE**

**U**

Unavoidable abandonment . . . . . 1.137  
Unintentional abandonment. . . . . 1.137  
United States as  
    Designated Office . . . . . 1.414  
    Elected Office . . . . . 1.414  
    International Preliminary Examining  
        Authority . . . . . 1.416  
    International Searching Authority . . . . . 1.413  
    Receiving Office . . . . . 1.412

Unlocatable files. . . . . 1.251  
Unsigned continuation or divisional application 1.53, 1.63  
Use of file of parent application. . . . . 1.53(d)

**W**

Waiver of confidentiality . . . . . 1.53(d)(6)  
Withdrawal from issue . . . . . 1.313  
Withdrawal of attorney or agent. . . . . 1.36(b)  
Withdrawal of request for statutory invention  
    registration . . . . . 1.296

*PRACTICE BEFORE THE PATENT AND  
TRADEMARK OFFICE*

**PART 10 — REPRESENTATION OF  
OTHERS BEFORE THE PATENT AND  
TRADEMARK OFFICE**

Sec.

- 10.1 Definitions.  
10.2 [Reserved]  
10.3 [Reserved]  
10.4 Committee on Discipline.
- INDIVIDUALS ENTITLED TO  
PRACTICE BEFORE THE PATENT  
AND TRADEMARK OFFICE
- 10.5 [Reserved]  
10.6 [Reserved]  
10.7 [Reserved]  
10.8 [Reserved]  
10.9 [Reserved]  
10.10 [Reserved]  
10.11 Removing names from the register.  
10.12 - 10.13 [Reserved]  
10.14 Individuals who may practice before the Office in  
trademark and other non-patent cases.  
10.15 Refusal to recognize a practitioner.  
10.16 - 10.17 [Reserved]  
10.18 Signature and certificate for correspondence filed  
in the Patent and Trademark Office.  
10.19 [Reserved]
- PATENT AND TRADEMARK OFFICE CODE  
OF PROFESSIONAL RESPONSIBILITY
- 10.20 Canons and Disciplinary Rules.  
10.21 Canon 1.  
10.22 Maintaining integrity and competence of the legal  
profession.  
10.23 Misconduct.  
10.24 Disclosure of information to authorities.  
10.25 - 10.29 [Reserved]  
10.30 Canon 2.  
10.31 Communications concerning a practitioner's  
services.  
10.32 Advertising.  
10.33 Direct contact with prospective clients.

- 10.34 Communication of fields of practice.  
10.35 Firm names and letterheads.  
10.36 Fees for legal services.  
10.37 Division of fees among practitioners.  
10.38 Agreements restricting the practice of a  
practitioner.  
10.39 Acceptance of employment.  
10.40 Withdrawal from employment.  
10.41 - 10.45 [Reserved]  
10.46 Canon 3.  
10.47 Aiding unauthorized practice of law.  
10.48 Sharing legal fees.  
10.49 Forming a partnership with a non-practitioner.  
10.50 - 10.55 [Reserved]  
10.56 Canon 4.  
10.57 Preservation of confidences and secrets of a client.  
10.58 - 10.60 [Reserved]  
10.61 Canon 5.  
10.62 Refusing employment when the interest of the  
practitioner may impair the practitioner's  
independent professional judgment.  
10.63 Withdrawal when the practitioner becomes a  
witness.  
10.64 Avoiding acquisition of interest in litigation or  
proceeding before the Office.  
10.65 Limiting business relations with a client.  
10.66 Refusing to accept or continue employment if the  
interests of another client may impair the  
independent professional judgment of the  
practitioner.  
10.67 Settling similar claims of clients.  
10.68 Avoiding influence by others than the client.  
10.69 - 10.75 [Reserved]  
10.76 Canon 6.  
10.77 Failing to act competently.  
10.78 Limiting liability to client.  
10.79 - 10.82 [Reserved]  
10.83 Canon 7.  
10.84 Representing a client zealously.  
10.85 Representing a client within the bounds of the law.  
10.86 [Reserved]  
10.87 Communicating with one of adverse interest.  
10.88 Threatening criminal prosecution.  
10.89 Conduct in proceedings.  
10.90 - 10.91 [Reserved]  
10.92 Contact with witnesses.  
10.93 Contact with officials.  
10.94 - 10.99 [Reserved]

- 10.100 Canon 8.
- 10.101 Action as a public official.
- 10.102 Statements concerning officials.
- 10.103 Practitioner candidate for judicial office.
- 10.104 - 10.109 [Reserved]
- 10.110 Canon 9.
- 10.111 Avoiding even the appearance of impropriety.
- 10.112 Preserving identity of funds and property of client.
- 10.113 - 10.129 [Reserved]

#### INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS

- 10.130 Reprimand, suspension or exclusion.
- 10.131 Investigations.
- 10.132 Initiating a disciplinary proceeding; reference to an administrative law judge.
- 10.133 Conference between Director and practitioner; resignation.
- 10.134 Complaint.
- 10.135 Service of complaint.
- 10.136 Answer to complaint.
- 10.137 Supplemental complaint.
- 10.138 Contested case.
- 10.139 Administrative law judge; appointment; responsibilities; review of interlocutory orders; stays.
- 10.140 Representative for Director or respondent.
- 10.141 Filing of papers.
- 10.142 Service of papers.
- 10.143 Motions.
- 10.144 Hearings.
- 10.145 Proof; variance; amendment of pleadings.
- 10.146 - 10.148 [Reserved]
- 10.149 Burden of proof.
- 10.150 Evidence.
- 10.151 Depositions.
- 10.152 Discovery.
- 10.153 Proposed findings and conclusions; post-hearing memorandum.
- 10.154 Initial decision of administrative law judge.
- 10.155 Appeal to the Commissioner.
- 10.156 Decision of the Commissioner.
- 10.157 Review of Commissioner's final decision.
- 10.158 Suspended or excluded practitioner.
- 10.159 Notice of suspension or exclusion.
- 10.160 Petition for reinstatement.
- 10.161 Savings clause.

- 10.162 - 10.169 [Reserved]
- 10.170 Suspension of rules.

#### § 10.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the Patent and Trademark Office to accomplish its federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

(a) *Affidavit* means affidavit, declaration under 35 U.S.C. 25 (see § 1.68 and § 2.20 of this subchapter), or statutory declaration under 28 U.S.C. 1746.

(b) *Application* includes an application for a design, plant, or utility patent, an application to reissue any patent, and an application to register a trademark.

(c) *Attorney or lawyer* means an individual who is a member in good standing of the bar of any United States court or the highest court of any State. A “non-lawyer” is a person who is not an attorney or lawyer.

(d) *Canon* is defined in § 10.20(a).

(e) *Confidence* is defined in § 10.57(a).

(f) *Differing interests* include every interest that may adversely affect either the judgment or the loyalty of a practitioner to a client, whether it be a conflicting, inconsistent, diverse, or other interest.

(g) *Director* means the Director of Enrollment and Discipline.

(h) *Disciplinary Rule* is defined in § 10.20(b).

(i) *Employee of a tribunal* includes all employees of courts, the Office, and other adjudicatory bodies.

(j) *Giving information* within the meaning of § 10.23(c) (2) includes making (1) a written statement or representation or (2) an oral statement or representation.

(k) *Law firm* includes a professional legal corporation or a partnership.

(l) *Legal counsel* means practitioner.

(m) *Legal profession* includes the individuals who are lawfully engaged in practice of patent, trademark, and other law before the Office.

(n) *Legal service* means any legal service which may lawfully be performed by a practitioner before the Office.

(o) *Legal System* includes the Office and courts and adjudicatory bodies which review matters on which the Office has acted.

(p) *Office* means Patent and Trademark Office.

(q) *Person* includes a corporation, an association, a trust, a partnership, and any other organization or legal entity.

(r) *Practitioner* means (1) an attorney or agent registered to practice before the Office in patent cases or (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this subchapter, to practice before the Office in trademark cases or other non-patent cases. A “suspended or excluded practitioner” is a practitioner who is suspended or excluded under § 10.156. A “non-practitioner” is an individual who is not a practitioner.

(s) A *proceeding before the Office* includes an application, a reexamination, a protest, a public use proceeding, a patent interference, an *inter partes* trademark proceeding, or any other proceeding which is pending before the Office.

(t) *Professional legal corporation* means a corporation authorized by law to practice law for profit.

(u) *Registration* means registration to practice before the Office in patent cases.

(v) *Respondent* is defined in § 10.134(a)(1).

(w) *Secret* is defined in § 10.57(a).

(x) *Solicit* is defined in § 10.33.

(y) *State* includes the District of Columbia, Puerto Rico, and other federal territories and possessions.

(z) *Tribunal* includes courts, the Office, and other adjudicatory bodies.

(aa) *United States* means the United States of America, its territories and possessions.

[Added 50 FR 5172, Feb. 6, 1985, effective Mar. 8, 1985]

## § 10.2 [Reserved]

[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

## § 10.3 [Reserved]

[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

## § 10.4 Committee on Discipline.

(a) The Commissioner shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office, none of whom reports directly or indirectly to the Director or the Solicitor. Each member of the Committee on Discipline shall be a member in good standing of the bar of a State.

(b) The Committee on Discipline shall meet at the request of the Director and after reviewing evidence presented by the Director shall, by majority vote, determine whether there is probable cause to bring charges under § 10.132 against a practitioner. When charges are brought against a practitioner, no member of the Committee on Discipline, employee under the direction of the Director, or associate solicitor or assistant solicitor in the Office of Solicitor shall participate in rendering a decision on the charges.

(c) No discovery shall be authorized of, and no member of the Committee on Discipline shall be required to testify about, deliberations of the Committee on Discipline.

[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985]

## INDIVIDUALS ENTITLED TO PRACTICE BEFORE THE PATENT AND TRADEMARK OFFICE

### § 10.5 [Reserved]

[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

### § 10.6 [Reserved]

[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985; paras. (d) & (e) removed 53 FR 38948, Oct. 4, 1988, effective Nov. 4, 1988; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

### § 10.7 [Reserved]

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

**§ 10.8 [Reserved]**

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

**§ 10.9 [Reserved]**

[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985; para. (c) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) amended, 60 FR 21438, May 2, 1995, effective June 1, 1995; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

**§ 10.10 [Reserved]**

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; revised 53 FR 38950, Oct. 4, 1988, effective Nov. 4, 1988; corrected 53 FR 41278, Oct. 20, 1988; removed and reserved, 69 FR 35427, June 24, 2004, effective July 26, 2004]

**§ 10.11 Removing names from the register.**

A letter may be addressed to any individual on the register, at the address of which separate notice was last received by the Director, for the purpose of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and the names of individuals so removed will be published in the Official Gazette. The name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in § 1.21(a)(3) of this subchapter.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; revised, 69 FR 35427, June 24, 2004, effective July 26, 2004]

**§ 10.12 - 10.13 [Reserved]****§ 10.14 Individuals who may practice before the Office in trademark and other non-patent cases.**

(a) *Attorneys.* Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to

practice before the Office in trademark and other non-patent cases.

(b) *Non-lawyers.* Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

(c) *Foreigners.* Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, *provided:* The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.15 Refusal to recognize a practitioner.**

Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who

is suspended or excluded under this subpart or removed under § 10.11(b) shall not be entitled to practice before the Office.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.16 - 10.17 [Reserved]

### § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of § 1.4(d), § 1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or

to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

- (1) Holding certain facts to have been established;
- (2) Returning papers;
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;
- (4) Imposing a monetary sanction;
- (5) Requiring a terminal disclaimer for the period of the delay; or
- (6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

## § 10.19 [Reserved]

PATENT AND TRADEMARK OFFICE CODE  
OF PROFESSIONAL RESPONSIBILITY§ 10.20 **Canons and Disciplinary Rules.**

(a) Canons are set out in §§ 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.

(b) Disciplinary Rules are set out in §§ 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.21 **Canon 1.**

A practitioner should assist in maintaining the integrity and competence of the legal profession.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.22 **Maintaining integrity and competence of the legal profession.**

(a) A practitioner is subject to discipline if the practitioner has made a materially false statement in, or if the practitioner has deliberately failed to disclose a material fact requested in connection with, the practitioner's application for registration or membership in the bar of any United States court or any State court or his or her authority to otherwise practice before the Office in trademark and other non-patent cases.

(b) A practitioner shall not further the application for registration or membership in the bar of any United States court, State court, or administrative agency of another person known by the practitioner to be unqualified in respect to character, education, or other relevant attribute.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]

§ 10.23 **Misconduct.**

(a) A practitioner shall not engage in disreputable or gross misconduct.

(b) A practitioner shall not:

(1) Violate a Disciplinary Rule.

(2) Circumvent a Disciplinary Rule through actions of another.

(3) Engage in illegal conduct involving moral turpitude.

(4) Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

(5) Engage in conduct that is prejudicial to the administration of justice.

(6) Engage in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office.

(c) Conduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to:

(1) Conviction of a criminal offense involving moral turpitude, dishonesty, or breach of trust.

(2) Knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information, to:

(i) A client in connection with any immediate, prospective, or pending business before the Office.

(ii) The Office or any employee of the Office.

(3) Misappropriation of, or failure to properly or timely remit, funds received by a practitioner or the practitioner's firm from a client to pay a fee which the client is required by law to pay to the Office.

(4) Directly or indirectly improperly influencing, attempting to improperly influence, offering or agreeing to improperly influence, or attempting to offer or agree to improperly influence an official action of any employee of the Office by:

(i) Use of threats, false accusations, duress, or coercion,

(ii) An offer of any special inducement or promise of advantage, or

(iii) Improperly bestowing of any gift, favor, or thing of value.



(5) Suspension or disbarment from practice as an attorney or agent on ethical grounds by any duly constituted authority of a State or the United States or, in the case of a practitioner who resides in a foreign country or is registered under § 10.6(c), by any duly constituted authority of:

- (i) A State,
- (ii) The United States, or
- (iii) The country in which the practitioner resides.

(6) Knowingly aiding or abetting a practitioner suspended or excluded from practice before the Office in engaging in unauthorized practice before the Office under § 10.158.

(7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See § 41.202(a)(1) of this title.

(8) Failing to inform a client or former client or failing to timely notify the Office of an inability to notify a client or former client of correspondence received from the Office or the client's or former client's opponent in an *inter partes* proceeding before the Office when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.

(9) Knowingly misusing a "Certificate of Mailing or Transmission" under § 1.8 of this chapter.

(10) Knowingly violating or causing to be violated the requirements of § 1.56 or § 1.555 of this subchapter.

(11) Except as permitted by § 1.52(c) of this chapter, knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers.

(12) Knowingly filing, or causing to be filed, a frivolous complaint alleging a violation by a practitioner of the Patent and Trademark Office Code of Professional Responsibility.

(13) Knowingly preparing or prosecuting or providing assistance in the preparation or prosecution

of a patent application in violation of an undertaking signed under § 10.10(b).

(14) Knowingly failing to advise the Director in writing of any change which would preclude continued registration under § 10.6.

(15) Signing a paper filed in the Office in violation of the provisions of § 10.18 or making a scandalous or indecent statement in a paper filed in the Office.

(16) Willfully refusing to reveal or report knowledge or evidence to the Director contrary to § 10.24 or paragraph (b) of § 10.131.

(17) Representing before the Office in a patent case either a joint venture comprising an inventor and an invention developer or an inventor referred to the registered practitioner by an invention developer when (i) the registered practitioner knows, or has been advised by the Office, that a formal complaint filed by a Federal or State agency, based on any violation of any law relating to securities, unfair methods of competition, unfair or deceptive acts or practices, mail fraud, or other civil or criminal conduct, is pending before a Federal or State court or Federal or State agency, or has been resolved unfavorably by such court or agency, against the invention developer in connection with invention development services and (ii) the registered practitioner fails to fully advise the inventor of the existence of the pending complaint or unfavorable resolution thereof prior to undertaking or continuing representation of the joint venture or inventor. "Invention developer" means any person, and any agent, employee, officer, partner, or independent contractor thereof, who is not a registered practitioner and who advertises invention development services in media of general circulation or who enters into contracts for invention development services with customers as a result of such advertisement. "Invention development services" means acts of invention development required or promised to be performed, or actually performed, or both, by an invention developer for a customer. "Invention development" means the evaluation, perfection, marketing, brokering, or promotion of an invention on behalf of a customer by an invention developer, including a patent search, preparation of a patent application, or any other act done by an invention developer for consideration toward the end of procuring or attempting to procure a license, buyer, or patent for an invention. "Customer"

means any individual who has made an invention and who enters into a contract for invention development services with an invention developer with respect to the invention by which the inventor becomes obligated to pay the invention developer less than \$5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention). “Contract for invention development services” means a contract for invention development services with an invention developer with respect to an invention made by a customer by which the inventor becomes obligated to pay the invention developer less than \$5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention).

(18) In the absence of information sufficient to establish a reasonable belief that fraud or inequitable conduct has occurred, alleging before a tribunal that anyone has committed a fraud on the Office or engaged in inequitable conduct in a proceeding before the Office.

(19) Action by an employee of the Office contrary to the provisions set forth in § 10.10(c).

(20) Knowing practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency, or commission employing said individual.

(d) A practitioner who acts with reckless indifference to whether a representation is true or false is chargeable with knowledge of its falsity. Deceitful statements of half-truths or concealment of material facts shall be deemed actual fraud within the meaning of this part.

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985; 50 FR 25980, June 24, 1985; paras. (c)(13), (19) & (20), 53 FR 38950, Oct. 4, 1988, effective Nov. 4, 1988; corrected 53 FR 41278, Oct. 20, 1988; paras. (c)(10) & (c)(11), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c)(9) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para. (c)(9) amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; para. (c)(15) amended, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c)(11) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para (c)(7) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

#### § 10.24 Disclosure of information to authorities.

(a) A practitioner possessing unprivileged knowledge of a violation of a Disciplinary Rule shall report such knowledge to the Director.

(b) A practitioner possessing unprivileged knowledge or evidence concerning another practitioner, employee of the Office, or a judge shall reveal fully such knowledge or evidence upon proper request of a tribunal or other authority empowered to investigate or act upon the conduct of practitioners, employees of the Office, or judges.

[Added 50 FR 5176, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.25 - 10.29 [Reserved]

#### § 10.30 Canon 2.

A practitioner should assist the legal profession in fulfilling its duty to make legal counsel available.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.31 Communications concerning a practitioner’s services.

(a) No practitioner shall with respect to any prospective business before the Office, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any prospective applicant or other person having immediate or prospective business before the Office.

(b) A practitioner may not use the name of a Member of either House of Congress or of an individual in the service of the United States in advertising the practitioner’s practice before the Office.

(c) Unless authorized under § 10.14(b), a non-lawyer practitioner shall not hold himself or herself out as authorized to practice before the Office in trademark cases.

(d) Unless a practitioner is an attorney, the practitioner shall not hold himself or herself out:

(1) To be an attorney or lawyer or

(2) As authorized to practice before the Office in non-patent and trademark cases.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.32 Advertising.**

(a) Subject to § 10.31, a practitioner may advertise services through public media, including a telephone directory, legal directory, newspaper, or other periodical, radio, or television, or through written communications not involving solicitation as defined by § 10.33.

(b) A practitioner shall not give anything of value to a person for recommending the practitioner's services, except that a practitioner may pay the reasonable cost of advertising or written communication permitted by this section and may pay the usual charges of a not-for-profit lawyer referral service or other legal service organization.

(c) Any communication made pursuant to this section shall include the name of at least one practitioner responsible for its content.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.33 Direct contact with prospective clients.**

A practitioner may not solicit professional employment from a prospective client with whom the practitioner has no family or prior professional relationship, by mail, in-person, or otherwise, when a significant motive for the practitioner's doing so is the practitioner's pecuniary gain under circumstances evidencing undue influence, intimidation, or overreaching. The term "solicit" includes contact in person, by telephone or telegraph, by letter or other writing, or by other communication directed to a specific recipient, but does not include letters addressed or advertising circulars distributed generally to persons not specifically known to need legal services of the kind provided by the practitioner in a particular matter, but who are so situated that they might in general find such services useful.

[Added 50 FR 5177, Feb.6, 1985, effective Mar. 8, 1985]

**§ 10.34 Communication of fields of practice.**

A registered practitioner may state or imply that the practitioner is a specialist as follows:

(a) A registered practitioner who is an attorney may use the designation "Patents," "Patent Attorney," "Patent Lawyer," "Registered Patent Attorney," or a substantially similar designation.

(b) A registered practitioner who is not an attorney may use the designation "Patents," "Patent Agent," "Registered Patent Agent," or a substantially similar designation, except that any practitioner who was registered prior to November 15, 1938, may refer to himself or herself as a "patent attorney."

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.35 Firm names and letterheads.**

(a) A practitioner shall not use a firm name, letterhead, or other professional designation that violates § 10.31. A trade name may be used by a practitioner in private practice if it does not imply a current connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of § 10.31.

(b) Practitioners may state or imply that they practice in a partnership or other organization only when that is the fact.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.36 Fees for legal services.**

(a) A practitioner shall not enter into an agreement for, charge, or collect an illegal or clearly excessive fee.

(b) A fee is clearly excessive when, after a review of the facts, a practitioner of ordinary prudence would be left with a definite and firm conviction that the fee is in excess of a reasonable fee. Factors to be considered as guides in determining the reasonableness of a fee include the following:

(1) The time and labor required, the novelty and difficulty of the questions involved, and the skill requisite to perform the legal service properly.

(2) The likelihood, if apparent to the client, that the acceptance of the particular employment will preclude other employment by the practitioner.

(3) The fee customarily charged for similar legal services.

(4) The amount involved and the results obtained.

(5) The time limitations imposed by the client or by the circumstances.

(6) The nature and length of the professional relationship with the client.

(7) The experience, reputation, and ability of the practitioner or practitioners performing the services.

(8) Whether the fee is fixed or contingent.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.37 Division of fees among practitioners.

(a) A practitioner shall not divide a fee for legal services with another practitioner who is not a partner in or associate of the practitioner's law firm or law office, unless:

(1) The client consents to employment of the other practitioner after a full disclosure that a division of fees will be made.

(2) The division is made in proportion to the services performed and responsibility assumed by each.

(3) The total fee of the practitioners does not clearly exceed reasonable compensation for all legal services rendered to the client.

(b) This section does not prohibit payment to a former partner or associate pursuant to a separation or retirement agreement.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.38 Agreements restricting the practice of a practitioner.

(a) A practitioner shall not be a party to or participate in a partnership or employment agreement with another practitioner that restricts the right of a practitioner to practice before the Office after the termination of a relationship created by the agreement, except as a condition to payment of retirement benefits.

(b) In connection with the settlement of a controversy or suit, a practitioner shall not enter into an agreement that restricts the practitioner's right to practice before the Office.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.39 Acceptance of employment.

A practitioner shall not accept employment on behalf of a person if the practitioner knows or it is obvious that such person wishes to:

(a) Bring a legal action, commence a proceeding before the Office, conduct a defense, assert a position in any proceeding pending before the Office, or otherwise have steps taken for the person, merely for the purpose of harassing or maliciously injuring any other person.

(b) Present a claim or defense in litigation or any proceeding before the Office that it is not warranted under existing law, unless it can be supported by good faith argument for an extension, modification, or reversal of existing law.

[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.40 Withdrawal from employment.

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) *Mandatory withdrawal.* A practitioner representing a client before the Office shall withdraw from employment if:

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) *Permissive withdrawal.* If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;

(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.41 - 10.45 [Reserved]

#### § 10.46 Canon 3.

A practitioner should assist in preventing the unauthorized practice of law.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.47 Aiding unauthorized practice of law.

(a) A practitioner shall not aid a non-practitioner in the unauthorized practice of law before the Office.

(b) A practitioner shall not aid a suspended or excluded practitioner in the practice of law before the Office.

(c) A practitioner shall not aid a non-lawyer in the unauthorized practice of law.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.48 Sharing legal fees.

A practitioner or a firm of practitioners shall not share legal fees with a non-practitioner except that:

(a) An agreement by a practitioner with the practitioner's firm, partner, or associate may provide for the payment of money, over a reasonable period of time after the practitioner's death, to the practitioner's estate or to one or more specified persons.

(b) A practitioner who undertakes to complete unfinished legal business of a deceased practitioner may pay to the estate of the deceased practitioner that proportion of the total compensation which fairly represents the services rendered by the deceased practitioner.

(c) A practitioner or firm of practitioners may include non-practitioner employees in a compensation or retirement plan, even though the plan is based in whole or in part on a profit-sharing arrangement, providing such plan does not circumvent another Disciplinary Rule.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985; para. (b) revised, 58 FR 54511, Oct. 22, 1993, effective June 3, 1994]

**§ 10.49 Forming a partnership with a non-practitioner.**

A practitioner shall not form a partnership with a nonpractitioner if any of the activities of the partnership consist of the practice of patent, trademark, or other law before the Office.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.50 - 10.55 [Reserved]**

**§ 10.56 Canon 4.**

A practitioner should preserve the confidences and secrets of a client.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.57 Preservation of confidences and secrets of a client.**

(a) “Confidence” refers to information protected by the attorney-client or agent-client privilege under applicable law. “Secret” refers to other information gained in the professional relationship that the client has requested be held inviolate or the disclosure of which would be embarrassing or would be likely to be detrimental to the client.

(b) Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly:

- (1) Reveal a confidence or secret of a client.
- (2) Use a confidence or secret of a client to the disadvantage of the client.

(3) Use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client consents after full disclosure.

(c) A practitioner may reveal:

(1) Confidences or secrets with the consent of the client affected but only after a full disclosure to the client.

(2) Confidences or secrets when permitted under Disciplinary Rules or required by law or court order.

(3) The intention of a client to commit a crime and the information necessary to prevent the crime.

(4) Confidences or secrets necessary to establish or collect the practitioner’s fee or to defend

the practitioner or the practitioner’s employees or associates against an accusation of wrongful conduct.

(d) A practitioner shall exercise reasonable care to prevent the practitioner’s employees, associates, and others whose services are utilized by the practitioner from disclosing or using confidences or secrets of a client, except that a practitioner may reveal the information allowed by paragraph (c) of this section through an employee.

[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.58 - 10.60 [Reserved]**

**§ 10.61 Canon 5.**

A practitioner should exercise independent professional judgment on behalf of a client.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.62 Refusing employment when the interest of the practitioner may impair the practitioner’s independent professional judgment.**

(a) Except with the consent of a client after full disclosure, a practitioner shall not accept employment if the exercise of the practitioner’s professional judgment on behalf of the client will be or reasonably may be affected by the practitioner’s own financial, business, property, or personal interests.

(b) A practitioner shall not accept employment in a proceeding before the Office if the practitioner knows or it is obvious that the practitioner or another practitioner in the practitioner’s firm ought to sign an affidavit to be filed in the Office or be called as a witness, except that the practitioner may undertake the employment and the practitioner or another practitioner in the practitioner’s firm may testify:

(1) If the testimony will relate solely to an uncontested matter.

(2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.

(3) If the testimony will relate solely to the nature and value of legal services rendered in the case

by the practitioner or the practitioner's firm to the client.

(4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.63 Withdrawal when the practitioner becomes a witness.**

(a) If, after undertaking employment in a proceeding in the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of § 10.62(b).

(b) If, after undertaking employment in a proceeding before the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm may be asked to sign an affidavit to be filed in the Office or be called as a witness other than on behalf of the practitioner's client, the practitioner may continue the representation until it is apparent that the practitioner's affidavit or testimony is or may be prejudicial to the practitioner's client.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.64 Avoiding acquisition of interest in litigation or proceeding before the Office.**

(a) A practitioner shall not acquire a proprietary interest in the subject matter of a proceeding before the Office which the practitioner is conducting for a client, except that the practitioner may:

- (1) Acquire a lien granted by law to secure the practitioner's fee or expenses; or
- (2) Contract with a client for a reasonable contingent fee; or

(3) In a patent case, take an interest in the patent as part or all of his or her fee.

(b) While representing a client in connection with a contemplated or pending proceeding before the Office, a practitioner shall not advance or guarantee financial assistance to a client, except that a practitioner may advance or guarantee the expenses of going forward in a proceeding before the Office including fees required by law to be paid to the Office, expenses of investigation, expenses of medical examination, and costs of obtaining and presenting evidence, provided the client remains ultimately liable for such expenses. A practitioner may, however, advance any fee required to prevent or remedy an abandonment of a client's application by reason of an act or omission attributable to the practitioner and not to the client, whether or not the client is ultimately liable for such fee.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.65 Limiting business relations with a client.**

A practitioner shall not enter into a business transaction with a client if they have differing interests therein and if the client expects the practitioner to exercise professional judgment therein for the protection of the client, unless the client has consented after full disclosure.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.**

(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the

practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(c) In the situations covered by paragraphs (a) and (b) of this section, a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.

(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.67 Settling similar claims of clients.

A practitioner who represents two or more clients shall not make or participate in the making of an aggregate settlement of the claims of or against the practitioner's clients, unless each client has consented to the settlement after being advised of the existence and nature of all the claims involved in the proposed settlement, of the total amount of the settlement, and of the participation of each person in the settlement.

[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.68 Avoiding influence by others than the client.

(a) Except with the consent of the practitioner's client after full disclosure, a practitioner shall not:

(1) Accept compensation from one other than the practitioner's client for the practitioner's legal services to or for the client.

(2) Accept from one other than the practitioner's client any thing of value related to the practitioner's representation of or the practitioner's employment by the client.

(b) A practitioner shall not permit a person who recommends, employs, or pays the practitioner to ren-

der legal services for another, to direct or regulate the practitioner's professional judgment in rendering such legal services.

(c) A practitioner shall not practice with or in the form of a professional corporation or association authorized to practice law for a profit, if a non-practitioner has the right to direct or control the professional judgment of a practitioner.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.69 - 10.75 [Reserved]

#### § 10.76 Canon 6.

A practitioner should represent a client competently.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.77 Failing to act competently.

A practitioner shall not:

(a) Handle a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with the practitioner another practitioner who is competent to handle it.

(b) Handle a legal matter without preparation adequate in the circumstances.

(c) Neglect a legal matter entrusted to the practitioner.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.78 Limiting liability to client.

A practitioner shall not attempt to exonerate himself or herself from, or limit his or her liability to, a client for his or her personal malpractice.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.79 - 10.82 [Reserved]

#### § 10.83 Canon 7.

A practitioner should represent a client zealously within the bounds of the law.



[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.84 Representing a client zealously.**

(a) A practitioner shall not intentionally:

(1) Fail to seek the lawful objectives of a client through reasonable available means permitted by law and the Disciplinary Rules, except as provided by paragraph (b) of this section. A practitioner does not violate the provisions of this section, however, by acceding to reasonable requests of opposing counsel which do not prejudice the rights of the client, by being punctual in fulfilling all professional commitments, by avoiding offensive tactics, or by treating with courtesy and consideration all persons involved in the legal process.

(2) Fail to carry out a contract of employment entered into with a client for professional services, but a practitioner may withdraw as permitted under §§ 10.40, 10.63, and 10.66.

(3) Prejudice or damage a client during the course of a professional relationship, except as required under this part.

(b) In representation of a client, a practitioner may:

(1) Where permissible, exercise professional judgment to waive or fail to assert a right or position of the client.

(2) Refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.85 Representing a client within the bounds of the law.**

(a) In representation of a client, a practitioner shall not:

(1) Initiate or defend any proceeding before the Office, assert a position, conduct a defense, delay a trial or proceeding before the Office, or take other action on behalf of the practitioner's client when the practitioner knows or when it is obvious that such action would serve merely to harass or maliciously injure another.

(2) Knowingly advance a claim or defense that is unwarranted under existing law, except that a practitioner may advance such claim or defense if it can be supported by good faith argument for an extension, modification, or reversal of existing law.

(3) Conceal or knowingly fail to disclose that which the practitioner is required by law to reveal.

(4) Knowingly use perjured testimony or false evidence.

(5) Knowingly make a false statement of law or fact.

(6) Participate in the creation or preservation of evidence when the practitioner knows or it is obvious that the evidence is false.

(7) Counsel or assist a client in conduct that the practitioner knows to be illegal or fraudulent.

(8) Knowingly engage in other illegal conduct or conduct contrary to a Disciplinary Rule.

(b) A practitioner who receives information clearly establishing that:

(1) A client has, in the course of the representation, perpetrated a fraud upon a person or tribunal shall promptly call upon the client to rectify the same, and if the client refuses or is unable to do so the practitioner shall reveal the fraud to the affected person or tribunal.

(2) A person other than a client has perpetrated a fraud upon a tribunal shall promptly reveal the fraud to the tribunal.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.86 [Reserved]**

**§ 10.87 Communicating with one of adverse interest.**

During the course of representation of a client, a practitioner shall not:

(a) Communicate or cause another to communicate on the subject of the representation with a party the practitioner knows to be represented by another practitioner in that matter unless the practitioner has the prior consent of the other practitioner representing such other party or is authorized by law to do so. It is not improper, however, for a practitioner to encourage a client to meet with an opposing party for settlement discussions.

(b) Give advice to a person who is not represented by a practitioner other than the advice to secure counsel, if the interests of such person are or have a reasonable possibility of being in conflict with the interests of the practitioner's client.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.88 Threatening criminal prosecution.**

A practitioner shall not present, participate in presenting, or threaten to present criminal charges solely to obtain an advantage in any prospective or pending proceeding before the Office.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.89 Conduct in proceedings.**

(a) A practitioner shall not disregard or advise a client to disregard any provision of this Subchapter or a decision of the Office made in the course of a proceeding before the Office, but the practitioner may take appropriate steps in good faith to test the validity of such provision or decision.

(b) In presenting a matter to the Office, a practitioner shall disclose:

(1) Controlling legal authority known to the practitioner to be directly adverse to the position of the client and which is not disclosed by opposing counsel or an employee of the Office.

(2) Unless privileged or irrelevant, the identities of the client the practitioner represents and of the persons who employed the practitioner.

(c) In appearing in a professional capacity before a tribunal, a practitioner shall not:

(1) State or allude to any matter that the practitioner has no reasonable basis to believe is relevant to the case or that will not be supported by admissible evidence.

(2) Ask any question that the practitioner has no reasonable basis to believe is relevant to the case and that is intended to degrade a witness or other person.

(3) Assert the practitioner's personal knowledge of the facts in issue, except when testifying as a witness.

(4) Assert the practitioner's personal opinion as to the justness of a cause, as to the credibility of a

witness, as to the culpability of a civil litigant, or as to the guilt or innocence of an accused; but the practitioner may argue, on the practitioner's analysis of the evidence, for any position or conclusion with respect to the matters stated herein.

(5) Engage in undignified or discourteous conduct before the Office (see § 1.3 of the subchapter).

(6) Intentionally or habitually violate any provision of this subchapter or established rule of evidence.

[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.90 - 10.91 [Reserved]**

**§ 10.92 Contact with witnesses.**

(a) A practitioner shall not suppress any evidence that the practitioner or the practitioner's client has a legal obligation to reveal or produce.

(b) A practitioner shall not advise or cause a person to be secreted or to leave the jurisdiction of a tribunal for the purpose of making the person unavailable as a witness therein.

(c) A practitioner shall not pay, offer to pay, or acquiesce in payment of compensation to a witness contingent upon the content of the witness' affidavit, testimony or the outcome of the case. But a practitioner may advance, guarantee, or acquiesce in the payment of:

(1) Expenses reasonably incurred by a witness in attending, testifying, or making an affidavit.

(2) Reasonable compensation to a witness for the witness' loss of time in attending, testifying, or making an affidavit.

(3) A reasonable fee for the professional services of an expert witness.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.93 Contact with officials.**

(a) A practitioner shall not give or lend anything of value to a judge, official, or employee of a tribunal under circumstances which might give the appearance that the gift or loan is made to influence official action.

(b) In an adversary proceeding, including any *inter partes* proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:

(1) In the course of official proceedings in the cause.

(2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(4) As otherwise authorized by law.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.94 - 10.99 [Reserved]

#### § 10.100 Canon 8.

A practitioner should assist in improving the legal system.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.101 Action as a public official.

(a) A practitioner who holds public office shall not:

(1) Use the practitioner's public position to obtain, or attempt to obtain, a special advantage in legislative matters for the practitioner or for a client under circumstances where the practitioner knows or it is obvious that such action is not in the public interest.

(2) Use the practitioner's public position to influence, or attempt to influence, a tribunal to act in favor of the practitioner or of a client.

(3) Accept any thing of value from any person when the practitioner knows or it is obvious that the offer is for the purpose of influencing the practitioner's action as a public official.

(b) A practitioner who is an officer or employee of the United States shall not practice before the

Office in patent cases except as provided in § 10.10(c) and (d).

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985; para. (b) amended, 54 FR 6520, Feb. 13, 1989]

#### § 10.102 Statements concerning officials.

(a) A practitioner shall not knowingly make false statements of fact concerning the qualifications of a candidate for election or appointment to a judicial office or to a position in the Office.

(b) A practitioner shall not knowingly make false accusations against a judge, other adjudicatory officer, or employee of the Office.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.103 Practitioner candidate for judicial office.

A practitioner who is a candidate for judicial office shall comply with applicable provisions of law.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.104 - 10.109 [Reserved]

#### § 10.110 Canon 9.

A practitioner should avoid even the appearance of professional impropriety.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

#### § 10.111 Avoiding even the appearance of impropriety.

(a) A practitioner shall not accept private employment in a matter upon the merits of which he or she has acted in a judicial capacity.

(b) A practitioner shall not accept private employment in a matter in which he or she had personal responsibility while a public employee.

(c) A practitioner shall not state or imply that the practitioner is able to influence improperly or upon irrelevant grounds any tribunal, legislative body, or public official.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.112 Preserving identity of funds and property of client.**

(a) All funds of clients paid to a practitioner or a practitioner's firm, other than advances for costs and expenses, shall be deposited in one or more identifiable bank accounts maintained in the United States or, in the case of a practitioner having an office in a foreign country or registered under § 10.6(c), in the United States or the foreign country.

(b) No funds belonging to the practitioner or the practitioner's firm shall be deposited in the bank accounts required by paragraph (a) of this section except as follows:

(1) Funds reasonably sufficient to pay bank charges may be deposited therein.

(2) Funds belonging in part to a client and in part presently or potentially to the practitioner or the practitioner's firm must be deposited therein, but the portion belonging to the practitioner or the practitioner's firm may be withdrawn when due unless the right of the practitioner or the practitioner's firm to receive it is disputed by the client, in which event the disputed portion shall not be withdrawn until the dispute is finally resolved.

(c) A practitioner shall:

(1) Promptly notify a client of the receipt of the client's funds, securities, or other properties.

(2) Identify and label securities and properties of a client promptly upon receipt and place them in a safe deposit box or other place of safekeeping as soon as practicable.

(3) Maintain complete records of all funds, securities, and other properties of a client coming into the possession of the practitioner and render appropriate accounts to the client regarding the funds, securities, or other properties.

(4) Promptly pay or deliver to the client as requested by a client the funds, securities, or other properties in the possession of the practitioner which the client is entitled to receive.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.113 - 10.129 [Reserved]**

**INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS**

**§ 10.130 Reprimand, suspension or exclusion.**

(a) The Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.

(b) Petitions to disqualify a practitioner in *ex parte* or *inter partes* cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.131 Investigations.**

(a) The Director is authorized to investigate possible violations of Disciplinary Rules by practitioners. See § 10.2(b)(2).

(b) Practitioners shall report and reveal to the Director any knowledge or evidence required by § 10.24. A practitioner shall cooperate with the Director in connection with any investigation under paragraph (a) of this section and with officials of the Office in connection with any disciplinary proceeding instituted under § 10.132(b).

(c) Any nonpractitioner possessing knowledge or information concerning a violation of a Disciplinary Rule by a practitioner may report the violation to the Director. The Director may require that the report be presented in the form of an affidavit.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.132 Initiating a disciplinary proceeding; reference to an administrative law judge.**

(a) If after conducting an investigation under § 10.131(a) the Director is of the opinion that a practitioner has violated a Disciplinary Rule, the Director shall, after complying where necessary with the provisions of 5 U.S.C. 558(c), call a meeting of the Committee on Discipline. The Committee on Discipline shall then determine as specified in § 10.4(b)

whether a disciplinary proceeding shall be instituted under paragraph (b) of this section.

(b) If the Committee on Discipline determines that probable cause exists to believe that a practitioner has violated a Disciplinary Rule, the Director shall institute a disciplinary proceeding by filing a complaint under § 10.134. The complaint shall be filed in the Office of the Director. A disciplinary proceeding may result in:

- (1) A reprimand, or
- (2) Suspension or exclusion of a practitioner from practice before the Office.

(c) Upon the filing of a complaint under § 10.134, the Commissioner will refer the disciplinary proceeding to an administrative law judge.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.133 Conference between Director and practitioner; resignation.**

(a) *General.* The Director may confer with a practitioner concerning possible violations by the practitioner of a Disciplinary Rule whether or not a disciplinary proceeding has been instituted.

(b) *Resignation.* Any practitioner who is the subject of an investigation under § 10.131 or against whom a complaint has been filed under § 10.134 may resign from practice before the Office only by submitting with the Director an affidavit stating his or her desire to resign.

(c) If filed prior to the date set by the administrative law judge for a hearing, the affidavit shall state that:

- (1) The resignation is freely and voluntarily proffered;
- (2) The practitioner is not acting under duress or coercion from the Office;
- (3) The practitioner is fully aware of the implications of filing the resignation;
- (4) The practitioner is aware (i) of a pending investigation or (ii) of charges arising from the complaint alleging that he or she is guilty of a violation of the Patent and Trademark Office Code of Professional Responsibility, the nature of which shall be set forth by the practitioner to the satisfaction of the Director;

(5) The practitioner acknowledges that, if and when he or she applies for reinstatement under

§ 10.160, the Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:

(i) The facts upon which the complaint is based are true and

(ii) The practitioner could not have successfully defended himself or herself against (A) charges predicated on the violation under investigation or (B) charges set out in the complaint filed against the practitioner.

(d) If filed on or after the date set by the administrative law judge for a hearing, the affidavit shall make the statements required by paragraphs (b) (1) through (4) of this section and shall state that:

(1) The practitioner acknowledges the facts upon which the complaint is based are true; and

(2) The resignation is being submitted because the practitioner could not successfully defend himself or herself against (i) charges predicated on the violation under investigation or (ii) charges set out in the complaint.

(e) When an affidavit under paragraphs (b) or (c) of this section is received while an investigation is pending, the Commissioner shall enter an order excluding the practitioner “on consent.” When an affidavit under paragraphs (b) or (c) of this section is received after a complaint under § 10.134 has been filed, the Director shall notify the administrative law judge. The administrative law judge shall enter an order transferring the disciplinary proceeding to the Commissioner and the Commissioner shall enter an order excluding the practitioner “on consent.”

(f) Any practitioner who resigns from practice before the Office under this section and who intends to reapply for admission to practice before the Office must comply with the provisions of § 10.158.

(g) *Settlement.* Before or after a complaint is filed under § 10.134, a settlement conference may occur between the Director and a practitioner for the purpose of settling any disciplinary matter. If an offer of settlement is made by the Director or the practitioner and is not accepted by the other, no reference to the offer of settlement or its refusal shall be admissible in evidence in the disciplinary proceeding unless both the Director and the practitioner agree in writing.

[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.134 Complaint.**

(a) A complaint instituting a disciplinary proceeding shall:

(1) Name the practitioner, who may then be referred to as the “respondent.”

(2) Give a plain and concise description of the alleged violations of the Disciplinary Rules by the practitioner.

(3) State the place and time for filing an answer by the respondent.

(4) State that a decision by default may be entered against the respondent if an answer is not timely filed.

(5) Be signed by the Director.

(b) A complaint will be deemed sufficient if it fairly informs the respondent of any violation of the Disciplinary Rules which form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

[Added 50 FR 5182, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.135 Service of complaint.**

(a) A complaint may be served on a respondent in any of the following methods:

(1) By handing a copy of the complaint personally to the respondent, in which case the individual handing the complaint to the respondent shall file an affidavit with the Director indicating the time and place the complaint was handed to the respondent.

(2) By mailing a copy of the complaint by “Express Mail” or first-class mail to:

(i) A registered practitioner at the address for which separate notice was last received by the Director or

(ii) A nonregistered practitioner at the last address for the respondent known to the Director.

(3) By any method mutually agreeable to the Director and the respondent.

(b) If a complaint served by mail under paragraph (a)(2) of this section is returned by the U.S. Postal Service, the Director shall mail a second copy of the complaint to the respondent. If the second copy of the complaint is also returned by the U.S. Postal Service, the Director shall serve the respondent by publishing an appropriate notice in the *Official Gazette* for four consecutive weeks, in which case the

time for answer shall be at least thirty days from the fourth publication of the notice.

(c) If a respondent is a registered practitioner, the Director may serve simultaneously with the complaint a letter under § 10.11(b). The Director may require the respondent to answer the § 10.11(b) letter within a period of not less than 15 days. An answer to the § 10.11(b) letter shall constitute proof of service. If the respondent fails to answer the § 10.11(b) letter, his or her name will be removed from the register as provided by § 10.11(b).

(d) If the respondent is represented by an attorney under § 10.140(a), a copy of the complaint shall also be served on the attorney.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.136 Answer to complaint.**

(a) *Time for answer.* An answer to a complaint shall be filed within a time set in the complaint which shall be not less than thirty days.

(b) *With whom filed.* The answer shall be filed in writing with the administrative law judge. The time for filing an answer may be extended once for a period of no more than thirty days by the administrative law judge upon a showing of good cause provided a motion requesting an extension of time is filed within thirty days after the date the complaint is filed by the Director. A copy of the answer shall be served on the Director.

(c) *Content.* The respondent shall include in the answer a statement of the facts which constitute the grounds of defense and shall specifically admit or deny each allegation set forth in the complaint. The respondent shall not deny a material allegation in the complaint which the respondent knows to be true or state that respondent is without sufficient information to form a belief as to the truth of an allegation when in fact the respondent possesses that information. The respondent shall also state affirmatively special matters of defense.

(d) *Failure to deny allegations in complaint.* Every allegation in the complaint which is not denied by a respondent in the answer is deemed to be admitted and may be considered proven. No further evidence in respect of that allegation need be received by the administrative law judge at any

hearing. Failure to timely file an answer will constitute an admission of the allegations in the complaint.

(e) *Reply by the Director.* No reply to an answer is required by the Director and any affirmative defense in the answer shall be deemed to be denied. The Director may, however, file a reply if he or she chooses or if ordered by the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]

### § 10.137 Supplemental complaint.

False statements in an answer may be made the basis of a supplemental complaint.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.138 Contested case.

Upon the filing of an answer by the respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.139 Administrative law judge; appointment; responsibilities; review of interlocutory orders; stays.

(a) *Appointment.* An administrative law judge, appointed under 5 U.S.C. 3105, shall conduct disciplinary proceedings as provided by this part.

(b) *Responsibilities.* The administrative law judge shall have authority to:

- (1) Administer oaths and affirmations;
- (2) Make rulings upon motions and other requests;
- (3) Rule upon offers of proof, receive relevant evidence, and examine witnesses;
- (4) Authorize the taking of a deposition of a witness in lieu of personal appearance of the witness before the administrative law judge;

(5) Determine the time and place of any hearing and regulate its course and conduct;

(6) Hold or provide for the holding of conferences to settle or simplify the issues;

(7) Receive and consider oral or written arguments on facts or law;

(8) Adopt procedures and modify procedures from time to time as occasion requires for the orderly disposition of proceedings;

(9) Make initial decisions under § 10.154; and

(10) Perform acts and take measures as necessary to promote the efficient and timely conduct of any disciplinary proceeding.

(c) *Time for making initial decision.* The administrative law judge shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 10.154 is normally issued within six months of the date a complaint is filed. The administrative law judge may, however, issue an initial decision more than six months after a complaint is filed if in his or her opinion there exist unusual circumstances which preclude issuance of an initial decision within six months of the filing of the complaint.

(d) *Review of interlocutory orders.* An interlocutory order of an administrative law judge will not be reviewed by the Commissioner except:

(1) When the administrative law judge shall be of the opinion (i) that the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion and (ii) that an immediate decision by the Commissioner may materially advance the ultimate termination of the disciplinary proceeding or

(2) In an extraordinary situation where justice requires review.

(e) *Stays pending review of interlocutory order.* If the Director or a respondent seeks review of an interlocutory order of an administrative law judge under paragraph (b)(2) of this section, any time period set for taking action by the administrative law judge shall not be stayed unless ordered by the Commissioner or the administrative law judge.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]

### § 10.140 Representative for Director or respondent.

(a) A respondent may be represented before the Office in connection with an investigation or disciplinary proceeding by an attorney. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 10.1(c) and shall state:

(1) The address to which the attorney wants correspondence related to the investigation or disciplinary proceeding sent and

(2) A telephone number where the attorney may be reached during normal business hours.

(b) The Commissioner shall designate at least two associate solicitors in the Office of the Solicitor to act as representatives for the Director in disciplinary proceedings. In prosecuting disciplinary proceedings, the designated associate solicitors shall not involve the Solicitor or the Deputy Solicitor. The Solicitor and the Deputy Solicitor shall remain insulated from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the Commissioner in deciding disciplinary proceedings.

[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.141 Filing of papers.

(a) The provisions of § 1.8 of this subchapter do not apply to disciplinary proceedings.

(b) All papers filed after the complaint and prior to entry of an initial decision by the administrative law judge shall be filed with the administrative law judge at an address or place designated by the administrative law judge. All papers filed after entry of an initial decision by the administrative law judge shall be filed with the Director. The Director shall promptly forward to the Commissioner any paper which requires action under this part by the Commissioner.

(c) The administrative law judge or the Director may provide for filing papers and other matters by hand or by "Express Mail."

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.142 Service of papers.

(a) All papers other than a complaint shall be served on a respondent represented by an attorney by:

(1) Delivering a copy of the paper to the office of the attorney; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to the attorney at the address provided by the attorney under § 10.140(a)(1); or

(3) Any other method mutually agreeable to the attorney and a representative for the Director.

(b) All papers other than a complaint shall be served on a respondent who is not represented by an attorney by:

(1) Delivering a copy of the paper to the respondent; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to the respondent at the address to which a complaint may be served or such other address as may be designated in writing by the respondent; or

(3) Any other method mutually agreeable to the respondent and a representative of the Director.

(c) A respondent shall serve on the representative for the Director one copy of each paper filed with the administrative law judge or the Director. A paper may be served on the representative for the Director by:

(1) Delivering a copy of the paper to the representative; or

(2) Mailing a copy of the paper by first-class mail or "Express Mail" to an address designated in writing by the representative; or

(3) Any other method mutually agreeable to the respondent and the representative.

(d) Each paper filed in a disciplinary proceeding shall contain therein a certificate of service indicating:

(1) The date of which service was made and

(2) The method by which service was made.

(e) The administrative law judge or the Commissioner may require that a paper be served by hand or by "Express Mail."

(f) Service by mail is completed when the paper mailed in the United States is placed into the custody of the U.S. Postal Service.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]



**§ 10.143 Motions.**

Motions may be filed with the administrative law judge. The administrative law judge will determine on a case-by-case basis the time period for response to a motion and whether replies to responses will be authorized. No motion shall be filed with the administrative law judge unless such motion is supported by a written statement by the moving party that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in an effort in good faith to resolve by agreement the issues raised by the motion and has been unable to reach agreement. If issues raised by a motion are resolved by the parties prior to a decision on the motion by the administrative law judge, the parties shall promptly notify the administrative law judge.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.144 Hearings.**

(a) The administrative law judge shall preside at hearings in disciplinary proceedings. Hearings will be stenographically recorded and transcribed and the testimony of witnesses will be received under oath or affirmation. The administrative law judge shall conduct hearings in accordance with 5 U.S.C. 556. A copy of the transcript of the hearing shall become part of the record. A copy of the transcript shall be provided to the Director and the respondent at the expense of the Office.

(b) If the respondent to a disciplinary proceeding fails to appear at the hearing after a notice of hearing has been given by the administrative law judge, the administrative law judge may deem the respondent to have waived the right to a hearing and may proceed with the hearing in the absence of the respondent.

(c) A hearing under this section will not be open to the public except that the Director may grant a request by a respondent to open his or her hearing to the public and make the record of the disciplinary proceeding available for public inspection, *provided*, Agreement is reached in advance to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations. If a disciplinary proceeding results in disciplinary action against a practitioner, and subject to § 10.159(c), the

record of the entire disciplinary proceeding, including any settlement agreement, will be available for public inspection.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.145 Proof; variance; amendment of pleadings.**

In case of a variance between the evidence and the allegations in a complaint, answer, or reply, if any, the administrative law judge may order or authorize amendment of the complaint, answer, or reply to conform to the evidence. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint, answer, or reply, as amended, and the administrative law judge shall make findings on any issue presented by the complaint, answer, or reply as amended.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.146 - 10.148 [Reserved]****§ 10.149 Burden of proof.**

In a disciplinary proceeding, the Director shall have the burden of proving his or her case by clear and convincing evidence and a respondent shall have the burden of proving any affirmative defense by clear and convincing evidence.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

**§ 10.150 Evidence.**

(a) *Rules of evidence.* The rules of evidence prevailing in courts of law and equity are not controlling in hearings in disciplinary proceedings. However, the administrative law judge shall exclude evidence which is irrelevant, immaterial, or unduly repetitious.

(b) *Depositions.* Depositions of witnesses taken pursuant to § 10.151 may be admitted as evidence.

(c) *Government documents.* Official documents, records, and papers of the Office are admissible without extrinsic evidence of authenticity. These documents, records, and papers may be evidenced by

a copy certified as correct by an employee of the Office.

(d) *Exhibits.* If any document, record, or other paper is introduced in evidence as an exhibit, the administrative law judge may authorize the withdrawal of the exhibit subject to any conditions the administrative law judge deems appropriate.

(e) *Objections.* Objections to evidence will be in short form, stating the grounds of objection. Objections and rulings on objections will be a part of the record. No exception to the ruling is necessary to preserve the rights of the parties.

[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.151 Depositions.

(a) Depositions for use at the hearing in lieu of personal appearance of a witness before the administrative law judge may be taken by respondent or the Director upon a showing of good cause and with the approval of, and under such conditions as may be deemed appropriate by, the administrative law judge. Depositions may be taken upon oral or written questions, upon not less than ten days written notice to the other party, before any officer authorized to administer an oath or affirmation in the place where the deposition is to be taken. The requirement of ten days notice may be waived by the parties and depositions may then be taken of a witness at a time and place mutually agreed to by the parties. When a deposition is taken upon written questions, copies of the written questions will be served upon the other party with the notice and copies of any written cross-questions will be served by hand or "Express Mail" not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise. A party on whose behalf a deposition is taken shall file a copy of a transcript of the deposition signed by a court reporter with the administrative law judge and shall serve one copy upon the opposing party. Expenses for a court reporter and preparing, serving, and filing depositions shall be borne by the party at whose instance the deposition is taken.

(b) When the Director and the respondent agree in writing, a deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the Director and the respondent. The deposition shall not be

filed with the administrative law judge and may not be admitted in evidence before the administrative law judge unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the administrative law judge who may reject the deposition on any reasonable basis including the fact that demeanor is involved and that the witness should have been called to appear personally before the administrative law judge.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.152 Discovery.

Discovery shall not be authorized except as follows:

(a) After an answer is filed under § 10.136 and when a party establishes in a clear and convincing manner that discovery is necessary and relevant, the administrative law judge, under such conditions as he or she deems appropriate, may order an opposing party to:

- (1) Answer a reasonable number of written requests for admission or interrogatories;
- (2) Produce for inspection and copying a reasonable number of documents; and
- (3) Produce for inspection a reasonable number of things other than documents.

(b) Discovery shall not be authorized under paragraph (a) of this section of any matter which:

- (1) Will be used by another party solely for impeachment or cross-examination;
- (2) Is not available to the party under 35 U.S.C. § 122;
- (3) Relates to any disciplinary proceeding commenced in the Patent and Trademark Office prior to March 8, 1985;
- (4) Relates to experts except as the administrative law judge may require under paragraph (e) of this section.

- (5) Is privileged; or
- (6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.

(c) The administrative law judge may deny discovery requested under paragraph (a) of this section if the discovery sought:

- (1) Will unduly delay the disciplinary proceeding;

(2) Will place an undue burden on the party required to produce the discovery sought; or

(3) Is available (i) generally to the public, (ii) equally to the parties; or (iii) to the party seeking the discovery through another source.

(d) Prior to authorizing discovery under paragraph (a) of this section, the administrative law judge shall require the party seeking discovery to file a motion (§ 10.143) and explain in detail for each request made how the discovery sought is necessary and relevant to an issue actually raised in the complaint or the answer.

(e) The administrative law judge may require parties to file and serve, prior to any hearing, a pre-hearing statement which contains:

(1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief,

(2) A list of proposed witnesses,

(3) As to each proposed expert witness:

(i) An identification of the field in which the individual will be qualified as an expert;

(ii) A statement as to the subject matter on which the expert is expected to testify; and

(iii) A statement of the substance of the facts and opinions to which the expert is expected to testify,

(4) The identity of government employees who have investigated the case, and

(5) Copies of memoranda reflecting respondent's own statements to administrative representatives.

(f) After a witness testifies for a party, if the opposing party requests, the party may be required to produce, prior to cross-examination, any written statement made by the witness.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.153 Proposed findings and conclusions; post-hearing memorandum.

Except in cases when the respondent has failed to answer the complaint, the administrative law judge, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

### § 10.154 Initial decision of administrative law judge.

(a) The administrative law judge shall make an initial decision in the case. The decision will include (1) a statement of findings and conclusions, as well as the reasons or basis therefor with appropriate references to the record, upon all the material issues of fact, law, or discretion presented on the record, and (2) an order of suspension or exclusion from practice, an order of reprimand, or an order dismissing the complaint. The administrative law judge shall file the decision with the Director and shall transmit a copy to the representative of the Director and to the respondent. In the absence of an appeal to the Commissioner, the decision of the administrative law judge will, without further proceedings, become the decision of the Commissioner of Patents and Trademarks thirty (30) days from the date of the decision of the administrative law judge.

(b) The initial decision of the administrative law judge shall explain the reason for any penalty or reprimand, suspension or exclusion. In determining any penalty, the following should normally be considered:

(1) The public interest;

(2) The seriousness of the violation of the Disciplinary Rule;

(3) The deterrent effects deemed necessary;

(4) The integrity of the legal profession; and

(5) Any extenuating circumstances.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]

### § 10.155 Appeal to the Commissioner.

(a) Within thirty (30) days from the date of the initial decision of the administrative law judge under § 10.154, either party may appeal to the Commissioner. If an appeal is taken, the time for filing a cross-appeal expires 14 days after the date of service of the appeal pursuant to § 10.142 or 30 days after the date of the initial decision of the administrative law judge, whichever is later. An appeal or cross-appeal by the respondent will be filed and served with the Director in duplicate and will include exceptions to the

























































































































































































